



## Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

9 December 2014\*

(Community trade mark — Opposition proceedings — Application for the Community figurative mark PROFLEX — Earlier national word mark PROFEX — Genuine use of the earlier mark — Article 42(2) and (3) of Regulation (EC) No 207/2009)

In Case T-278/12,

**Inter-Union Technohandel GmbH**, established in Landau in der Pfalz (Germany), represented by K. Schmidt-Hern and A. Feutlinske, lawyers,

applicant,

v

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

defendant,

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

**Gumersport Mediterranea de Distribuciones, SL**, established in Barcelona (Spain),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 27 March 2012 (Case R 413/2011-2), concerning opposition proceedings between Inter-Union Technohandel GmbH and Gumersport Mediterranea de Distribuciones, SL,

THE GENERAL COURT (First Chamber),

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

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 22 June 2012,

having regard to the response lodged at the Court Registry on 4 October 2012,

having regard to the reply lodged at the Court Registry on 9 January 2013,

\* Language of the case: English.

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur and pursuant to Article 135a of the Rules of Procedure of the General Court, to give a ruling without an oral procedure,

gives the following

## Judgment

### Background to the dispute

- 1 On 13 December 2005, Gumersport Mediterranea de Distribuciones, SL, ('Gumersport Mediterranea') filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).
- 2 The mark in respect of which registration was sought is the figurative sign reproduced below:



- 3 The goods in respect of which registration was sought are in Classes 9, 12 and 25 under the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the purposes of Registration of Marks, as revised and amended, and correspond, for each of those classes, to the following description:
  - Class 9: 'Protective helmets for sports, sports glasses, sunglasses; speed indicators, automatic indicators of low pressure in vehicle tyres';
  - Class 12: 'Vehicles; vehicles for locomotion by air, land or water; bicycles and bicycle accessories, bicycle bells, inner tubes for bicycles, bicycle frames, tyres for bicycles, bicycle hubs, gears for bicycles, bicycle brakes, bicycle mudguards, direction indicators for bicycles, bicycle rims, bicycle handles, cranks for bicycles, motors for bicycles (mopeds); bicycle tyres, pedals for bicycles, spokes for bicycles, dress guards for bicycles, wheels for bicycles, bicycle saddles, bicycle stands, cycle bells, tubeless tyres for bicycles, bicycle chains, special baskets for bicycles, rear view mirrors, repair outfits for inner tubes, bicycle carriers, anti-skid chains, bicycle frames, axles, spoke clips for wheels, tricycles';
  - Class 25: 'Shirts, T-shirts, blouses, windcheaters, sweatshirts, parkas, jackets, trousers, gloves (clothing), socks, stockings, underwear, pyjamas, nightdresses, waistcoats, cloaks, shawls, coats, mufflers, jerseys, skirts, dresses, neckties, belts, braces, swimsuits, sportswear included in this class; clothing and footwear for cyclists; anti-sweat underclothing; caps, raincoats, anoraks; dressing gowns; stoles, headscarves; suits; slippers; footwear and headgear; knitwear (clothing)'.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 26/2006 of 26 June 2006.

- 5 On 6 September 2006, the applicant — Inter-Union Technohandel GmbH — filed a notice of opposition, pursuant to Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009), to registration of the trade mark applied for in respect of all the goods referred to in paragraph 3 above.
- 6 The opposition was based on the German word mark PROFEX, registered as No 39628817 on 12 February 1997 and renewed on 14 July 2006, covering the following goods in Classes 6, 8, 9, 11, 12, 16, 17 and 21: ‘chain locks, shackle locks, wire rope locks, spiral locks, cable locks; thermometers, speedometers, milometers and compasses for land vehicles; protective helmets, protective gloves; electrical fuses, fuse holders, electric generators and dynamos for land vehicles; electric and electronic alarm systems; mechanical anti-theft devices (other than for land vehicles); accessories for land vehicles, specifically headlights, rear headlights, rear lights, indicator lights, hand lights, map-reading lights, bulbs and reflectors; accessories for land vehicles, specifically steering-wheel covers, emergency toolkits, exhaust embellishers, ornamental hub caps, tank caps, mud flaps, backrests, seat-belt upholstery, head cushions, seat covers, child’s seats, rear-view mirrors, actuator buttons (not metal), door buffers, air pumps, drinks flasks, kick stands, mechanical anti-theft devices for vehicles; spare parts for land vehicles, specifically tyres, hoses, brakes, brake clips, brake blocks, brake cables, brake levers, control gear, rear derailleur, gear-shift levers, shift cables, cogwheels, chains, chain guards, mudguards/splashguards, pedals, bells, bicycle saddles, bicycle handlebars, bicycle front attachments; trailers for land vehicles; child’s seats for land vehicles; accessories for land vehicles, specifically baskets, boxes, containers and retainers for luggage and small items, luggage racks, saddle, handlebar and frame bags (empty); notepads, adhesive signs, adhesive tape, insulating tape; accessories for land vehicles, specifically foils, shades, blinds and screens made of plastic for use as sun shields’.
- 7 The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).
- 8 During the procedure, OHIM — acting at the request of Gumersport Mediterranea — asked Inter-Union Technohandel to provide proof of genuine use of the earlier mark, for the purposes of Article 43(2) and (3) of Regulation No 40/94 (now Article 42(2) and (3) of Regulation No 207/2009). Inter-Union Technohandel produced in that connection various items of evidence examined by the Opposition Division.
- 9 By decision of 2 July 2009, the Opposition Division rejected the opposition in its entirety pursuant to Article 42(2) and (3) of Regulation No 207/2009, finding that Inter-Union Technohandel had not produced sufficient evidence to prove genuine use of the earlier trade mark.
- 10 On 26 August 2009, Inter-Union Technohandel filed an appeal with OHIM, under Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division of 2 July 2009.
- 11 By decision of 14 June 2010, the Second Board of Appeal of OHIM annulled the decision of the Opposition Division and referred the case back to the Opposition Division. The Board of Appeal held in essence that, by failing to consider certain evidence adduced by Inter-Union Technohandel, the Opposition Division had relied on an incomplete factual basis in taking its decision.
- 12 On 17 December 2010, the Opposition Division gave a new decision in which it concluded that genuine use of the earlier mark had been established with regard to some of the goods for which it was registered, namely, various types of accessories for bicycles and motor vehicles. According to the Opposition Division, the goods for which the earlier mark was used are either explicitly mentioned in the evidence lodged, or fall within the following subcategories of the earlier mark: mechanical anti-theft devices (other than for land vehicles); accessories for land vehicles, specifically headlights, rear headlights, rear lights, indicator lights, hand lights, map-reading lights, bulbs and reflectors; accessories for land vehicles, specifically steering-wheel covers, exhaust embellishers, seat-belt upholstery, head cushions, seat covers, child’s seats, rear-view mirrors, air pumps, drinks flasks, kick

stands; spare parts for land vehicles, specifically tyres, hoses, brakes, brake clips, brake blocks, brake cables, brake levers, control gear, rear derailleur, gear-shift levers, shift cables, cogwheels, chains, chain guards, mudguards/splashguards, pedals, bells, bicycle saddles, bicycle handlebars, bicycle front attachments; trailers for land vehicles; accessories for land vehicles, specifically foils, shades, blinds and screens made of plastic for use as sun shields and in particular shackle locks, spiral locks; thermometers, speedometers, milometers and compasses for land vehicles; protective helmets, child's seats for land vehicles.

- 13 The Opposition Division then examined the likelihood of confusion and partially upheld the opposition with regard to 'protective helmets for sports; speed indicators, automatic indicators of low pressure in vehicle tyres' in Class 9 and 'vehicles; vehicles for locomotion by land; bicycles and bicycle accessories, bicycle bells, inner tubes for bicycles, bicycle frames, tyres for bicycles, bicycle hubs, gears for bicycles, bicycle brakes, bicycle mudguards, direction indicators for bicycles, bicycle rims, bicycle handles, cranks for bicycles, motors for bicycles (mopeds); bicycle tyres, pedals for bicycles, spokes for bicycles, dress guards for bicycles, wheels for bicycles, bicycle saddles, bicycle stands, cycle bells, tubeless tyres for bicycles, bicycle chains, special baskets for bicycles, rear view mirrors, repair outfits for inner tubes, bicycle carriers, anti-skid chains, bicycle frames, axles, spoke clips for wheels, tricycles' in Class 12. The Opposition Division therefore refused the application for a Community trade mark in respect of those goods.
- 14 On 16 February 2011, Gumersport Mediterranea filed a notice of appeal with OHIM against the Opposition Division's decision of 17 December 2010 to the extent that it partially upheld the opposition and refused the application for a Community trade mark.
- 15 By decision of 27 March 2012 ('the contested decision'), the Second Board of Appeal of OHIM upheld the appeal and annulled the Opposition Division's decision of 17 December 2010.
- 16 The first point made by the Board of Appeal was that the appeal covered the goods in respect of which the opposition had been upheld and the application for a Community trade mark refused, namely, the Class 9 and Class 12 goods referred to in paragraph 13 above (paragraphs 13 and 14 of the contested decision).
- 17 The Board of Appeal went on to find in essence that, contrary to the finding made by the Opposition Division, Inter-Union Technohandel had not demonstrated the extent of the use and had consequently failed to prove genuine use of the earlier mark (paragraphs 32 to 39 of the contested decision). The Board of Appeal therefore concluded that the opposition fell to be rejected under Article 42(2) and (3) of Regulation No 207/2009 and Rule 22(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended (paragraph 40 of the contested decision).

### **Forms of order sought**

- 18 Inter-Union Technohandel claims that the Court should:
- annul the contested decision;
  - order OHIM to pay the costs.
- 19 OHIM contends that the Court should:
- dismiss the action;
  - order Inter-Union Technohandel to pay the costs.

## Law

- 20 Inter-Union Technohandel relies on two pleas in law in support of its action: (i) infringement of Article 42(2) and (3) of Regulation No 207/2009 and Rule 22 of Regulation No 2868/95; and (ii) infringement of Article 76(1) of Regulation No 207/2009.
- 21 The Court considers it appropriate to begin by examining the first plea.
- 22 By that plea, Inter-Union Technohandel submits that the Board of Appeal was wrong in concluding that the evidence before it did not establish the extent of the use of the earlier mark. Inter-Union Technohandel argues, in essence, that the Board of Appeal erred in its assessment of the evidence produced during the administrative procedure. That erroneous assessment arises, in particular, as a result of the fact that the Board of Appeal applied the wrong criteria — that is to say, criteria that were ‘too demanding’ — in determining whether genuine use of the earlier mark had been proved.
- 23 OHIM disputes Inter-Union Technohandel’s arguments.
- 24 It should be noted that, under Article 42(2) and (3) of Regulation No 207/2009, an applicant for a Community trade mark against which an opposition is filed may require proof that the earlier national mark, relied on in support of that opposition, has been put to genuine use during the five years preceding the date on which the application was published.
- 25 Furthermore, under Rule 22(3) of Regulation No 2868/95, as amended, proof of use must relate to the place, time, extent and nature of the use of the earlier mark.
- 26 According to settled case-law, it follows from the abovementioned provisions, read also in the light of recital 10 in the preamble to Regulation No 207/2009, that the *ratio legis* for the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a Community trade mark application is to restrict the number of conflicts between two marks where there is no good commercial justification deriving from the active functioning of the mark on the market. On the other hand, those provisions are not intended to give rise to an assessment of an undertaking’s commercial success or a review of its economic strategy; nor are they intended to restrict trade mark protection to cases where large-scale commercial use has been made of the marks (see, to that effect, judgment of 8 July 2004 in *Sunrider v OHIM — Espadafor Caba (VITAFRUIT)*, T-203/02, EU:T:2004:225, paragraphs 36 to 38 and the case-law cited).
- 27 It can be said that there is genuine use of a mark where it is 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, in order to create or preserve an outlet for those goods or services, but genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (see, by analogy, judgment of 11 March 2003 in *Ansul*, C-40/01, EU:C:2003:145, paragraph 43). Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (judgment in *VITAFRUIT*, paragraph 26 above, EU:T:2004:225, paragraph 39; see also, to that effect and by analogy, judgment in *Ansul*, EU:C:2003:145, paragraph 37).
- 28 In assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (judgment in *VITAFRUIT*, paragraph 26 above, EU:T:2004:225, paragraph 40; see also, to that effect and by analogy, judgment in *Ansul*, paragraph 27 above, EU:C:2003:145, paragraph 43).

- 29 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of time for which the mark was used and the frequency of use (judgments in *VITAFRUIT*, paragraph 26 above, EU:T:2004:225, paragraph 41, and of 8 July 2004 in *MFE Marienfelde v OHIM — Vétoquinol (HIPOVITON)*, T-334/01, EU:T:2004:223, paragraph 35).
- 30 In order to determine whether use of an earlier trade mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (judgments in *VITAFRUIT*, paragraph 26 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, paragraph 29 above, EU:T:2004:223, paragraph 36).
- 31 Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (judgments of 12 December 2002 in *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)*, T-39/01, EU:T:2002:316, paragraph 47, and of 6 October 2004 in *Vitakraft-Werke Wührmann v OHIM — Krafft (VITAKRAFT)*, T-356/02, EU:T:2004:292, paragraph 28).
- 32 It is in the light of those considerations that the present plea must be examined.
- 33 Given that the application for a Community trade mark filed by Gumersport Mediterranea was published on 26 June 2006, the five-year period referred to in Article 42(2) and (3) of Regulation No 207/2009 spans the period from 26 June 2001 to 25 June 2006, as the Board of Appeal correctly found in paragraph 25 of the contested decision.
- 34 It can be seen from paragraph 28 of the contested decision that, in order to assess whether the use of the earlier mark during the relevant period was genuine, the Board of Appeal took into account the following evidence submitted by Inter-Union Technohandel.
- 35 First, the Board of Appeal took into account a document sent by Inter-Union Technohandel to Deutsche Bahn AG and dated 5 March 2007, which set out a table showing the yearly turnover achieved between 1997 and 2006 from the sale of bicycle accessories marketed under the earlier mark.
- 36 Second, the Board of Appeal took into account an affidavit, signed on 30 October 2009 by Mr S., Inter-Union Technohandel's authorised representative. Appended to that document were tables, also signed and dated, displaying information on the turnover from the sale of a number of bicycle and motor vehicle accessories marketed under the earlier mark.
- 37 Third, the Board of Appeal took into account three bills from R & P, an advertising agency, for the production of catalogues and other promotional material for equipment marketed under the earlier mark.
- 38 Fourth, the Board of Appeal took into account examples of advertising for the earlier mark.
- 39 Fifth, the Board of Appeal took into account an article in German from May 2002, which referred to the earlier mark in the title and text.
- 40 Sixth, the Board of Appeal took into account three articles in the monthly magazine *test*, published by the Stiftung Warentest (the official foundation for product testing). Two of the articles, from April 2005, referred to bicycle helmets marketed under the earlier mark. The third article, from June 2002, referred to a car seat marketed under the earlier mark.

- 41 Seventh and lastly, the Board of Appeal took into account catalogues for the years 2002, 2005 and 2006 on bicycle and motor vehicle accessories marketed under the earlier mark.
- 42 In the contested decision, the Board of Appeal found, consistently with the decision of the Opposition Division, that the evidence adduced established that the period of use of the earlier mark fell within the relevant period (paragraph 29 of the contested decision). Moreover, the Board of Appeal upheld the Opposition Division's finding that the earlier mark was used in Germany (paragraph 30 of the contested decision). The Board of Appeal also found, consistently with the decision of the Opposition Division, that the evidence adduced showed that the earlier mark was used as registered (paragraph 31 of the contested decision).
- 43 On the other hand, the Board of Appeal disagreed with the Opposition Division regarding the extent of the use of the earlier mark.
- 44 The Board of Appeal found that, given the 'clear' links between the signatory of the affidavit and Inter-Union Technohandel, probative value could not be attributed to that statement unless it was substantiated by other evidence (paragraph 36 of the contested decision).
- 45 The Board of Appeal went on to find, in essence, that the other evidence provided by Inter-Union Technohandel did not substantiate the content of the affidavit and that, in consequence, the extent of the use of the earlier mark had not been established (paragraphs 37 to 40 of the contested decision).
- 46 Inter-Union Technohandel first of all takes issue with the Board of Appeal for not finding that the affidavit and the turnover tables appended thereto constituted, in themselves, sufficient proof of genuine use of the earlier mark.
- 47 In that regard, Inter-Union Technohandel maintains that the affidavit meets the criteria required under the relevant EU legislation. It also submits that the Board of Appeal failed to take proper account of the meaning and cogency of an affidavit under German law. Such a statement is admissible as evidence in a German court and any false statement is punishable under Paragraph 156 of the Strafgesetzbuch (German Criminal Code). Lastly, Inter-Union Technohandel submits that the Board of Appeal failed to take into account the fact that the affidavit appeared to be sound and reliable.
- 48 It should be noted that Mr S.'s affidavit is signed and dated. In that affidavit, Mr S. states that he has been informed that his statement was to be submitted to OHIM and that making a false statement was a criminal offence. In that document, Mr S. declared that Inter-Union Technohandel widely sells bicycle and motor vehicle accessories under the earlier mark. Mr S. appended to the affidavit turnover tables, also signed and dated, setting out information on the turnover achieved through the sale of bicycle and motor vehicle accessories between 2001 and 2006. That information was broken down by year and by product. Mr S. stated that approximately 90% of turnover came from sales in Germany. He also declared that the effects of his affidavit extended to the turnover figures mentioned in the appended tables. Lastly, he indicated that the catalogues of goods marketed under the earlier mark — including the catalogues produced before OHIM during the administrative procedure — were sent to all buying agents, marketing directors and department heads of large retailers.
- 49 It should be observed that the affidavit is a '[statement] in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up' for the purposes of Article 78(1)(f) of Regulation No 207/2009. In the light of that provision, read together with Rule 22(4) of Regulation No 2868/95, it must be held that that affidavit constitutes evidence of use of the mark (see, to that effect, judgments of 7 June 2005 in *Lidl Stiftung v OHIM — REWE-Zentral (Salvita)*, T-303/03, ECR, EU:T:2005:200, paragraph 40, and 28 March 2012 in *Rehbein v OHIM — Dias Martinho (OUTBURST)*, T-214/08, ECR, EU:T:2012:161, paragraph 32). The parties disagree on the probative value to be attributed to the affidavit.

- 50 On that point, in order to assess the probative value of a document, it is necessary first and foremost to determine the credibility of the information that it contains. It is then necessary to take account of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (judgments in *Salvita*, paragraph 49 above, EU:T:2005:200, paragraph 42, and of 13 June 2012 in *Süid-Chemie v OHIM — Byk-Cera (CERATIX)*, T-312/11, EU:T:2012:296, paragraph 29).
- 51 Furthermore, it follows from the case-law that, where a statement has been established for the purposes of Article 78(1)(f) of Regulation No 207/2009 by one of the applicant company's executives, probative value can be attributed to that statement only if it is supported by other evidence (see, to that effect, judgments of 13 May 2009 in *Schuhpark Fascies v OHIM — Leder & Schuh (jello SCHUHPARK)*, T-183/08, EU:T:2009:156, paragraph 39, and *CERATIX*, paragraph 50 above, EU:T:2012:296, paragraph 30; and of 12 March 2014 in *Globosat Programadora v OHIM — Sport TV Portugal (SPORT TV INTERNACIONAL)*, T-348/12, EU:T:2014:116, paragraph 33).
- 52 In the present case, although Mr S.'s affidavit is affirmed and contains, inter alia, information — in the form of turnover tables broken down by product and by year — relating to the extent of the use of the earlier mark in Germany, it should be noted that it originates with one of Inter-Union Technohandel's executives and not a third party who could reasonably be expected to be more objective. Consequently, in accordance with the case-law referred to in paragraphs 50 and 51 above, the Board of Appeal was correct to find, in paragraph 36 of the contested decision, that, given the 'clear' links between the signatory of the affidavit and Inter-Union Technohandel, probative value could not be attributed to that statement unless it was supported by other evidence.
- 53 Inter-Union Technohandel's argument concerning the probative force attributed to the affidavit under German law does not call into question the above conclusion. Regardless of the probative value that may be attributed to that affidavit under German law, it must be held that there is nothing in either Regulation No 207/2009 or Regulation No 2868/95 to substantiate a finding that the probative value of items of evidence relating to use of the mark, including written statements as referred to in Article 78(1)(f) of Regulation No 207/2009, must be assessed in the light of the national law of a Member State (see, to that effect, judgments of *Salvita*, paragraph 49 above, EU:T:2005:200, paragraph 42, and *jello SCHUHPARK*, paragraph 51 above, EU:T:2009:156, paragraph 38).
- 54 On the basis of the foregoing, it is necessary to reject Inter-Union Technohandel's submission that the Board of Appeal should have found that Mr S.'s affidavit constituted, in itself, sufficient proof of genuine use of the earlier mark.
- 55 Next, it is necessary to consider whether the Board of Appeal was correct in finding that the other evidence provided by Inter-Union Technohandel during the administrative procedure did not substantiate the content of the affidavit.
- 56 First, the Board of Appeal was correct in finding, in paragraph 38 of the contested decision, that Mr S.'s affidavit was not substantiated by the document that Inter-Union Technohandel had sent to Deutsche Bahn (see paragraph 35 above). As the Board of Appeal pointed out, that document could not substantiate the affidavit, because it was unsigned, it did not specify the goods concerned and the turnover figures mentioned in that document were different from those mentioned in the affidavit. Nevertheless, the Court finds that the turnover figures indicated in the document sent to Deutsche Bahn, albeit different from the figures set out in Mr S.'s affidavit, do not contradict those figures, as OHIM suggested in its reply to the Court. The turnover figures quoted in the document sent to Deutsche Bahn are higher, in respect of the same years, than those mentioned in Mr S.'s affidavit, since — as can be seen from that document — those figures relate to all bicycle accessories sold, while the turnover figures in the affidavit concern specific accessories. Consequently, even though the document sent to Deutsche Bahn does not substantiate the content of the affidavit, it does not diminish its probative value.



57 Second, in paragraph 37 of the contested decision, the Board of Appeal stated that the affidavit could not be substantiated by the catalogues (see paragraph 41 above) or by the articles on product testing (see paragraph 40 above). The findings made in two paragraphs of the contested decision appear to have been intended to justify that assertion on the part of the Board of Appeal.

58 In the first place, after stating that Mr S.'s affidavit could not be substantiated by the catalogues or by the articles on product testing, the Board of Appeal made the following findings in paragraph 37 of the contested decision:

'On this point [namely, the question of the extent of the use] attached to the affidavit were turnover figures from 2001 to 2006 for several bicycle and car accessory items under the earlier mark PROFLEX to which the affidavit refers, but these turnover figures have been elaborated by the opponent itself and the fact that the affidavit includes them by reference does not mean that they are either corroborated by the catalogues or by the cited articles.'

59 That passage, taken from paragraph 37 of the contested decision, does not provide a sound basis for the Board of Appeal's finding that the affidavit could not be substantiated by the catalogues or by the articles on product testing.

60 In the second place, the Board of Appeal states as follows in paragraph 39 of the contested decision, referring to the judgment of 8 March 2012 in *Arrieta D. Gross v OHIM — International Biocentric Foundation and Others (BIODANZA)*, T-298/10, (EU:T:2012:113):

'The advertisements, catalogues, and magazine articles cannot prove the fact that they were distributed to a potential German clientele, or the extent of any distribution, or the number of sales or contracts made for the goods protected by the mark. The mere existence of advertisements, catalogues, and magazine articles could, at most, make it probable or credible that the goods advertised under the earlier mark were sold or, at least, offered for sale within the relevant territory, but it cannot prove that fact and still less the extent of the use as was unduly supposed by the ... decision [of the Opposition Division] ([see] 5 March 2012, T-298/10, "BIODANZA", paragraph 36).'

61 It is clear from paragraph 39 of the contested decision that the Board of Appeal, relying on the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), found that the various catalogues, magazine articles and advertisements produced by Inter-Union Technohandel — including the articles on product testing published in Stiftung Warentest's magazine *test* — could not demonstrate any use, let alone the extent of use, of the earlier mark and accordingly did not substantiate the content of Mr. S.'s affidavit.

62 However, the Board of Appeal was under a duty to consider whether the other evidence produced by Inter-Union Technohandel — apart from Mr S.'s affidavit — substantiated the content of that statement for the purposes of establishing the extent of the use of the earlier mark. It appears from the contested decision that the Board of Appeal did not deny that the affidavit and the appended turnover tables provided sufficient information, particularly as regards commercial volume, length and frequency of use (see paragraph 29 above), for the purposes of establishing the extent of the use of the earlier mark in relation, at the very least, to the goods mentioned in the affidavit and in the appended turnover tables. The Board of Appeal merely questioned, correctly, the reliability of the information given in the affidavit because of the 'clear' links between its signatory and Inter-Union Technohandel.

63 In other words, the Board of Appeal was under a duty to consider whether the evidence, other than the affidavit, substantiated the information given in that statement and should not have confined itself to considering whether that evidence — in itself, without the affidavit — established the extent of the use of the earlier mark. Were the Board of Appeal to proceed in such a manner, it would effectively divest Mr S.'s affidavit of all probative value. However, the Court has stated that the fact that a statement made in accordance with Article 78(1)(f) of Regulation No 207/2009 was from an employee

of the company concerned — like Mr S.'s affidavit in the present case — cannot, by itself, deprive that statement of all value (see, to that effect, judgment in *CERATIX*, paragraph 50 above, EU:T:2012:296, paragraph 30 and the case-law cited).

- 64 In the light of that preliminary observation, the Court finds that the Board of Appeal did not carry out a proper examination of the evidence produced by Inter-Union Technohandel, namely, Mr S.'s affidavit and the 'advertisements, catalogues and magazine articles', including the articles published in Stiftung Warentest's magazine *test*. As can be seen from paragraphs 37 and 39 of the contested decision, the Board of Appeal considered whether the 'articles on actual product tests' and 'advertisements, catalogues, and magazine articles' alone could demonstrate the extent of the use of the earlier mark and, relying on the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), concluded that they could not. No part of the contested decision shows that the Board of Appeal examined the content of Mr S.'s affidavit in conjunction with the 'advertisements, catalogues and magazine articles', including the articles published in Stiftung Warentest's magazine *test*. That finding is confirmed by the reference made by the Board of Appeal to the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), in which, as is also pointed out in paragraphs 69 and 70 below, the question at issue was whether the advertising material used by the proprietor of the earlier mark — which was the only evidence produced for the purposes of demonstrating the genuine use of that mark — could demonstrate such use.
- 65 The present case differs on the facts from the case that led to the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), in that the Board of Appeal had before it a number of items of evidence from various sources, produced by Inter-Union Technohandel, and was under a duty to consider whether the evidence substantiated the content of the affidavit and confirmed the veracity of the information given in that statement.
- 66 The contested decision is affected by that incorrect examination carried out by the Board of Appeal, which is a sufficient basis for its annulment.
- 67 Additionally, irrespective of the incorrect examination, the Court finds that the Board of Appeal also erred with regard to the assessment of the probative value of the articles on product testing published in Stiftung Warentest's magazine *test*.
- 68 According to paragraph 39 of the contested decision, the Board of Appeal found that 'the advertisements, catalogues and magazine articles', including the articles published in Stiftung Warentest's magazine *test*, could not prove use of the earlier mark, let alone the extent of that use. In that connection, the Board of Appeal relied on the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113).
- 69 In its judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), the Court had to consider whether the advertising material placed by the proprietor of the earlier mark in magazines, or distributed by the proprietor in the form of leaflets or flyers, was proof of the genuine use of that mark. In the case giving rise to that judgment, the advertising material was the only evidence produced by the proprietor of the earlier mark for the purposes of demonstrating genuine use of that mark (judgment in *BIODANZA*, paragraph 60 above, EU:T:2012:113, paragraphs 63 to 66).
- 70 In that context, the Court held in paragraphs 68 and 69 of the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), that the genuine use of the mark in question could not be proved simply by producing copies of advertising material mentioning that mark in relation to the intended goods or services. The Court stated that it must also be demonstrated that, regardless of its nature, that material has been sufficiently distributed to the relevant public to establish the genuine nature of the use of the trade mark at issue. The Court added that, where advertising has appeared in the printed

press, that entails adducing evidence of the distribution of the newspaper or of the magazine concerned to the relevant public and that it cannot be otherwise unless the advertising has appeared in newspapers or magazines that are very well known, the circulation of which is a well-known fact.

- 71 In the present case, the Board of Appeal erred by relying on the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), in order to hold, in paragraph 39 of the contested decision, that the articles on product testing published in Stiftung Warentest's magazine *test* could not prove the extent of the use of the earlier mark.
- 72 Clearly, the articles on product testing published in Stiftung Warentest's magazine *test* are different in nature and function from the advertising material at issue in the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113).
- 73 More specifically, the function of the advertising material at issue in the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113) was to promote the sale of a product or service covered by the mark concerned, which did not entail providing information on its actual use. It is because of that lack of information that the Court pointed out the need for the proprietor of the earlier mark to demonstrate that the advertising material had been sufficiently distributed to the relevant public, with the exception of cases in which that distribution was a well-known fact.
- 74 By contrast, the function of the articles produced by Inter-Union Technohandel from Stiftung Warentest's magazine *test* is not to advertise a product, but to present its advantages and disadvantages and to compare it with identical products marketed under other trade marks, in order to help consumers in their choice of purchase. More fundamentally, it is clear from the content of those articles that they relate to products which are already on the market. Those articles contain information on the average price of the products on the market.
- 75 Accordingly, unlike the advertising material at issue in the judgment in *BIODANZA*, paragraph 60 above (EU:T:2012:113), the articles produced by Inter-Union Technohandel from Stiftung Warentest's magazine *test* provide information concerning the extent of the use of the earlier mark in relation to the products tested, which the Board of Appeal should have taken into account and considered together with the other evidence produced, and especially with Mr S.'s affidavit. For the same reasons, the Board of Appeal should also have taken into account the references, in the advertising catalogues submitted by Inter-Union Technohandel during the administrative procedure, to tests carried out by Stiftung Warentest.
- 76 Lastly, it should be noted that, given the nature and function of Stiftung Warentest's magazine *test*, the extent of its distribution to the relevant public — an issue widely discussed by the parties in their written pleadings submitted to the Court — is not a decisive factor. Whatever the extent of their distribution, the articles from the magazine *test* provide, by dint of the very fact that they concern goods marketed under the earlier mark, information on the extent of its use in relation to those goods and accordingly have a probative value that ought to have been taken into account by the Board of Appeal.
- 77 It is clear from paragraphs 62 to 66 above that, in failing to consider whether the advertisements, catalogues and magazine articles, including the articles on product testing published in Stiftung Warentest's magazine *test*, substantiated the content of Mr S.'s affidavit and the appended turnover tables, the Board of Appeal carried out an incorrect assessment of the evidence. It is also clear, from paragraphs 67 to 75 above, that the Board of Appeal erred in refusing to attribute any probative value to the articles on product testing published in Stiftung Warentest's magazine *test* or to Inter-Union Technohandel's advertising catalogues, which contain references to tests carried out by the Stiftung Warentest on a number of its products. It must therefore be held that the Board of Appeal infringed Article 42(2) and (3) of Regulation No 207/2009 and that the contested decision must be annulled.

78 It follows from all the foregoing that the first plea in law raised by Inter-Union Technohandel must be upheld and that the contested decision must be annulled, without there being any need to examine Inter-Union Technohandel's second plea.

### **Costs**

79 Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by Inter-Union Technohandel.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 27 March 2012 (Case R 413/2011-2);**
- 2. Orders OHIM to pay the costs.**

Kanninen

Pelikánová

Buttigieg

Delivered in open court in Luxembourg on 9 December 2014.

[Signatures]