



## Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

13 December 2018\*

[Text rectified by order of 30 April 2019]

(EU trade mark — Invalidity proceedings — EU word mark PLOMBIR — Absolute ground for refusal — Descriptive character — Article 7(1)(c) of Regulation (EC) No 207/2009 (now Article 7(1)(c) of Regulation (EU) 2017/1001) — Examination of the facts — Article 76(1) of Regulation No 207/2009 (now Article 95(1) of Regulation 2017/1001) — Evidence submitted for the first time before the General Court)

In Case T-830/16,

**Monolith Frost GmbH**, established in Leopoldshöhe (Germany), represented by E. Liebich and S. Labesius, lawyers,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by A. Söder, D. Walicka and M. Fischer, acting as Agents,

defendant,

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

**Dovgan GmbH**, established in Hamburg (Germany), represented by J.-C. Plate and R. Kaase, lawyers,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 22 September 2016 (Case R 1812/2015-4), relating to invalidity proceedings between Monolith Frost and Dovgan,

THE GENERAL COURT (First Chamber),

composed of I. Pelikánová, President, V. Valančius and U. Öberg (Rapporteur), Judges,

Registrar: R. Ukelyte, Administrator,

having regard to the application lodged at the Registry of the General Court on 23 November 2016,

having regard to the response of EUIPO lodged at the Registry of the General Court on 20 February 2017,

\* Language of the case: German.

having regard to the response of the intervener lodged at the Registry of the General Court on 6 March 2017,

further to the hearing on 17 April 2018,

gives the following

## Judgment

### Background to the dispute

- 1 On 14 June 2010, the intervener, Dovgan GmbH, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced 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)).
- 2 The trade mark in respect of which registration was sought is the word sign PLOMBIR.
- 3 The goods and services for which registration was sought are in Classes 29 and 30 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, and correspond, in relation to each of those classes, to the following description:
  - Class 29: ‘Compotes, eggs, milk, and milk products’;
  - Class 30: ‘Ices, coffee, cocoa’.
- 4 The trade mark application was published in *Community Trade Marks Bulletin* No 2011/118 of 27 June 2011. The trade mark was registered as an EU trade mark on 4 October 2011 under number 009171695 in respect of the goods referred to in paragraph 3 above.
- 5 On 12 May 2014, the applicant, Monolith Frost GmbH, filed an application with EUIPO for a declaration of partial invalidity of the trade mark PLOMBIR in respect of the goods referred to in paragraph 3 above, on the basis of the provisions of Article 52(1)(a) in conjunction with the provisions of Article 7(1)(c) of Regulation No 207/2009 (now Article 59(1)(a) and Article 7(1)(c) of Regulation 2017/1001).
- 6 In support of its application, the applicant relied on the requirement of availability for export and asserted that the contested mark was the transliteration into Latin characters of the word ‘Пломбир’, meaning ‘ice-cream’ in Russian. It submitted that the descriptive character of the contested mark would be perceived by persons residing in Germany and in other EU countries, such as the Baltic States, who understand Russian.
- 7 By decision of 14 July 2015, the Cancellation Division of EUIPO upheld the application for a declaration of invalidity in respect of some of the goods in Classes 29 (milk and milk products) and 30 (ices) (‘the goods at issue’).
- 8 On 9 November 2015, the intervener filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the decision of the Cancellation Division. It filed a statement setting out the grounds of appeal on 16 November 2015.

- 9 By decision of 22 September 2016 ('the contested decision'), the Fourth Board of Appeal of EUIPO annulled the Cancellation Division's decision and rejected the application for a declaration of invalidity in its entirety. In particular, first, it considered that even if the goods at issue targeted, in this case, at any end consumer, irrespective of age, income or linguistic knowledge, the assessment of the contested mark's descriptive character should be restricted to German territory, since the evidence submitted and the explanations provided by the applicant related to that territory alone.
- 10 Secondly, the Board of Appeal found that the applicant had not proved that a sufficiently significant percentage of the end consumers of the goods at issue in Germany had a good command of Russian, in so far as the evidence submitted in that regard was either unreliable or unsuitable.
- 11 Thirdly, the Board of Appeal found that the applicant had failed to prove that the relevant public would have a clear understanding of the meaning of 'plombir'. In that regard, in so far as the relevant German public would have to transliterate the word 'plombir' into Cyrillic characters and recognise it as the Russian word 'Пломбир' in order to be able to attribute a descriptive meaning to it, that public would be required to make a twofold mental effort. Finally, the Board found that it did not have sufficient evidence to conclude that the word 'plombir', or 'Пломбир', was Russian for 'ices'.

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

- 12 The applicant claims that the Court should:
- annul the contested decision;
  - order EUIPO to pay the costs, including those incurred before the Board of Appeal.
- 13 EUIPO and the intervener contend that the Court should:
- dismiss the action;
  - order the applicant to pay the costs.

### **Law**

#### ***The admissibility of the documents produced for the first time before the General Court***

- 14 EUIPO and the intervener contend that some documents were submitted for the first time before the General Court, namely Annexes K6 to K12 and K14 and K15 to the application and Annexes K16 to K24 to the request for a hearing, which concern the comprehension of Russian in Germany and in the rest of the European Union, including, in particular, in the Baltic States, the definition of the word 'Пломбир' in online dictionaries and the use of the word 'plombir' for descriptive purposes to designate ice-cream in Germany.
- 15 In that regard, it should be noted that the purpose of actions before the General Court is to review the legality of decisions of the Boards of Appeal of EUIPO for the purposes of Article 65 of Regulation No 207/2009 (now Article 72 of Regulation 2017/1001), so it is not the Court's function to review the facts in the light of documents produced for the first time before it (see, to that effect, judgments of 13 March 2007, *OHIM v Kaul*, C-29/05 P, EU:C:2007:162, paragraph 54, and of 21 April 2005, *Ampafrance v OHIM — Johnson & Johnson (monBeBé)*, T-164/03, EU:T:2005:140, paragraph 29).

- 16 However, neither the parties nor the Court itself can be precluded from drawing on national legislation, case-law or academic writing, where it is not alleged that the Board of Appeal failed to take the factual aspects of a specific national judgment into account, but rather reliance is placed on judgments or academic writing in support of a plea alleging that the Board of Appeal misapplied a provision of Regulation No 207/2009 (see judgment of 18 March 2016, *Karl-May-Verlag v OHIM — Constantin Film Produktion (WINNETOU)*, T-501/13, EU:T:2016:161, paragraph 18 and the case-law cited).
- 17 In the present case, Annexes K7 to K9 to the application consist of a number of decisions of the Bundespatentgericht (Federal Patent Court, Germany). However, their main purpose is to establish that the German public specialising in trade with Russia understands Russian and, therefore, to criticise the Board of Appeal for not having taken into account the facts, rather than to determine the content of national law. In accordance with the case-law referred to in paragraph 16 above, they must therefore be deemed inadmissible.
- 18 Conversely, contrary to what is alleged by EUIPO and the intervener, Annex K6 to the application, which contains excerpts from a 2014 market study of the Federal Ministry of Food and Agriculture, should be found to be admissible, since that market study provided a basis for the decision of the Bundespatentgericht (Federal Patent Court, Germany) of 6 April 2016 (28 W (pat) 17/13) and it constitutes an addition to a piece of evidence which had already been submitted to the adjudicating bodies of EUIPO.
- 19 In the circumstances of the present case, Annexes K10 to K12 to the application must also be declared admissible. Although they were produced for the first time before the General Court, they are intended to establish the accuracy of a well-known fact, namely the fact that Russian is understood in the Baltic States. As it is, the applicant is entitled to produce documents before the Court as evidence of the accuracy of a well-known fact which was not established in the decision of the body of EUIPO contested before the Court (see, to that effect, judgment of 10 November 2011, *LG Electronics v OHIM*, C-88/11 P, not published, EU:C:2011:727, paragraphs 29 and 30 and the case-law cited, and of 20 June 2012, *Kraft Foods Schweiz v OHIM — Compañía Nacional de Chocolates (CORONA)*, T-357/10, not published, EU:T:2012:312, paragraph 16 and the case-law cited).
- 20 As regards Annexes K14 and K15 to the application and Annexes K16 to K24 to the request for a hearing, it should be noted that the former seek to dispute the findings of the Board of Appeal that led to the annulment of the Cancellation Division's decision, and that the latter seek to respond to the EUIPO's arguments in the first round of pleadings.
- 21 In that regard, it is clear from the case-law that evidence in rebuttal and the amplification of previous evidence, submitted in response to evidence in rebuttal put forward by the opposing party in his defence, are not covered by the time-bar rule in Article 85(1) of the Rules of Procedure of the General Court, which provides that evidence produced or offered is to be submitted in the first exchange of pleadings. Indeed, that provision concerns fresh evidence and must be read in the light of Article 92(7) of the Rules of Procedure, which expressly provides that evidence may be submitted in rebuttal and previous evidence may be amplified (judgment of 22 June 2017, *Biogena Naturprodukte v EUIPO (ZUM wohl)*, T-236/16, EU:T:2017:416, paragraph 17; see also, by analogy, judgments of 17 December 1998, *Baustahlgewebe v Commission*, C-185/95 P, EU:C:1998:608, paragraph 72, and of 12 September 2012, *Italy v Commission*, T-394/06, not published, EU:T:2012:417, paragraph 45).
- 22 In those circumstances, it must be concluded that Annexes K16 to K24 to the request for a hearing are admissible on the same basis as annexes K14 and K15 to the application and all the other documents produced by the applicant for the first time before the General Court, with the exception of Annexes K7 to K9 to the application.

23 As regards the document produced by the intervener during the hearing, which consists of a decision of the Bundesgerichtshof (Federal Court of Justice, Germany) of 6 July 2017 annulling the decision of the Bundespatentgericht (Federal Patent Court, Germany) of 6 April 2016, it should be observed that the Court refused to allow that document to be added to the case file at the hearing, on the ground that it had been submitted late.

### *Substance*

24 In support of its action, the applicant raises three pleas in law alleging (i) infringement of Article 7(1)(c) of Regulation No 207/2009, (ii) infringement of the principle, laid down in Article 76(1) of that regulation (now Article 95(1) of Regulation 2017/1001), that EUIPO is to examine the facts of its own motion, and (iii) infringement of the obligation to state reasons, laid down in Article 75 of the same regulation (now Article 94 of Regulation 2017/1001).

25 The Court will examine, first, the second plea, and then, the first and third pleas.

### *The second plea, alleging infringement of Article 76(1) of Regulation No 207/2009*

26 By the second plea, the applicant alleges that the Board of Appeal did not take into account well-known facts relating to the dissemination of Russian in Germany and the Baltic States which the applicant had already relied on before the Cancellation Division.

27 EUIPO and the intervener dispute the applicant's arguments.

28 It should be noted, first, that by its argument that it is well known that Russian is understood in Germany, the applicant seeks to call into question the merits of the Board of Appeal's conclusion that, in essence, it cannot be inferred from matters of common knowledge that a significant proportion of the relevant German public understands Russian, rather than to allege that the Board failed to assess the accuracy of such a statement.

29 In so far as the question whether or not the Board of Appeal correctly assessed certain facts, arguments or evidence comes under the examination of the substantive legality of the contested decision, and not the lawfulness of the procedure which led to its adoption, the applicant's argument should be found to be irrelevant in the context of the second plea, which seeks to establish the infringement of the principle, laid down in Article 76(1) of Regulation No 207/2009, that EUIPO is to examine the facts of its own motion (see, to that effect, judgment of 18 May 2017, *Reisswolf v EUIPO (secret.service.)*, T-163/16, not published, EU:T:2017:350, paragraph 21).

30 Secondly, the applicant's argument that it is well known that Russian is understood in the Baltic States seeks, in essence, to dispute the Board of Appeal's conclusion that there was no need to take into account Baltic State nationals in the definition of the relevant public, on the ground that the applicant merely asserted, without providing any evidence thereof, that those countries had a high proportion of Russian speakers.

31 In that regard, it is clear from the case-law that the presumption of validity of an EU trade mark in invalidity proceedings restricts EUIPO's obligation, under Article 76(1) of Regulation No 207/2009, to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal. As the registered EU trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity of that mark to invoke before EUIPO the specific facts which call the validity of that trade mark into question (see, to that effect, judgments of 13 September 2013,



*Fürstlich Castell'sches Domänenamt v OHIM — Castel Frères (CASTEL)*, T-320/10, EU:T:2013:424, paragraphs 27 and 28, and of 28 September 2016, *European Food v EUIPO — Société des produits Nestlé (FITNESS)*, T-476/15, EU:T:2016:568, paragraphs 47 and 48).

- 32 For the purposes of challenging the validity of a registered EU trade mark, the applicant in invalidity proceedings may, however, rely on well-known facts. According to the case-law, well-known facts are facts which are likely to be known by anyone or which may be learnt from generally accessible sources (judgments of 22 June 2004, *Ruiz-Picasso and Others v OHIM — DaimlerChrysler (PICARO)*, T-185/02, EU:T:2004:189, paragraph 29, and of 8 September 2010, *Wilfer v OHIM (Representation of the head of a guitar)*, T-458/08, not published, EU:T:2010:358, paragraph 72).
- 33 Moreover, it is clear from the case-law that, where the bodies of EUIPO decide to take account of well-known facts, they are not obliged to establish in their decisions the accuracy of such facts (see judgments of 1 March 2016, *Peri v OHIM (Multirop)*, T-538/14, not published, EU:T:2016:117, paragraph 14 and the case-law cited, and of 21 September 2017, *Novartis v EUIPO — Meda (Zimara)*, T-238/15, not published, EU:T:2017:636, paragraph 123).
- 34 Similarly, the parties to proceedings before the adjudicating bodies of EUIPO cannot be criticised for not providing evidence of the accuracy of well-known facts. It is only after stating that the well-known facts alleged by the parties to invalidity proceedings cannot be regarded as such that the Board of Appeal may, where appropriate, disregard them on the ground that the parties have not provided sufficient evidence of their accuracy.
- 35 In the light of all the foregoing, it must be concluded that the Board of Appeal infringed Article 76(1) of Regulation No 207/2009 in so far as it excluded Baltic State nationals from the definition of the relevant public solely because of the absence of concrete evidence that Russian is understood in those countries, without ruling beforehand on whether it is well known, as had been claimed by the applicant, that Russian is commonly understood by the population in those countries.
- 36 Accordingly, in so far as the Board of Appeal did not take into account the applicant's argument that a significant proportion of the population of the Baltic States speaks Russian, and failed to determine whether that fact is well known, it must be concluded that the second plea is well founded.
- 37 That finding alone is not, however, sufficient to warrant annulment of the contested decision inasmuch as the error committed by the Board of Appeal, relating to the infringement of Article 76(1) of Regulation No 207/2009, could not have had a decisive effect on the outcome (see, to that effect, judgment of 12 September 2007, *Philip Morris Products v OHIM (Shape of a packet of cigarettes)*, T-140/06, not published, EU:T:2007:272, paragraph 72)
- 38 It is only if the first plea is well-founded, particularly as regards the descriptive meaning that the contested mark could have for the Russian-speaking part of the relevant public residing, in some circumstances, in the Baltic States in particular, that the error noted in paragraph 36 above would have an effect on the outcome of the examination and may, therefore, justify the annulment of the contested decision.

*The first plea, alleging infringement of Article 7(1)(c) of Regulation No 207/2009*

- 39 By the first plea, which is divided into four parts, the applicant submits, in the first place, that the Board of Appeal's definition of the relevant public is incorrect in that it failed to take into account either the specialist public in the European Union engaged in trade with Russia, or the Russian-speaking public in the European Union.

- 40 In the second place, the applicant submits that the Board of Appeal did not correctly assess, in accordance with Article 7(2) of Regulation No 207/2009 (now Article 7(2) of Regulation 2017/1001), the part of the European Union in respect of which the absolute ground of refusal referred to in Article 7(1)(c) of that regulation could apply.
- 41 In the third place, the applicant disputes the Board of Appeal's assessment as regards the meaning of the word 'Пломбир' in Russian. In the fourth place, the applicant disputes the Board of Appeal's assessment as regards the relevant public's perception of the transliteration of that word into Latin characters (plombir).
- 42 EUIPO and the intervener dispute the applicant's arguments. They contend, in essence, that the applicant has failed to prove that the word 'plombir' or 'Пломбир' would be understood to mean ice-cream in Russian. They take the view, in any event, that that descriptive meaning will not be perceived by the relevant public. According to EUIPO, there is no widespread awareness of where Russian is understood in the European Union. The intervener contends that, in so far as Russian is a foreign language for EU citizens, it fell to the applicant to demonstrate that the word 'plombir' was part of the basic vocabulary in that language.
- 43 It should be borne in mind that Article 52(1)(a) of Regulation No 207/2009 provides that an EU trade mark is to be declared invalid where it has been registered contrary to the provisions of Article 7 of that regulation. Under Article 7(1)(c) of that regulation, the following are not to be registered: 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service'.
- 44 Article 7(1)(c) of Regulation No 207/2009 pursues an aim that is in the public interest, which requires that signs or indications that may serve, in trade, to designate characteristics of the goods or services for which registration is sought, may be freely used by all. That provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks, and prevents an undertaking from monopolising the use of a descriptive term to the detriment of other undertakings, including its competitors, for whom the extent of the vocabulary available to describe their own products is thereby reduced (see judgment of 25 November 2015, *Ewald Dörken v OHIM — Schürmann (VENT ROLL)*, T-223/14, not published, EU:T:2015:879, paragraph 20 and the case-law cited).

– *The first and second parts of the first plea*

- 45 The first and second parts of the first plea should be examined together in so far as they seek to establish the inaccuracy of the Board of Appeal's assessment concerning the relevant public and the part of the European Union in the light of which the descriptive character of the contested mark should be assessed.
- 46 According to settled case-law, the descriptive character of a sign must be assessed, first, in relation to the goods or services concerned and, second, in relation to the perception of the public targeted, which is composed of the consumers of those goods or services (judgments of 27 February 2002, *Eurocool Logistik v OHIM (EUROCOOL)*, T-34/00, EU:T:2002:41, paragraph 38, and of 22 May 2008, *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, T-254/06, not published, EU:T:2008:165, paragraph 33; see, also, judgment of 17 May 2011, *Consejo Regulador de la Denominación de Origen Txakoli de Álava and Others v OHIM (TXAKOLI)*, T-341/09, EU:T:2011:220, paragraph 20 and the case-law cited).

- 47 In the present case, the Board of Appeal held, in paragraph 16 of the contested decision, that the goods covered by the contested trade mark targeted any end consumer in the European Union, and the applicant does not challenge that assessment.
- 48 However, the applicant submits that the Board of Appeal was wrong not to assess the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 207/2009 in relation to, on the one hand, the public specialising in trade with Russia and, on the other, Russian-speaking consumers who are members of the general public of the European Union and reside, in particular, in Germany and the Baltic States.
- 49 In that regard, the applicant disputes, in essence, the Board of Appeal's interpretation of the concept of 'part of the Union', within the meaning of Article 7(2) of Regulation No 207/2009, which provides that a trade mark is to be refused registration as an EU trade mark 'notwithstanding that the [absolute] grounds of non-registrability obtain in only part of the Union'. It submits that the Board of Appeal should have examined the descriptive character of the contested trade mark from the point of view of Russian-speaking consumers who are members of the general public of the European Union and reside, in particular, in Germany and the Baltic States as 'part of the Union' within the meaning of that provision.
- 50 In that regard, it should be pointed out that, in paragraph 18 of the contested decision, the Board of Appeal found that, unlike a Member State or group of Member States, a cross-border minority cannot constitute a 'part of the Union', within the meaning of Article 7(2) of Regulation No 207/2009.
- 51 As the Court held in its judgment of 22 June 2006, *Storck v OHIM* (C-25/05 P, EU:C:2006:422, paragraph 83), the part of the Union referred to in Article 7(2) of Regulation No 207/2009 may consist of a single Member State.
- 52 However, it cannot be inferred from that case-law, arising from the particular facts of that case, that the EU judicature therefore intended to interpret the terms 'part of the [Union]' in Article 7(2) of Regulation No 207/2009 as not being applicable to a territory smaller than the territory of a Member State. It is clear from the choice of the terms used in that article that the legislature was seeking to make it impossible to register a sign where grounds for refusal exist in part of one or more Member States (see, to that effect, judgment of 13 September 2012, *Sogepi Consulting y Publicidad v OHIM (ESPETEC)*, T-72/11, not published, EU:T:2012:424, paragraphs 35 and 36).
- 53 Moreover, Article 7(2) of Regulation No 207/2009 cannot be understood as necessarily referring, in the case of a word mark, to one of the official languages of a Member State of the European Union (judgment of 13 September 2012, *ESPETEC*, T-72/11, not published, EU:T:2012:424, paragraph 36; see, also, judgment of 19 July 2017, *Lackmann Fleisch-und Feinkostfabrik v EUIPO (медведь)*, T-432/16, not published, EU:T:2017:527, paragraph 28 and the case-law cited).
- 54 In view of the foregoing, as the applicant submits, pursuant to Article 7(2) of Regulation No 207/2009, the relevant public in relation to which the absolute ground for refusal should be assessed consists of Russian-speaking consumers who are members of the general public in the European Union, since the applicant claims that the contested mark is descriptive in Russian.
- 55 [As rectified by order of 30 April 2019] As regards the applicant's argument that Russian-speaking consumers in the European Union reside, in particular, in Germany and in the Baltic States, first, it should be found that, contrary to what the Board of Appeal concluded in paragraphs 23 and 24 of the contested decision, the evidence which the applicant submitted to the Board establishes conclusively that a significant proportion of the German population speaks Russian. It is apparent from the judgment of the Landgericht Köln (District Court, Cologne, Germany) of 27 January 2016, which the applicant produced before the Board of Appeal, that there is a population of approximately three million Russian-speakers in German territory.



- 56 Secondly, as regards the question whether a significant proportion of Russian-speaking EU citizens reside in the Baltic States, it should be noted that EUIPO acknowledged at the hearing that it was well known that Russian is generally understood in the Baltic States.
- 57 Furthermore, the General Court recently confirmed that it was well known that a significant proportion of Baltic State nationals know Russian or speak it as their mother tongue (see, to that effect, judgment of 19 July 2017, *медведь*, T-432/16, not published, EU:T:2017:527, paragraph 29). The applicant rightly notes that the First Board of Appeal of EUIPO had reached the same conclusion in the decision of 17 May 2016, which was the subject of that judgment, and in another decision of 20 June 2013 given in case R 814/2012-1, which is also cited in the application.
- 58 In that regard, it is clear from the case-law that the examination of any trade mark application must be stringent and full and must be undertaken in each individual case (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraph 77). The legality of the decisions of the Boards of Appeal of EUIPO must be assessed solely on the basis of Regulation No 207/2009 as interpreted by the European Union judicature, and not on the basis of a previous decision-making practice (see judgment of 8 May 2012, *Mizuno v OHIM — Golfino (G)*, T-101/11, not published, EU:T:2012:223, paragraph 77 and the case-law cited; see also, to that effect, judgments of 26 April 2007, *Alcon v OHIM*, C-412/05 P, EU:C:2007:252, paragraph 65, and of 2 May 2012, *Universal Display v OHIM (UniversalPHOLED)*, T-435/11, not published, EU:T:2012:210, paragraph 37).
- 59 However, in the light of the case-law requiring EUIPO to take into account the decisions already adopted and consider with special care whether it should decide in the same way or not (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraph 74), it must be found that the earlier decisions referred to by the applicant clearly constituted recent evidence that it could be regarded as a ‘well-known fact’ that Russian is understood in the European Union and, in particular, in the Baltic States, since that fact was also taken into account by the adjudicating bodies of EUIPO in the context of those decisions.
- 60 In those circumstances, and without there being any need to assess the merits of the applicant’s argument concerning the existence of a public specialised in trade with Russia, it should be concluded that the Board of Appeal committed an error of assessment in determining the relevant public, and infringed Article 7(2) of Regulation No 207/2009, since the relevant public in relation to which the absolute ground for refusal ought to have been assessed was the Russian-speaking public, which includes the general public within the European Union which understands or speaks Russian and resides, in particular, in Germany and in the Baltic States.
- 61 Therefore, the first and second parts of the first plea must be upheld.

– *The third and fourth parts of the first plea*

- 62 By the third part of the first plea, the applicant disputes, in essence, the Board of Appeal’s finding that the applicant had failed to establish that the word ‘Пломбир’ had a descriptive meaning in Russian for the goods covered by the contested mark. By the fourth part of the first plea, it challenges the Board of Appeal’s conclusion that ‘the mental effort’ which the relevant public is required to make, namely an effort to transliterate and translate, does not prove that the public perceives any descriptive meaning in the word ‘plombir’.
- 63 EUIPO and the intervener dispute the applicant’s arguments.

- 64 As regards, first, the meaning of the word ‘Пломбир’ (‘plombir’ in Russian), it should be noted that the Cancellation Division of EUIPO, without being challenged on this point by the Board of Appeal in the contested decision, considered that the word ‘Пломбир’ was used, at the time of the former Union of Soviet Socialist Republics (USSR), to describe a sort of ice-cream.
- 65 The Board of Appeal did not mention any evidence to support the conclusion that the word ‘plombir’ was no longer in use in Russia. Accordingly, although paragraph 30 of the contested decision states that the expressions ‘edible ices’ or ‘ice-cream’ translate as ‘(сливотсчноје) моросченоје’ (сливочное мороженое) in German-Russian dictionaries, it cannot be established on the basis of those considerations alone that the word ‘Пломбир’ or ‘plombir’ is not also used, in Russian, to describe those products or a variety of those products.
- 66 Furthermore, it should be noted that it is clear from paragraph 32 of the contested decision and from EUIPO’s case file that the applicant submitted to the Board of Appeal extracts from the 2003 GOST technical standards, in which the goods described by the word ‘plombir’ and the goods described by the word ‘moroschenoje’ come under the same classification number (52175-2003). Those official standards, established by the State Committee for the Russian Federation for Standardisation, Metrology and Certification after the collapse of the former USSR, constitute concrete evidence for the purpose of establishing that the word ‘plombir’ or ‘Пломбир’ is a common Russian word for edible ices.
- 67 The applicant also produced before the Board of Appeal the decision of the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) of 12 March 2013, confirming that ‘plombir’ or ‘Пломбир’ was, including at the time that decision was adopted, a Russian word for ice-cream.
- 68 It follows that the applicant has submitted to the Board of Appeal sufficient evidence to establish that ‘plombir’ or ‘Пломбир’ was a Russian descriptive term for the goods in question.
- 69 Moreover, it should be noted that the dictionary excerpts, which the applicant produced for the first time before the General Court (Annexes K16 and K17 of the request for a hearing), confirm that that word is commonly used in Russian for ice-cream.
- 70 The intervener’s argument that it is necessary to take into account the use of the word ‘plombir’ or ‘Пломбир’ for other goods cannot call that finding into question. According to settled case-law, the fact that an expression could have several meanings does not mean that it is not descriptive, for the purposes of Article 7(1)(c) of Regulation No 207/2009. It is sufficient that, in at least one of its meanings, the trade mark could be used in a way that is descriptive of the goods at issue (see judgment of 12 February 2004, *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraph 97 and the case-law cited).
- 71 Secondly, as regards the perception of the contested trade mark by Russian-speaking consumers in the EU residing, in particular, in the Baltic States and Germany, it should be noted that, for a sign to come within the scope of Article 7(1)(c) of Regulation No 207/2009, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgment of 22 June 2005, *Metso Paper Automation v OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraph 25 and the case-law cited).
- 72 In the present case, contrary to what the Board of Appeal held in the contested decision, the Russian-speaking public will more readily associate the word ‘plombir’, rather than the word ‘Пломбир’, with the descriptive meaning ‘ice-cream’ in Russian, since all of that public has a command of the Latin alphabet, but not necessarily the Cyrillic alphabet.

- 73 As the applicant argues, the Russian-speaking public in the European Union is also likely to use means of communication which cannot process Cyrillic characters, and is therefore accustomed to transliterating Russian words into Latin characters.
- 74 It should be recalled, moreover, that the transliteration into Latin characters of a word from another alphabet does not necessarily prevent the relevant public from perceiving the descriptive meaning of that word (see, to that effect, judgment of 16 December 2010, *Deutsche Steinzeug Cremer & Breuer v OHIM (CHROMA)*, T-281/09, EU:T:2010:537, paragraph 34 and the case-law cited).
- 75 In the present case, it follows from the foregoing that, in so far as the word ‘plombir’ constitutes a faithful transliteration of the word ‘Пломбир’ into characters from the Latin alphabet known to the relevant Russian-speaking consumer in the European Union, its descriptive meaning is capable of being immediately and directly grasped by that consumer.
- 76 Accordingly, the third and fourth parts of the first plea and, consequently, the first plea in its entirety, should be upheld.
- 77 In the light of the foregoing considerations, and without there being any need to examine the third plea alleging infringement of the obligation to state reasons provided for in Article 75 of Regulation No 207/2009, the contested decision must be annulled.

#### **Costs**

- 78 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings.
- 79 Under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal of EUIPO are to be regarded as recoverable costs.
- 80 Since EUIPO has been unsuccessful, it must be ordered to bear its own costs and to pay those incurred by the applicant, in accordance with the form of order sought by the applicant. Those also include the costs necessarily incurred by the applicant for the purposes of the proceedings before the Board of Appeal of EUIPO.
- 81 Since the intervener has been unsuccessful, it must be ordered to bear its own costs.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 22 September 2016 (Case R 1812/2015-4);**
- 2. Orders EUIPO to bear its own costs and to pay those incurred by Monolith Frost GmbH, including the costs necessarily incurred by Monolith Frost GmbH for the purposes of the proceedings before the Board of Appeal of EUIPO;**
- 3. Orders Dovgan GmbH to bear its own costs.**

Pelikánová

Valančius

Öberg

Delivered in open court in Luxembourg on 13 December 2018.

[Signatures]