



Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

7 May 2019*

(EU trade mark – Application for an EU figurative mark representing a car in a speech bubble – Admissibility of the appeal before the Board of Appeal – Article 49(1) of Regulation (EU) 2017/1001 – Restriction of the list of goods or services covered by the mark applied for – Article 27(5) of Delegated Regulation (EU) 2018/625 – Extent of the examination to be carried out by the Board of Appeal – Obligation to adjudicate on a request for restriction)

In Case T-629/18,

mobile.de GmbH, established in Dreilinden (Germany), represented by T. Lührig, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by M. Fischer, acting as Agent,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 7 August 2018 (Case R 2653/2017-4), concerning an application for the registration of a figurative sign representing a car in a speech bubble as a European Union trade mark,

THE GENERAL COURT (First Chamber),

composed of I. Pelikánová, President, P. Nihoul and J. Svenningsen (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 18 October 2018,

having regard to the response lodged at the Court Registry on 20 December 2018,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

* Language of the case: German.

Judgment

Background to the dispute

1 On 30 June 2016, the applicant, mobile.de 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 Registration as a mark was sought for the following figurative sign:



3 The goods and services in respect of which registration was sought are in Classes 9, 12, 16, 25, 28, 35 to 38, 41, 42 and 45 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.

4 By letter of 22 July 2016, the EUIPO examiner raised objections to the registration of the mark concerned in respect of some of the goods and services at issue on the basis of Article 7(1)(b) of Regulation No 207/2009 (now Article 7(1)(b) of Regulation 2017/1001), on the ground that it was devoid of distinctive character.

5 On 25 November 2016, in response to that letter from the examiner, the applicant submitted observations contesting all of the examiner's objections.

6 By letter of 23 March 2017, the examiner partly withdrew her objections in respect of some of the goods and services initially referred to in her letter of 22 July 2016. The applicant was asked to submit its observations or to supply other evidence to establish the distinctive character acquired through use of the mark concerned for the goods and services in respect of which the examiner had maintained her objections. Those further observations were submitted by the applicant on 24 July 2017.

7 By decision of 3 October 2017, the examiner refused registration of the mark concerned for the goods and services mentioned in her letter of 23 March 2017, pursuant to Articles 7(1)(b) and 42(2) of Regulation 2017/1001.

8 On 15 December 2017, the applicant filed a notice of appeal with EUIPO, seeking annulment of the examiner's decision in so far as she had rejected the application for registration of the mark concerned.

9 On 16 February 2018, the applicant submitted two documents to EUIPO, one of which contained a request for restriction of the list of goods and services in respect of which registration of the mark had initially been sought. That request for restriction covered all the goods and services in respect of which registration had been refused by the examiner.

- 10 On the same day, the applicant submitted another document, entitled ‘Statement of grounds of appeal/notice concerning the restriction of the trade mark application’ which included, as an annex, the request for restriction submitted previously.
- 11 On 6 April 2018, following a request by EUIPO, the applicant had to re-submit its request for restriction of the list of goods and services for which registration of the mark concerned had been sought, in a different format (PDF) and in an amended form, but still with the same content.
- 12 On 10 May 2018, the Registry of the Boards of Appeal acknowledged receipt of the two requests for restriction, lodged on 16 February and 6 April 2018 respectively.
- 13 By letter of 6 June 2018, EUIPO notified the applicant that the appeal had been remitted to the Fourth Board of Appeal pursuant to Article 69(2) of Regulation 2017/1001, since the examiner had not rectified the decision.
- 14 By decision of 7 August 2018 (‘the contested decision’), the Fourth Board of Appeal of EUIPO dismissed the appeal as inadmissible, pursuant to the third sentence of Article 68(1) of Regulation 2017/1001, read in conjunction with Article 23(1)(d) of Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation 2017/1001 and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1), on the ground that the second document submitted by the applicant on 16 February 2018, entitled ‘Statement of grounds of appeal/notice concerning the restriction of the trade mark application’, did not meet the necessary criteria for constituting a statement of grounds of appeal under Article 22(1)(b) of the Delegated Regulation.
- 15 The Board of Appeal stated that, in the aforementioned document of 16 February 2018, the applicant merely referred to the annex containing the request for restriction of the list of goods and services in respect of which registration of the mark concerned had been sought by way of explanation for the fact that that request for restriction related to all the goods and services in respect of which the examiner had refused registration and which formed the sole subject of the appeal and that, for that reason, it had decided to file an application for a declaration that there was no need to adjudicate. Based on those considerations, the Board of Appeal took the view that that document did not contain any element justifying why the examiner’s decision should be annulled and that the appeal should therefore be declared inadmissible. Accordingly, since no valid written statement setting out the grounds of appeal had been submitted within four months of the date of notification of the examiner’s decision, the Board of Appeal found that the examiner’s decision had become final.

Forms of order sought

- 16 The applicant claims that the Court should:
 - annul the contested decision;
 - order EUIPO to pay the costs.
- 17 EUIPO endorses the form of order sought by the applicant, including in relation to costs.

Law

- 18 As a preliminary point, it is important to note that so far as its views on procedure are concerned, EUIPO cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed. Nothing

prevents EUIPO from endorsing a head of claim of the applicant's (see, to that effect, judgment of 25 October 2005, *Peek & Cloppenburg v OHIM (Cloppenburg)*, T-379/03, EU:T:2005:373, paragraph 22).

- 19 In the present case, EUIPO's forms of order are admissible in so far as they, and the arguments set out in support thereof, do not go beyond the forms of order sought and the pleas in law put forward by the applicant.
- 20 Despite the fact that the parties concur on the substance of the present case, the action has not become devoid of purpose. Notwithstanding the agreement between the parties, as matters stand, the contested decision has been neither amended nor withdrawn by the Board of Appeal, EUIPO not possessing the power to do so or to give instructions to that effect to the Boards of Appeal, whose independence is enshrined in Article 166(7) of Regulation 2017/1001. Therefore, the Court is not relieved of the need to examine the lawfulness of the contested decision in the light of the pleas in law put forward in the application initiating the proceedings and there is still a need to adjudicate on the substance (see, to that effect, judgment of 25 October 2005, *Cloppenburg*, T-379/03, EU:T:2005:373, paragraphs 28 and 29).
- 21 In support of its action, the applicant raises four pleas in law, the first alleging infringement of Article 49(1) of Regulation 2017/1001; the second, infringement of the second sentence of Article 71(1) of that regulation; the third, infringement of the fourth sentence of Article 68(1) of Regulation 2017/1001, read in conjunction with Article 23(1)(d) of Delegated Regulation 2018/625; and the fourth, infringement of the fourth sentence of Article 68(1) of Regulation 2017/1001, read in conjunction with Articles 23(1)(e) and 22(1)(b) of Delegated Regulation 2018/625.
- 22 By its first plea, the applicant claims that the Board of Appeal infringed its right to restrict the list of goods and services contained in its trade mark application under Article 49(1) of Regulation 2017/1001. According to the applicant, that right of restriction applies at any time during the proceedings, including during proceedings before the Board of Appeal. As its request was lodged when the examiner's decision was still subject to the suspensive effect of the appeal, the Board of Appeal was required to exercise the powers of the authority which had taken the initial decision, namely the examiner, and to 'take note' of the restriction of the goods and services in respect of which registration of the mark concerned had been sought. That should have led the Board of Appeal to conclude that, as a result of that restriction, which corresponded to the goods and services in respect of which the examiner had refused registration, the initial decision was no longer of any effect and there was no longer any need to adjudicate on the appeal.
- 23 EUIPO essentially supports the applicant's arguments and maintains that it is for the Board of Appeal to adjudicate on a request for restriction of the list of goods and services covered, submitted by a trade mark applicant during the appeal proceedings, in accordance with Article 49(1) of Regulation 2017/1001, at the latest in its decision on the appeal, in accordance with Article 27(5) of Delegated Regulation 2018/625.
- 24 On that point, it should be noted that, once an appeal has been lodged, the Board of Appeal becomes the competent authority to rule on the application for registration of a trade mark. Since the applicant, as the trade mark applicant, had filed a request for restriction of the list of goods and services covered by the application for registration of the trade mark concerned at a time when the examiner's decision to refuse to register that trade mark was being challenged before the Board of Appeal, the Board became the competent authority to adjudicate on such a request for restriction (see, to that effect, judgment of 16 March 2017, *Capella v EUIPO – Abus (APUS)*, T-473/15, not published, EU:T:2017:174, paragraph 36).

- 25 As regards the right of a trade mark applicant to restrict the list of goods and services covered by its trade mark application, it should be borne in mind that, under Article 49(1) of Regulation 2017/1001, a trade mark applicant ‘may at any time withdraw his EU trade mark application or restrict the list of goods or services contained therein’.
- 26 Thus, under Article 49(1) of Regulation 2017/1001, a restriction of the list of goods and services covered by an EU trade mark application may be made at any time, including, therefore, during proceedings before the Board of Appeal (see, to that effect, judgment of 16 March 2017, *APLUS*, T-473/15, not published, EU:T:2017:174, paragraph 37).
- 27 In the present case, it is common ground that the two documents filed by the applicant on 16 February 2018 were submitted after the appeal was lodged with the Board of Appeal and within the time limit for filing a written statement setting out the grounds of appeal as laid down in the last sentence of Article 68(1) of Regulation 2017/1001. Therefore, the request for restriction was submitted during the proceedings before the Board of Appeal in compliance with Article 49(1) of that regulation.
- 28 The first sentence of Article 27(5) of Delegated Regulation 2018/625 provides that the Board of Appeal is to adjudicate on such requests for restriction, declared in accordance with Article 49 of Regulation 2017/1001, at the latest in its decision on the appeal. That obligation on the Board of Appeal to adjudicate on such a request for restriction is separate from the question of whether a statement of grounds of appeal has been filed in accordance with Article 22(1)(b) of Delegated Regulation 2018/625.
- 29 Accordingly, since the applicant submitted a request for restriction of the list of goods or services contained in its application for the registration of the mark concerned, in accordance with Article 49(1) of Regulation 2017/1001, within the prescribed period for filing a statement setting out the grounds of appeal as laid down in the last sentence of Article 68(1) of that regulation, the Board of Appeal was required to examine it.
- 30 Having dismissed the appeal as inadmissible on the ground that the document of 16 February 2018 entitled ‘Statement of grounds of appeal/notice concerning the restriction of the trade mark application’, submitted by the applicant, did not meet the necessary criteria to be admitted as a written statement setting out the grounds of appeal, the Board of Appeal failed to adjudicate on the applicant’s request for restriction of the list of goods and services, in breach of Article 49(1) of Regulation 2017/1001, read in conjunction with Article 27(5) of Delegated Regulation 2018/625.
- 31 Therefore, the first plea must be upheld and, accordingly, the contested decision must be annulled in its entirety, without it being necessary to examine the other three pleas raised by the applicant.

Costs

- 32 Under Article 134(1) 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 EUIPO has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant and by EUIPO.

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 7 August 2018 (Case R 2653/2017-4);**
- 2. Orders EUIPO to pay the costs.**

Pelikánová

Nihoul

Svenningsen

Delivered in open court in Luxembourg on 7 May 2019.

[Signatures]