



Reports of Cases

OPINION OF ADVOCATE GENERAL
SHARPSTON
delivered on 19 December 2019¹

Case C-714/18 P

ACTC GmbH

v

European Union Intellectual Property Office (EUIPO)

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

I. Introduction

1. The present case should lead the Court to rule on the scope of the concept of ‘part of the goods or services’ referred to in Article 42(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [EU] trade mark,² as amended by Regulation (EU) 2015/2424,³ which governs the proof of genuine use of an earlier EU trade mark in the context of opposition proceedings brought by the proprietor of that mark.

2. Although that concept was interpreted by the General Court of the European Union in the judgment of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*,⁴ the Court has not had occasion, however, to confirm the principles set out therein, on which the judgment of 13 September 2018, *ACTC v EUIPO — Taiga (tigha)*,⁵ the subject of this appeal (‘the judgment under appeal’) brought by ACTC GmbH, is based.

¹ Original language: French.

² OJ 2009 L 78, p. 1.

³ Regulation of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21; ‘Regulation No 207/2009’). Regulation No 207/2009 was 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).

⁴ T-126/03, (‘the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*’), EU:T:2005:288.

⁵ T-94/17, not published, EU:T:2018:539.

3. This appeal therefore gives the Court the opportunity to examine an essential component of the analysis relating to the existence of genuine use of the earlier EU trade mark, namely the material extent of that use, following the judgment of 19 December 2012, *Leno Marken*,⁶ which concerned the territorial extent of that use. In particular, the Court is asked to rule on the criterion to be used for defining a subcategory of goods and/or services for which the earlier EU trade mark has been put to genuine use.

4. At the request of the Court, this Opinion will be limited to the analysis of the main new legal issues which arise in this case, namely those raised by the first ground of appeal, alleging infringement of Article 42(2) of Regulation No 207/2009, and by the third complaint of the second part of the second ground of this appeal, relating to the assessment of the conceptual similarity of the signs at issue.

II. Legal framework

5. Article 8(1)(b) of Regulation No 207/2009 provides:

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

...

(b) if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.’

6. The first subparagraph of Article 15(1) of that regulation is worded as follows:

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

7. Article 42(2) of that regulation states:

‘If the applicant so requests, the proprietor of an earlier EU trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of filing or the date of priority of the EU trade mark application, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier EU trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier EU trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.’

⁶ C-149/11, EU:C:2012:816.

III. Background to the dispute

8. The background to the dispute was set out in detail in the judgment under appeal, in particular, in paragraphs 1 to 10 thereof, to which I refer in that regard. The main points needed to understand this Opinion may be summarised as follows.

9. This dispute arises from the opposition filed by Taiga AB, proprietor of the EU word mark TAIGA ('the earlier mark') against registration of the word sign 'tigha' ('the mark applied for') sought by ACTC, in relation to goods in, inter alia, Class 25 of the Nice Agreement⁷ and corresponding to the following description:

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

10. That opposition is based on the existence of a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009.

11. By a decision of 9 February 2015, the Opposition Division rejected the opposition. Taiga filed a notice of appeal against that decision. By a decision of 9 December 2016 ('the contested decision'), the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) partially annulled the decision of the Opposition Division, namely for all the goods at issue, in Class 25 of the Nice Agreement, and consequently rejected the application for registration concerning those goods.

12. In the first place, the Board of Appeal found that the use of the earlier mark had been proved, inter alia, for certain goods in Class 25 of the Nice Agreement (clothing; outer clothing; underwear; headgear for wear and headwear; working overalls; gloves; belts and socks).

13. In the second place, in the context of the assessment of the likelihood of confusion, after having observed that the relevant territory was that of the European Union, and that consumers would pay an enhanced level of attention when buying goods covered by the earlier mark and an average level of attention in respect of certain goods covered by the mark applied for (clothing, footwear, headgear and bags), the Board of Appeal found, in particular, that the goods at issue, in Class 25 of the Nice Agreement, were identical or similar to the goods covered by the earlier mark, that the signs at issue were visually very similar, phonetically identical, at least for English-speaking consumers, and that those signs could not be associated with any concept for the majority of the relevant public. In those circumstances, the Board of Appeal found, regarding the goods in Class 25 of the Nice Agreement, that there was a likelihood of confusion between the marks at issue.

IV. The procedure before the General Court

14. On 13 February 2017, the appellant brought an action before the General Court for the annulment of the contested decision. In support of its action, it relied, in essence, on two pleas in law, alleging infringement, first, of Article 42(2) of Regulation No 207/2009 and, second, of Article 8(1)(b) of that regulation.

15. By the judgment under appeal, the General Court dismissed that action in its entirety.

⁷ Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement').

V. The forms of order sought by the parties and the procedure before the Court of Justice

16. By its appeal, the appellant requests the Court, primarily, to set aside the judgment under appeal and to annul the contested decision and, in the alternative, to set aside that judgment and refer the case back to the General Court. It also asks the Court to order EUIPO to pay the costs.

17. EUIPO requests the Court to dismiss that appeal and to order the appellant to pay the costs.

18. Taiga, for its part, requests the Court to dismiss that appeal and to order the appellant to pay the costs, including those incurred by Taiga.

VI. Assessment

19. In support of its appeal, the appellant puts forward two grounds.

20. The first ground of appeal alleges infringement by the General Court of Article 42(2) of Regulation No 207/2009. By that ground, the appellant asks the Court to adjudicate on the rules and principles applicable to the definition of a subcategory of goods in connection with proof of genuine use of the earlier mark.⁸

21. The second ground of appeal alleges infringement by the General Court of Article 8(1)(b) of that regulation. The appellant criticises the assessments made by the General Court concerning the existence of a likelihood of confusion between the marks at issue and, in particular, concerning the manner in which the examination relating to the conceptual similarity of the conflicting signs was carried out.

A. The first ground of appeal, alleging infringement of Article 42(2) of Regulation No 207/2009

1. The judgment under appeal

22. Before the General Court, the appellant claimed that the proof of use submitted by Taiga did not prove genuine use of the earlier mark for the category of ‘clothing’, as a whole, in Class 25 of the Nice Agreement. In particular, the appellant criticised the Board of Appeal for not having found that there was an independent subcategory of goods covered by the earlier mark, which referred only to special weather protective outdoor clothing.⁹

23. The General Court examined the arguments raised by the appellant in paragraphs 23 to 37 of the judgment under appeal. It recalled, first of all, in paragraph 28 of that judgment, the provisions laid down in Articles 15 and 42 of Regulation No 207/2009. The General Court then recalled the principles it has developed in its own case-law, concerning, on the one hand, in paragraphs 29 to 31 of the judgment under appeal, the *ratio legis* of Article 42 of that regulation, and, on the other hand, in paragraph 32 of that judgment, the criteria to be used for determining whether an independent subcategory of goods exists for the purposes of that provision.

⁸ The issue of genuine use is specific and preliminary in character, since it leads to a determination whether, for the purposes of the examination of the opposition, the earlier trade mark can be deemed to be *registered* in respect of the goods or services in question, that issue thus not falling within the context of the examination of the opposition proper, alleging the existence of a *likelihood of confusion* with that mark.

⁹ In its appeal, the appellant maintains that the subcategory of goods which is claimed to exist comprises the following goods: ‘clothing; outer clothing, underwear, headgear for wear and headwear, gloves; belts and socks; *all aforementioned goods to be used as special weather protective outdoor clothing for the purpose of protection against cold, windy and/or rainy weather conditions only*; working overalls’ (Emphasis added).

24. For the purposes of the analysis, I feel that it would be useful to reproduce those paragraphs:

- ‘29 The provisions of Article 42 of Regulation No 207/2009 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so they cannot be interpreted in such a way as to give rise to an unjustified limitation of the scope of protection of the earlier mark, in particular in the event that the goods or services for which that mark was registered constitute a sufficiently narrowly defined category, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him (see, to that effect, judgment of 14 July 2005, *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraphs 51 and 53).
- 30 If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition [judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 45, and judgment of 13 February 2007, *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, ^[10] (T-256/04, EU:T:2007:46, paragraph 23)].
- 31 However, although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not result in the proprietor of that trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It must be observed in that regard that it is in practice impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories [judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 46, and judgment of 6 March 2014, *Anapurna v OHIM — Annapurna (ANNAPURNA)*, T-71/13, not published, EU:T:2014:105, paragraph 63].
- 32 As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the

¹⁰ Judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*.

definition of subcategories of goods or services (see judgment of 18 October 2016, *August Storck v EUIPO — Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).¹¹

25. After thus recalling the applicable legal rules and case-law principles, the General Court examined, in paragraphs 33 to 36 of the judgment under appeal, whether the proof submitted by Taiga actually made it possible to discern an independent subcategory of goods containing only special weather-protective outdoor clothing.

26. First, the General Court held that the articles referred to in the evidence of use submitted by Taiga have ‘the same purpose, since they are intended to cover the human body, to conceal, adorn and protect it against the elements’ and ‘cannot, in any event, be regarded as “[in essence] different” within the meaning of the case-law referred to in paragraph 31 of the judgment under appeal.¹²

27. Second, the General Court pointed out that the particular characteristics of those goods are, in principle, irrelevant, since, in accordance with the case-law cited in paragraph 32 of the judgment under appeal, they are not relevant to the definition of a subcategory of goods.¹³

28. In paragraph 37 of the judgment under appeal, the General Court consequently rejected that plea.

2. Analysis

29. By the first ground of its appeal, the appellant criticises paragraph 34 of the judgment under appeal in which the General Court held that the articles referred to in the evidence of use submitted by Taiga had the same purpose, since they were intended ‘to cover the human body, to conceal, adorn and protect it against the elements’.

30. The appellant maintains that that analysis is vitiated by two errors of law, since the General Court departed from the rules and principles which it had itself identified in its judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)*.

31. This first ground of appeal is divided into two parts.

32. By the first part of this ground, the appellant complains that the General Court based its assessment not on goods for which the earlier mark was registered but only on the goods referred to in the evidence of use submitted by Taiga. According to the appellant, the question which the General Court should have answered is whether the earlier mark was registered for a category of goods which was sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, so that the use related only to specific goods in a broader category.

33. By the second part of this ground of appeal, the appellant criticises the General Court for not taking into account the fact that those goods are designed to have multiple uses, namely to cover, conceal, adorn or protect the human body, that they are targeted, furthermore, at a different public and, finally, that they are sold in shops which are also different, so that those goods may easily be distinguished from the clothing goods covered by the mark applied for.

¹¹ That case-law consists of the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)* (paragraphs 29 and 31), and the judgment of 16 May 2013, *Aleris v OHIM — Carefusion 303 (ALARIS)* (T-353/12, not published, EU:T:2013:257, paragraphs 22 and 23).

¹² See paragraph 34 of the judgment under appeal.

¹³ See paragraph 35 of the judgment under appeal.

34. I note, as a preliminary point, that it is not for the Court of Justice to rule on whether genuine use of the earlier mark has actually been proved for a subcategory of goods different from the generic category of the clothing in Class 25 of the Nice Agreement. That is an assessment of the relevant facts and of the evidence, which lies, in principle and according to settled case-law, within the sole jurisdiction of the General Court.¹⁴

35. In contrast, it is for the Court of Justice to rule on the legal principles and rules used by the General Court for the purposes of its assessment. The concept of ‘part of the goods or services’ referred to in Article 42(2) of Regulation No 207/2009 is intended to specify the material extent of use, which constitutes an essential component for the purposes of analysing whether there is genuine use of the trade mark.

36. Although the appellant makes no criticism of the case-law developed by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, it is, in my view, essential for the Court of Justice to express a view on that case-law in order not only to rule on the heads of complaint raised by the appellant in this appeal, but also to confirm or call into question case-law on which the General Court has relied for several years.

(a) The rules and principles set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)*

37. I wish to state clearly at the outset that I agree with the considerations set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, reproduced in point 24 of this Opinion.

38. I think that the interpretation which the General Court has given to the concept of ‘part of the goods or services’, in Article 42(2) of Regulation No 207/2009, makes it possible, above all, to ensure the essential function of the trade mark. That interpretation is also in line with the rules laid down by the EU legislature in that regulation and with the case-law of the Court of Justice concerning the interpretation of the concept of ‘genuine use’ of the earlier mark.

39. The function of a trade mark, I would point out, is to guarantee the identity of origin of the marked goods or services to the consumer by enabling that person, without any possibility of confusion, to distinguish those goods or services from others which have a different origin.¹⁵

40. In order to ensure that that function can be fulfilled, Regulation No 207/2009 confers on the proprietor of the trade mark a series of rights and powers, thus enabling – through the exclusive use of the distinctive sign and the identification of the goods or services which it covers – fair and undistorted competition on the market. However, those rights must be limited to what is strictly necessary for the attainment of that objective, particularly as, unlike the protection granted by other intellectual and industrial property rights, the protection conferred by trade mark rights may be of unlimited duration.

41. The EU legislature has therefore sought to ensure that trade marks can fulfil their essential function while at the same time ensuring that the trade mark right is not diverted from its function in order to obtain an unfair competitive advantage.

¹⁴ See judgments of 5 September 2019, *European Union v Guardian Europe* and *Guardian Europe v European Union* (C-447/17 P and C-479/17 P, EU:C:2019:672, paragraph 137 and the case-law cited), and of 13 November 2019, *Outsource Professional Services v EUIPO* (C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).

¹⁵ See, inter alia, judgment of 17 October 2019, *Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid* (C-514/18 P, not published, EU:C:2019:878, paragraph 37 and the case-law cited).

42. It is thus apparent from Article 15 of Regulation No 207/2009 that there is no justification for protecting an earlier mark unless it is put to ‘genuine use in the Union in connection with the goods or services in respect of which it is registered’.¹⁶

43. To that end, Article 42(2) of that regulation provides that an EU trade mark applicant may request proof that the earlier mark has been put to ‘genuine use’ in the Union during the period of five years preceding the date of publication of the trade mark application against which an opposition has been filed.¹⁷ The EU legislature therefore considered that a period of five years was reasonable for assessing whether the use is genuine.

44. It is apparent from the Court’s case-law that the concept of ‘genuine use’ is an autonomous concept of EU law.¹⁸ According to the Court, there is ‘genuine use’ of a trade mark where it is used in accordance with its essential function; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark.¹⁹ The Court considers that a trade mark which is not used obstructs not only competition — since it limits the range of signs which can be registered as trade marks by others and denies competitors the opportunity to use that trade mark or a similar one when putting on to the internal market goods or services which are identical or similar to those covered by the mark in question — but also the free movement of goods and services.²⁰

45. I consider that the principles set out by the General Court in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)* are in line with the case-law of the Court of Justice.

46. In the first place, the General Court examined, in the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and in the context of Article 43(2) of Council Regulation (EC) No 40/94 on the Community trade mark²¹ (now Article 42(2) of Regulation No 207/2009), the issue of the extent of the protection to be afforded in the event of ‘partial use’ of the earlier mark, that is to say of a mark in relation to which genuine use has been established for only ‘part of the goods or services’ for which it has been registered. On the basis that the provisions of Article 43 of Regulation No 40/94 (now Article 42 of Regulation No 207/2009) constitute a limitation on the rights which the proprietor of the earlier mark derives from his registration, the General Court interpreted the concept of ‘part of the goods or services’ referred to in that provision as meaning that it enables the earlier mark above all to fulfil its essential function. The interpretation it provided thus seeks to strike a fair balance between, on the one hand, the maintenance and preservation of the exclusive rights conferred, for that purpose, on the proprietor of the earlier mark and, on the other hand, the limitation of those rights in order to prevent a trade mark which has been used in relation to part of the goods or services being afforded extensive protection merely because it has been registered for a wide range of goods or services.²²

47. The breadth of the categories of goods or services for which the earlier mark was registered is a key element of that balance.²³

48. The General Court thus identifies two kinds of situation.

¹⁶ See, also, recital 10 of that regulation.

¹⁷ See, in that regard, clarifications provided by the EU legislature in Rules 15 to 22 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), Regulation No 2868/95 being applicable to Regulation No 207/2009.

¹⁸ See, *inter alia*, judgment of 11 March 2003, *Ansul*, C-40/01, EU:C:2003:145, paragraphs 25 to 31.

¹⁹ See order of 27 January 2004, *La Mer Technology* (C-259/02, EU:C:2004:50, paragraph 27), and judgment of 17 October 2019, *Landeskammer für Land- und Forstwirtschaft in Steiermark v Schmid* (C-514/18 P, not published, EU:C:2019:878, paragraph 36 and the case-law cited).

²⁰ See judgment of 19 December 2012, *Leno Marken* (C-149/11, EU:C:2012:816, paragraph 32).

²¹ OJ 1994 L 11, p. 1.

²² See judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*, paragraph 51.

²³ *Ibidem*, paragraph 44.

49. The first situation is that in which the earlier mark has been registered for goods and services defined particularly ‘precisely and narrowly’ and, thus, forming a more homogenous category of goods or services. In that case, the General Court considers that it is not possible to make any significant sub-divisions within the category concerned, since the proof of genuine use of the mark for those goods or services must cover the entire category for the purposes of the opposition.²⁴

50. I agree with the General Court’s reasoning. As regards goods in a category of more or less homogenous goods, a consumer who wishes to purchase a product in that category will think or is likely to think of the earlier mark and of what that mark will guarantee him as regards the quality of the product, for example. Accordingly, it is justified and adequate, in my view, to prove genuine use of the mark for part of the goods in that category. That makes it possible to avoid the likelihood of confusion referred to in Article 8(1)(b) of Regulation No 207/2009, and also to protect the commercial interests of the proprietor of the earlier mark. It is important not to limit unduly the exclusive rights of that proprietor to extend his range of goods within that homogenous category by requiring excessive proof of genuine use.

51. The second situation is that in which the earlier mark has been registered for a broad heterogeneous category of goods or services. The General Court assumes, in that case, that it is possible to identify a number of subcategories *capable* of being viewed independently, provided that those subcategories are coherent, which means that they contain goods or services which are ‘similar’ or which are not ‘in essence different’.²⁵ In that situation, the General Court considers that proof of genuine use of the trade mark in relation to part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong.²⁶

52. I also agree with that analysis. With regard to goods in a heterogeneous category of goods which are nevertheless in the same class of goods, there is not only a lower risk of confusion on the part of the relevant public, but also less justification for protecting the commercial interests of the proprietor of the earlier mark. If he has registered his trade mark for a broad range of goods which he may possibly market, but which, clearly, he has not yet put on the market, he blocks the access of his competitors to a large goods market. The solution set out by the General Court therefore ensures observance of the rights afforded to the proprietor of the earlier mark, in particular that of enjoying protection in relation to goods or services similar to those for which he has been able to prove genuine use and that of extending his range of goods to include them, while making the trade mark available for goods or services which, because they are ‘sufficiently distinct’,²⁷ fall within another category or subcategory of goods or services.

53. In the second place, in order to identify a ‘coherent’ subcategory of goods capable of being viewed independently, the General Court relies on the criterion of the purpose or intended use of the goods or services at issue since it considers that the nature or characteristics of those goods or services are irrelevant for the purposes of that assessment.²⁸

54. Once again, I can only agree with that assessment.

²⁴ *Ibidem*, paragraph 45.

²⁵ Here I am quoting the words used by the General Court in the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* (paragraph 46).

²⁶ See judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* (paragraph 45).

²⁷ *Ibidem* (paragraph 46).

²⁸ That is apparent from the case-law established in the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*. See also paragraph 32 of the judgment under appeal.

55. First, in my view, it makes it possible to safeguard the exclusive rights of the proprietor of the earlier mark. To define an independent subcategory of goods taking account not only of the purpose but also of the particular nature and characteristics of those goods would be tantamount to limiting far too strictly the material scope of those rights and, in particular, the rights of that proprietor to develop and extend his range of goods for which the earlier mark is registered. Although the criteria relating to the nature and characteristics of the goods are, in themselves, important criteria, they are more relevant for defining the relevant public and assessing the likelihood of confusion.

56. Second, I would point out that the Court has endorsed the General Court's approach in assessing the validity of a limitation on goods proposed by a trade mark applicant pursuant to Article 43(1) of Regulation No 207/2009.

57. In the judgment of 11 December 2014, *OHIM v Kessel medintim*,²⁹ the Court held that the criterion of the purpose and intended use of the goods at issue was a criterion which made it possible to define sufficiently precisely a subcategory of goods covered by the application for registration as an EU trade mark, thus satisfying the requirement of clarity laid down in Article 43(1) of Regulation No 207/2009.³⁰ As is implicit in paragraph 39 of that judgment,³¹ the Court confirmed the case-law established by the General Court in the judgment in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, according to which the purpose or intended use of the product or service at issue is a decisive criterion in the definition of a subcategory of goods or services, since consumers primarily seek a product or service which can meet their specific needs.³²

58. In my view, there is nothing to prevent the Court's analysis in the judgment of 11 December 2014, *OHIM v Kessel medintim*,³³ with regard to the definition of a subcategory of goods in the context of Article 43(1) of Regulation No 207/2009, from being transposed to the application of Article 42(2) of that regulation. It seems to me that the definition of a subcategory of goods, whether in relation to an opposition or a restriction, must be based on identical criteria, so as to make it possible, in the assessment of the likelihood of confusion, to compare the goods at issue, which are defined on the basis of the same criteria.

59. In the light of those factors, I therefore think that the Court should confirm the rules and principles which the General Court set out in the judgments in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)* and *Mundipharma v OHIM — Altana Pharma (RESPICUR)* for the purposes of defining a subcategory of goods and/or services in connection with the application of Article 42(2) of Regulation No 207/2009.

60. It is now necessary to examine the merits of the first ground of appeal raised by the appellant, which is divided into two parts.

²⁹ C-31/14 P, not published, EU:C:2014:2436.

³⁰ See paragraph 37 of that judgment.

³¹ In that paragraph, the Court refers expressly to paragraphs 48 to 50 of the judgment of 8 November 2013, *Kessel v OHIM — Janssen-Cilag (Premeno)* (T-536/10, not published, EU:T:2013:586). Those paragraphs conclude the reasoning adopted by the General Court in paragraphs 43 to 47 of its judgment.

³² See paragraph 29 of that judgment.

³³ C-31/14 P, not published, EU:C:2014:2436.

(b) The first part of the first ground of appeal, alleging incorrect application of the method for determining an independent subcategory of goods

61. I should point out that, by the first part of the first ground, the appellant maintains that, in paragraph 34 of the judgment under appeal, the General Court erred in law by assessing whether there was an independent subcategory of goods solely on the basis of the goods referred to in the evidence of use submitted by Taiga. According to the appellant, the General Court should have considered whether the earlier mark was registered for a category of goods which was sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently.

62. I consider that this part of the first ground of appeal is unfounded.

63. Since the proprietor of the earlier mark has proved genuine use of that mark in relation to part of the goods for which it is registered, the question whether those goods fall within a subcategory capable of being viewed independently must be assessed *in concreto* with regard, above all, to those goods. It is therefore not a case of defining, in an abstract manner, subcategories of goods, but rather of comparing the goods in respect of which the earlier mark has been put to genuine use with the category of goods covered by the application for registration of that mark.

64. It must be concluded from a reading of paragraphs 33 and 34 of the judgment under appeal that the General Court did just that. It is apparent from paragraph 33 of that judgment that the General Court examined whether the articles referred to in the evidence of use submitted by Taiga constituted an independent subcategory ‘*in relation to the goods in Class 25 [of the Nice Agreement]*’, that is to say, in relation to the more general category of goods covered by the earlier mark. By concluding, in paragraph 34 of the judgment under appeal, that those articles ‘cannot, in any event, be regarded as “[in essence] different” within the meaning of [the judgment in *Reckitt Benckiser (España) v OHIM — Aladin (ALADIN)*]’, the General Court therefore correctly compared the articles for which genuine use of the earlier mark was proved with the goods in the more general category of clothing for which that mark was registered.

65. I therefore propose that the Court reject this first part of the first ground of appeal as unfounded.

(c) The second part of the first ground of appeal, alleging incorrect application of the criteria for determining an independent subcategory of goods

66. The second part of the first ground of appeal is composed of two complaints.

(1) The first complaint, relating to the criterion of the purpose and intended use of the goods

67. In support of its first complaint, the appellant criticises the General Court for not having applied correctly the criterion of the purpose and intended use of the goods at issue in order to identify a coherent subcategory of goods capable of being viewed independently. It maintains that the General Court did not take into account the different purposes of those goods or the multiple uses for which they are intended for the purposes of that identification, such uses consisting, *inter alia*, in ‘adorning’ or ‘protecting’ the human body which, according to the appellant, are mutually exclusive.

68. I consider that this complaint is admissible since the appellant does not dispute the findings of the General Court concerning the purpose and intended use of the goods for which genuine use has been established, but the way in which the General Court applied the criterion of the purpose and intended use in order to determine whether there was an independent subcategory of goods for the purposes of Article 42(2) of Regulation No 207/2009.

69. However, I consider that the appellant's criticism is unfounded.

70. The aim of the criterion of the purpose and intended use of the goods is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically.

71. A product has purposes which progress and know-how tend to multiply. Cleansing products, for example, are no longer intended only to clean the skin, but also to care for it, whether in a medical sense or not. In the same way, clothing goods fulfil, as well as their primary function, that is, to cover, conceal or protect the human body against adverse weather conditions, a common aesthetic function, by contributing to the consumer's external image. Although consumers look for clothes to protect themselves against the rain, be that outer clothing or a hat, or to protect themselves against the cold, such as underwear or gloves and socks, they may also look for the most aesthetically pleasing garment. Clearly, each of those purposes cannot be considered in isolation in determining whether there is a distinct subcategory of goods. If that were the case, it would limit once again the rights of the proprietor of the earlier mark to expand and enhance his range of goods. Moreover, it would obviously discourage research and development which trade mark law specifically aims to encourage.

72. In the judgment under appeal, the General Court was therefore right, in my view, not to distinguish between the uses consisting of 'protecting' the human body, 'adorning' it, or 'concealing' it and 'covering' it, which are intended uses of clothing goods. Far from being mutually exclusive, those different uses are combined for the purpose of putting those goods on the market.

73. I would point out however that those different purposes are a factor which may be taken into consideration when assessing the relevant public, its level of attention and the likelihood of confusion.

74. In the light of these factors, I therefore propose that the Court reject this first complaint of the second part of the first plea as unfounded.

(2) The second complaint, relating to the criteria concerning the nature and characteristics of the goods at issue

75. By the second complaint, the appellant criticises the General Court for not having properly considered the fact that the goods at issue were targeted at a different public and that they were, furthermore, sold in shops which were also different, so that those goods differ from the clothing goods covered by the mark applied for.

76. This complaint must be rejected at the outset as unfounded.

77. It is apparent from the case-law which I have just examined that criteria other than the purpose and intended use of the goods at issue, such as the public at which they are targeted or their distribution chain, are not, as a general rule, relevant for defining a subcategory of goods capable of being viewed independently. Accordingly, the General Court cannot be said to have committed any error of law by not taking those criteria into account for the purposes of its assessment.

78. In the light of all those considerations, I therefore propose that the Court reject the first ground of appeal as unfounded.

B. Focused consideration of the second ground of appeal

79. In accordance with the Court's request, this Opinion will be limited to the analysis of the second part of this second ground of appeal and, in particular, to the third complaint thereof.

80. In order to give a better understanding of the context of that complaint, I should point out that, by its second ground of appeal, the appellant maintains that the General Court wrongly concluded that there was a likelihood of confusion between the marks at issue. The first part of this ground alleges an incorrect assessment of the similarity or identity of the goods at issue. The second part of the ground of appeal is made up of three complaints, concerning the assessment of the visual, phonetic and conceptual similarity respectively of the signs at issue. Finally, the third part of the second ground of appeal concerns the global assessment of the likelihood of confusion carried out by the General Court.

81. As regards, in particular, the third complaint of the second part of the second ground of appeal, this alleges that the General Court incorrectly assessed the conceptual similarity of the signs at issue. The appellant criticises, in essence, the General Court's analysis in which it concluded that the conceptual differences between the mark applied for and the earlier mark had not been established on the territory of the European Union *as a whole*, so that they could not offset the visual and phonetic similarities between the signs at issue.

82. In support of that complaint, the appellant relies on two arguments.

83. As regards the first argument, the appellant criticises the General Court's analysis in paragraph 71 of the judgment under appeal, in which it held that the appellant had not succeeded in showing that the word 'täiga' has specific meaning for average consumers located in the south of the European continent and for English-speaking consumers.

84. According to the appellant, that analysis is incorrect. It claims that it developed that argument in paragraph 18 of its application to the General Court and demonstrated indisputably that that term forms part of the current terminology of the French language and moreover, of general education throughout Europe given the size of the area to which that term relates.

85. In my view, that argument is manifestly inadmissible.

86. It should be pointed out that, in paragraph 71 of the judgment under appeal, the General Court found that 'there is nothing in the file to establish that the word "täiga" has a specific and immediate meaning for average consumers who are located in the parts of the territory of the European Union other than the north and east of the European continent, who constitute a significant proportion of EU consumers' and that that is the case, 'inter alia, for average consumers in southern parts of the European continent and English-speaking consumers'.

87. It is settled case-law that the General Court has exclusive jurisdiction to assess the value which should be attached to the evidence produced before it. That assessment does not therefore constitute, save where the evidence has been distorted, a point of law which is subject to review by the Court of Justice on appeal.³⁴

88. In its appeal, the appellant has not established, or even alleged, that the assessment in paragraph 71 of the judgment under appeal was based on a distortion of the evidence. Moreover, I would point out in the alternative that, contrary to what it alleges, the appellant did not develop those arguments in paragraph 18 of its application.

89. Consequently, I consider that this first argument must be rejected as manifestly inadmissible.

³⁴ See judgments of 5 September 2019, *European Union v Guardian Europe* and *Guardian Europe v European Union* (C-447/17 P and C-479/17 P, EU:C:2019:672, paragraph 137 and the case-law cited), and of 13 November 2019, *Outsource Professional Services v EUIPO* (C-528/18 P, not published, EU:C:2019:961, paragraph 47 and the case-law cited).

90. As regards the second argument, the appellant criticises the General Court for having disregarded its own case-law on assessing the conceptual similarity of the signs at issue.

91. The appellant submits that the analysis in paragraph 67 of the judgment under appeal, which led the General Court to conclude that the appellant had failed to demonstrate that the word ‘taïga’ has a clear and specific meaning from the point of view of the relevant public made up of EU consumers *as a whole*, is unsupported in the case-law to which the General Court expressly referred, namely the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*.³⁵ Moreover, the appellant maintains that, in accordance with the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)*,³⁶ in order to conclude that there are conceptual differences between the signs at issue, it is sufficient that a term is understood in a part of the European Union.

92. After examining that case-law, I consider that neither of those criticisms is well founded.

93. As regards the first criticism, relating to an incorrect reference to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*,³⁷ it is useful to recall that, in paragraph 54 of that judgment, the General Court held that conceptual differences between the signs at issue *are such as to counteract*, to a large extent, visual and aural similarities if one of the marks at issue has, from the point of view of the ‘relevant public’, a *clear and specific* meaning so that the public is capable of grasping it *immediately*.

94. I begin by observing that, in view of the words used by the General Court in that judgment, it was entitled to conclude, in the judgment under appeal, that, for all consumers located in the territory of the 28 Member States of the European Union, the word ‘taïga’ would not *clearly* and *immediately* prompt them to recall their geographical education so that they would readily associate it with the boreal forest.

95. Having said that, I observe that, in the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*,³⁸ the General Court referred to the ‘relevant public’ without any further mention or clarification, whereas, in paragraph 67 of the judgment under appeal, it stated that the relevant public was ‘made up of EU consumers, as a whole’. It is that detail of ‘as a whole’ that the appellant in this case is disputing.

96. I do not think that, by adding that detail, the General Court disregarded its case-law or committed any error of law.

97. As is apparent from paragraph 67 of the judgment under appeal, the detail ‘as a whole’ is designed to show that it is necessary to take into account the perception of consumers located *in all the States which make up the European Union*. It thus enables the General Court to reject the appellant’s argument relating to the perception of consumers located ‘in many [EU] countries’.

98. The General Court thus applied its case-law according to which, ‘[w]here the protection of the earlier trade mark extends to the entirety of the European Union, it is necessary to take into account the perception of the marks at issue by the consumer of the goods in question *in that territory*’.³⁹ Unlike the case which gave rise to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM* —

³⁵ T-292/01, EU:T:2003:264.

³⁶ T-487/12, not published, EU:T:2013:637.

³⁷ T-292/01, EU:T:2003:264.

³⁸ *Idem*.

³⁹ Judgment of 13 June 2013, *Hostel drap v OHIM — Aznar textil (MY drap)* (T-636/11, not published, EU:T:2013:314, paragraph 22) (emphasis added).

Pash Textilvertrieb und Einzelhandel (BASS),⁴⁰ in which the relevant public was composed of German consumers,⁴¹ in the case in the main proceedings the relevant public is composed, as is apparent from paragraphs 38 and 39 of the judgment under appeal, of consumers located in the territory of the European Union.

99. Finally, I would point out that the reference to the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*,⁴² is preceded by the words ‘see, to that effect’. The expression ‘to that effect’ shows that the General Court intended to refer to the principle set out in the judgment in question while specifically applying that principle to the present case. That expression did not therefore require the General Court to reproduce in identical terms the principle set out in the judgment in question. It allowed it, on the contrary, in paragraph 67 of the judgment under appeal, to take the specific features of the present case into account.

100. Accordingly, it seems to me that it cannot be alleged that the General Court erred in referring to paragraph 54 of the judgment of 14 October 2003, *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)*.⁴³

101. As regards the second criticism, relating to the General Court’s failure to have regard to the judgment of 11 December 2013 *Eckes-Granini v OHIM — Panini (PANINI)*,⁴⁴ I think that that too is unfounded.

102. Contrary to what the appellant maintains, that judgment does not permit the inference that it is sufficient that a term is understood in a part of the European Union to conclude that there are conceptual differences which offset the visual and phonetic similarities between the signs at issue.

103. It is first necessary to recall the context of the case which gave rise to that judgment.

104. In that case, the General Court was called upon to examine whether, for the relevant public consisting of EU consumers, there was a clear conceptual difference between the element ‘panini’, the subject of the mark applied for, and the element ‘granini’, the subject of the earlier mark.

105. After having found, at the outset, that the element ‘granini’ had no meaning, the General Court examined to what extent the relevant public associated the element ‘panini’ with a particular concept. To that end, the General Court distinguished between, first, the Italian-speaking public, which it considered quite able to associate the element ‘panini’ with small bread rolls or sandwiches made from those small bread rolls and for which there was a clear conceptual difference between the signs at issue, second, the non-Italian-speaking public, such as the Spanish- or French-speaking public, also capable of associating the element ‘panini’ with a particular concept and, finally, third, the public for which that element ‘panini’ was, by contrast, wholly meaningless.⁴⁵

106. At the end of that analysis, the General Court confirmed the assessment of the Board of Appeal, which had found that, in some Member States, such as Italy and Spain, the signs at issue were conceptually different, whereas, in other Member States, in which the element ‘panini’ had no meaning, no comparison could be made between the signs at issue from a conceptual point of view.⁴⁶

40 T-292/01, EU:T:2003:264.

41 Paragraph 43 of that judgment.

42 T-292/01, EU:T:2003:264.

43 *Idem*.

44 T-487/12, not published, EU:T:2013:637.

45 See judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)* (T-487/12, not published, EU:T:2013:637, paragraph 56).

46 *Ibidem*, paragraph 58.

107. Contrary to what the appellant maintains, the General Court did not therefore consider in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)*,⁴⁷ that it is sufficient that one section only of the relevant public associates the term in question with a particular concept to conclude that there are conceptual differences capable of offsetting the visual and phonetic similarities between the signs at issue.

108. Accordingly, it cannot be alleged that, in the judgment under appeal, the General Court disregarded the rules applied in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)*.⁴⁸

109. I would point out that, in the judgment under appeal, the General Court followed an analytical framework similar to that which it had adopted in the judgment of 11 December 2013, *Eckes-Granini v OHIM — Panini (PANINI)*:⁴⁹ it examined the extent to which the relevant public (consisting, I would recall, of EU consumers) was able to associate the word ‘taïga’ with a specific concept. The General Court distinguished, in particular, between:

- consumers located in the north and east of the European continent, who are *very likely* to be able to associate the word ‘taïga’ with the boreal forest and for whom there is therefore a conceptual difference between the signs at issue,⁵⁰
- ‘average’ consumers located in parts of the territory of the European Union other than the north and east of the European continent, in particular, consumers from southern Europe and English-speaking consumers, who constitute a significant proportion of the relevant public and *for whom it was not established* that there is a clear conceptual difference between the signs at issue.⁵¹

110. Since, in accordance with the case-law referred to, the meaning of a word must be assessed in relation to the way in which it is understood by the relevant public as a whole and must therefore not be limited to the perception of consumers in only one part of the relevant territory, the General Court rejected, in paragraph 73 of the judgment under appeal, the appellant’s argument that the meaning of the term ‘taïga’ is such as to offset the visual and phonetic similarities between the signs at issue. It cannot be claimed that, in so doing, the General Court erred in law.

111. In the light of all those considerations, I therefore propose that the Court reject the third complaint of the second part of the second ground of appeal, as in part manifestly inadmissible and in part unfounded.

VII. Conclusion

112. In the light of the foregoing considerations, I propose that the Court should, without prejudice to the admissibility or merits of the other grounds of appeal put forward by ACTC GmbH or to the order for costs, reject the first ground of this appeal as unfounded, and the third complaint of the second part of the second ground of appeal as in part manifestly inadmissible and in part unfounded.

⁴⁷ T-487/12, not published, EU:T:2013:637.

⁴⁸ *Idem*.

⁴⁹ *Idem*.

⁵⁰ See paragraph 70 of the judgment under appeal.

⁵¹ See paragraph 71 of the judgment under appeal.