

— order John Mills Ltd to pay the costs incurred by the Office.

### **Pleas in law and main arguments**

#### *Violation of Articles 8(3) of Regulation 207/2009 <sup>(1)</sup>*

- The General Court misinterpreted the provisions of Article 8(3) of Regulation 207/2009 by limiting its scope to the notion of ‘identity’ of the signs and attributing it the meaning proper to Article 8(1)(a) of Regulation 207/2009.
- The General Court did not take sufficient account of the purpose of Article 8(3) of Regulation 207/2009, i.e. to prevent the misuse of a mark by the trade mark proprietor’s agent as the agent may exploit the knowledge and experience acquired during its business relationship with the proprietor and therefore improperly benefit from the effort and investment which the trade mark proprietor himself made, giving preference to an arguable literal interpretation. While it is a teleological approach to the interpretation of the EU trade mark law that is consistently applied by the EU judicature.
- A literal interpretation does not lead either to the conclusion that Article 8(3) of Regulation 207/2009 applies only to identical marks. It is therefore enough if the signs at issue coincide in elements in which the earlier mark’s distinctive character essentially consists. On this basis the proper test for examining the conflicting marks under the Article 8(3) of Regulation 207/2009 is whether the EUTM application reproduces the essential elements of the earlier mark in such a way as to make it evident that the applicant is misappropriating the legitimate proprietor’s rights on its mark. In fact, the disloyal agent would be in a position to prevent not only any subsequent registration of the earlier mark by the original proprietor within the EU — but indeed any use thereof by the principal within the EU.

#### *Violation of Article 36 of the Statute of the Court of Justice*

- The judgment under appeal is tainted by contradictory reasoning to the extent that it accepts, on the one hand, that signs are identical where one reproduces the other without any modification or addition and, on the other hand, that they are also identical where variations are made without altering the distinctive character (see paragraphs 38-40 of the Contested Judgment). Such reasoning is contradictory since the same notion of ‘identity’ is applied to distinct legal and factual situations and is erroneously given two different contents.
- The General Court did not provide any reasons as to why the conflicting trade marks do not fall under the scope of Article 8(3) of Regulation 207/2009 following the test it introduced in paragraph 39 of the contested judgment.

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<sup>(1)</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009, L 78, p. 1).

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**Appeal brought on 21 December 2018 by The Yokohama Rubber Co. Ltd against the judgment of the General Court (Seventh Chamber, Extended Composition) delivered on 24 October 2018 in Case T-447/16: *Pirelli Tyre v EUIPO***

**(Case C-818/18 P)**

(2019/C 148/10)

*Language of the case: English*

### **Parties**

*Appellant:* The Yokohama Rubber Co. Ltd (represented by: D. Martucci, F. Boscaroli de Roberto, avvocati)

*Other parties to the proceedings:* European Union Intellectual Property Office, Pirelli Tyre SpA

### **Form of order sought**

The appellant claims that the Court should:

- set aside the judgment under appeal;
- if necessary, refer the case back to the General Court;
- order Pirelli Tyre S.p.A. to pay the costs including the costs incurred in the course of the proceedings of General Court and the Board of Appeal.

### **Pleas in law and main arguments**

*First part of the first plea in law: does the mark constitute the shape of the goods within the meaning of Article 7(1)(e)(ii) of Regulation No 40/94 (1)?*

The General Court affirmed that, even though the graphic representation constituting the contested sign shows no contours and is not accompanied by any additional description, Pirelli did not contest that some of its tyre models contain, on the surface of the tyre, a groove in the shape represented by the contested sign. Also the possibility afforded to the competent authority to take into account material relevant to identifying the essential characteristics of a contested three-dimensional sign has been extended to the examination of two-dimensional signs. The General Court concluded its reasoning affirming that: 'It must be stated that, when analysed objectively and specifically, the contested mark does not represent a tread pattern design. It represents, at most, an individual groove of a tyre tread'. The Court of Justice has reiterated that the case law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product or part of the product itself, also applies where, as in the present case, the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product or part of the product. In such a case, the trade mark likewise does not consist of a sign unrelated to the appearance of the products it covers. The graphic representation of the challenged trade mark exactly reproduces the shape of the product (i.e. pattern) which it is to designate or of the product to which relate for technical reasons. The explanation provided by the General Court, according to which the sign is not a significant part of the product, is arbitrary and contrary to the case law decided by the Court of Justice and by the same General Court. The question is not if the sign constitutes a significant part of the product but if the sign is a part of the product.

*Second part of the first plea in law: did the Board of Appeal add to the shape elements which did not form part of the sign and which were therefore external and foreign?*

The General Court affirms that the Board of Appeal departed from the shape represented by the contested sign and modified it. In other words, the Board of Appeal have modified the nature of the sign, alleging or supposing external and foreign features or characteristics. In truth, the Board of Appeal did not add elements to the sign but evaluated the shape of the actual goods and not an abstract shape. If the sign, as affirmed by the General Court, is a true to life representation of a part of the goods covered by the sign, it is necessary to analyze the characteristics of the shape arising from the graphic representation from the point of view of the function of the goods concerned. In our opinion, the General Court seems to affirm that the EUIPO tried to find hidden characteristics which are not visible in the shape represented. Although that assessment should undoubtedly be confined *prima facie* to an analysis of the shape as applied for, the relationship between that shape (groove) and the function of the goods (tyre) necessitates the consideration of additional information. In our view, the analysis of the sign as applied for is quite simple due to the fact that on the products the trade mark appears as a serial reproduction of the sign. Therefore the question is: 'does the depiction amount unquestionably to a representation of a functional element of a part of the product?' and not, contrary to the statement of the General Court, 'does the depiction amount unquestionably to a representation of a significant part or a small portion of the product?'.

*Second plea in law: on distortion of the facts*

The General Court erred in evaluating all the facts and all the documents filed by Yokohama. In our case we have indicated precisely the evidence alleged to have been distorted by the General Court and showed the errors of appraisal which, in our view, led to that distortion. Such distortion is obvious from the documents on the Court's file, without there being any need to carry out a new assessment of the facts and evidence.

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<sup>(1)</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994, L 11, p. 1).

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**Appeal brought on 28 December 2018 by Mamas and Papas Ltd against the judgment of the General Court  
(Second Chamber) delivered on 23 October 2018 in Case T-672/17: Mamas and Papas v EUIPO**

**(Case C-825/18 P)**

(2019/C 148/11)

*Language of the case: English*

**Parties**

*Appellant:* Mamas and Papas Ltd (represented by: S. Malynicz QC, B. Whitehead, J. Dainty, Solicitors)

*Other party to the proceedings:* European Union Intellectual Property Office

**Form of order sought**

The appellant claims that the Court should:

- set aside the judgment of the General Court in Case T-672/17, Mamas and Papas Ltd v EUIPO;
- give judgment on the issue of prior disclosure;
- refer the case back to the General Court of the European Union on the remaining pleas in law that were brought before the General Court but not resolved by that Court;
- order the Office and intervener to bear their own costs and pay those of the appellant.

**Pleas in law and main arguments**

First the General Court erred in law regarding the powers of the EUIPO to examine the facts under Article 63(1) CDR <sup>(1)</sup> in relation to disclosure of the prior design. Where prior disclosure is positively averred by the design holder, it is not open to the EUIPO to come to a different conclusion on that issue.