

European Union - Dr. Helen Papaconstantinou, John Filias and Associates

In *Paul Alfons Rehbein (GmbH & Co) KG v Office for Harmonisation in the Internal Market* (OHIM) (Case T-214/08, March 28 2012), the General Court has interpreted Rule 22(2) of the Community Trademark Implementation Regulation (2868/95), ruling that it does not preclude the admission of additional evidence which merely supplements other evidence submitted within the set time limit, if the initial evidence was not irrelevant, but was deemed to be insufficient.

In March 2005 Hervé and Manuel Carlos Dias Martinho filed an application for the registration of the following figurative mark as Community trademark for goods in Classes 18 and 25 of the Nice Classification:



In December 2005 Paul Alfons Rehbein (GmbH & Co) KG opposed the registration of the mark on the basis of its prior word mark OUTBURST, which was registered in Germany on August 31 1999 and covered goods in Class 25.

Based on Article 43(2)(3) of the Community Trademark Regulation (40/94), Hervé and Manuel Carlos Dias Martinho requested that Rehbein submit proof that the earlier mark had been put to genuine use. Rehbein submitted:

- a written statement by its managing director stating that its subsidiary had been using the mark extensively since 2000 for sportswear, providing the volume of sales of clothes bearing the mark for each year between 2000 and 2005 and the number of the clothes.

- lists of sales of clothes bearing the mark for each year between 2000 and 2005 broken down by customer, type of clothing, as well as, among other things, various order sheets, delivery notes, invoices and extracts from catalogues.
- a written statement by the managing director of a client company of Rehbein's subsidiary stating that it had been purchasing sportswear labelled with the mark OUTBURST and reselling them “on an extensive scale” between 2000 and 2005, providing the amount of the purchases and the number of the clothes.

The Opposition Division of OHIM rejected the opposition on the grounds that Rehbein had not provided proof of the genuine use of the earlier mark.

Rehbein appealed and submitted additional evidence to that already provided in the first instance. However, the Second Board of Appeal of OHIM dismissed the appeal, stating that:

- the evidence presented was not sufficient “overall” to prove a genuine use of the earlier German mark; and
- the supplementary evidence had been filed after the expiry of the time limit set by OHIM and no new factors existed which would be capable of justifying the late submission.

Rehbein appealed to the General Court, relying on the following two pleas:

- the evidence which was timely submitted at first instance proved that the earlier mark had been put to genuine use to the required legal standard; and
- the Board of Appeal ought to have taken into consideration the evidence filed for the first time before it.

Ruling on the first plea, the General Court first analysed the meaning of 'genuine use', and proceeded to examine the ruling of the board. Although the court concluded that the board had erred in finding that the first written statement submitted by Rehbein could not have the “full and complete independent” probative value of a statement within the meaning of Article 76(1)(f) of the Community Trademark Regulation, it held that this finding did not affect the substance of the analysis of the board, since it did not lead it to deny all probative value to the written statement of Rehbein's managing director.

The court further held that, although this document contained evidence of use of the earlier mark relating to the place (Germany), time (2000 to 2005), extent (yearly turnover and number of items sold per year) and nature of the designated products (eg, sport clothing, jackets and raincoats), the evidence was not corroborated by the documents annexed to the statement, because no reference was made to the earlier mark. The court then held that Rehbein could not claim that the evidence contained in the written statement of its managing director was capable of remedying the shortcomings of the attached material, and stressed that it is the evidence contained in the written statement that must be supported by other evidence, and not vice versa.

Regarding the written statement of the managing director of the customer company of Rehbein's subsidiary, the court held that, although it was sufficient to attest to certain facts because it came from a third party, it concerned only certain purchases made by just one customer of a subsidiary of Rehbein and, therefore, established only a very limited use of the earlier mark in Germany during the relevant period. Consequently, the General Court rejected the first plea.

Turning to the second plea, the General Court held that, in accordance with established case law, the meaning of Article 74(2) of the Community Trademark Regulation, is that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time limits to which such submission is subject under the provisions of that regulation, and that OHIM is in no way prohibited from taking into account facts and evidence which are submitted or produced late. The parties before OHIM may submit evidence after the expiry of set deadlines, under the condition that there is no provision to the contrary.

The General Court held that, in the present case, a provision to the contrary did exist, namely Article 43(2) and (3) of the Community Trademark Regulation, as implemented by Rule 22(2) of Regulation 2868/95. According to this provision:

"Where, pursuant to Article 43 (2) or (3) of the regulation, the opposing party has to furnish proof of use or show that there are proper reasons for non-use, OHIM shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, OHIM shall reject the opposition."

In line with established case law, however, the rule cannot be interpreted as precluding additional evidence from being taken into consideration when new factors exist, even after the expiry of the time limit. The Board of Appeal had held that, in this case, there was no new factor justifying the late submission. However, Rehbein asserted that the additional evidence should have been taken into account because it merely supplemented and explained the evidence submitted to OHIM. OHIM, although it agreed with the arguments of the board, suggested that the boards of appeal could accept new evidence if it is "purely complementary" to the evidence timely filed at first instance.

As the parties did not contest that Rehbein had timely produced evidence which it believed sufficiently proved the genuine use of the earlier mark, or that the additional evidence submitted to the board was intended to strengthen or clarify the content of the initial evidence, the court held that the latter was not the first and only evidence of use of the mark. Consequently, the court concluded that the board had the discretion to evaluate the newly submitted material. The court held that Rule 22(2) should be interpreted as not precluding the admission of additional evidence which merely supplements other evidence submitted timely from being taken into account, where the initial evidence was not irrelevant, but was found to be insufficient. The General Court thus annulled the decision.

*Maria Athanassiadou, Dr Helen Papaconstantinou, John Filias and Associates,
Athens*