



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

18 May 2018*

(EU trade mark — Revocation proceedings — EU word mark VSL#3 — Trade mark having become a common name in the trade for a product or service for which it is registered — Mark liable to mislead the public — Article 51(1)(b) and (c) of Regulation (EC) No 207/2009 (now Article 58(1)(b) and (c) of Regulation (EU) 2017/1001))

In Case T-419/17,

Mendes SA, established in Lugano (Switzerland), represented by G. Carpineti, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by J. Crespo Carrillo, acting as Agent,

defendant,

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

Actial Farmaceutica Srl, established in Rome (Italy), represented by S. Giudici, lawyer,

ACTION brought against the decision of the Second Board of Appeal of EUIPO of 3 May 2017 (Case R 1306/2016-2), relating to revocation proceedings between Mendes and Actial Farmaceutica,

THE GENERAL COURT (Fifth Chamber),

composed of D. Gratsias, President, A. Dittrich and P.G. Xuereb (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 4 July 2017,

having regard to the response of EUIPO lodged at the Court Registry 27 September 2017,

having regard to the response of the intervener lodged at the Court Registry on 11 October 2017,

* Language of the case: Italian.

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

Judgment

Background to the dispute

- 1 On 23 December 1999, Mendes s.u.r.l. filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended, itself 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 mark for which registration was sought was the word sign VSL#3.
- 3 The goods for which registration was sought are in Class 5 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 to the following description: ‘Pharmaceutical, veterinary and sanitary goods; dietetic substances adapted for medical use, food for babies; nutraceuticals; dietary supplements’.
- 4 The EU trade mark application was published in *Community Trade Marks Bulletin* No 2000/059 of 24 July 2000 and the mark was registered on 5 July 2001.
- 5 On 1 April 2004, EUIPO registered the transfer by Mendes s.u.r.l. of the contested mark to Actial Farmacêutica Lda.
- 6 On 2 December 2016, EUIPO registered the transfer of the contested mark by Actial Farmacêutica Lda to the intervener, Actial Farmaceutica Srl.
- 7 On 8 September 2014, the applicant, Mendes SA, filed an application for revocation of the contested mark for all the goods for which it was registered, pursuant to Article 51(1)(b) and (c) of Regulation No 207/2009 (now Article 58(1)(b) and (c) of Regulation 2017/1001), on the ground that, first, that mark had become, in consequence of acts or inactivity of the intervener, the common name in the trade for the products at issue and, second, that that mark misleads the public because of its use.
- 8 By decision of 2 June 2016, the Cancellation Division rejected the application for revocation.
- 9 On 19 July 2016, the applicant 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.
- 10 By decision of 3 May 2017 (‘the contested decision’), the Second Board of Appeal of EUIPO dismissed the appeal. In the first place, the Board of Appeal considered, in essence, that the evidence submitted by the applicant did not make it possible to establish that the contested mark had become the

common name in the trade for the products for which it was registered. In the second place, the Board of Appeal considered, in essence, that the misleading use of the contested mark had not been duly substantiated by the applicant.

Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision;
- order that the applicant be reimbursed the costs relating to the proceedings in full, or at least that each party is to bear its own costs in full.

12 EUIPO and the intervener contend that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

Law

Admissibility of the documents produced for the first time before the Court

13 EUIPO claims that Annexes A.9, A.36 and A.39 to the application, concerning the guidelines of the World Gastroenterology Organisation (Annex A.9), the content of the website 'www.vsl3.co.uk' (Annex A.36) and the packaging of the product at issue distributed with a modified formulation (Annex A.39) are produced for the first time before the Court and are, therefore, inadmissible.

14 In the circumstances, it should be pointed out that Annexes A.9, A.36 and A.39 to the application did not form part of the administrative file submitted by the applicant to the Board of Appeal of EUIPO.

15 In that regard, it should be borne in mind that the purpose of actions before the 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 that it is not the Court's function to review the facts in the light of documents produced for the first time before it.

16 The documents referred to above must therefore be rejected, without it being necessary to examine their probative value (see, to that effect, judgment of 24 November 2005, *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, EU:T:2005:420, paragraph 19 and the case-law cited).

Substance

17 In support of its action, the applicant puts forward two pleas in law. The first alleges infringement of Article 51(1)(b) of Regulation No 207/2009. The second alleges infringement of Article 51(1)(c) of Regulation No 207/2009.

The first plea in law, alleging infringement of Article 51(1)(b) of Regulation No 207/2009

- 18 In the context of the first plea, alleging infringement of Article 51(1)(b) of Regulation No 207/2009, the applicant claims, first of all, that the Board of Appeal erred in defining the relevant circles and their perception of the contested mark. The applicant states, in addition, that the transformation of the contested mark into the common name in the trade for the product for which it is registered is attributable to its proprietor.
- 19 EUIPO and the intervener dispute the applicant's arguments.
- 20 Under Article 51(1)(b) of Regulation No 207/2009, the rights of the proprietor of the EU trade mark are to be declared to be revoked, on application to EUIPO or on the basis of a counterclaim in infringement proceedings, if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered.
- 21 It must be noted that there is no case-law relating to the application of Article 51(1)(b) of Regulation No 207/2009. Nevertheless, the Court of Justice, in the cases giving rise to the judgments of 29 April 2004, *Björnekulla Fruktindustrier* (C-371/02, EU:C:2004:275), and of 6 March 2014, *Backaldrin Österreich The Kornspitz Company* (C-409/12, EU:C:2014:130), was asked to interpret Article 12(2)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and Article 12(2)(a) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), the content of which is, in essence, identical to that of Article 51(1)(b) of Regulation No 207/2009.
- 22 It is apparent from the case-law of the Court of Justice applicable, by analogy, to Article 51(1)(b) of Regulation No 207/2009 that that article addresses the situation where the mark is no longer capable of fulfilling its function of an indication of origin (see, by analogy, judgments of 29 April 2004, *Björnekulla Fruktindustrier*, C-371/02, EU:C:2004:275, paragraph 22, and of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 19).
- 23 Among the various functions of a trade mark, that of an indication of origin plays an essential part. It serves to identify the goods or services covered by the mark as originating from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. That undertaking is that under the control of which the goods or services are marketed (see, by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 20 and the case-law cited).
- 24 That essential function of trade marks has been incorporated by the European Union legislature into Article 4 of Regulation No 207/2009 (now Article 4 of Regulation 2017/1001), which provides that signs capable of being represented graphically may constitute a trade mark provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (see, by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 21 and the case-law cited).
- 25 Thus, while Article 7 of Regulation No 207/2009 (now Article 7 of Regulation 2017/1001) specifies circumstances in which the mark is from the outset incapable of fulfilling its function of an indication of origin, Article 51(1)(b) of that regulation concerns the situation in which the use of a mark has become so widespread that the sign constituting that mark has come to designate the kind, the type or the nature of the goods or services covered by the registration rather than the specific goods or services originating from a particular undertaking (see, by analogy, Opinion of Advocate General Léger in *Björnekulla Fruktindustrier*, C-371/02, EU:C:2003:615, point 50). The mark, having become

the common name of a product, has therefore lost its distinctive character, with the result that it no longer fulfils that function (see, by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 22 and the case-law cited).

- 26 The rights conferred on the proprietor of a mark under Article 9 of Regulation No 207/2009 (now Article 9 of Regulation 2017/1001) may then be revoked provided, first, that that mark has become, in the trade, a common name for a product or service for which it is registered and, second, that that transformation is due to acts or inactivity of that proprietor (see, to that effect and by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 30, and Opinion of Advocate General Cruz Villalón in *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2013:563, point 31). Those conditions are cumulative.
- 27 It is in the light of those principles that this plea must be examined.
- 28 The Board of Appeal considered, in paragraph 41 of the contested decision, that the evidence produced by the applicant did not make it possible to show the transformation of the contested mark into a common name, in the trade, for the product in respect of which it was registered. More specifically, first, the applicant having failed to demonstrate that the contested mark was perceived as a common name in the trade by end consumers, the Board of Appeal took the view that that was enough to oppose the application for revocation submitted by the applicant. Second, however, the Board of Appeal continued its assessment by analysing the perception of the contested mark by the vendors of the product marketed under the contested mark, in particular pharmacists. Even if it were to be assumed that the penalty of revocation for transformation of the mark into a common name in the trade was also applicable to the assumption that the mark was quite capable of performing its function of an indication of origin for end consumers, the Board of Appeal found that the evidence produced by the applicant was inadequate to prove that the vendors of the product at issue perceived the contested mark as a common name in the trade for that product. The Board of Appeal considered, moreover, that, in any event, the evidence adduced by the applicant did not show exhaustively that even doctors and the scientific community perceived the contested mark as a common name. The contested mark was, therefore, quite capable of performing its function of an indication of origin.
- 29 None of the arguments put forward by the applicant can cast doubt on that finding.
- 30 According to the applicant, the Board of Appeal was wrong not to take account of the perception of the contested mark by specialist doctors and the medical and scientific community. As regards end consumers, the applicant submits that the Board of Appeal erred in not considering, on the one hand, that, among those end consumers, those who bought of their own accord the product marketed under the contested mark constituted an insignificant part [of those consumers] and, on the other, that they had limited, or even no, perception of the mark, knowledge of which they acquired after the dispensing of the prescription, without in fact making a choice at the time of purchase. The applicant maintains that the relevant circles are constituted of, first, the medical and scientific community, second, professionals who are involved in the marketing of the product, in particular doctors, and, third, end consumers, belonging however only to specific categories of patients with specific diseases.
- 31 In that regard, according to the case-law, in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially (see, by analogy, judgment of 29 April 2004, *Björnekulla Fruktindustrier*, C-371/02, EU:C:2004:275, paragraph 26).

- 32 The mark forms part of a process of communication between vendors and purchasers. That process produces its intended result and the trade mark fulfils the function justifying its existence only where both parties involved in the communication ‘understand’ the trade mark, in the sense that they are aware of its function of an indication of origin. If either party considers the trade mark to be a generic name, the information which the trade mark conveys is not transmitted (see, by analogy, Opinion of Advocate General Cruz Villalón in *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2013:563, point 58; see, to that effect and by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 29).
- 33 Nevertheless, a trade mark may, even if the purchaser does not know that it is a trade mark, continue to perform its function of an indication of origin when an intermediary exerts decisive influence over the purchaser’s decision to purchase and the intermediary’s knowledge of the trade mark’s function as an indication of origin thus leads to the success of the communication process. That is the case when it is customary in the relevant market for the intermediary to give advice which has a decisive bearing on the decision to purchase or where the intermediary actually makes the decision for the consumer himself, as is the case with pharmacists and doctors in relation to medicinal products available only on prescription (see, by analogy, Opinion of Advocate General Cruz Villalón in *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2013:563, point 59).
- 34 Thus, while the relevant circles include primarily consumers and end users, intermediaries playing a part in the assessment of the customary nature of the mark must also be taken into account (see, to that effect and by analogy, judgment of 6 March 2014, *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2014:130, paragraph 27 and the case-law cited, and Opinion of Advocate General Cruz Villalón in *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2013:563, point 59).
- 35 It follows from the case-law cited in paragraphs 31 to 34 above that the relevant circles, whose point of view must be taken into account when it is assessed whether the contested mark has become, in the trade, the common name of the product marketed under it, must be defined in the light of the characteristics of that product’s market.
- 36 In the circumstances of the case, the product marketed under the contested mark consists of a probiotic preparation for treating gastrointestinal disorders. That pharmaceutical product is freely available and may be purchased without a medical prescription, which is moreover accepted by the applicant. Nevertheless, the applicant claims that the proportion of end consumers who buy spontaneously, for the first time, without medical prescription or suggestion, the pharmaceutical product at issue constitutes an insignificant proportion of all end consumers. While it is unnecessary to rule on the relevance of that argument, it must be noted that the applicant has not substantiated it in any way.
- 37 The relevant circles thus include, in the first place, the end consumers of the product marketed under the contested mark. Given that the product does not require a medical prescription, end consumers, exposed in particular to the intervener’s advertising as well as to the comments of other patients, play a role in the decision to purchase that product, contrary to what is claimed by the applicant (see, to that effect, Opinion of Advocate General Kokott in *Alcon v OHIM*, C-412/05 P, EU:C:2006:687, point 55). End consumers include persons suffering from gastrointestinal disorders, and not only those persons with certain specific illnesses, as the applicant claims. Besides the fact that the applicant adduces no evidence in support of its assertion, it is apparent from the documents it submitted that the product marketed under the contested mark is also used for the treatment of gastrointestinal disorders.
- 38 In the second place, as regards professionals, the relevant circles include, primarily, as the Board of Appeal notes in paragraph 28 of the contested decision, pharmacists. The latter, who are likely to provide persons suffering from gastrointestinal disorders with explanations and advice, can play an

important role in end consumers' decision to purchase (see, to that effect and by analogy, Opinion of Advocate General Cruz Villalón in *Backaldrin Österreich The Kornspitz Company*, C-409/12, EU:C:2013:563, point 59).

- 39 The relevant circles, as far as professionals are concerned, also include doctors, both general practitioners and specialists. While it is true that the decision to purchase non-prescription medicinal products is very often decided solely by the end consumer, such products may also be acquired at the instigation of doctors (see, to that effect, Opinion of Advocate General Kokott in *Alcon v OHIM*, C-412/05 P, EU:C:2006:687, point 55).
- 40 By contrast, contrary to the applicant's claim, the scientific community is not part of the relevant circles, playing no part at all in the communication process between the vendor, on the one hand, and the purchaser, on the other. It has, in consequence, no influence over end consumers' decision to purchase.
- 41 Consequently, it is in the light of the relevant circles thus defined that the question whether the contested trade mark has become the common name in the trade for the product for which it is registered must be examined.
- 42 As a preliminary point, in the present case, having regard to the influence exercised by professionals, namely: pharmacists and doctors, over end consumers' decision to purchase, it follows from the case-law cited in paragraphs 31 to 34 above that the fact that end consumers still perceive the function as an indication of origin of the contested mark is not sufficient to frustrate the application for revocation of that mark given the importance of professionals' perception of it.
- 43 If, in the contested decision, the Board of Appeal initially restricted its analysis to the perception of the contested mark by end users only, that is not, however, liable to lead to annulment of the contested decision, inasmuch as the Board of Appeal then also took account of the perception of that mark by professionals, namely: pharmacists and doctors.
- 44 That being so, it must be noted that the applicant has not succeeded in showing that end consumers and professionals, namely: pharmacists and doctors, perceive the contested mark as a common name for the product at issue.
- 45 First of all, as regards end consumers of the product marketed under the contested mark, the applicant, which considers that they are not part of the relevant circles, does not demonstrate the change in their perception of the mark. In any event, the specialised scientific documents submitted by the applicant are not aimed at end consumers. As emphasised by the Board of Appeal in paragraph 29 of the contested decision, the word sign VSL#3 appears on the packaging of the product marketed under the contested mark followed, in addition, by the symbol '©'. The contested mark is, therefore, quite capable of performing its function of an indication of origin for end consumers.
- 46 Moreover, as regards professionals, the applicant, focusing its evidence exclusively on medical specialists and the scientific community, pays absolutely no heed to pharmacists and general practitioners' perception of the contested mark. However that may be, the specialised scientific documents submitted by the applicant do not make it possible to establish any change in the perception of that mark by pharmacists and doctors, whether general practitioners or specialists. First of all, the word sign VSL#3 has, in certain publications, a direct connection with a commercial origin, mentioned in parenthesis. Second, in the vast majority of articles, the reference to the word sign VSL#3 is preceded by expressions such as 'probiotic preparation', 'probiotic mixture' or even merely the word 'probiotic'. The contested mark not, therefore, being used as a common name, it is not presented as the common name in the trade for the product for which it is registered. Third, as stated for the sake of completeness by the Board of Appeal in paragraph 38 of the contested decision, the applicant does

not contradict the intervener when it claims that the word sign VSL#3 appears in no dictionary, has never been classified as a common name and is not included in the list of international non-proprietary names (INN).

- 47 Moreover, as regards pharmacists more particularly, they, as pointed out by the Board of Appeal in paragraph 30 of the contested decision, have knowledge of sources of production and marketing controls. The applicant has not shown that the documentation produced, mainly American, exerts any influence on them and on their perception of the contested mark. For the sake of completeness, as the Board of Appeal again states without being contradicted by the applicant, the fact that the contested mark is not used by other undertakings, competing with the intervener, runs counter to any change in the perception of that mark by pharmacists.
- 48 The contested mark therefore still performs its function of an indication of origin for professionals, namely: doctors and pharmacists.
- 49 Consequently, the applicant is not justified in claiming that the relevant circles now perceive the contested mark as the common name for the product in respect of which it is registered.
- 50 The first of the conditions listed in paragraph 26 above not being satisfied, the first plea in law must be rejected without considering whether the applicant has provided evidence to prove that transformation of the contested mark into a common name in the trade for the products it covers is caused by acts or inactivity of the intervener.

The second plea in law, alleging infringement of Article 51(1)(c) of Regulation No 207/2009

- 51 In the context of the second plea, alleging infringement of Article 51(1)(c) of Regulation No 207/2009, the applicant maintains that the Board of Appeal wrongly concluded that the misleading use of the contested mark after its registration had not been duly proved.
- 52 EUIPO and the intervener dispute the applicant's arguments.
- 53 Under Article 51(1)(c) of Regulation No 207/2009, the rights of the proprietor of the EU trade mark are to be declared to be revoked, on application to EUIPO or on the basis of a counterclaim in infringement proceedings, if, in consequence of the use made of the trade mark by its proprietor or with his consent in respect of the goods or services for which it is registered, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- 54 It is apparent from the case-law that the ground of revocation covered by Article 51(1)(c) of Regulation No 207/2009 presupposes the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see, to that effect, judgment of 14 May 2009, *Fiorucci v OHIM — Edwin (ELIO FIORUCCI)*, T-165/06, EU:T:2009:157, paragraph 33; see also, by analogy, judgment of 30 March 2006, *Emanuel*, C-259/04, EU:C:2006:215, paragraph 47).
- 55 Whether or not Article 51(1)(c) of Regulation No 207/2009 is applicable depends on misleading use of the mark after its registration. Such misleading use must be duly proved by the applicant (see, to that effect, judgment of 14 May 2009, *ELIO FIORUCCI*, T-165/06, EU:T:2009:157, paragraph 36).
- 56 It is in the light of the foregoing that this plea is to be examined.
- 57 In this instance, the Board of Appeal considered, in paragraph 52 of the contested decision, that misleading use of the contested mark after its registration had not been duly proved by the applicant. The rights of the proprietor of the contested mark were not, therefore, to be declared to be revoked,

under Article 51(1)(c) of Regulation No 207/2009. According to the Board of Appeal, it is only when the consumer concerned is led to believe that the products and services possess a certain characteristic, which they do not in fact possess, that he will be deceived by the mark. However, if the message communicated by the mark is not sufficiently clear to designate a specific characteristic of the products and services covered, that message cannot be considered to be deceptive. Given that it had already established that the contested mark was not the common name in the trade for the product in respect of which it was registered, and that it contained no descriptive indication of that product or of its characteristics, the Board of Appeal stated that that mark was not a sufficiently specific designation capable of giving rise to actual deceit or a sufficiently serious risk that the consumer would be deceived.

58 The applicant puts forward no argument capable of invalidating the assessment of the Board of Appeal.

59 First, according to the applicant, the word sign VSL#3 is the acronym for ‘Very Safe Lactobacilli’, the symbol ‘#’ meaning ‘number’ in English and the number 3 referring to the number of species of bifidobacteria. Since the second half of 2014 and the alterations made, by a different producer, to the formulation of the product in respect of which the contested mark is registered, the concept of ‘very safe lactobacilli’ has ceased to be applicable. The fact that the intervener has continued to use the contested mark for the new, potentially unsafe, product, by improperly appropriating the scientific literature on the active ingredient ‘VSL#3’ demonstrates the misleading nature of the intervener’s conduct.

60 While, having regard to the wording of Article 51(1)(c) of Regulation No 207/2009, alterations to the composition of a product covered by a mark can lead to the latter being revoked, it will be revoked only if it conveys incorrect information concerning the nature, quality or geographical origin of that product.

61 It is apparent from paragraphs 49 and 50 above that the contested mark has not become, in the trade, the common name for the product at issue in respect of which it is registered. Furthermore, the applicant has produced no evidence to show that the contested mark should be understood as being the acronym of ‘Very Safe Lactobacilli’. The descriptive character of the contested mark is, in consequence, not proved. Therefore, contrary to the applicant’s claim, the contested mark does not convey a clear message concerning the product at issue or its characteristics.

62 Given that the contested mark does not constitute a sufficiently specific designation capable of giving rise to actual deceit or a sufficiently serious risk that the consumer will be deceived, the applicant’s argument mentioned in paragraph 59 above must be rejected as unfounded.

63 Second, the applicant claims, in essence, that the intervener should be deprived of its rights because of the deterioration in quality of the product marketed under the contested mark. According to the applicant, since the second half of 2014, the formulation of that product, and more specifically its immunological and biochemical profile, has been radically altered. Therefore, the contested mark designates a product which no longer has the same safety profile or the same therapeutic effects as previously.

64 Contrary to the applicant’s claim and as is apparent from the case-law cited in paragraphs 53 to 55 above, the protection afforded to consumers under Article 51(1)(c) of Regulation No 207/2009 relates only to the intrinsic characteristics of the product, which those consumers expect having regard to the message conveyed by the mark. That provision is in no way intended to impose on the proprietor of a mark the obligation to ensure a certain level of quality, except where the mark conveys such a message. In the present case, the applicant having failed to show that the contested mark created any expectations on the part of consumers, whether linked to the intrinsic characteristics or to the quality

of the product at issue, the Board of Appeal was fully entitled to consider, in paragraph 50 of the contested decision, that the possible deterioration of the product at issue could result in a “decline” in commercial terms’, but not to legal revocation.

- 65 In addition, the Board of Appeal correctly stated in paragraph 51 of the contested decision that consumers were, at all events, in a position to assess directly the quality of the product at issue, when choosing it, given that the packaging of the two different formulations of that product provides all the necessary information concerning its content. In particular, as the Board of Appeal found without being challenged by the applicant, it is apparent from that packaging that the two formulations of the product at issue each contain eight different strains of live lactobacilli which, even though of different origin, are of the same species.
- 66 Consequently, the Board of Appeal was right to consider, in paragraph 52 of the contested decision, that misleading use of the contested mark after its registration had not been duly substantiated by the applicant.
- 67 In addition, it must be observed that the applicant’s unsubstantiated argument that the fact that market operators cannot use the probiotic mixture ‘VSL#3’ creates an undue monopoly and a clear distortion of competition adversely affecting consumer protection cannot be accepted.
- 68 Pursuant to Article 9(1) of Regulation No 207/2009 (now Article 9(1) of Regulation 2017/1001), the intervener, as proprietor of the contested mark, has been granted exclusive rights entitling it, inter alia, to prohibit third parties from using a sign in relation to which there exists, by reason of its similarity to the earlier trade mark and the identity of the products covered by the marks at issue, a likelihood of confusion on the part of the public. The advantage of the legal regime of the EU trade mark lies precisely in the fact that it enables holders of an earlier mark to oppose the registration of later marks which take unfair advantage of the distinctiveness or the repute of the earlier mark. Hence, far from according an unfair and unjustifiable monopoly to the proprietors of an earlier mark, that regime enables those proprietors to protect and exploit the substantial investment made to promote their earlier mark (judgment of 21 February 2006, *Royal County of Berkshire Polo Club v OHIM — Polo/Lauren (ROYAL COUNTY OF BERKSHIRE POLO CLUB)*, T-214/04, EU:T:2006:58, paragraph 43).
- 69 In the circumstances, inasmuch as it has not been demonstrated by the applicant that the contested mark was used misleadingly by the intervener, the latter is entitled to exercise its exclusive rights in accordance with Article 9(1) of Regulation No 207/2009.
- 70 In the light of the foregoing, the second plea must be rejected and, in consequence, the action dismissed in its entirety.

Costs

- 71 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.
- 72 Since the applicant has been unsuccessful, it must be ordered to bear its own costs and to pay those incurred by EUIPO and the intervener, in accordance with the forms of order sought by them.

On those grounds,

THE GENERAL COURT (Fifth Chamber),

hereby:

- 1. Dismisses the action;**
- 2. Orders Mendes SA to bear the costs.**

Gratsias

Dittrich

Xuereb

Delivered in open court in Luxembourg on 18 May 2018

[Signatures]