



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

13 May 2020*

(EU trade mark – Invalidity proceedings – EU word mark BIO-INSECT Shocker – Absolute ground for refusal – Mark likely to deceive the public – Article 7(1)(g) of Regulation (EC) No 207/2009)

In Case T-86/19,

SolNova AG, established in Zollikorn (Switzerland), represented by P. Lee, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by A. Söder, acting as Agent,

defendant,

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

Canina Pharma GmbH, established in Hamm (Germany), represented by O. Bischof, lawyer,

ACTION brought against the decision of the Second Board of Appeal of EUIPO of 11 December 2018 (Case R 276/2018-2), concerning invalidity proceedings between SolNova and Canina Pharma,

THE GENERAL COURT (Ninth Chamber),

composed of M.J. Costeira, President, B. Berke (Rapporteur) and T. Perišin, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 15 February 2019,

having regard to the response of EUIPO lodged at the Court Registry on 30 April 2019,

having regard to the response of the intervener lodged at the Court Registry on 24 April 2019,

* Language of the case: German.

having regard to the fact that no request for a hearing was submitted by the parties within three weeks of 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 26 November 2015, the intervener, Canina Pharma GmbH, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a mark was sought for the word sign BIO-INSECT Shocker.
- 3 The goods and services in respect of which registration was sought are in Classes 1, 5 and 31 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, for each of those classes, to the following description:
 - Class 1: ‘Biocidal preparations for use in manufacture; chemical preparations for use in the manufacture of biocides; additives, chemical, to insecticides’;
 - Class 5: ‘Disinfectants; vermin destroying preparations; parasiticides; bacteriological preparations for medical and veterinary use; nutritional supplements; medicinal sprays; antibacterial sprays; anti-inflammatory sprays; insecticides; insect attractants; anti-insect spray; insect repellents; preparations for destroying insects; insect growth regulators; tissues impregnated with insect repellents; powders for killing fleas; flea sprays; flea collars; flea exterminating preparations; animal flea collars; powders for killing fleas on animals; biocides; animal repellent formulations; veterinary preparations; veterinary diagnostic reagents; veterinary vaccines; food supplements for veterinary use; sanitary preparations for veterinary use’;
 - Class 31: ‘Live animals; fresh fruits and vegetables; malt; pet drinks; fodder’.
- 4 The trade mark application was published in *Community Trade Marks Bulletin* No 2015/229 of 2 December 2015 and the contested mark was registered on 10 March 2016 under number 014837553.
- 5 On 12 May 2016, the applicant, SolNova AG, submitted third-party observations against the registration of the contested mark, arguing that Article 7(1)(b), (c) and (f) of Regulation No 207/2009 (now Article 7(1)(b), (c) and (f) of Regulation 2017/1001) precluded the registration of that mark. Since those observations were submitted after the contested mark had already been registered, they were not taken into consideration by EUIPO.

- 6 On 25 July 2016, the applicant filed an application for a declaration of invalidity of the contested mark under Article 52(1)(a) of Regulation No 207/2009 (now Article 59(1)(a) of Regulation 2017/1001) and under Article 7(1)(b), (c), (f) and (g) of Regulation No 207/2009 (now Article 7(1)(b), (c), (f) and (g) of Regulation 2017/1001), for all the goods covered by that mark.
- 7 On 20 December 2017, the Cancellation Division rejected the application for a declaration of invalidity, finding, first, that the contested mark was not descriptive of the registered goods for the purposes of Article 7(1)(c) of Regulation 2017/1001 and, in particular, that the use of the term ‘shocker’ was unusual in reference to those goods.
- 8 The Cancellation Division further found that the contested mark possessed a sufficiently distinctive character for the purposes of Article 7(1)(b) of Regulation 2017/1001.
- 9 Lastly, the Cancellation Division decided that the contested mark was not contrary to public policy under Article 7(1)(f) of Regulation 2017/1001 and that it was not deceptive for the purposes of Articles 7(1)(g) of that regulation.
- 10 On 7 February 2018, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against the decision of the Cancellation Division.
- 11 By decision of 11 December 2018 (‘the contested decision’), the Second Board of Appeal of EUIPO dismissed the appeal.
- 12 In the first place, the Board of Appeal rejected the plea based on Article 7(1)(c) of Regulation 2017/1001 alleging that the contested mark was descriptive of the goods that it covered. First, it considered that the relevant public partly consisted of the general public and specialists and partly consisted exclusively of specialists. It also found that the level of consumer attention was average to high depending on the type of goods and that, since the contested mark was composed of English words, the relevant public to be taken into consideration was the English-speaking one.
- 13 Second, the Board of Appeal noted that some of the goods covered by the contested mark were related to insecticides or insecticide products (‘insecticide-related goods’) while others were not, and that the applicant had failed to put forward pleas and arguments establishing that the contested mark was descriptive of the latter.
- 14 Third, the Board of Appeal held that the English phrase ‘bio insect shocker’ was not a direct description of the characteristics of the insecticide-related goods, that the term was merely allusive and evocative and that, in order to arrive at the meaning of the contested mark which had been assumed by the applicant, namely an environmentally friendly product to exert a controlling effect on insects by putting them into a state of shock, the relevant consumers had to engage in a thought process involving several steps and make an intellectual effort. In that context, the Board of Appeal noted that the English word ‘shocker’ means ‘something that shocks’ and that that meaning is different from ‘kill’ or ‘repel’.
- 15 Fourth, the Board of Appeal considered that the applicant had failed to prove widespread use of the term ‘insect shocker’ in the course of trade. In that regard, it found that some of the evidence provided by the applicant was irrelevant because it concerned either use after the trade mark

application was made or use by undertakings which used the contested mark with the intervener's consent and that the remaining evidence was not sufficient to establish customary use.

- 16 In the second place, the Board of Appeal rejected the plea based on Article 7(1)(b) of Regulation 2017/1001 alleging that the contested mark was devoid of distinctive character on the ground that that plea was based solely on the mark's allegedly descriptive character.
- 17 In the third place, the Board of Appeal dismissed the plea under Article 7(1)(f) of Regulation 2017/1001 that the contested mark was contrary to public policy on the ground that the applicant had not proved that use of that mark necessarily constituted, at the time when the trade mark application was filed, an infringement of Regulation (EU) No 528/2012 of the European Parliament and of the Council of 22 May 2012 concerning the making available on the market and use of biocidal products (OJ 2012 L 167, p. 1).
- 18 In the fourth place, the Board of Appeal rejected the plea based on Article 7(1)(g) of Regulation 2017/1001 alleging that the contested mark was of such a nature as to deceive the public, on the ground that the applicant had not proved that the mark could be classified as deceptive, which it had inferred from an alleged infringement of Regulation No 528/2012, and that a non-deceptive use of the contested mark was possible.

Forms of order sought

- 19 By application lodged at the Court Registry on 15 February 2019, the applicant brought the present action.
- 20 The applicant claims that the Court should:
 - annul the contested decision;
 - order the intervener to pay the costs, including those incurred by the applicant before the Board of Appeal.
- 21 EUIPO contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs.
- 22 The intervener contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs.

Law

Applicable law

- 23 As a preliminary point, it must be borne in mind that under settled case-law, when considering whether the absolute grounds referred to in Article 7(1) of Regulation No 207/2009 preclude the registration of a mark or must give rise to a declaration that a previously registered mark is invalid, the adjudicating bodies of EUIPO must take the date of filing of the application for registration as the material date (see judgments of 21 November 2013, *Heede v OHIM (Matrix-Energetics)*, T-313/11, not published, EU:T:2013:603, paragraph 47 and the case-law cited, and of 8 May 2019, *VI.TO. v EUIPO – Bottega (Shape of a golden bottle)*, T-324/18, not published, EU:T:2019:297, paragraph 17 and the case-law cited).
- 24 Under Article 212 of Regulation 2017/1001, that regulation is applicable from 1 October 2017, and its wording, purpose and scheme do not indicate that Article 7 should apply to situations established before its entry into force.
- 25 In the present case, since registration of the contested mark was sought on 26 November 2015, Article 7 of Regulation No 207/2009 is applicable.
- 26 However, it is apparent from paragraph 12 of the contested decision that the Board of Appeal relied on Regulation 2017/1001, as did the applicant, which quoted that regulation in the application.
- 27 Nonetheless, since Article 7(1)(b), (c), (f) and (g) of Regulation No 207/2009 was not amended by Regulation 2017/1001, the fact that the Board of Appeal and the applicant relied on Article 7 of Regulation 2017/1001 is irrelevant to the present case. Accordingly, the contested decision and the application must be read as referring to Regulation No 207/2009.

Substance

- 28 In support of its action, the applicant raises three pleas in law alleging (i) infringement of Article 7(1)(b) and (c) of Regulation No 207/2009; (ii) infringement of Article 7(1)(f) of that regulation; and (iii) infringement of Article 7(1)(g) of that regulation.
- 29 The Court considers it expedient to deal with the first plea, then the third plea.

The first plea, alleging infringement of Article 7(1)(b) and (c) of Regulation No 207/2009

- 30 By its first plea, the applicant challenges the Board of Appeal's assessment that the contested mark is not distinctive and is descriptive for the purposes of Article 7(1)(b) and (c) of Regulation No 207/2009 for insecticide-related goods.
- 31 EUIPO and the intervener dispute the applicant's arguments.
- 32 Under Article 7(1)(c) of Regulation No 207/2009, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service,

or other characteristics of the goods or service are not to be registered. Under Article 7(2) of that regulation, paragraph 1 is to apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union.

- 33 Thus, Article 7(1)(c) of Regulation No 207/2009 prevents the signs and indications to which it refers from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim which is in the public interest, namely that signs or indications may be freely used by all (judgments of 23 October 2003, *OHIM v Wrigley*, C-191/01 P, EU:C:2003:579, paragraph 31, and of 27 February 2015, *Universal Utility International v OHIM (Greenworld)*, T-106/14, not published, EU:T:2015:123, paragraph 14).
- 34 Moreover, a sign's descriptiveness can only be assessed, first, in relation to the way in which it is understood by the relevant public and, second, in relation to the goods or services concerned (see judgment of 14 July 2017, *Klassisk investment v EUIPO (CLASSIC FINE FOODS)*, T-194/16, not published, EU:T:2017:498, paragraph 22 and the case-law cited).
- 35 Consequently, for a sign to be caught by the prohibition set out in Article 7(1)(c) of Regulation No 207/2009, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgment of 14 July 2017, *CLASSIC FINE FOODS*, T-194/16, not published, EU:T:2017:498, paragraph 20 and the case-law cited).
- 36 In that respect, first of all, the Board of Appeal found that the relevant public consisted partly of the general public and specialists and partly of specialists exclusively, that the level of attention was average to high depending on the goods and that the assessment would be based on the English-speaking public since the mark in question was composed of English words.
- 37 The applicant does not dispute the findings of the Board of Appeal on that point.
- 38 Second, the Board of Appeal noted that, according to the *Oxford English Dictionary*, the English word 'shocker' means, in essence, something that shocks, especially through being unacceptable or sensational, and that the related English verb 'to shock' means to 'cause (someone) to feel surprised and upset' or to 'affect someone with physiological shock, or with an electric shock'.
- 39 Having found, in essence, that the insecticide-related goods in respect of which the contested mark was registered were intended to kill or repel insects, and not to subject them to an electric shock or to put them into a state of shock, the Board of Appeal found that several mental steps were required to establish a link between the words 'bio insect shocker' and the meaning presumed by the applicant and, therefore, that the mark was not a descriptive sign, but an evocative or allusive one.
- 40 In addition, the Board of Appeal considered that the applicant had failed to prove widespread use of the term 'insect shocker' in the course of trade. In that regard, it considered that part of the evidence provided by the applicant was irrelevant because it concerned use either subsequent to the trade mark application or by undertakings using the contested trade mark with the intervener's consent, and that the two remaining items of evidence were not sufficient to prove customary use.

- 41 In the first place, the applicant submits that the term ‘shocker’ describes an obvious, possible or intended insect repellent mode of action and that it is easily conceivable that chemical insect repellents will put insects into a state of shock or repel them, so the consumer will establish, without further thought, a direct and specific relationship between the contested mark and the goods covered by the application.
- 42 The applicant does not contest the meaning of the word ‘shocker’ established by the Board of Appeal, according to which it refers to the idea of something that shocks, but adds that the word will also easily be understood as referring to the idea of an insect repellent.
- 43 However, it should be noted in this regard that, according to the *Oxford English Dictionary* definition, there is nothing to suggest that the relevant public will make a connection between the term ‘shocker’ and an anti-insect or insect repellent product.
- 44 Since the meaning of the word refers to the idea of something that shocks and not that kills or repels, several mental steps are required for the relevant public to perceive the contested mark as a description of the goods concerned or one of their characteristics.
- 45 There is not therefore a sufficiently direct and specific relationship between them within the meaning of the case-law cited in paragraph 35 above to enable the public concerned immediately to perceive, without further thought, a description of the goods in question or one of their characteristics.
- 46 In the second place, the applicant submits that the terms ‘shocker’ and ‘insect shocker’ were used prior to the filing date of the contested mark to describe various goods in the generic class of insect repellents. Therefore, the relevant consumer will not associate the term with a particular origin of the various goods, but only with a generic term for insect repellents.
- 47 Furthermore, insect repellents produced by various manufacturers are marketed under the name Bio Insect Shocker and the Board of Appeal considered incorrectly that two of the items of evidence submitted concerned undertakings which had used the contested mark with the intervener’s consent.
- 48 In support of its point that use of the word ‘shocker’ is customary for insect repellents, the applicant first adduces three items of evidence, in Annexes L 5, L 6 and L 7 to the application.
- 49 As EUIPO points out, those documents were produced for the first time before the Court.
- 50 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 72 of Regulation 2017/1001, so it is not the Court’s function to review the facts in the light of documents produced for the first time before it. The abovementioned documents must therefore be excluded, and there is no need to assess 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).
- 51 Second, the applicant produced before the Cancellation Division a copy of the website ‘amazon.co.uk’ dated 11 March 2017 showing an insect repellent geranium called ‘Mosquito-Shocker’. That document shows that the product was available on the site from 31 March 2014.

- 52 In addition, the applicant produced before the Cancellation Division a copy of an advertisement dated 11 March 2017 for a product called ‘Dr Obermann’s Insect shocker spray for dogs and cats’.
- 53 The applicant also produced before the Cancellation Division a printout from the website ‘sk-snakes.de’ dated 11 March 2017 showing the ‘Bio Insect Shocker 150 ml – Milbenspray’ produced by the manufacturer Dragon.
- 54 In addition, the applicant produced before the Cancellation Division a printout from the website ‘www.aponeo.de’ dated 11 March 2017 showing the ‘Bio Insect Shocker flüssig’ produced by the manufacturer organicVet GmbH, established in Gutenbergstr. 11, 26632 Ihlow.
- 55 Finally, the applicant produced before the Cancellation Division a printout from the website ‘www.canina.de’ dated 14 March 2017 concerning the ‘Petvital Bio-Insect-Shocker’, a biological pest control aerosol which repels fleas, lice, chewing lice, mites and ticks.
- 56 Third, before the Board of Appeal, the applicant produced an undated screenshot from the ‘Dr Obermann’s’ website, a screenshot from the ‘Dr Obermann’s’ website mentioning ‘Dr Obermann’s Insect shocker spray for dogs and cats’, an undated screenshot from the ‘Amazon’ website where products from the Dr Obermann’s brand were on sale, and an undated screenshot of a Google search using the keyword ‘Fahrrad [bicycle]’.
- 57 The Board of Appeal found that the evidence submitted was insufficient on the grounds that, with the exception of the screenshot of the website ‘amazon.co.uk’ in Annex L 2 to the EUIPO file, the evidence submitted was either dated after the application for registration or undated; that two of the four examples were from undertakings using the sign Bio Insect Shocker with the intervener’s consent; and that the third example was from an undertaking against which the intervener had taken legal action for infringement of the contested trade mark.
- 58 In that regard, it should be recalled that, under the case-law, when considering whether the absolute grounds referred to in Article 7(1) of Regulation No 207/2009 preclude the registration of a mark or must give rise to a declaration that a previously registered mark is invalid, the adjudicating bodies of EUIPO must take the date of filing of the application for registration as the material date (see judgments of 21 November 2013, *Matrix-Energetics*, T-313/11, not published, EU:T:2013:603, paragraph 47 and the case-law cited, and of 8 May 2019, *Shape of a golden bottle*, T-324/18, not published, EU:T:2019:297, paragraph 17 and the case-law cited).
- 59 That obligation, however, does not preclude the adjudicating bodies of EUIPO from taking into account, where appropriate, material subsequent to the application for registration, provided that such material allows conclusions to be drawn with regard to the situation as it was on that date (see judgment of 6 March 2014, *Pi-Design and Others v Yoshida Metal Industry*, C-337/12 P to C-340/12 P, not published, EU:C:2014:129, paragraph 60 and the case-law cited).
- 60 The evidence of the descriptive character of the contested mark must therefore relate to the date when the application for registration was filed, namely 26 November 2015, or make it possible to draw conclusions with regard to the situation as it was on that date.
- 61 Only Annex L 2 produced before the Cancellation Division, which refers to the use of the element ‘shocker’ for an insect repellent from 2014, allows conclusions to be drawn with regard to the situation as it was on the date of the application for registration.

- 62 It must therefore be found that the Board of Appeal was entitled, without making an error of assessment, to consider that the evidence adduced was not sufficient to establish widespread use of the term ‘shocker’ to designate insect repellents.
- 63 It follows from the foregoing that the Board of Appeal did not commit an error of assessment in finding that the contested mark had been registered in accordance with Article 7(1)(c) of Regulation No 207/2009.
- 64 In the third place, in its first plea, the applicant claims that the contested mark is devoid of distinctive character on the ground that the relevant public will not have to take several mental steps to envisage the intended mode of action.
- 65 Since the applicant’s submissions concerning the contested mark’s alleged lack of distinctiveness under Article 7(1)(b) of Regulation No 207/2009 are based exclusively on its alleged descriptive character and since the contested mark is not descriptive of the goods concerned, that plea cannot be upheld.
- 66 The first plea is therefore unfounded and must be rejected.

The third plea, alleging infringement of Article 7(1)(g) of Regulation No 207/2009

- 67 By its third plea, the applicant submits, in essence, that the contested mark is of such a nature as to deceive the public within the meaning of Article 7(1)(g) of Regulation No 207/2009, in so far as it will be perceived by the relevant public as relating to organic goods or goods associated with respect for the environment.
- 68 At the outset, it should be noted that, in its third plea, the applicant disputes only the assessment of the deceptive nature of the mark in relation to the goods which the Board of Appeal identified as biocides in paragraphs 48 and 49 of the contested decision.
- 69 EUIPO and the intervener contend, in essence, that there is not a sufficient risk of deception because the relevant public will not associate the word ‘bio’ with the goods being harmless for the environment or health and because a non-deceptive use of the sign is possible.
- 70 Under Article 7(1)(g) of Regulation No 207/2009, registration is to be refused for trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.
- 71 According to settled case-law, the circumstances for refusing registration referred to by Article 7(1)(g) of Regulation No 207/2009 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see judgment of 29 November 2018, *Khadi and Village Industries Commission v EUIPO – BNP Best Natural Products (Khadi Ayurveda)*, T-683/17, not published, EU:T:2018:860, paragraph 44 and the case-law cited).
- 72 It must be borne in mind, in this respect, that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish those goods or services from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the

control of a single undertaking which is responsible for their quality. A trade mark no longer fulfils that role of acting as a guarantee if the information that it contains deceives the public (see judgment of 29 November 2018, *Khadi Ayurveda*, T-683/17, not published, EU:T:2018:860, paragraph 45 and the case-law cited).

- 73 In paragraph 58 of the contested decision, the Board of Appeal found, in relation to the goods that it had identified as biocides, that, since the applicant had not proved that the contested mark infringed Article 69(2) and Article 72(3) of Regulation No 528/2012, there could be no infringement of Article 7(1)(g) of Regulation No 207/2009.
- 74 It also stated that there was no infringement of Article 7(1)(g) of Regulation No 207/2009 because a non-deceptive use of the sign was possible.
- 75 Article 3(1)(a) of Regulation No 528/2012 defines a biocidal product as any substance or mixture, in the form in which it is supplied to the user, consisting of, containing or generating one or more active substances, with the intention of destroying, deterring, rendering harmless, preventing the action of, or otherwise exerting a controlling effect on, any harmful organism by any means other than mere physical or mechanical action.
- 76 Article 69(2) of Regulation No 528/2012 provides:
'... Authorisation holders shall ensure that labels are not misleading in respect of the risks from the product to human health, animal health or the environment or its efficacy and, in any case, do not mention the indications "low-risk biocidal product", "non-toxic", "harmless", "natural", "environmentally friendly", "animal friendly" or similar indications ...'
- 77 Furthermore, Article 72(3) of Regulation No 528/2012 reads:
'Advertisements for biocidal products shall not refer to the product in a manner which is misleading in respect of the risks from the product to human health, animal health or the environment or its efficacy. In any case, the advertising of a biocidal product shall not mention "low-risk biocidal product", "non-toxic", "harmless", "natural", "environmentally friendly", "animal friendly" or any similar indication.'
- 78 First of all, it is apparent from those provisions that the presence of indications on a biocidal product such as those in respect of which the contested trade mark is registered which give the impression that that product is natural, does not harm health or is environmentally friendly is of such a nature as to mislead and deceive the consumer.
- 79 The presence of such an indication on a biocidal product is therefore sufficient to establish a sufficiently serious risk of deceiving the consumer for the purposes of the case-law referred to in paragraph 71 above.
- 80 On that point, the Court has previously held that the use of the word element 'bio' as a prefix or suffix has acquired a highly suggestive connotation, which may be perceived in different ways according to the product offered for sale, but which, in general, refers to the idea of environmental protection, the use of natural materials or even ecological manufacturing processes (see, to that effect, judgments of 29 April 2010, *Kerma v OHIM (BIOPIETRA)*, T-586/08, not published, EU:T:2010:171, paragraph 25; of 21 February 2013, *Laboratoire Bioderma v OHIM – Cabinet*

Continental (BIODERMA), T-427/11, not published, EU:T:2013:92, paragraphs 45 and 46; and of 10 September 2015, *Laverana v OHIM (BIO FLUIDE DE PLANTE PROPRE FABRICATION)*, T-568/14, not published, EU:T:2015:625, paragraph 17).

- 81 Moreover, according to Article 2(c) of Council Regulation (EC) No 834/2007 of 28 June 2007 on organic production and labelling of organic products and repealing Regulation (EEC) No 2092/91 (OJ 2007 L 189, p. 1), the term ‘organic’ describes products coming from or related to organic production. It is apparent from recital 1 of that regulation that that term relates to concepts such as respect for the environment, biodiversity and products produced using natural substances and processes. Article 23(1) of that regulation states that that definition also covers diminutives such as ‘bio’ (judgment of 5 June 2019, *Biolatte v EUIPO (Biolatte)*, T-229/18, not published, EU:T:2019:375, paragraph 49).
- 82 Such remarks can also be made, in the present case, with respect to the perception of the word element ‘bio’ by the relevant English-speaking public.
- 83 The presence of the term ‘bio’ on the biocidal products in respect of which the contested mark is registered therefore suffices to establish a sufficiently serious risk that the consumer will be deceived.
- 84 Next, the Court has already held that Article 7(1)(g) of Regulation No 207/2009 applies even if a non-deceptive use of the mark at issue is possible (see, to that effect, judgment of 27 October 2016, *Caffè Nero Group v EUIPO (CAFFÈ NERO)*, T-29/16, not published, EU:T:2016:635, paragraphs 48 and 49).
- 85 The fact that a non-deceptive use of the mark is possible, even assuming this were proved, cannot, therefore, rule out an infringement of Article 7(1)(g) of Regulation No 207/2009.
- 86 Lastly, the fact that the intervener is not an authorisation holder within the meaning of Regulation No 528/2012 is irrelevant, since it does not rid the term ‘bio’ affixed to biocidal products of its deceptiveness in connection with that regulation.
- 87 It follows that the Board of Appeal committed an error of assessment in finding that the contested mark was not deceptive in respect of the goods which it had identified as biocidal products.
- 88 Consequently, the third plea should be upheld and the contested decision annulled in so far as it as it relates to ‘biocidal preparations for use in manufacture; chemical preparations for use in the manufacture of biocides; additives, chemical, to insecticides’, included in Class 1, and ‘disinfectants; vermin destroying preparations; parasiticides; bacteriological preparations for medical and veterinary use; medicinal sprays; antibacterial sprays; insecticides; insect attractants; anti-insect spray; insect repellents; preparations for destroying insects; insect growth regulators; tissues impregnated with insect repellents; powders for killing fleas; flea sprays; flea collars; flea exterminating preparations; animal flea collars; powders for killing fleas on animals; biocides; animal repellent formulations; veterinary preparations; veterinary vaccines; sanitary preparations for veterinary use’ included in Class 5.
- 89 In the light of the foregoing finding and in so far as the second plea relates to the same goods as the third plea, there is no need to examine the second plea.

Costs

- 90 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. In addition, under Article 134(2) of those rules, where there is more than one unsuccessful party the Court is to decide how the costs are to be shared.
- 91 In the present case, EUIPO and the intervener have been unsuccessful for the main part, but the applicant has requested only that the intervener be ordered to pay the costs.
- 92 In that regard, it must be borne in mind that, under Article 135(1) of the Rules of Procedure, the Court may decide, if equity so requires, that an unsuccessful party is to pay only a proportion of the costs of the other party in addition to bearing its own, or even that it is not to be ordered to pay any costs. Therefore, in the present case, in addition to its own costs, the intervener must be ordered to pay half of the costs incurred by the applicant before the Court. The applicant is to bear half of its own costs. EUIPO is to bear its own costs.
- 93 The applicant has also claimed that the intervener should be ordered to pay the costs incurred in the proceedings before the Board of Appeal. On that point, it should be remembered that, under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs. However, that does not apply to costs incurred for the purposes of the proceedings before the Cancellation Division. Accordingly, the intervener must be ordered to pay the costs incurred by the applicant before the Board of Appeal.

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 11 December 2018 (Case R 276/2018-2) in so far as it relates to 'biocidal preparations for use in manufacture; chemical preparations for use in the manufacture of biocides; additives, chemical, to insecticides', included in Class 1, and 'disinfectants; vermin destroying preparations; parasiticides; bacteriological preparations for medical and veterinary use; medicinal sprays; antibacterial sprays; insecticides; insect attractants; anti-insect spray; insect repellents; preparations for destroying insects; insect growth regulators; tissues impregnated with insect repellents; powders for killing fleas; flea sprays; flea collars; flea exterminating preparations; animal flea collars; powders for killing fleas on animals; biocides; animal repellent formulations; veterinary preparations; veterinary vaccines; sanitary preparations for veterinary use' included in Class 5;**
- 2. Dismisses the action as to the remainder;**
- 3. Orders Canina Pharma GmbH to bear, in addition to its own costs, half of the costs incurred by SolNova AG before the Court and the costs necessarily incurred by it for the purposes of the proceedings before the Board of Appeal of EUIPO;**

4. Orders SolNova to bear half of its own costs before the Court;

5. Orders EUIPO to bear its own costs.

Costeira

Berke

Perišin

Delivered in open court in Luxembourg on 13 May 2020.

[Signatures]