



## Reports of Cases

JUDGMENT OF THE GENERAL COURT (Sixth Chamber, Extended Composition)

29 June 2022\*

(EU trade mark – Invalidity proceedings – EU figurative mark La Irlandesa 1943 – Absolute grounds for invalidity – Declaration of invalidity by the Grand Board of Appeal of EUIPO – Evidence submitted for the first time before the Court – Relevant date for the examination of an absolute ground for invalidity – Mark of such a nature as to deceive the public – Article 7(1)(g) of Regulation (EC) No 207/2009 (now Article 7(1)(g) of Regulation (EU) 2017/1001) – Bad faith – Article 52(1)(b) of Regulation No 207/2009 (now Article 59(1)(b) of Regulation 2017/1001))

In Case T-306/20,

**Hijos de Moisés Rodríguez González, SA**, established in Las Palmas de Gran Canaria (Spain), represented by J. García Domínguez, lawyer,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by A. Folliard-Monguiral, D. Hanf and E. Markakis, acting as Agents,

defendant,

the other party to the proceedings before the Grand Board of Appeal of EUIPO being

**Ireland,**

and

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

**Ornua Co-operative Ltd**, established in Dublin (Ireland), represented by E. Armijo Chávarri and A. Sanz Cerralbo, lawyers,

THE GENERAL COURT (Sixth Chamber, Extended Composition),

composed of A. Marcoulli, President, S. Frimodt Nielsen, J. Schwarcz (Rapporteur), C. Iliopoulos and R. Norkus, Judges,

\* Language of the case: English.

Registrar: A. Juhász-Tóth, Administrator,  
having regard to the written part of the procedure,  
further to the hearing on 3 February 2022,  
gives the following

### Judgment

- 1 By its action under Article 263 TFEU, the applicant, Hijos de Moisés Rodríguez González, SA, seeks the annulment of the decision of the Grand Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 2 March 2020 (Case R 1499/2016-G) ('the contested decision').

### Background to the dispute

- 2 On 6 August 2013, the applicant filed an application for registration of an EU trade mark with 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)).
- 3 Registration as a mark was sought for the following figurative sign:



- 4 On 3 January 2014, the mark applied for was registered in respect of the following goods in Class 29 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: 'Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats'.
- 5 On 7 January 2015, Ireland and the intervener, Ornuu Co-operative (previously known as Irish Dairy Board Co-operative Ltd), filed an application for a declaration that the contested mark was invalid in respect of all the goods referred to in paragraph 4 above.
- 6 In the application for a declaration of invalidity it was claimed that the mark was deceptive under the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) of that regulation (now Article 59(1)(a) and Article 7(1)(g) of Regulation 2017/1001), and that the registration of that mark had been applied for in bad faith for the purposes of Article 52(1)(b) of that regulation (now Article 59(1)(b) of Regulation 2017/1001).

- 7 By decision of 15 June 2016, the Cancellation Division rejected the application for a declaration of invalidity in its entirety. It found that Article 7(1)(g) of Regulation No 207/2009 was not applicable, because it had to be established that the contested mark was deceptive at the time it was filed. The Cancellation Division took the view that, in the case before it, any possible deception resulted from the use of that mark after the end of the commercial agreement which had been entered into by the applicant and the intervener and which was in force from 1967 to 2011. It found that that situation was specifically covered by the ground for revocation laid down in Article 51(1)(c) of Regulation No 207/2009 (now Article 58(1)(c) of Regulation 2017/1001). The Cancellation Division also rejected the argument raised under Article 52(1)(b) of that regulation, finding that no conclusion regarding bad faith could be drawn from the fact that the contested mark had been filed after the termination of the business relationship with the intervener.
- 8 On 12 August 2016, Ireland and the intervener filed a notice of appeal with EUIPO against the Cancellation Division's decision.
- 9 By decision of 6 December 2017, the Presidium of the Boards of Appeal referred the case to the Grand Board of Appeal.
- 10 By the contested decision, the Grand Board of Appeal of EUIPO found that, at the time when the application for registration was filed, the contested mark was used in a deceptive manner. It also found that the registration of that mark had been applied for in bad faith. Consequently, it annulled the Cancellation Division's decision and declared the contested mark invalid.

### **Forms of order sought**

- 11 The applicant claims that the Court should:
- annul the contested decision;
  - order EUIPO and the intervener to pay the costs.
- 12 EUIPO and the intervener contend that the Court should:
- dismiss the action;
  - order the applicant to pay the costs.
- 13 Ireland has not lodged a response and has not therefore sought any form of order in the present case.

### **Law**

- 14 In view of the date on which the application for registration at issue was filed, namely 6 August 2013, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009 (see, to that effect, judgment of 29 September 2021, *Univers Agro v EUIPO – Shandong Hengfeng Rubber & Plastic (AGATE)*, T-592/20, not published, EU:T:2021:633, paragraph 19 and the case-law cited). Moreover, since, according to settled case-law, procedural rules are generally held to apply on the

date on which they enter into force (see, to that effect, judgment of 8 September 2021, *Qx World v EUIPO – Mandelay (EDUCTOR)*, T-84/20, not published, EU:T:2021:555, paragraph 17 and the case-law cited), the present dispute is governed by the procedural provisions of Regulation 2017/1001.

- 15 Consequently, in the present case, so far as concerns the substantive rules, the references to Article 59(1)(a) and (b) and to Article 7(1)(g) of Regulation 2017/1001 made by the Grand Board of Appeal in the contested decision and by the parties to the proceedings must be understood as referring to Article 52(1)(a) and (b) and Article 7(1)(g) of Regulation No 207/2009 respectively, which are worded identically to those later provisions.

### ***Documents submitted for the first time before the Court***

- 16 EUIPO and the intervener contend that Annexes A.6 to A.8 to the application are inadmissible. They argue that those annexes contain documents which were never submitted in the course of the administrative proceedings before EUIPO and which must therefore, according to settled case-law, be declared inadmissible.
- 17 It must be stated, as EUIPO and the intervener maintain, that Annexes A.6 to A.8 to the application were submitted for the first time before the Court. Annexes A.6 and A.7 contain documents relating to advertising expenditure, as well as certain invoices and data regarding annual sales under the contested mark. They seek to prove both the size of that mark's market share in the Canary Islands (Spain) and its reputation there, as well as the distinctive character acquired by that mark. Annex A.8 consists of a sworn statement by one of the applicant's representatives dated 15 May 2020, that is to say, after the contested decision, which was delivered on 2 March 2020.
- 18 Those documents, which were produced for the first time before the Court, cannot be taken into consideration. The purpose of actions before the Court is to review the legality of decisions of the Boards of Appeal of EUIPO in accordance with 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. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value (see, to that effect, judgments 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, and of 18 March 2016, *Karl-May-Verlag v OHIM – Constantin Film Produktion (WINNETOU)*, T-501/13, EU:T:2016:161, paragraph 17).

### ***Substance***

#### *Preliminary observations regarding the pleas raised by the applicant and the structure of the contested decision*

- 19 The applicant relies on two pleas in law, alleging, first, infringement of the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof, relating to trade marks which are of such a nature as to deceive the public, and, second, infringement of Article 52(1)(b) of that regulation; a provision concerning trade mark applications which have been filed in bad faith.

- 20 The reasoning in the contested decision is based on two pillars, which correspond to the first plea and the second plea, respectively.
- 21 Where the operative part of a decision is based on several pillars of reasoning, each of which would in itself be sufficient to justify that operative part, that decision should, in principle, be annulled only if each of those pillars is vitiated by an illegality. In such a case, an error or other illegality which affects only one of the pillars of reasoning cannot be sufficient to justify annulment of the decision at issue because that error could not have had a decisive effect on the operative part adopted by the decision maker (judgment of 20 January 2021, *Jareš Procházková and Jareš v EUIPO – Elton Hodinářská (MANUFACTURE PRIM 1949)*, T-656/18, not published, EU:T:2021:17, paragraph 19 and the case-law cited; see also, to that effect, judgment of 29 January 2020, *Vinos de Arganza v EUIPO – Nordbrand Nordhausen (ENCANTO)*, T-239/19, not published, EU:T:2020:12, paragraph 49 and the case-law cited).
- 22 Consequently, the contested decision can be annulled only if both pillars of the Grand Board of Appeal's reasoning are vitiated by an illegality.
- 23 Furthermore, it must be stated that, before determining whether the contested mark was deceptive or whether it had been filed in bad faith, the Grand Board of Appeal examined the inherent characteristics of that mark, which served as the basis for the reasoning set out in the contested decision. It must therefore be ascertained, first of all, before ruling on the two pleas put forward by the applicant, whether that examination was correctly carried out.

*The inherent characteristics of the contested mark, and the goods covered by that mark*

- 24 The Grand Board of Appeal found that the contested mark was a figurative sign, which consisted of the words 'la' and 'irlandesa' in white letters on a green label with a yellow border and included a design (also in yellow) and the inscription '1943' in small letters under those words.
- 25 Next, the Grand Board of Appeal deduced from the fact that the words contained in that mark were Spanish that the relevant public would be the average Spanish-speaking consumer for whom the goods at issue, namely foodstuffs in Class 29, were intended. According to the Grand Board of Appeal, the word element of the contested mark was the dominant element and clearly meant, for that consumer, that someone (a woman) or something was of Irish origin.
- 26 The Grand Board of Appeal added that it was a well-known fact that the colour green was used to represent Ireland, for example at internationally celebrated festivities such as Saint Patrick's Day. It noted that Ireland was known as the 'Emerald Isle'; a reference to the greenness of its countryside. It found that that colour would confirm the public's perception that the goods bearing the contested mark were of Irish origin, particularly because those goods were foodstuffs which could be produced in Ireland and some of them, such as meat, fish and butter, were known for their quality if they were of Irish origin.
- 27 There is nothing which calls into question the Grand Board of Appeal's analysis regarding the inherent characteristics of the contested mark and concerning the meaning of that mark for the relevant public.
- 28 By virtue of its relative size and its central position, the word element is dominant in the contested mark, in particular in comparison with the inscription '1943', which is in small letters. It is also dominant in comparison with the yellow design which is situated immediately below it. In that

regard, it should be borne in mind that, where a mark is composed of word elements and figurative elements, as is the case here, the former are, as a rule, more distinctive than the latter, because the average consumer will more easily refer to the goods in question by citing the name rather than by describing the figurative element of the mark (see judgments of 7 May 2015, *Cosmowell v OHIM – Haw Par (GELENGOLD)*, T-599/13, EU:T:2015:262, paragraph 48 and the case-law cited, and of 5 May 2021, *Grangé and Van Strydonck v EUIPO – Nema (âme)*, T-442/20, not published, EU:T:2021:237, paragraph 38).

- 29 The applicant conceded in its application before the Court that it agreed with the persons applying for a declaration of invalidity at least as regards the following meanings of the word element ‘la irlandesa’ of the contested mark: ‘native of Ireland, of the country of Ireland’ or ‘Irish woman’, the feminine definite article ‘la’ being added to those words. It observes that the Royal Spanish Academy’s *Diccionario de la lengua española* (Dictionary of the Spanish Language) and the *Collins English Dictionary* both include those meanings, which are, in its view, those which are relevant in the present case.
- 30 It must therefore be held that the dominant word element of the contested mark has such a meaning in Spanish; a fact which supports the Grand Board of Appeal’s finding that that element clearly indicates an Irish origin for the average Spanish-speaking consumer.
- 31 As regards the colour green in the contested mark, it should be noted that well-known facts are defined as facts which are likely to be known by anyone or which may be learnt from generally accessible sources (see judgments of 13 December 2018, *Monolith Frost v EUIPO – Dovgan (PLOMBIR)*, T-830/16, EU:T:2018:941, paragraph 32 and the case-law cited, and of 10 June 2020, *Louis Vuitton Malletier v EUIPO – Wisniewski (Representation of a chequerboard pattern)*, T-105/19, not published, EU:T:2020:258, paragraph 30 and the case-law cited).
- 32 The Grand Board of Appeal was fully entitled to find that it was a well-known fact that the colour green was used to represent Ireland. It explained in a convincing manner that that colour performed that function when the Irish festival of Saint Patrick’s Day was celebrated and that Ireland was known as the ‘Emerald Isle’; a reference to the greenness of its countryside.
- 33 That function of representing Ireland performed by the colour green, although it is not necessarily likely to be known by anyone, may nevertheless be learnt from generally accessible sources.
- 34 In that regard, in the application, the applicant refers to an argument which it put forward before the Cancellation Division, according to which the colour green was merely one aspect of the ‘play made by the [contested] sign on freshness (green pastures) and the sun (yellow)’. That argument cannot, however, succeed, because, even if the colour green were to perform such a function, it would not be inconsistent with the well-known fact stated by the Grand Board of Appeal that that colour represented Ireland. Moreover, the applicant has not adduced any evidence before the Court to contest the accuracy of this well-known fact.
- 35 In addition, without there being any need to rule on the question of the general quality of goods originating in Ireland, it should be noted that the applicant has also not disputed that that country produced meat, fish and dairy products, those three types of goods being covered by the contested mark.

36 Consequently, having regard to the dominant word element ‘la irlandesa’ and its meaning for the relevant public, borne out by the colour green which surrounds it, the Grand Board of Appeal was correct to find that, when the contested mark was affixed, without further indication, to the goods covered by that mark, Spanish-speaking consumers would at first sight and without any further thought establish a direct connection between the meaning of that word element and a characteristic of those goods, namely their geographical origin, and that, when seeing the mark affixed to those goods, those Spanish-speaking consumers would therefore believe that those goods originated in Ireland.

*The first plea in law, alleging infringement of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof*

37 The first plea is divided into three parts. First of all, under the first part, the applicant criticises the Grand Board of Appeal for having applied to invalidity proceedings the conditions applicable to grounds for revocation. Next, by the second part, it claims that the contested decision misapplied Article 7(1)(g) of Regulation No 207/2009. Lastly, as regards the third part of the first plea, it submits that the Grand Board of Appeal should have taken account of the acquired distinctive character of the contested mark.

38 It is appropriate to examine, first of all, the third part of the first plea, and then to consider the first and second parts of that plea together.

*– The third part of the first plea in law, alleging that the Grand Board of Appeal should have taken account of the acquired distinctive character of the contested mark*

39 The applicant criticises the Grand Board of Appeal for not having taken into consideration certain elements indicating that the contested mark had acquired distinctive character over time. In that regard, it relies on the uninterrupted use of the mark since 1967, on the fact that it is the only party to have used that mark in Spain, and on the significant share of the butter market which it has held for a long time in the Canary Islands under the same mark.

40 EUIPO and the intervener reject the applicant’s arguments.

41 It must be held, as EUIPO correctly observes, that the provisions of Regulation No 207/2009 dealing with the distinctive character acquired by a mark as a result of its use, as an exception to certain absolute grounds for refusal or invalidity, do not apply to marks regarded to be misleading. Neither Article 7(3) nor Article 52(2) of Regulation No 207/2009 (now Article 7(3) and Article 59(2) of Regulation 2017/1001) refers to Article 7(1)(g) of that regulation. Those first two provisions refer only to the grounds set out in Article 7(1)(b) to (d) of that regulation (now Article 7(1)(b) to (d) of Regulation 2017/1001).

42 Accordingly, the third part of the first plea must be rejected as ineffective.

– *The first part of the first plea in law, alleging that the Grand Board of Appeal should not have applied to invalidity proceedings the conditions applicable to grounds for revocation, and the second part of the first plea in law, alleging misapplication of Article 7(1)(g) of Regulation No 207/2009*

- 43 Under the first part of the first plea, the applicant notes that EU trade mark legislation distinguishes between grounds for invalidity and grounds for revocation. According to the applicant, in the present case, the Grand Board of Appeal incorrectly applied the rules on revocation proceedings to invalidity proceedings, which creates a situation of legal uncertainty.
- 44 The applicant submits that invalidity proceedings call for an analysis on the date of filing of the mark, relating in particular to its nature, the elements of which it is composed and the goods which it designates, whereas revocation proceedings involve an examination of the use of the mark by its proprietor after its registration. The Grand Board of Appeal erred in substantiating the invalidity of the contested mark in the light of use subsequent to its registration, instead of having regard to the date of filing.
- 45 According to the applicant, the Cancellation Division correctly found that: (i) the persons applying for a declaration of invalidity had sought to establish that the contested mark was misleading on the basis of acts which occurred long after it was filed with EUIPO; (ii) those acts could have been relevant in revocation proceedings, but not in invalidity proceedings; and (iii) at the relevant date on which the application for registration was filed, there was no manifest inconsistency between the contested mark and the goods designated by it, which precluded any deceptive nature.
- 46 The applicant remarks that honest use of the contested mark should be presumed, unless there is evidence to the contrary, which should relate to the date of filing of the application for registration of the mark and not merely to the use subsequently made of the mark by its proprietor.
- 47 In response to the first part of the first plea raised by the applicant, EUIPO contends that, in accordance with the applicable law, the Grand Board of Appeal examined the application for a declaration of invalidity by reference to the date of filing of the application for the contested mark. According to EUIPO, that mark is inherently deceptive, having regard in particular to its colours, its figurative elements and Ireland's reputation for the agricultural goods covered by the contested mark. In the absence of the list of those goods being expressly limited to goods of Irish origin, the contested mark will mislead the relevant public as regards their geographical origin. The evidence subsequent to the trade mark application, such as the 2014 catalogue, merely confirms the assessment which the Grand Board of Appeal carried out, as it was required to do, by reference to the date of filing of the contested mark.
- 48 As regards the first part of the first plea, the intervener's arguments are, in essence, those put forward by EUIPO.
- 49 Under the second part of the first plea, the applicant remarks that the link between the contested mark and Ireland is not in itself sufficient to mislead consumers as to the nature or geographical origin of the goods, since the sign will be perceived as evocative, in particular because it contains numerical and figurative elements. The sign will thus be perceived as a trade mark and not as an indication of geographical origin.



- 50 Furthermore, the applicant criticises the contested decision in so far as it is based on earlier decisions of the Oficina Española de Patentes y Marcas (Spanish Patent and Trade Mark Office) which rejected applications for similar trade marks containing the element ‘la irlandesa’ filed by the applicant, and on a decision of the Cancellation Division of EUIPO declaring such a mark to be invalid. According to the applicant, those decisions concern marks which are different and which specifically designated butter – and, in some cases, dairy products – whereas the contested mark in the present case designates goods in Class 29 as a whole.
- 51 In response to the second part of the first plea, EUIPO contends that the applicant’s argument alleging that the contested mark is evocative is not convincing. As regards the earlier decisions cited in the contested decision, EUIPO replies to the applicant that they were relevant with regard to the perception of the relevant public and that the Grand Board of Appeal could legitimately refer to those decisions in order to confirm its own findings.
- 52 The intervener, in essence, agrees with EUIPO’s arguments concerning the second part of the first plea.
- 53 It should be borne in mind that, under Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof, a trade mark is to be declared invalid where it has been registered despite being of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services concerned.
- 54 According to settled case-law, the only date relevant for the purposes of the assessment of an application for a declaration of invalidity is the date of filing of the application for the mark at issue (orders of 24 September 2009, *Bateaux mouches v OHIM*, C-78/09 P, not published, EU:C:2009:584, paragraph 18, and of 23 April 2010, *OHIM v Frosch Touristik*, C-332/09 P, not published, EU:C:2010:225, paragraph 41). However, the case-law allows material subsequent to that date to be taken into account if it relates to the situation on the date of filing of the trade mark application (judgment of 3 June 2009, *Frosch Touristik v OHIM – DSR touristik (FLUGBÖRSE)*, T-189/07, EU:T:2009:172, paragraphs 19 and 28).
- 55 The circumstances referred to in 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 26 October 2017, *Alpirsbacher Klosterbräu Glauner v EUIPO (Klosterstoff)*, T-844/16, EU:T:2017:759, paragraph 42 and the case-law cited).
- 56 The assessment of the ground mentioned in Article 7(1)(g) of Regulation No 207/2009 cannot extend to anything other than the goods or services in question, on the one hand, and the perception of the mark by the relevant public, on the other (see judgment of 22 March 2018, *Safe Skies v EUIPO – Travel Sentry (TSA LOCK)*, T-60/17, not published, EU:T:2018:164, paragraph 63 and the case-law cited).
- 57 Moreover, Article 7(1)(g) of Regulation No 207/2009 implies a sufficiently specific designation of potential characteristics of the goods and services covered by the trade mark. Only where the targeted consumer is led to believe that the goods and services possess certain characteristics which they do not in fact possess will he or she be deceived by the trade mark (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 53 and the case-law cited).

- 58 Under Article 7(2) of Regulation No 207/2009 (now Article 7(2) of Regulation 2017/1001), Article 7(1) of that regulation applies notwithstanding that the grounds of non-registrability obtain in only part of the European Union.
- 59 In the present case, the Grand Board of Appeal began by examining the inherent characteristics of the contested mark, in order to establish its meaning for the relevant public, taking into account the goods designated in the trade mark application. It found that, when seeing the contested mark affixed to the goods at issue, Spanish-speaking consumers would believe that those goods originated in Ireland.
- 60 The Grand Board of Appeal inferred from that analysis of the contested mark that, ‘already at the time of its filing’, that mark was misleading for the relevant public. In order to ‘confirm’ that finding, it took into consideration the evidence submitted by the persons applying for a declaration of invalidity, in particular a decision of the Cancellation Division of EUIPO of 25 September 2002, which had declared invalid a mark containing the element ‘la irlandesa’ which was similar to the contested mark. The evidence also consisted of the following elements, subsequent to the date of filing of the trade mark application:
- the applicant’s online catalogue, dating from 2014;
  - photographs of foodstuffs bearing the contested mark, manufactured in 2016 and purchased in Spain the same year.
- 61 According to the Grand Board of Appeal, it was apparent from that evidence, in particular from the information on the packaging of the goods and their labels, in very small characters or in the form of country codes or health numbers for those goods, that those goods had been manufactured in countries other than Ireland. Moreover, the applicant acknowledged in its observations before the Grand Board of Appeal that the contested mark ‘[was] not limited only to goods originating from Ireland’.
- 62 The Grand Board of Appeal also relied on Spanish judicial decisions and a decision of the Spanish Patents and Trade Marks Office, all of which were prior to the date of filing of the contested mark, in order to ‘confirm’ that the mark was misleading.
- 63 It should be noted that Articles 52 to 54 of Regulation No 207/2009 (Articles 53 and 54 are now Articles 60 and 61 of Regulation 2017/1001) govern the grounds for invalidity of an EU trade mark, whereas a separate provision, Article 51 of that regulation, concerns grounds for revocation.
- 64 Furthermore, it should be noted that the misleading nature of a mark constitutes an absolute ground for invalidity of that mark under the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof, and, in addition, a ground for revocation under Article 51(1)(c) of that regulation.
- 65 Article 51(1)(c) of Regulation No 207/2009 provides expressly that the misleading nature of a registered trade mark, which justifies a declaration that the rights of its proprietor are revoked, arises from the use made of that mark, whereas the provisions of Article 52(1)(a) of that regulation, in conjunction with Article 7(1)(g) thereof, which render invalid a mark that has been registered in spite of its deceptive nature, do not contain any reference to such use.

- 66 It follows from the foregoing that, in principle, the examination of an application for revocation within the meaning of Article 51(1)(c) of Regulation No 207/2009 requires that account be taken of the actual use of the mark and thus of evidence subsequent to its filing, whereas that is not the case for the purpose of examining an application for a declaration of invalidity brought under the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof. The examination of such an application for a declaration of invalidity requires that it be established that the sign filed for the purposes of registration as a mark was per se of such a nature as to deceive the consumer at the time of filing of the application for registration, since the subsequent management of that sign is irrelevant (see, to that effect, judgment of 8 June 2017, *W.F. Gözze Frottierweberei and Gözze*, C-689/15, EU:C:2017:434, paragraphs 55 and 56).
- 67 That principle is confirmed by the case-law, according to which the only date relevant for the purposes of the assessment of an application for a declaration of invalidity is the date of filing of the application for the mark at issue (orders of 24 September 2009, *Bateaux mouches v OHIM*, C-78/09 P, not published, EU:C:2009:584, paragraph 18, and of 23 April 2010, *OHIM v Frosch Touristik*, C-332/09 P, not published, EU:C:2010:225, paragraph 41) and according to which material subsequent to the date of filing of the trade mark application may be taken into account only if it relates to the situation on that date (judgment of 3 June 2009, *FLUGBÖRSE*, T-189/07, EU:T:2009:172, paragraphs 19 and 28).
- 68 In other words, in the case of invalidity, the question which arises is whether the mark should not have been registered *ab initio* for reasons already existing on the date of the trade mark application, since the consideration of subsequent evidence can serve only to clarify the circumstances as they were on that date.
- 69 It is in the light of those considerations that it must be determined whether the Grand Board of Appeal was correct in deciding to declare the contested mark to be invalid on the ground that it was of such a nature as to deceive the public as to the geographical origin of the goods at issue.
- 70 As has been stated in paragraph 36 above, the Grand Board of Appeal correctly found that the relevant public would perceive the contested mark as indicating that the goods covered by that mark were of Irish origin.
- 71 However, as the applicant is fully entitled to observe, for the purpose of applying Article 7(1)(g) of Regulation No 207/2009, the Grand Board of Appeal should have ascertained whether, on the date of the application for registration of the mark, there was any inconsistency between the information which the contested mark conveyed and the characteristics of the goods designated in that application (see, to that effect, judgments of 27 October 2016, *Caffè Nero Group v EUIPO (CAFFÈ NERO)*, T-29/16, not published, EU:T:2016:635, paragraphs 45 to 50, and of 13 May 2020, *SolNova v EUIPO – Canina Pharma (BIO-INSECT Shocker)*, T-86/19, EU:T:2020:199, paragraphs 70 to 87). It should be noted that the list of goods covered by the contested mark did not contain any indication of their geographical origin and that it could therefore cover goods originating from Ireland. Accordingly, unlike the circumstances on which the Court ruled in the *CAFFÈ NERO* (T-29/16, not published, EU:T:2016:635) and *BIO-INSECT Shocker* (T-86/19, EU:T:2020:199) cases mentioned above, there was no inconsistency, in the present case, on the date of filing of the contested mark, between that mark and the goods designated, with the result that it was not possible to find that such a mark was deceptive on that date.

- 72 Since, on the date of the application for registration, there was no inconsistency between the contested mark and the goods covered by that mark, the Grand Board of Appeal erred in criticising the applicant for not having limited the list of those goods to goods originating from Ireland. The insertion of such a limitation into that list was not required by Article 7(1)(g) of Regulation No 207/2009, which seeks to prevent the registration of trade marks of such a nature as to deceive the public.
- 73 Furthermore, since the contested mark could not be regarded as misleading on the date of the application for registration in 2013, the subsequent evidence dating from 2014 and from 2016 taken into consideration by the Grand Board of Appeal could not confirm such a misleading nature. In the light of the case file, it has not been established that that subsequent evidence concerned the situation on the date of filing of the trade mark application and, consequently, the case-law illustrated in the judgment of 3 June 2009, *FLUGBÖRSE* (T-189/07, EU:T:2009:172), which could have allowed such evidence to be taken into account, did not apply in the present case.
- 74 Furthermore, the Grand Board of Appeal noted that ‘it [had] been proven – and [the applicant] has not denied it – that the mark was already in use before its filing date’. However, it does not explain how that use of the contested mark, prior to the filing, ‘has been proven’ or how such earlier use demonstrates the misleading nature of that mark.
- 75 As regards the decision of the Cancellation Division of EUIPO of 25 September 2002, as well as the Spanish judicial decisions and a decision of the Spanish Patents and Trade Marks Office referred to in the contested decision and prior to the date of filing of the contested mark, it should be noted that neither the decision-making practice of EUIPO nor the decisions of national authorities are binding on the Court (see, to that effect, judgments of 9 March 2012, *Ella Valley Vineyards v OHIM – HFP (ELLA VALLEY VINEYARDS)*, T-32/10, EU:T:2012:118, paragraph 54 and the case-law cited, and of 28 October 2020, *Electrolux Home Products v EUIPO – D. Consult (FRIGIDAIRE)*, T-583/19, not published, EU:T:2020:511, paragraph 31 and the case-law cited). Those decisions do not allow the analytical framework established by EU legislation and required for the examination of an application for a declaration of invalidity, such as that at issue in the present case, to be disregarded, since that framework is not the same as that applicable to the examination of an application for revocation.
- 76 It follows from the foregoing that the third part of the first plea is unfounded, but that the first and second parts of that plea, which have been examined together, are well founded, as the Grand Board of Appeal erred in the application of the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof.
- 77 That error affects the legality of the first pillar of the contested decision. Nevertheless, it cannot lead to the annulment of the contested decision unless the second pillar of that decision has also been vitiated by illegality.

*The second plea in law, alleging infringement of Article 52(1)(b) of Regulation No 207/2009*

- 78 The applicant submits that the Grand Board of Appeal did not show that the applicant acted in bad faith when it filed its application for registration of the contested mark. It remarks that for more than 40 years it has used similar trade marks containing the element ‘la irlandesa’, which are still valid, and that it cannot be inferred from the fact that its business relationship with the intervener ended in 2011 that it acted in bad faith. The Grand Board of Appeal wrongly focused

on examples of disputes or of applications for registration which were refused in respect of similar marks containing the element ‘la irlandesa’ and incorrectly regarded certain characteristics of the contested mark as evidence that the applicant acted in bad faith, in particular its figurative elements, its colour and the fact that it evoked a geographical origin.

- 79 EUIPO and the intervener dispute the applicant’s arguments.
- 80 It should be noted that, under Article 52(1)(b) of Regulation No 207/2009, a trade mark is to be declared invalid where the trade mark applicant was acting in bad faith when he or she filed the application for the trade mark.
- 81 It is also apparent from that provision that the relevant time for determining whether there was bad faith on the part of the applicant is the time of filing the application for registration (judgment of 11 June 2009, *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraph 35). However, use of the contested mark may constitute a factor to be taken into account when establishing the intention underlying the application for registration, including use subsequent to the date of that application (see, to that effect, judgments of 1 February 2012, *Carrols v OHIM – Gambettola (Pollo Tropical CHICKEN ON THE GRILL)*, T-291/09, EU:T:2012:39, paragraph 76; of 8 May 2014, *Simca Europe v OHIM – PSA Peugeot Citroën (Simca)*, T-327/12, EU:T:2014:240, paragraph 48; and of 23 May 2019, *Holzer y Cia v EUIPO – Annco (ANN TAYLOR and AT ANN TAYLOR)*, T-3/18 and T-4/18, EU:T:2019:357, paragraph 126).
- 82 The concept of bad faith referred to in Article 52(1)(b) of Regulation No 207/2009 is not defined, delimited or even described in any way in the legislation (see judgments of 11 July 2013, *SA.PAR. v OHIM – Salini Costruttori (GRUPPO SALINI)*, T-321/10, EU:T:2013:372, paragraph 19 and the case-law cited, and of 8 March 2017, *Biernacka-Hoba v EUIPO – Formata Bogusław Hoba (Formata)*, T-23/16, not published, EU:T:2017:149, paragraph 41 and the case-law cited). According to the case-law, that concept cannot be confined to a limited category of specific circumstances. The public interest objective of that provision, which is that of preventing trade mark registrations that are abusive or contrary to honest commercial and business practices, would be compromised if bad faith could be established only in the circumstances exhaustively listed (see judgment of 21 April 2021, *Hasbro v EUIPO – Kreativni Dogadaji (MONOPOLY)*, T-663/19, EU:T:2021:211, paragraph 37 and the case-law cited).
- 83 Any claim of bad faith must be the subject of an overall assessment, taking into account all the factual circumstances relevant to the particular case (judgment of 12 September 2019, *Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO*, C-104/18 P, EU:C:2019:724, paragraph 47).
- 84 Accordingly, it is settled case-law that, in the context of the overall analysis undertaken pursuant to Article 52(1)(b) of Regulation No 207/2009, account may be taken of the origin of the contested sign and its use since its creation, the commercial logic underlying the filing of the application for registration of that sign as an EU trade mark, and the chronology of events leading up to that filing (see judgment of 21 April 2021, *MONOPOLY*, T-663/19, EU:T:2021:211, paragraph 38 and the case-law cited).
- 85 In addition, consideration must be given to the trade mark applicant’s intention at the time when he or she files the application for registration, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case (judgments of 11 June 2009, *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraphs 41

and 42, and of 8 March 2017, *Formata*, T-23/16, not published, EU:T:2017:149, paragraph 44). In that regard, it is necessary to examine the intention of the trade mark applicant such as it may be inferred from objective circumstances and from his or her specific actions, from his or her role or position, from the awareness he or she possessed of the use of the earlier sign, from the contractual, pre-contractual or post-contractual relationship he or she had with the applicant for a declaration of invalidity, from the existence of reciprocal duties or obligations, and, more generally, from all the objective situations of conflicting interests in which the trade mark applicant has operated (judgment of 11 July 2013, *GRUPPO SALINI*, T-321/10, EU:T:2013:372, paragraph 28).

- 86 Where the applicant for a declaration of invalidity seeks to rely on that ground, it is for that party to prove the circumstances which substantiate a finding that the EU trade mark proprietor was acting in bad faith when it filed the application for registration of that mark (see judgment of 26 February 2015, *Pangyrus v OHIM – RSVP Design (COLOURBLIND)*, T-257/11, not published, EU:T:2015:115, paragraph 63 and the case-law cited).
- 87 There is a presumption of good faith until proof to the contrary is adduced (see judgment of 8 March 2017, *Formata*, T-23/16, not published, EU:T:2017:149, paragraph 45 and the case-law cited).
- 88 In the present case, the Grand Board of Appeal lists several factors which, in its view, support the conclusion that the applicant acted in bad faith when it applied for registration of the contested mark.
- 89 First, the Grand Board of Appeal reiterates its finding that the contested mark misleads the Spanish-speaking consumer by establishing a clear geographical link to Ireland when the goods at issue do not originate in that country.
- 90 Secondly, the Grand Board of Appeal remarks that, on account of that deceptive nature, marks containing the element ‘la irlandesa’ similar to the mark at issue in the present case and covering more specific lists of goods were declared to be invalid or refused by EUIPO and by the Spanish judicial and administrative authorities and that, since those decisions, which were unfavourable to the applicant, were handed down in 2000, 2001 and 2002, a long time before the date of filing of the contested mark in 2013, the applicant was necessarily aware of those decisions on that date. According to the Grand Board of Appeal, that awareness is confirmed by the fact that the applicant subsequently obtained Spanish registrations of similar marks by including expressly in the description of the goods a geographical limitation relating to Ireland, which it did not do with regard to the contested mark.
- 91 Thirdly, the Grand Board of Appeal notes that, for many years, the applicant was the intervener’s exclusive agency and purchased Irish butter in bulk from it, packaged it and sold it in the Canary Islands. It finds that the Spanish trade mark La Irlandesa filed in 1967 by the applicant was intended to promote the sale of butter of Irish origin in Spain, that that mark originated from the contractual relationship between the applicant and the intervener, and that that mark related to the Irish origin of the goods which the applicant was authorised to sell in the context of that relationship. According to the Grand Board of Appeal, after that business relationship came to an end in 2011, the applicant continued to sell the goods under marks containing the words ‘la’ and ‘irlandesa’, although they were no longer of Irish origin. The applicant has not demonstrated any legitimate commercial logic to explain the filing of the contested mark; nor has it demonstrated the economic logic of its use following the end of the business relationship with

the intervener in 2011. The applicant therefore sought only to obtain an unfair advantage from a business relationship which has been terminated, in order to continue to benefit from the image of Irish goods.

- 92 Fourthly, the Grand Board of Appeal found that, in view of the misleading use of the contested mark and the earlier decisions of EUIPO and the Spanish authorities, as well as the earlier business relationship with the intervener, which has now been terminated, the applicant, when filing the contested mark, intended to continue to mislead the public as to the geographical origin of the goods concerned and to take advantage of the good image of Irish goods. The applicant therefore had a dishonest intention, having deliberately filed the contested mark in order to create an association with Ireland.
- 93 In the light of all those factors, the Grand Board of Appeal concluded that the applicant acted in bad faith when it filed the contested mark. Consequently, it declared that that mark was also invalid on this ground.
- 94 As a preliminary point, it should be borne in mind that it follows from the case-law cited in paragraph 81 above that, in order to decide whether the applicant acted in bad faith when it applied for registration of the contested mark, the Grand Board of Appeal could legitimately rely on evidence subsequent to the date on which the contested mark was filed, since that evidence constituted evidence relating to the situation on the relevant date, and even on the use of the contested mark subsequent to that filing.
- 95 In the present case, in the first place, as regards the misleading use of the contested mark, it is common ground between the parties that: (i) for decades, the applicant sold butter of Irish origin under that mark in the context of its contractual relationship with the intervener; (ii) after that relationship came to an end, it continued to sell foodstuffs under that mark; and (iii) a not insignificant part of those foodstuffs, including dairy products and pork products, was not of Irish origin. In any event, the applicant has not claimed that all the goods which it sold under the contested mark originated in Ireland.
- 96 In other words, the applicant sold goods under the contested mark even though a not insignificant part of those goods was not of Irish origin and therefore did not correspond to the relevant public's perception of those goods.
- 97 Although that fact is irrelevant for the purpose of examining the first plea, based on the provisions of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(g) thereof, it is not irrelevant for the purpose of examining the second plea alleging bad faith on the part of the applicant.
- 98 Once the applicant had extended the use of the contested mark to goods other than butter of Irish origin, Spanish-speaking consumers, who constitute the relevant public, were likely to be misled as to the geographical origin of those goods, since they had become accustomed over the course of several decades to the contested mark being affixed to butter originating from Ireland. Such conduct is evidence of bad faith inasmuch as it shows that, when filing the application for the contested mark, the applicant intended unfairly to transfer the advantage derived from the association with Ireland to goods not having that geographical origin, in particular after the end of its business relationship with the intervener which supplied it with Irish butter.

- 99 In that regard, any information appearing on the packaging and labels of the goods sold by the applicant is not in itself capable of dispelling the risk of misleading consumers. Since the information is displayed in very small characters or in the form of country codes or health numbers it remains uncertain whether that information is invariably perceived by the relevant public.
- 100 In the second place, as regards the cases in which marks containing the element ‘la irlandesa’ which were similar to the mark at issue in the present case were declared to be invalid or refused by EUIPO and the Spanish judicial and administrative authorities in 2000, 2001 and 2002, it is true that they cannot bind the Court and that, in any event, they do not make it possible to determine whether the contested mark is misleading for the purposes of Article 7(1)(g) of Regulation No 207/2009, but they confirm that the contested mark could be perceived by the relevant public as indicating that the goods to which that mark was affixed were of Irish origin. They also indicate that the use of the contested mark for goods not of Irish origin was controversial as regards its potential deceptive nature; a fact of which the applicant was necessarily aware on the date of the application for registration of that mark and which is therefore capable of supporting the existence of bad faith on the part of the applicant on that date.
- 101 In the third and last place, the Grand Board of Appeal was entitled to rely on the evidence submitted to it, which makes it possible in particular to establish a chronology of events characterising the filing of the application for registration of the contested mark, in order to find that the applicant had adopted a commercial strategy of association with the marks containing the element ‘la irlandesa’ which were linked to the applicant’s former business relationship with the intervener (see, to that effect, judgments of 8 May 2014, *Simca*, T-327/12, EU:T:2014:240, paragraph 63, and of 23 May 2019, *ANN TAYLOR and AT ANN TAYLOR*, T-3/18 and T-4/18, EU:T:2019:357, paragraph 164), in order to continue to take advantage of that relationship, which has been terminated, and the marks which were linked to it (see, to that effect, judgment of 14 May 2019, *Moreira v EUIPO – Da Silva Santos Júnior (NEYMAR)*, T-795/17, not published, EU:T:2019:329, paragraphs 49 to 51 and 55).
- 102 It may be inferred from the foregoing considerations that registration of the contested mark was contrary to honest commercial and business practices. The Grand Board of Appeal was therefore correct in finding that the applicant acted in bad faith when it applied for registration of the contested mark.
- 103 None of the arguments put forward by the applicant is capable of calling that finding into question.
- 104 As regards the applicant’s arguments that it has used similar marks containing the element ‘la irlandesa’ registered at European or national level for more than 40 years, which are still valid, and that the Grand Board of Appeal should not have focused solely on disputes or applications for registration which were refused, it is sufficient to state, once again, that in its review of legality, the Court is not bound by the decision-making practice of EUIPO (see, to that effect, judgment of 28 October 2020, *FRIGIDAIRE*, T-583/19, not published, EU:T:2020:511, paragraph 31 and the case-law cited); nor is it bound by a decision adopted in a Member State finding a sign to be registrable as a national trade mark (see, to that effect, judgment of 17 November 2021, *Jakober v EUIPO (Shape of a cup)*, T-658/20, not published, EU:T:2021:795, paragraph 41). Consequently, those arguments must be set aside.



- 105 As regards the applicant's argument that it cannot be inferred from the fact that its business relationship with the intervener came to an end in 2011 that it acted in bad faith, that argument must be rejected on the ground that the marks containing the element 'la irlandesa', like the contested mark, were linked to that relationship and that the end of that relationship was a relevant factor for the purpose of assessing the applicant's intention when filing the contested mark (see, to that effect, judgment of 30 April 2019, *Kuota International v EUIPO – Sintema Sport (K)*, T-136/18, not published, EU:T:2019:265, paragraph 45). The applicant continued to use the contested mark after the end of that relationship for goods not originating in Ireland, whereas the Irish origin of the goods was a fundamental aspect of that relationship and of the initial use of that mark.
- 106 Lastly, as regards the allegation that the Grand Board of Appeal regarded certain characteristics of the contested mark as evidence of bad faith, in particular its figurative elements, its colour and the fact that it evoked a geographical origin, first, it should be recalled that, as has been pointed out in paragraphs 24 to 36 above, the Grand Board of Appeal correctly found that, when seeing the contested mark affixed to the goods at issue, Spanish-speaking consumers were led to believe that those goods originated in Ireland, taking into account the actual characteristics of that mark. Second, in accordance with the case-law referred to in paragraph 83 above, the Grand Board of Appeal had to take account of all the relevant factual circumstances in the context of an overall assessment of the case before it and could therefore validly take into consideration, among all those circumstances, the relevant public's perception of the contested mark in relation to the goods at issue.
- 107 In the light of the foregoing, the second plea must be rejected.
- 108 Having regard to all the foregoing considerations, it must be concluded that the fact that the first plea is well founded has no bearing on the legality of the contested decision, since the second plea directed against the second pillar of that decision is not, for its part, well founded and that second pillar is such as to justify, by itself, the operative part of that decision (see judgments of 29 January 2020, *ENCANTO*, T-239/19, not published, EU:T:2020:12, paragraph 49 and the case-law cited, and of 20 January 2021, *MANUFACTURE PRIM 1949*, T-656/18, not published, EU:T:2021:17, paragraph 19 and the case-law cited).
- 109 The action must therefore be dismissed.

### **Costs**

- 110 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.
- 111 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Sixth Chamber, Extended Composition)

hereby:

- 1. Dismisses the action;**
- 2. Orders Hijos de Moisés Rodríguez González, SA, to pay the costs.**

Marcoulli

Frimodt Nielsen

Schwarcz

Iliopoulos

Norkus

Delivered in open court in Luxembourg on 29 June 2022.

E. Coulon  
Registrar

M. van der Woude  
President