



Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

11 November 2020*

(Appeal – EU trade mark – Regulation (EC) No 207/2009 – Opposition proceedings – Relative ground for refusal – Article 8(3) – Scope – Identity or similarity of the mark applied for to the earlier mark – EU word mark MINERAL MAGIC – Application for registration by the agent or representative of the proprietor of the earlier mark – Earlier national word mark MAGIC MINERALS BY JEROME ALEXANDER)

In Case C-809/18 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 20 December 2018,

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

the other parties to the proceedings being:

John Mills Ltd, established in London (United Kingdom), represented by S. Malynicz QC,
applicant at first instance,

Jerome Alexander Consulting Corp., established in Surfside (United States),
intervener at first instance,

THE COURT (Fifth Chamber),

composed of E. Regan (Rapporteur), President of the Chamber, M. Ilešič, E. Juhász, C. Lycourgos and I. Jarukaitis, Judges,

Advocate General: G. Pitruzzella,

Registrar: R. Schiano, Administrator,

having regard to the written procedure and further to the hearing on 16 January 2020,

after hearing the Opinion of the Advocate General at the sitting on 30 April 2020,

gives the following

* Language of the case: English.

Judgment

- 1 By its appeal, the European Union Intellectual Property Office (EUIPO) asks the Court to set aside the judgment of the General Court of the European Union of 15 October 2018, *John Mills v EUIPO – Jerome Alexander Consulting (MINERAL MAGIC)* (T-7/17, ‘the judgment under appeal’, EU:T:2018:679), by which the General Court annulled the decision of the First Board of Appeal of EUIPO of 5 October 2016 (Case R 2087/2015-1), relating to opposition proceedings between Jerome Alexander Consulting Corp. and John Mills Ltd (‘the decision at issue’).

Legal context

International law

- 2 The Paris Convention for the Protection of Industrial Property was signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, vol. 828, No 11851, p. 305; ‘the Paris Convention’). Article 6 *septies* of that convention provides:

‘(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor’s authorisation, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1) above, be entitled to oppose the use of his mark by his agent or representative if he has not authorised such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.’

- 3 Article 29 of that convention provides in its paragraph (1):

‘(a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director-General, after consultation with the interested Governments, in the English, German, Italian, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail.

...’

- 4 Article 2(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights, as set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organisation, which was approved on behalf of the European Community by Council Decision 94/800/EC of 22 December

1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1), ('the TRIPS Agreement') provides:

'In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).'

EU law

5 Article 8 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [EU] trade mark (OJ 2009 L 78, p. 1), entitled 'Relative grounds for refusal', provides:

'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

...

3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

...

5. Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier [EU] trade mark, the trade mark has a reputation in the [European Union] and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.'

6 Under Article 52 of that regulation, entitled 'Absolute grounds for invalidity':

'1. [An EU] trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

...

(b) where the applicant was acting in bad faith when he filed the application for the trade mark.

...'

Background to the dispute and the decision at issue

- 7 On 18 September 2013, John Mills, the applicant at first instance, filed an application for registration of an EU trade mark with EUIPO pursuant to Regulation No 207/2009.
- 8 The mark in respect of which registration was sought is the word sign ‘MINERAL MAGIC’ (‘the contested mark’).
- 9 The goods in respect of which registration was sought are in Class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Hair lotions; abrasive preparations; soaps; perfumery; essential oils; cosmetics; preparations for cleaning and care of the skin, scalp and hair; deodorants for personal use’.
- 10 The EU trade mark application was published in *Community Trade Marks Bulletin* No 2014/14 of 23 January 2014.
- 11 On 23 April 2015, Jerome Alexander Consulting, the intervener at first instance, filed an opposition under Article 41 of Regulation No 207/2009 to the registration of the contested mark for the goods referred to in paragraph 9 of the present judgment.
- 12 The opposition was based on the following earlier marks:
- American word mark No 4274584 MAGIC MINERALS BY JEROME ALEXANDER, designating the following goods: ‘Face powder featuring mineral enhancements’;
 - American non-registered word mark MAGIC MINERALS, designating the following goods: ‘Cosmetics’.
- 13 The grounds relied on in support of the opposition were those referred to in Article 8(3) of that regulation.
- 14 By decision of 18 August 2015, the Opposition Division rejected that opposition.
- 15 On 15 October 2015, Jerome Alexander Consulting filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009.
- 16 By the decision at issue, the First Board of Appeal of EUIPO (‘the Board of Appeal’) annulled the decision of the Opposition Division and, and, on the basis of Article 8(3) of Regulation No 207/2009, refused registration of the contested mark.
- 17 First, the Board of Appeal took note of the fact that Jerome Alexander Consulting was no longer basing its opposition on the non-registered American trade mark MAGIC MINERALS and that it was thus relying solely on the American word mark MAGIC MINERALS BY JEROME ALEXANDER.
- 18 Secondly, the Board of Appeal recalled the purpose of Article 8(3) of Regulation No 207/2009, which is to prevent the misuse of a trade mark by the trade mark proprietor’s agent, and also set out the conditions which, in its view, must be fulfilled in order for an opposition to succeed on that basis: namely, the opposing party must be the proprietor of the earlier mark; the applicant for registration of the mark must be or have been the agent or representative of the proprietor of the mark; the application must have been filed in the name of that agent or representative without the proprietor’s consent and without there being legitimate reasons to justify the action of that agent or representative; and the application must relate to identical or similar signs and goods.

- 19 Thirdly, the Board of Appeal examined in detail whether those conditions for upholding an opposition on the basis of Article 8(3) of Regulation No 207/2009 were fulfilled. First, so far as the existence of an agent/principal relationship is concerned, the Board of Appeal stated that the terms ‘agent’ and ‘representative’ should be interpreted broadly.
- 20 In the present case, the Board of Appeal found that the distribution agreement between the parties provided that John Mills would be responsible for distributing the goods of Jerome Alexander Consulting within the European Union. The Board of Appeal also noted that provisions on the exclusivity of the distribution agreement, a non-competition clause and provisions relating to the intellectual property rights of Jerome Alexander Consulting were to be found in the agreement. It concluded that the evidence presented by Jerome Alexander Consulting, namely purchase orders, one of which bore a date that preceded by two months the date on which the application for the contested mark had been filed, demonstrated the existence of a significant commercial relationship which went beyond a simple supplier/distributor relationship. The Board of Appeal thus concluded that there existed, at the time when the trade mark application was filed, an actual, ongoing and non-transient business relationship between the parties which gave rise to a general duty of trust and loyalty and that John Mills was an ‘agent’ within the meaning of Article 8(3) of Regulation No 207/2009.
- 21 Fourthly, the Board of Appeal pointed out that Article 8(3) of that regulation relates not only to cases in which the goods or services compared are identical, but also to cases in which they are similar. It noted that, in the present case, the goods covered by the signs at issue were identical – the ‘cosmetics’ covered by the contested mark encompassing ‘face powder featuring mineral enhancements’ covered by the earlier mark – or similar – the remaining goods covered by the contested mark having various links with those covered by the earlier mark because of the fact that they may contain the same ingredients, are often produced by the same companies and are offered together in drug stores or the same retail store aisles.
- 22 With regard to the signs at issue, the Board of Appeal found them to be similar. In the first place, it noted the striking resemblance between the first two word elements, namely ‘magic’ and ‘minerals’, of the earlier mark, on the one hand, and the word elements of the contested mark, on the other hand.
- 23 In the second place, it stated that the earlier mark is likely to be perceived by the relevant public in the European Union as a sign consisting of two components. First, the component ‘by jerome alexander’ is likely to be perceived as a so-called ‘house mark’, in other words, as identifying the entity responsible for the product, and, secondly, the component ‘magic minerals’ is most likely to be perceived as an identification of the product itself or of the product line.
- 24 Finally, the Board of Appeal took the view that the fact that the United States Patent and Trademark Office (USPTO) did not object to registration of the trade mark MAGIC MINERALS BY JEROME ALEXANDER despite the existence of the trade mark MINERAL MAGIC COSMETICS did not mean that there was no likelihood of confusion between those marks. The Board of Appeal noted that the proprietor of the trade mark MINERAL MAGIC COSMETICS would have had to file an opposition in that regard. Taking into account all of those factors, the Board of Appeal upheld the opposition under Article 8(3) of Regulation No 207/2009.

The procedure before the General Court and the judgment under appeal

- 25 By application lodged at the Registry of the General Court on 5 January 2017, John Mills brought an action for annulment of the decision at issue.

- 26 In support of its action, it relied on a single plea in law, alleging infringement of Article 8(3) of Regulation No 207/2009, which was subdivided into three complaints. The first alleged that the Board of Appeal had erred in holding that John Mills was an ‘agent’ or ‘representative’ of the proprietor of the earlier mark for the purposes of that provision. By its second complaint, John Mills submitted that the Board of Appeal had erred in law in finding that Article 8(3) of Regulation No 207/2009 was applicable even though the signs at issue were merely similar and not identical. The third complaint alleged that the Board of Appeal had erred in holding that that provision was applicable even though the goods encompassed by the earlier mark were not identical to the goods covered by the contested mark.
- 27 By the judgment under appeal, the General Court, on the basis of the second complaint alone, upheld the single plea in law and, consequently, annulled the decision at issue.

Forms of order sought

- 28 EUIPO contends that the Court should:
- set aside the judgment under appeal; and
 - order John Mills to pay the costs.
- 29 John Mills claims that the Court should:
- dismiss the appeal; and
 - order EUIPO to pay the costs.

The appeal

- 30 In support of its appeal, EUIPO relies on two grounds of appeal alleging, first, infringement of Article 8(3) of Regulation No 207/2009 and, secondly, contradiction in the reasoning and failure to state reasons with regard to the application of the concept of ‘identity’.

Arguments of the parties

- 31 By its first ground of appeal, EUIPO submits that it was on the basis of a misinterpretation of Article 8(3) of Regulation No 207/2009 that the General Court held, in paragraph 37 of the judgment under appeal, that that provision can be applied only if the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical and not merely similar.
- 32 According to EUIPO, the purpose of Article 8(3) of that regulation is to prevent the misuse of a trade mark by the agent of its proprietor, as the agent may exploit the knowledge and experience acquired during the business relationship between him and that proprietor and may therefore improperly benefit from the effort and investment which that proprietor himself has made. Such exploitation of knowledge and improper benefit, EUIPO argues, are not confined to the registration and use of an identical mark, but also occur where the agent intends to misuse the essential components of the earlier mark.
- 33 EUIPO claims that, by the statements in paragraphs 25 and 26 of the judgment under appeal, the General Court misinterpreted Article 8(3) of Regulation No 207/2009 in a manner which undermines the objective pursued by that provision. As is apparent from paragraph 25 of that judgment, the General Court correctly stated that that provision requires that there must be a direct link between the earlier mark and the mark applied for and that such a link can exist only if the marks in question

‘match’. However, by inferring from that observation, in paragraph 26 of that judgment, that the marks must be identical in order for there to be misuse, the General Court, according to EUIPO, contradicts one of the cornerstones of trade mark law according to which a link between two signs may be established by various degrees of similarity, taking into account all the other circumstances of the case, and not only in cases of identity.

- 34 In view of the objective pursued by Article 8(3) of Regulation No 207/2009, the relevant criterion for the purposes of applying that provision is, according to EUIPO, the equivalence, in economic or commercial terms, of the marks analysed as a whole. It is necessary to assess whether the mark applied for corresponds, in essence, to the earlier mark. In that regard, it is sufficient if the signs at issue coincide in elements in which the earlier mark’s distinctive character essentially consists.
- 35 EUIPO claims that such a teleological interpretation does not contradict the literal reading of Article 8(3) of that regulation.
- 36 As the General Court observed in the judgment under appeal, that provision, unlike Article 8(1) of Regulation No 207/2009 and Article 8(5) thereof, does not explicitly refer to the degree of proximity between the marks at issue for the purposes of its application. According to EUIPO, the EU legislature did not, therefore, intend to indicate that Article 8(3) of that regulation should be confined solely to cases where the trade marks and the goods and services covered by them are strictly identical.
- 37 On the contrary, EUIPO submits, that provision reproduces the wording of Article 6 *septies* of the Paris Convention. However, the explanation provided in the *travaux préparatoires* relating to that convention appears to support an interpretation according to which that provision encompasses signs and goods which are not strictly but in essence identical, that is to say, commercially and economically equivalent. Whereas that convention lays down minimum standards of protection, the General Court attributed a scope to Article 8(3) of Regulation No 207/2009 which grants trade mark proprietors protection that is below the levels of protection afforded by Article 6 *septies* of the Paris Convention.
- 38 Furthermore, the reading by the General Court, in paragraphs 27 to 35 of the judgment under appeal, of the *travaux préparatoires* relating to the provision contained in Article 8(3) of that regulation is, according to EUIPO, contradictory since, inter alia, relying on the fact that several proposals as regards the addition of the words ‘similar marks’ to the wording of that provision were rejected by the Working Group, it inferred that the EU legislature intended to confine the application of that provision to identical marks only, whereas the concept of ‘identity’ is also absent from the wording of that provision.
- 39 Furthermore, EUIPO submits that the argument put forward by the General Court in paragraph 35 of the judgment under appeal, to the effect that recourse cannot be had to the *travaux préparatoires* relating to the Paris Convention in view of the fact that there is no ambiguity in the wording of Article 6 *septies* of that convention, is also contradictory. According to EUIPO, the conclusion reached by the General Court in that judgment differs from that which it reached in the judgment of 13 April 2011, *Safariland v OHIM – DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)* (T-262/09, EU:T:2011:171, paragraph 61). It is therefore obvious, in EUIPO’s view, that the wording of Article 8(3) of Regulation No 207/2009 is not sufficiently clear for the view to be taken that the reference to the concept of ‘identity’ is unambiguous.
- 40 Since Article 8(3) of Regulation No 207/2009 is designed to prevent the agent from exploiting the knowledge and experience acquired during the business relationship between him and the proprietor of the trade mark and thus from benefiting improperly from the effort and investment which the legitimate proprietor of the trade mark himself has made, it is not necessary, according to EUIPO, to define the exact degree of similarity between the signs concerned or to impose clear limits on the situations in which that provision should apply.

- 41 EUIPO submits that the General Court’s approach deprives that ground for refusal of the flexibility necessary to adapt its scope to the different ways in which an agent might attempt to misuse the trade mark of his principal, as revealed by the present case, in which the agent applied for registration, as an EU trade mark, of only the first part of the earlier mark, by inverting the words ‘MINERAL MAGIC’ and omitting the name of the producer.
- 42 Although a situation such as that which arises in the present case could amount to bad faith and, therefore, give rise to the application of the ground for invalidity provided for in Article 52(1)(b) of Regulation No 207/2009, that circumstance should not, however, in EUIPO’s view, argue in favour of a restrictive interpretation of Article 8(3) of that regulation. The choice of the EU legislature to provide for a separate ground in the case of unauthorised applications for registration by agents or representatives of the proprietor of the earlier mark is justified by the need to act in this respect as soon as possible, without the need to oblige that proprietor to wait until the mark applied for is registered in order to be able to seek to have it cancelled.
- 43 John Mills submits that EUIPO’s line of argument is based on a mistaken approach according to which, since Article 8(3) of Regulation No 207/2009 does not contain an explicit requirement that the signs must be identical or similar, that provision is neutral in that respect and, therefore, a literal interpretation of that provision is consistent with a purposive interpretation thereof which allows the marks at issue to be compared on the basis of their mere similarity.
- 44 Although Article 8(3) of Regulation No 207/2009 does not expressly use the words ‘identical or similar’, both the wording of Article 6 *septies* of the Paris Convention and the wording of Article 8(3) of Regulation No 207/2009, by referring only to ‘the [trade] mark’, appear to exclude marks which are merely similar. According to John Mills, the latter provision therefore allows, as the General Court rightly found in paragraphs 24 and 25 of the judgment under appeal, only opposition based on the identity of the mark applied for by the agent or representative of the proprietor of the earlier mark with that of which the putative principal is the proprietor.
- 45 John Mills submits that the General Court rightly noted, first, in paragraphs 26 to 35 of the judgment under appeal, that such an approach is supported by the *travaux préparatoires* and by other language versions of the provision at issue and, secondly, in paragraph 36 of that judgment, that the fact that a condition relating to similarity is expressly laid down in other provisions of Regulation No 207/2009 constitutes a further indication that Article 8(3) of that regulation does not require such a condition to be satisfied.
- 46 Furthermore, according to John Mills, EUIPO cannot effectively rely on the judgment of 13 April 2011, *Safariland v OHIM – DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)* (T-262/09, EU:T:2011:171) in support of the interpretation relied upon. Not only is that judgment of the General Court not binding on the Court of Justice, but the relevant paragraph of that judgment, namely paragraph 61, does not contain any discussion of the question at issue in the present appeal. As is apparent from paragraph 74 of that judgment, the General Court was not called upon to decide whether the marks must be identical or similar, since the action failed on the ground that the condition relating to the existence of a representative relationship was not satisfied.
- 47 Furthermore, John Mills submits that, in the context of its purposive approach in support of an expanded notion of Article 8(3) of Regulation No 207/2009, EUIPO merely provides an elusive definition of the requirements. EUIPO asserts both that, on the one hand, for the purposes of the application of that provision, it is sufficient for the signs to coincide in elements in which the earlier mark’s distinctive character essentially consists and that, on the other hand, it is not necessary to define a priori the exact degree of resemblance between the signs.

- 48 According to John Mills, such suggestions are wrong. First, the assessment of distinctiveness is not an abstract assessment, but should be made from the perspective of the relevant consumer. However, that consumer should be the consumer of the country in which the earlier mark is registered, which creates difficulties of proof as to the understanding of that mark and to the degree of distinctiveness of the coinciding element.
- 49 Secondly, the criteria put forward by EUIPO for the purposes of the application of Article 8(3) of Regulation No 207/2009 are broader than those applied, in particular, in the assessment of similar marks giving rise to a likelihood of confusion under Article 8(1)(b) of that regulation, since mere coincidence, and not similarity, is sufficient and there is also no requirement for a likelihood of confusion.
- 50 Those criteria are also broader than those laid down in Article 8(5) of Regulation No 207/2009, which grants extended protection to trade marks with a reputation within the European Union, since, first, those criteria do not require a reputation within the European Union, but only registration in a country which is a party to the Paris Convention, and secondly, they also do not require that unfair advantage be taken of the distinctive character or reputation of the trade mark.
- 51 Thirdly, according to John Mills, the criteria suggested by EUIPO do not guarantee legal certainty and raise issues of proof. The requirement relating to signs which coincide in elements in which the earlier mark's distinctive character essentially consists would have the effect of confronting the parties to the proceedings before EUIPO as well as EUIPO itself with the impossible task of trying to predict which signs could be registered in the European Union, in particular since Article 8(3) of Regulation No 207/2009 relates to marks which may appear in hundreds of non-EU trade mark registers.
- 52 In view of those difficulties, according to John Mills, EUIPO argues that it is possible to ignore any requirement of identity or similarity of the marks and focus on the sole issue of whether the agent or representative has imitated or misused the principal's mark. However, John Mills submits, the EU legislature has already, to that end, laid down a separate provision, namely Article 52(1)(b) of Regulation No 207/2009, which concerns the invalidity of a trade mark in the case where the applicant was acting in bad faith at the time of filing the trade mark application.
- 53 Fourthly, John Mills submits that, under a teleological approach, the scope of Article 8(3) of Regulation No 207/2009 must be limited to the special case in which an agent or representative seeks to register 'the trade mark', namely the earlier trade mark, and not a different one, where it cannot justify its behaviour. That approach facilitates the application of that provision and allows undertakings and EUIPO to foresee the likely results of a dispute under that provision.

Findings of the Court

- 54 By its first ground of appeal, EUIPO criticises the General Court on the ground that it infringed Article 8(3) of Regulation No 207/2009 by interpreting that provision as covering only the situation in which the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical.
- 55 In that regard, it must be recalled that, according to settled case-law of the Court, the interpretation of a provision of EU law requires account to be taken not only of its wording, but also of its context, and the objectives and purpose pursued by the act of which it forms part. The legislative history of a provision of EU law may also reveal elements that are relevant to its interpretation (judgment of 25 June 2020, *A and Others (Wind turbines at Aalter and Nevele)*, C-24/19, EU:C:2020:503, paragraph 37 and the case-law cited).

- 56 As regards, first, the wording of Article 8(3) of Regulation No 207/2009, it should be noted that that provision merely provides that, upon opposition by the proprietor of the trade mark, a trade mark is not to be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless that agent or representative justifies his action.
- 57 Thus, although the wording of that provision suggests a close relationship between 'the' earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark, that provision does not, however, explicitly state, as the General Court observed, in essence, in paragraph 24 of the judgment under appeal, whether it applies only in the case where the mark applied for by that agent or representative is identical to the earlier mark or whether cases in which the marks at issue are similar may also come within the scope of that provision.
- 58 Secondly, as regards the background to Article 8(3) of Regulation No 207/2009, it is apparent from the *travaux préparatoires* relating to that provision that, as the General Court pointed out in paragraphs 26 to 31 of the judgment under appeal, and as the Advocate General has also observed in points 27 to 30 of his Opinion, the EU legislature, it is true, expressly refused to state therein that it applies in cases where there is similarity between the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark.
- 59 However, it was also for the General Court, first, to take account of the fact that the EU legislature also did not intend to retain, in that provision, the explicit reference to the identity between the earlier trade mark and that applied for by the agent or representative of the proprietor of the earlier trade mark provided for by the pre-draft version of the regulation relating to the EU trade mark.
- 60 Secondly, the General Court could not find, contrary to what it stated in paragraph 30 of the judgment under appeal, that the fact that the EU legislature had twice refrained from making express mention of the fact that the provision concerned should apply in the case of similar marks is sufficient proof of its intention in that regard, since the *travaux préparatoires* do not indicate the reasons which justified the refusal to include such a reference to the similarity of the marks at issue.
- 61 It follows that it cannot be inferred from the *travaux préparatoires* relating to Article 8(3) of Regulation No 207/2009 that, by reason of the fact that that provision does not mention similarity between the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark, the scope of that provision is limited solely to cases in which the marks at issue are identical.
- 62 By contrast, it is apparent from the *travaux préparatoires* that Article 8(3) of Regulation No 207/2009 reflects the choice of the EU legislature to reproduce, in essence, Article 6 *septies*(1) of the Paris Convention.
- 63 In that regard, it should be noted that Council Document No 11035/82 of 1 December 1982 relating to, inter alia, the conclusions of the Working Group on the regulation on the Community trade mark, on which the General Court relies in, inter alia, paragraph 32 of the judgment under appeal, states that that group agreed that the provision in Article 8(3) of Regulation No 207/2009 should be interpreted as applying within the meaning of Article 6 *septies* of the Paris Convention.
- 64 Furthermore, since the European Union is a party to the TRIPS Agreement, it is under an obligation to interpret its trade-mark legislation, so far as possible, in the light of the wording and purpose of that agreement (judgment of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraph 42 and the case-law cited). In particular, Article 2(1) of the TRIPS Agreement provides that, with respect to Parts II, III and IV of that agreement, the States which are parties thereto must comply with Articles 1 to 12 and 19 of the Paris Convention.

- 65 It follows that, so far as the interpretation of Article 8(3) of Regulation No 207/2009 is concerned, account should be taken of Article 6 *septies* of that convention.
- 66 In that regard, in the French-language version of the Paris Convention, which is the authentic version, in accordance with its Article 29, Article 6 *septies* thereof admittedly uses, for the purposes of designating the earlier mark when registration is applied for by the agent or representative of the proprietor of the earlier mark in his own name, the expression ‘cette marque’ (‘the mark’).
- 67 However, the General Court could not, on the basis of that finding alone and in the absence of further justification, affirm, as it did in paragraph 34 of the judgment under appeal, that that provision of the Paris Convention, as it is worded, cannot be interpreted otherwise than as meaning that the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are the same, and consequently find, in paragraph 35 of that judgment, that, in view of the absence of ambiguity in the wording of Article 6 *septies* of the Paris Convention, there was no need to take account of the *travaux préparatoires* relating to that provision.
- 68 It is apparent from the Acts of the Conference of Lisbon, held from 6 to 31 October 1958 for the purpose of revising the Paris Convention, during which Article 6 *septies* was introduced, that a trade mark applied for by the agent or representative of the proprietor of the earlier mark may also be covered by that provision in the case where the mark applied for is similar to that earlier mark (Proceedings of the Lisbon Conference, p. 681).
- 69 It follows that it is not possible to uphold an interpretation according to which, in so far as Article 8(3) of Regulation No 207/2009 does not refer to the identity or similarity of the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark, the application of that provision is limited solely to the situation in which the marks at issue are identical, to the exclusion of any other factor.
- 70 Thirdly, such an interpretation would have the effect of calling into question the general scheme of Regulation No 207/2009 in that it would result in the proprietor of the earlier mark being deprived of the possibility of opposing, on the basis of Article 8(3) of that regulation, the registration of a similar mark by his agent or representative even though, following such registration, the latter would be entitled to file a notice of opposition, pursuant, in particular, to Article 8(1)(b) of that regulation, to the application for subsequent registration of the initial mark by that proprietor on the ground of its similarity to the mark registered by the agent or representative of that proprietor.
- 71 Fourthly, an interpretation according to which Article 8(3) of Regulation No 207/2009 also allows the proprietor of the earlier mark to oppose the registration of a similar mark applied for by his agent or representative is supported by the objective pursued by that provision.
- 72 As the General Court correctly pointed out in paragraph 25 of the judgment under appeal, the objective pursued by that provision is to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark, as those persons may exploit the knowledge and experience acquired during their business relationship with that proprietor and may therefore improperly benefit from the effort and investment which the proprietor himself has made.
- 73 However, the view cannot be taken that such misuse may be considered liable to occur only in cases where the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical, and not in cases where the marks at issue are similar.
- 74 It follows from the foregoing considerations that, by limiting the application of Article 8(3) of Regulation No 207/2009 solely to the situation in which the earlier mark and the mark applied for by the agent or representative of the proprietor of the earlier mark are identical, to the exclusion of any similarity between them, the General Court erred in law.

75 Accordingly, the first ground of appeal raised by EUIPO must be upheld and, consequently, the judgment under appeal must be set aside without it being necessary to examine the other arguments put forward by EUIPO in support of that ground of appeal or the second ground of appeal.

The action before the General Court

76 In accordance with the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, if the appeal is well founded the Court of Justice is to quash the decision of the General Court. It may then itself give final judgment in the matter, where the state of the proceedings so permits, or refer the case back to the General Court for judgment.

77 In the present case, having regard, in particular, to the fact that the action at first instance is based on a single plea in law, alleging infringement of Article 8(3) of Regulation No 207/2009, which is subdivided into three parts which were the subject of an exchange of arguments before the General Court and the examination of which does not require the adoption of any additional measures for organising the procedure or examining the file, the Court of Justice considers that that action is in a state ready to be adjudicated on and that it is appropriate to give a final ruling on it.

The first part of the single plea in law

Arguments of the parties

78 By the first part of its single plea in law plea, John Mills claims that the Board of Appeal erred in considering it to be an ‘agent’ or ‘representative’ of the proprietor of the earlier mark, within the meaning of Article 8(3) of Regulation No 207/2009.

79 In that regard, in paragraph 20 of the decision at issue, the Board of Appeal found, on the basis of the judgment of 13 April 2011, *Safariland v OHIM – DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)* (T-262/09, EU:T:2011:171, paragraph 64), that the terms ‘agent’ and ‘representative’ used in that provision should be interpreted broadly.

80 However, John Mills submits, the General Court went on in that judgment to conclude that the opponent had not furnished proof that there was an agreement with the applicant for the contested mark of the kind that links a principal and its agent, or that such a relationship existed in fact.

81 John Mills claims that, in the circumstances of the present case, an examination of the terms of the distribution agreement between John Mills and the proprietor of the earlier mark should have led the Board of Appeal to take the view that John Mills was neither the agent of that proprietor nor engaged in a contractual relationship under which it represented the interests of that proprietor.

82 EUIPO and Jerome Alexander Consulting submit that the first part of the single plea in law is unfounded.

Findings of the Court

83 In so far as John Mills criticises the Board of Appeal on the ground that it erred in finding that it was an ‘agent’ of the proprietor of the earlier mark within the meaning of Article 8(3) of Regulation No 207/2009, it should be noted that, as recalled in paragraph 72 of the present judgment, the objective of that provision is to prevent the misuse of the earlier mark by the agent or representative

of the proprietor of that mark, as those persons may exploit the knowledge and experience acquired during their business relationship with the proprietor and may therefore improperly benefit from the effort and investment which the proprietor himself has made.

- 84 It follows that the attainment of that objective requires a broad interpretation of the concepts of ‘agent’ and ‘representative’ within the meaning of that provision. That finding as to the meaning of the condition relating to the status of the applicant for registration of the mark vis-à-vis the proprietor of the earlier mark is, moreover, corroborated by the fact that, under that provision, those two concepts are linked by the coordinating conjunction ‘or’, which testifies to the application of Article 8(3) of Regulation No 207/2009 in the various cases of representation of the interests of one party by another.
- 85 The Board of Appeal therefore did not commit an error of law by stating, in paragraph 20 of the decision at issue, that those concepts must be interpreted in such a way as to cover all forms of relationship based on a contractual agreement under which one of the parties represents the interests of the other, with the result that it is sufficient, for the purposes of the application of that provision, that there is some agreement or commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark.
- 86 In that regard, it should be noted that, as is apparent from the findings of the Board of Appeal in paragraphs 22 and 23 of the decision at issue, there was a distribution agreement between John Mills and the proprietor of the earlier mark by which they had agreed that the proprietor would supply the goods under the designation ‘Magic Minerals by Jerome Alexander’ to John Mills and that the latter would be responsible for distributing the goods of that proprietor within the European Union and worldwide. Furthermore, that agreement contained – a fact not disputed by John Mills – provisions under which John Mills was, at the very least, a preferred distributor of those goods, as well as a non-competition clause and provisions relating to the intellectual-property rights of the proprietor of the earlier mark with respect to those goods. Moreover, the last purchase order by which John Mills ordered ‘Magic Minerals’ goods from the proprietor of that mark was dated only approximately two months before John Mills filed its application for registration of the contested mark.
- 87 It follows from those factors that, having regard to the considerations set out in paragraph 85 of the present judgment, the Board of Appeal acted correctly in concluding, in paragraph 25 of the decision at issue, that John Mills had to be regarded as an ‘agent’ of the proprietor of the earlier mark within the meaning of Article 8(3) of Regulation No 207/2009.
- 88 Consequently, the first part of the single plea in law must be rejected as being unfounded.

The second part of the single plea in law

Arguments of the parties

- 89 By the second part of its single plea in law, John Mills claims that the Board of Appeal erred in holding that it was sufficient that the earlier mark was merely similar, rather than identical, to the contested mark in order for Article 8(3) of Regulation No 207/2009 to be capable of being invoked and that it also erred in adopting the perception of the EU public for the purposes of assessing whether there was a likelihood of confusion between the marks at issue.
- 90 EUIPO and Jerome Alexander Consulting submit that the second part of the single plea in law is unfounded.

Findings of the Court

- 91 In so far as John Mills criticises the Board of Appeal on the ground that it held that Article 8(3) of Regulation No 207/2009 was applicable in the present case because of the similarity of the marks at issue, it should be noted, first, that, as is apparent from paragraphs 54 to 74 of the present judgment, that provision applies to applications for registration by the agent or representative of the proprietor of the earlier mark both where the mark applied for is identical with that earlier mark and where it is similar to it.
- 92 Secondly, it should be observed that, while the application of Article 8(3) of Regulation No 207/2009 stems from, inter alia, the similarity between the marks at issue, the specific condition for the protection guaranteed by that provision is that the application for registration must have been made by the agent or representative of the proprietor of the earlier mark, in his own name and without the proprietor's consent, and without that agent or representative justifying his actions. Consequently, the similarity between the marks at issue for the purposes of the application of Article 8(3) of Regulation No 207/2009 is not to be assessed on the basis of the existence of a likelihood of confusion, that condition being specific to Article 8(1)(b) of that regulation (see, by analogy, judgment of 18 June 2009, *L'Oréal and Others*, C-487/07, EU:C:2009:378, paragraphs 34 to 36).
- 93 That being so, in so far as the Board of Appeal wrongly assessed, in paragraphs 34 and 35 of the decision at issue, the likelihood of confusion between the marks at issue in relation to their perception by the relevant public in the European Union, it must be noted that such a consideration is, in any event, not necessary having regard to the finding made by the Board of Appeal, in paragraph 33 of the decision at issue, that, without this being disputed, on the basis of each of the signs at issue considered as a whole, those signs had to be recognised as being similar.
- 94 Consequently, the second part of the single plea in law in the action must be rejected as being, in part, unfounded and, in part, ineffective.

The third part of the single plea in law

Arguments of the parties

- 95 By the third part of its single plea in law, John Mills submits, first, that it is on the basis of a misinterpretation of Article 8(3) of Regulation No 207/2009 that the Board of Appeal held that that provision is applicable not only where the goods or services for which registration of the mark is sought and those covered by the earlier mark are identical, but also where they are similar.
- 96 Secondly, John Mills submits that, although there is identity between the 'face powder featuring mineral enhancements' covered by the earlier mark and the 'cosmetics' and 'preparations for ... care of the skin' covered by the application for registration of the contested mark, this is not the case for the remaining goods covered by that contested mark. Furthermore, those remaining goods and the goods covered by the earlier mark are also not similar or, at the very least, such similarity has not been shown.
- 97 EUIPO and Jerome Alexander Consulting submit that the third part of the single plea in law is unfounded.

Findings of the Court

- 98 In so far as John Mills criticises the Board of Appeal on the ground that it found that Article 8(3) of Regulation No 207/2009 was applicable in the present case, even though not all of the goods to which the application for registration of the contested mark refers were identical to those covered by the earlier mark, it should be borne in mind that, even though that provision does not mention the goods or services for which the mark is sought, the essential function of a mark is to indicate the commercial origin of the goods or services covered (judgment of 12 September 2019, *Deutsches Patent- und Markenamt (#darferdas?)*, C-541/18, EU:C:2019:725, paragraph 18).
- 99 Consequently, for reasons similar to those set out in paragraphs 70 to 73 of the present judgment, having regard to the general scheme of Article 8(3) of Regulation No 207/2009 and the objective pursued by it, the application of that provision cannot be precluded by the fact that the goods or services covered by the application for registration and those covered by the earlier mark are similar, and not identical.
- 100 Furthermore, in the present case, it should be noted, first, that John Mills does not dispute the fact that the ‘face powder featuring mineral enhancements’ covered by the earlier mark is identical to the ‘cosmetics’ and ‘preparations for ... care of the skin’ covered by the application for registration of the contested mark. Secondly, in paragraph 31 of the decision at issue, the Board of Appeal observed, inter alia, that, as regards the remaining goods covered by the marks at issue, they might be made of the same ingredients, they were often produced by the same companies and they were often offered together in drugstores and the same retail store aisles. According to the Court’s settled case-law, in assessing the similarity of the goods or services at issue, all the relevant factors relating to those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (judgment of 20 September 2017, *The Tea Board v EUIPO*, C-673/15 P to C-676/15 P, EU:C:2017:702, paragraph 48 and the case-law cited).
- 101 Accordingly, the Board of Appeal acted correctly in finding, on the basis of the factors set out in paragraph 31 of the decision at issue, that those remaining goods were similar.
- 102 The third part of the single plea in law must consequently be rejected as being unfounded.
- 103 It follows that the action must be dismissed in its entirety.

Costs

- 104 Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court itself gives final judgment in the case, the Court is to make a decision as to the costs.
- 105 Under Article 138(1) of those rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings.
- 106 Since EUIPO and Jerome Alexander Consulting have applied for an order that John Mills should pay the costs, and as John Mills has been unsuccessful in its pleas in law, it must be ordered to pay, in addition to its own costs, the costs incurred by EUIPO relating to the present appeal and to the proceedings before the General Court, and those of Jerome Alexander Consulting relating to the proceedings before the General Court.

On those grounds, the Court (Fifth Chamber) hereby:

- 1. Sets aside the judgment of the General Court of the European Union of 15 October 2018, *John Mills v EUIPO – Jerome Alexander Consulting (MINERAL MAGIC)* (T-7/17, EU:T:2018:679);**
- 2. Dismisses the action in Case T-7/17, brought by John Mills Ltd against the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 5 October 2016 (Case R 2087/2015-1);**
- 3. Orders John Mills Ltd to pay, in addition to its own costs, the costs incurred by the European Union Intellectual Property Office (EUIPO) relating to the present appeal and to the proceedings before the General Court, and those incurred by Jerome Alexander Consulting Corp. relating to the proceedings before the General Court.**

Regan

Ilešič

Juhász

Lycourgos

Jarukaitis

Delivered in open court in Luxembourg on 11 November 2020.

A. Calot Escobar
Registrar

E. Regan
President of the Fifth Chamber