

OPINION OF ADVOCATE GENERAL
SHARPSTON
delivered on 7 December 2017([1](#))

Joined Cases C-85/16 P and C-86/16 P

Kenzo Tsujimoto
v
European Union Intellectual Property Office (EUIPO)

(Appeals — Application to register a European Union trade mark — ‘KENZO ESTATE’ — Earlier European Union trade mark ‘KENZO’ — Relative grounds for refusal — Article 8(5) of Regulation (EC) No 207/2009 — Interpretation of the expression ‘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’ — Whether the use of a person’s forename constitutes use with due cause)

1. By these appeals Mr Kenzo Tsujimoto (‘Mr Tsujimoto’) asks the Court to set aside two judgments of the General Court of 2 December 2015, *Tsujimoto v OHIM* ([2](#)) and *Tsujimoto v OHIM*. ([3](#)) The Court has asked me to focus on one part of Mr Tsujimoto’s appeal in this Opinion, namely the interpretation of the relative grounds for refusal to register a trade mark set out in Article 8(5) of Council Regulation (EC) No 207/2009 on the Community trade mark. ([4](#)) The issue for consideration is whether the word mark ‘KENZO ESTATE’, which Mr Tsujimoto sought to register as a European Union trade mark, falls within the meaning of the expression ‘use without due cause of the trade mark applied for’ in that provision. Mr Tsujimoto argues that because that mark is comprised partly of his forename ‘Kenzo’, its registration would constitute use *with* due cause and therefore Article 8(5) of Regulation No 207/2009 does not apply.

Regulation No 207/2009

2. Recital 7 states that ‘the rights in an [EU] trade mark should not be obtained otherwise than by registration, and registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights’.

3. Article 8 sets out the grounds for determining whether an application for registration of a trade mark should be refused where opposition proceedings have been brought by the proprietor of an earlier trade mark. Those grounds are twofold. Registration of the trade mark applied for is refused ‘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’ (Article 8(1)(a)). Registration is also refused ‘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’ (Article 8(1)

(b)). For the purposes of Article 8(2), an earlier trade mark means, inter alia, EU trade marks (Article 8(2)(a)(i)).

4. Article 8(5) states, ‘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’. (5)

5. Similar wording to Article 8(5) is used in Article 9 (‘Rights conferred by an [EU] trade mark’) in Section 2 (‘Effects of EU trade marks’). Article 9(1) lists the circumstances in which the proprietor of an EU trade mark is entitled to prevent all third parties not having his consent from using signs in the course of trade. These include, in Article 9(1)(c), using ‘any sign which is identical with, or similar to, the [EU] trade mark in relation to goods or services which are not similar to those for which the [EU] trade mark is registered, where the latter has a reputation in the [European Union] and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the [EU] trade mark’. (6)

6. Section 2 also includes Article 12 (‘Limitation of the effects of an [EU] trade mark’). That article provides that:

‘An [EU] trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practices in industrial and commercial matters.’

7. Under Article 15 of Regulation No 207/2009, if within a period of five years following registration the proprietor has not put the EU trade mark to genuine use in connection with the goods or services in respect of which it is registered certain sanctions may apply. Likewise (pursuant to Article 51) the proprietor’s rights can be declared to be revoked if within a continuous period of five years the trade mark has not been put to genuine use. In the same vein, Article 54 provides that where the proprietor has acquiesced for a period of five successive years in the use of a later EU trade mark in the European Union while being aware of such use, he is no longer entitled to apply for a declaration of invalidity or to oppose the use of the later trade mark.

Background to the current proceedings

Case C-85/16 P

8. On 21 January 2008 Mr Tsujimoto filed an application for international registration of the word sign ‘KENZO ESTATE’ (‘the trade mark applied for’) as a trade mark in the then European Community. The goods for which registration was sought were in class 33 of the Nice Agreement; (7) they corresponded to the description: ‘Wine; alcoholic beverages of fruit; western liquors (in general)’. On 17 March 2008 that application was published in the *Community Trade Marks Bulletin* No 12/2008. On 16 December 2008 Kenzo SA (the intervener before the General Court (‘Kenzo’)) filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009, invoking Article 8(5) thereof. The

opposition was based on the earlier EU mark 'KENZO' registered on 20 February 2001 for goods in, inter alia, classes 3, 18 and 25 of the Nice Classification. (8) On 20 December 2011 the Opposition Division rejected the opposition. Kenzo challenged that decision before the Board of Appeal.

9. On 22 May 2013 the Board of Appeal upheld Kenzo's challenge in its entirety. It considered that the three cumulative conditions in Article 8(5) were met: (i) the marks at issue were highly similar for a non-negligible part of the relevant public; (ii) contrary to the view of the Opposition Division, the earlier mark had established a reputation; and (iii) the mark for which registration was sought would ride on the coat-tails of the earlier mark. The Board of Appeal concluded that there was a risk that the trade mark which Mr Tsujimoto sought to register would take unfair advantage of the reputation of the earlier trade mark 'KENZO' for the purposes of Article 8(5) of Regulation No 207/2009.

10. On 8 August 2013 Mr Tsujimoto lodged an appeal against that decision with the General Court. He raised two pleas in law. He claimed that the Board of Appeal had infringed Article 76(2) (9) and Article 8(5) of Regulation No 207/2009. The General Court dismissed the action in its entirety and ordered Mr Tsujimoto to pay the costs.

Case C-86/16 P

11. On 18 August 2009 Mr Tsujimoto filed a further application for international registration of the word sign 'KENZO ESTATE' ('the trade mark applied for') as a trade mark in the then European Community. The goods and services for which registration was sought are in classes 29, 30, 31, 35, 41 and 43 of the Nice Classification. (10) The application for registration was published in the *Community Trade Marks Bulletin* No 44/2009 of 16 November 2009. On 12 August 2010 Kenzo filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 invoking Article 8(5) thereof. The opposition was again based on the earlier word mark 'KENZO' registered on 20 February 2001 for goods in, inter alia, classes 3, 18 and 25 of the Nice Classification.

12. By a decision of 24 May 2012 the Opposition Division rejected Kenzo's opposition. On 23 July 2012 Kenzo challenged that decision before the Board of Appeal which upheld Kenzo's challenge in part by a decision of 3 July 2013. The Board of Appeal found, with regard to the goods in classes 29 to 31 (covered by the registration applied for by Mr Tsujimoto), that they were not regarded as luxury goods and that they were not invariably associated with the world of glamour or fashion. It took the view that they were common mass-consumed foodstuffs that could be bought in any corner shop and that they had only a peripheral relation with Kenzo's goods. The Board of Appeal therefore rejected the opposition in respect of those goods. However, it upheld the opposition in relation to services and goods in classes 35, 41 and 43 of the Nice Classification.

13. On 26 September 2013 Mr Tsujimoto lodged an appeal against that decision in the General Court. He claimed that the Board of Appeal had infringed Article 76(2) and Article 8(5) of Regulation No 207/2009. The General Court dismissed the action in its entirety and ordered Mr Tsujimoto to pay the costs.

The appeals and the procedure before the Court of Justice

14. Mr Tsujimoto asks the Court in the two cases at issue to:

- set aside the judgment of the General Court;
- give a final ruling on the dispute;
- order EUIPO and Kenzo to pay the costs of the proceedings, including the proceedings before the Board of Appeal.

15. EUIPO and Kenzo ask the Court to dismiss both appeals and to order Mr Tsujimoto to pay the costs of the proceedings.

16. In both cases Mr Tsujimoto raises two grounds of appeal. First, he claims that the General Court erred in law in interpreting Article 76(2) of Regulation No 207/2009. By the second ground, which is divided into four pleas, Mr Tsujimoto complains that the General Court infringed Article 8(5) of that regulation. The fourth plea of that ground is the same in both C-85/16 P and C-86/16 P. That plea raises a new point of law and I shall therefore focus solely upon that point in this Opinion.

Fourth plea of the second ground of appeal — misinterpretation of Article 8(5) of Regulation No 207/2009 — use ‘without due cause’ of the trade mark applied for

17. Mr Tsujimoto argues that the General Court erred in law. The sign which he sought to register (KENZO ESTATE) includes his forename: thus use of that sign was *with* due cause. Mr Tsujimoto also submits that the General Court’s reasoning is inadequate as it merely states that ‘no due cause has been demonstrated’. He contends that that court foundered by failing to rule that the Board of Appeal should have given reasons for its conclusion that the use of Mr Tsujimoto’s forename in the sign KENZO ESTATE was use without due cause.

The judgments under appeal

18. The General Court held that the Board of Appeal was correct in deciding that registration of the trade mark which Mr Tsujimoto had applied for would pose a risk of an unfair advantage to the reputation of the earlier trade mark. It confirmed the Board’s finding that Mr Tsujimoto’s mark ‘... would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by [Kenzo] in order to create and maintain the mark’s image’. (11)

19. The General Court recalled in its judgment that Mr Tsujimoto maintained that the Board of Appeal infringed Article 8(5) of Regulation No 207/2009 as it had failed to take into account the argument that he simply sought to register his forename as a trade mark. (12) The General Court ruled as follows:

‘It must be pointed out that the Board of Appeal responded to the applicant’s argument by stating that “no due cause [had] been demonstrated” (paragraph 50 of the contested decision). Admittedly, that is a laconic response, but it is adequate. Regulation No 207/2009 does not provide any unconditional right to register a name as a Community trade mark (see, to that effect, judgment of 25 May 2011, *Prinz von Hannover v OHIM (Representation of a coat of arms)*, T-397/09, EU:T:2011:246, paragraph 29), let alone to register a forename as a trade mark. Consequently, the fact that the applicant’s forename is Kenzo is not enough to constitute due cause for the use of the mark in respect of which registration is sought, for the purposes of Article 8(5) of Regulation No 207/2009 ...

It follows that the fourth part of the second plea must be rejected.’ (13)

Assessment

The obligation to state reasons

20. Mr Tsujimoto’s argument that the General Court’s reasoning in its judgments is inadequate is essentially a complaint that the General Court failed to state reasons for upholding the Board of Appeal’s decisions finding that the use of his forename in the trade mark applied for was use without due cause for the purposes of Article 8(5) of Regulation No 207/2009.

21. The obligation to state reasons derives from Article 36 of the Statute of the Court of Justice which is applicable to the General Court by virtue of the first paragraph of Article 53 of that statute and from Article 117 of the Rules of Procedure of the General Court. (14) It is settled case-law that the Court does not require the General Court to provide an account which follows exhaustively and one by one all the arguments put forward by the parties to the case, and that the General Court’s reasoning may therefore be implicit, on condition that it enables the persons concerned to know why the General

Court has not upheld their arguments and provides the Court of Justice with sufficient material for it to exercise its power of review. (15)

22. It is clear from the judgments under appeal that the General Court examined Mr Tsujimoto's argument concerning the use of his forename. The General Court took the view that whilst the Board of Appeal's response to that argument was 'laconic' it was nonetheless adequate. (16) It is true that the General Court has not set out in detail its view of the interpretation of Article 8(5) of Regulation No 207/2009. However, that court stated expressly that it considered that an assertion that use of a forename of itself amounts to due cause for the purposes of that provision is insufficient. I am therefore of the view that it is possible to establish from the General Court's decision why that court rejected Mr Tsujimoto's plea in that respect.

Article 8(5) of Regulation No 207/2009

23. The essence of Mr Tsujimoto's case is that he should be entitled to register the trade mark KENZO ESTATE because he uses the word 'Kenzo' in good faith as it is his forename.

24. I disagree with Mr Tsujimoto. In my view it does not follow from the fact that Kenzo is his forename that use of the trade mark which he sought to register would constitute use 'with due cause' for the purposes of Article 8(5) of Regulation No 207/2009. The word mark Kenzo was registered in 2001: some eight years before Mr Tsujimoto's application for registration. The rights in that mark are protected under Regulation No 207/2009 and the protection afforded is not displaced simply because Kenzo happens to be a relatively common forename in Japan.

25. I shall start my analysis with some preliminary observations. It is common ground that the word mark Kenzo is the 'earlier trade mark' for the purposes of Article 8(2)(a)(i) of Regulation No 207/2009 in the cases at issue. In paragraph 54 of its judgments the General Court confirmed the finding of the Board of Appeal that Mr Tsujimoto's mark would 'ride on the coat-tails of the earlier trade mark' and thus cause injury to the proprietor, Kenzo.

26. As regards the interpretation of Article 8(5) of Regulation No 207/2009, it should first be borne in mind that the expression 'use without due cause of the trade mark applied for' is not defined in that regulation. That concept must therefore be interpreted in the light of the overall scheme and objectives of the system of which it forms part, and, in particular, must take into account the context of the provision which contains it. (17)

27. Second, within the system established by Regulation No 207/2009 Article 8 is entitled 'Relative grounds for refusal'. It lays down the rules for resolving disputes where an earlier trade mark establishes rights for the proprietor at a time when a subsequent application for registration is made. Article 9 sets out the rights that an EU trade mark confers on the proprietor. Under that provision he has the right to prevent all third parties (not having his consent) from using an identical or similar sign in relation to goods or services which are identical with those for which the EU trade mark is registered (Article 9(1)(a)). He may also prevent the use of any sign where, because of its identity with, or similarity to, the EU trade mark and the identity or similarity of the goods or services covered by that trade mark and the sign, there exists a likelihood of confusion on the part of the public (Article 9(1)(b)). The wording of Article 9(1)(c) (which deals with 'use without due cause') is similar to the last condition in Article 8(5). I consider that these two provisions should be interpreted consistently with a view to ensuring that Regulation No 207/2009 is interpreted in a coherent manner. (18)

28. Third, Regulation No 207/2009 and the Trade Mark Directive share a common historical background and their common aim is to establish a European trade mark regime. (19) The parallel provisions to Articles 8(5) and 9(1)(c) of Regulation No 207/2009 in that directive are Articles 4(4)(a) and 5(2) respectively. It therefore seems to me that it is appropriate to refer to existing case-law interpreting the parallel provisions in the Trade Mark Directive in any examination of Article 8(5) of Regulation No 207/2009. The Court has already ruled that the interpretation of Article 5(2) of the Trade Mark Directive applies equally to Article 4(4)(a) of that directive. (20) I consider that the same approach holds with regard to Articles 8(5) and 9(1)(c) of Regulation No 207/2009.

29. Regarding the scheme of Regulation No 207/2009, the Court's ruling in *Levi Strauss* (21) provides some useful guidance which I consider may be applied by analogy. The legislative scheme requires consequences to be drawn from the proprietor's conduct in determining the scope of protection of those rights. (22)

30. Thus, Article 15 provides that if, following completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State concerned in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, that trade mark is to be subject to the sanctions provided for in Regulation No 207/2009, unless there are proper reasons for non-use. Under Article 51 of Regulation No 207/2009, the rights of the proprietor of the EU trade mark are liable to be revoked, if the mark has not been put to genuine use within a continuous period of five years or if it has become, in consequence of its proprietor's conduct, the common name for a product or service. Finally, under Article 54, where the proprietor of an earlier trade mark has acquiesced, for a period of five successive years, in the use of a later trade mark registered in the European Union while being aware of such use, he is in principle no longer entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used. (23)

31. Those provisions indicate that the purpose of Regulation No 207/2009 is generally to strike an appropriate balance. The interests of the proprietor of a trade mark are to safeguard its essential function within the European Union. That function is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish that product or service from others which have another origin. The proprietor must be protected against competitors wishing to take unfair advantage of the status and reputation of his trade mark by selling products illegally bearing that mark. The other part of the balancing exercise comprises the interests of other economic operators in having trade marks capable of denoting their products and services. (24)

32. It follows that the protection of rights that the proprietor of a trade mark derives under Regulation No 207/2009 is not unconditional, since in order to maintain the balance between those two sets of interests that protection is limited in particular to those cases in which the proprietor shows himself to be sufficiently vigilant by opposing the use of signs by other operators likely to infringe his mark. (25) That is precisely the position in the instant cases where Kenzo has actively opposed the registration of the trade mark applied for. Kenzo thus seeks to safeguard the essential function of the earlier trade mark.

33. Within the scheme of Regulation No 207/2009, does Mr Tsujimoto's application to register a trade mark which includes his forename amount to use with due cause for the purposes of Article 8(5) of that regulation? (26)

34. The Court's ruling in *Leidseplein Beheer and de Vries*, which concerns Article 5(2) of the Trade Mark Directive, sets out some principles that may usefully be taken into account in examining Article 8(5) of Regulation No 207/2009. The Court there stated that the protection afforded to a trade mark with a reputation is extensive. In the present matter Kenzo has demonstrated the existence of a form of injury to the earlier mark in so far as there is a finding that Mr Tsujimoto's mark would ride on the coat-tails of that trade mark. (27) Accordingly, the onus is on Mr Tsujimoto to establish that he nevertheless has due cause for registering KENZO ESTATE. (28) The concept of 'due cause' may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation. That concept cannot lead to the recognition for Mr Tsujimoto's benefit of the rights connected with a registered mark. Rather, where due cause is established it obliges the proprietor of the mark with a reputation (here, Kenzo) to tolerate the use of a similar sign. (29)

35. It seems to me that applying those principles here, the balance does not lie in Mr Tsujimoto's favour.

36. In *Leidseplein Beheer and de Vries*, it was common ground that the third party (Mr de Vries, holder of the sign at issue) had registered that sign and established use *before* the proprietor who sought to rely on Article 5(2) of the Trade Mark Directive (Red Bull GmbH) had registered its own trade mark. (30) However, here Mr Tsujimoto applied to register the sign KENZO ESTATE eight years *after* the EU trade mark Kenzo had been registered. (31)

37. Thus, no question arises as to whether Mr Tsujimoto's sign was accepted by, and what its reputation was with, the relevant public. Against that background, the bare fact that Mr Tsujimoto would like to use his forename as a trade mark does not tip the balance in his favour for the purposes of the balancing exercise to be conducted when considering whether he can demonstrate use with due cause.

38. If more weight were to be given to the fact that Mr Tsujimoto's forename is Kenzo than to the injury caused to the proprietor of the established EU trade mark, that would substantially undermine the protection afforded by Regulation No 207/2009. Categorising such use automatically as use with due cause would mean that any earlier trade mark comprised of a name would be stripped of its essential function.

39. The concept of using names as trade marks is far from being unusual. (32) Thus, the Court has held that in cases where there is a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009, it is appropriate to take account of factors specific to the case at issue, such as whether the person concerned is well known. (33) It seems clear that where a name is registered as a trade mark under Regulation No 207/2009, the essential function of the mark is to safeguard the proprietor's interests under that regulation. It cannot follow (as Mr Tsujimoto asserts) that simply because the mark which he sought to register is made up partly of his forename, that that constitutes use with due cause.

40. As regards the aims of the relative grounds of refusal, recital 7 of Regulation No 207/2009 states that 'registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights'. That indicates that registration should be refused if it is considered that the mark for which registration is sought would conflict with an earlier trade mark for the purposes of Article 8(5). The wording of that provision refers to situations where use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark. The General Court's statement in paragraph 54 of the judgments under appeal, upholding the Board of Appeal's finding that the trade mark which Mr Tsujimoto sought to register 'would ride on the coat-tails of Kenzo's earlier mark' is a clear indication that that court considered that Mr Tsujimoto's mark would take unfair advantage of the earlier trade mark.

41. I conclude that use of Mr Tsujimoto's forename in the sign which he sought to register does not constitute use with due cause for the purposes of Article 8(5) of Regulation No 207/2009.

42. I add for the sake of good order that a proprietor of an EU trade mark is not entitled to prohibit a third party from using in the course of trade his own name or address, provided he uses them in accordance with honest practices in industrial or commercial matters. (34) Thus, Regulation No 207/2009 ensures that a person in Mr Tsujimoto's situation is not prevented from using his forename as a name in the course of trade as a result of Kenzo's prior registration.

43. That is consistent with Article 7 of the Charter which guarantees the right to respect for a person's private and family life. The Court has repeatedly ruled that a person's name is a constituent element of his identity and private life. We identify ourselves by using our names. A person's name is also a link to his family and ancestry or heritage and concerns his private and family life. (35) However, the fact that Kenzo has registered a common forename (which happens to be Mr Tsujimoto's forename) as a trade mark does not go so far as to impinge on his private or family life.

Costs

44. In accordance with Article 137 of the Rules of Procedure of the Court of Justice, a decision as to costs shall be given in the judgment which closes these proceedings.

Conclusion

45. In the light of the foregoing considerations I propose that the Court should:

- reject the fourth plea of the second ground of appeal as being unfounded; and
- make the appropriate order for costs pursuant to the Rules of Procedure of the Court of Justice at the close of these proceedings.

[1](#) Original language: English.

[2](#) Judgment of 2 December 2015, *Tsujimoto v OHIM — Kenzo (KENZO ESTATE)*, T-414/13, not published, EU:T:2015:923.

[3](#) Judgment of 2 December 2015, *Tsujimoto v OHIM — Kenzo (KENZO ESTATE)*, T-522/13, not published, EU:T:2015:922. I refer to T-414/13 and T-522/13 together in this Opinion as ‘the judgments under appeal’.

[4](#) OJ 2009 L 78, p. 1. Regulation No 207/2009 repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). That regulation was in force when Mr Tsujimoto sought to register the trade mark at issue in T-414/13. The numbering of the relevant provisions remained the same. Regulation No 207/2009 was amended several times. It is the original version of that regulation which applied when Mr Tsujimoto sought to register the trade mark at issue in T-522/13. I shall refer to the points when Mr Tsujimoto sought registration as ‘the material time’. That regulation was repealed and 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) with effect from 1 October 2017. The material provisions of Regulation No 207/2009 remain unchanged in Regulation 2017/1001.

[5](#) Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25) (‘the Trade Mark Directive’). Directive 2008/95 repealed and replaced First Council Directive 89/104/EEC of 21 December 1988 (OJ 1989 L 40, p. 1). The latter directive was in force when Mr Tsujimoto sought to register the trade mark at issue in T-414/13. The numbering and the relevant provisions remained the same in Directive 2008/95 which applied when Mr Tsujimoto sought to register the trade mark at issue in T-522/13. Directive 2008/95 has provisions which reflect the wording of Article 8(5) of Regulation No 207/2009. That directive has since been repealed and will be replaced by Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 336, p. 1) with effect from 15 January 2019. At the material time the parallel provisions of Directive 2008/95 were in Article 4(3) concerning trade marks registered in the European Union and Article 4(4)(a) in relation to trade marks registered in a Member State. The numbering of those provisions has changed in Directive 2015/2436. Article 4(3) and 4(4)(a) of Directive 2008/95 are now Article 5(3)(a) of the new directive.

[6](#) The wording of Article 9(1)(c) of Regulation No 207/2009 is reflected in Article 5(2) of Directive 2008/95. That provision is now Article 10(2)(c) in Directive 2015/2436.

[7](#) 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 (‘the Nice Classification’).

[8](#) Those classes correspond to the following descriptions: class 3, ‘bleaching preparations and other substances for laundry use’; class 18, ‘leather and imitations of leather, belts, bags, hand bags’; class 25, ‘clothing footwear, headgear’.

[9](#) Article 76(2) of Regulation No 207/2009 permits EUIPO to disregard facts or evidence which are not submitted in due time by the parties concerned. It has no bearing on the question raised by Mr Tsujimoto’s plea regarding the relative grounds for refusal to register a trade mark set out in Article 8(5) of Regulation No 207/2009 and the use of the forename ‘Kenzo’.

[10](#) They correspond to the following description: class 29, ‘Olive oil (for food); grape seed oil (for food); edible oils and fats; raisins; processed vegetables and fruits; frozen vegetables; frozen fruits; raw pulses; processed meat products; processed seafood’; class 30, ‘Confectionery, bread and buns; wine vinegar; olive dressing; seasonings (other than spices); spices; sandwiches; pizzas; hot dogs (sandwiches); meat pies; ravioli’; class 31, ‘Grapes (fresh); olives (fresh); fruits (fresh); vegetables (fresh); seeds and bulbs’; class 35, ‘Marketing research on wine; providing information on wine sales; advertising and publicity services; import-export agencies; retail services or wholesale services for foods and beverages; retail services or wholesale services for liquor’; class 41, inter alia, ‘Educational and instruction services relating to general knowledge of wine; educational and instruction services relating to general knowledge of obtaining the sommelier certification’; and class 43, ‘Providing foods and beverages; providing temporary accommodation’.

[11](#) Paragraph 54 of the judgments under appeal.

[12](#) Paragraph 57 of the judgment under appeal in T-414/13: the corresponding passage in T-522/13 is paragraph 58.

[13](#) See paragraphs 58 and 59 of Case T-414/13 (EU:T:2015:923) and paragraphs 59 and 60 of Case T-522/13 (EU:T:2015:922), which are drafted in identical terms.

[14](#) Judgment of 11 May 2017, *Dyson v Commission*, C-44/16 P, EU:C:2017:357, paragraph 37 and the case-law cited.

[15](#) Judgment of 11 May 2017, *Dyson v Commission*, C-44/16 P, EU:C:2017:357, paragraph 38 and the case-law cited.

[16](#) See paragraph 58 in T-414/13 (EU:T:2015:923) and the corresponding paragraph 59 in T-522/13 (EU:T:2015:922), cited in point 19 above.

[17](#) Judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraph 28.

[18](#) See by analogy, judgment of 9 January 2003, *Davidoff*, C-292/00, EU:C:2003:9, paragraph 17.

[19](#) See Von Mühlendhal, A., Botis, D., Maniatis, S., Wiseman, I., *Trade Mark Law in Europe* (third edition), published by Oxford University Press 2016, paragraphs 231 and 262. See also Commission press

Release IP/15/4823 of 21 April 2015.

[20](#) Judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraphs 24 and 25.

[21](#) Judgment of 27 April 2006, C-145/05, EU:C:2006:264.

[22](#) Judgment of 27 April 2006, *Levi Strauss*, C-145/05, EU:C:2006:264, paragraph 27. See also point 27 above.

[23](#) Judgment of 27 April 2006, *Levi Strauss*, C-145/05, EU:C:2006:264, paragraph 28.

[24](#) Judgment of 27 April 2006, *Levi Strauss*, C-145/05, EU:C:2006:264, paragraphs 15 and 29.

[25](#) Judgment of 27 April 2006, *Levi Strauss*, C-145/05, EU:C:2006:264, paragraph 30.

[26](#) Judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraph 43.

[27](#) See point 11 above.

[28](#) Judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraphs 39 to 44.

[29](#) Judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraphs 45 and 46.

[30](#) Judgment of 6 February 2014, *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraphs 50 and 52 and the case-law cited.

[31](#) See points 8 and 11 above.

[32](#) Certain celebrities have registered their names as trade marks, such as Frank Sinatra, Elvis, Beyoncé, Michael Jordan, Arnold Schwarzenegger and David Beckham.

[33](#) Judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, EU:C:2010:368, paragraphs 36 and 37.

[34](#) Article 12 of Regulation No 207/2009, indent (a).

[35](#) Judgment of 22 December 2010, *Sayn-Wittgenstein*, C-208/09, EU:C:2010:806, paragraph 52; see further judgment of 8 June 2017, *Freitag*, C-541/15, EU:C:2017:432, paragraphs 33 to 36.