

JUDGMENT OF THE GENERAL COURT (Second Chamber)

13 May 2020 (*)

(EU trade mark — Application for the EU word mark XOXO — Absolute ground for refusal — No distinctive character — Article 7(1)(b) and (2) of Regulation (EU) 2017/1001)

In Case T-503/19,

Global Brand Holdings, LLC, established in New York, New York (United States), represented by D. de Marion de Glatigny, lawyer,

applicant,

v

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

defendant,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 11 April 2019 (Case R 1413/2018-1), concerning an application for registration of the word sign XOXO as an EU trade mark,

THE GENERAL COURT (Second Chamber),

composed of V. Tomljenović, President, P. Škvařilová-Pelzl and I. Nömm (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 5 July 2019,

having regard to the response lodged at the Court Registry on 29 August 2019,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

- 1 On 9 August 2017, the applicant, Global Brand Holdings, LLC, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a mark was sought for the word sign XOXO.
- 3 The goods and services in respect of which registration was sought are in Classes 3, 9, 14, 18, 25 and 35 of the Nice Agreement concerning the International Classification of Goods and Services for the

Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

- Class 3: ‘Fragrances; body cleaning and beauty care preparations; shower gel; shaving soap; body lotion; shampoo; hair conditioner; handwash; eye gel; bath foam; body wash; body butter; shower scrub; lip balm; facial wash; hand and nail cream; soaps; perfumes; perfumery; cosmetic kits; travel kits; cosmetics; lipstick; eyeliner; mascara; nail polish; hair lotions; hair spray; dentifrices; essential oils’;
- Class 9: ‘Eyewear; sunglasses; spectacles; spectacle frames; cases, chains and retainers for sunglasses and spectacles; fascias, cases, covers, carry cases and holders for computers, mobile telephones, smartphones, tablet computers, portable digital assistants and other mobile devices; cases and holders for CDs and DVDs’;
- Class 14: ‘Precious metals and their alloys; precious stones; jewellery; imitation jewellery; costume jewellery; fashion jewellery; bracelets; brooches; chains; charms; earrings; necklaces; rings; horological and chronometric instruments; clocks; watches; watch bands; watch straps; bracelets for watches; watch and clock cases and protectors; key rings of precious metals; accessories, parts and fittings for all the aforesaid goods’;
- Class 18: ‘Leather and imitations of leather; trunks and travelling bags; bags; baggage; luggage; attaché cases; backpacks; beach bags; briefcases; document bags; handbags; hip bags; holdalls; kit bags; make-up bags; make-up cases; pouches; rucksacks; satchels; shoulder bags; sling bags; sports bags; toiletry bags; toiletry cases; purses; wallets; banknote holders; credit card holders; luggage label holders; shoulder belts; garment carriers; securing straps for articles of luggage; umbrellas; parasols; accessories, parts and fittings for all the aforesaid goods’;
- Class 25: ‘Clothing; shirts; shorts; pants; jackets; T-shirts; sweatshirts; sweatpants; hats; socks; sweaters; swimwear; jeans; dresses; skirts; blouses; vests; blazers; overalls; tank tops; footwear; underwear; baby doll pajamas; bras; camisoles; chemises; headbands; lingerie; loungewear; pajamas; panties; robes; sleepwear; headwear’;
- Class 35: ‘Retail services connected with the sale of fragrances, body cleaning and beauty care preparations, shower gel, shaving soap, body lotion, shampoo, hair conditioner, handwash, eye gel, bath foam, body wash, body butter, shower scrub, lip balm, facial wash, hand and nail cream, soaps, perfumes, perfumery, cosmetic kits, travel kits, cosmetics, lipstick, eyeliner, mascara, nail polish, hair lotions, hair spray, dentifrices, essential oils, and shampoo; Retail services connected with the sale of eyewear, sunglasses, spectacles, spectacle frames, cases, chains and retainers for sunglasses and spectacles, fascias, cases, covers, carry cases and holders for computers, mobile telephones, smartphones, tablet computers, portable digital assistants and other mobile devices, and cases and holders for CDs and DVDs; Retail services connected with the sale of precious metals and their alloys, precious stones, jewellery, imitation jewellery, costume jewellery, fashion jewellery, bracelets, brooches, chains, charms, earrings, necklaces, rings, horological and chronometric instruments, clocks, watches, watch bands, watch straps, bracelets for watches, watch and clock cases and protectors, key rings of precious metals, and accessories, parts and fittings for all the aforesaid goods; Retail services connected with the sale of leather and imitations of leather, trunks and travelling bags, bags, baggage, luggage, attache cases, backpacks, beach bags, briefcases, document bags, handbags, hip bags, holdalls, kit bags, make-up bags, make-up cases, pouches, rucksacks, satchels, shoulder bags, sling bags, sports bags, toiletry bags, toiletry cases, purses, wallets, banknote holders, credit card holders, and accessories, parts and fittings for all the aforesaid goods; Retail services connected with the sale of luggage label holders, shoulder belts, garment carriers, securing straps for articles of luggage, umbrellas, parasols, and accessories, parts and fittings for all the aforesaid goods; Retail services connected with the sale of clothing, shirts, shorts, pants, jackets, T-shirts, sweatshirts, sweatpants, hats, socks, sweaters, swimwear, jeans, dresses, skirts, blouses, vests, blazers, overalls, tank tops, footwear, underwear, baby doll pajamas, bras, camisoles, chemises, headbands, lingerie, loungewear, pajamas, panties, robes, sleepwear, and headwear’.

- 4 On 8 September 2017, following a request to that effect by EUIPO, the applicant amended its trade mark application by excluding ‘accessories’ from the goods covered by Classes 14 and 18.
- 5 The trade mark application was published in *European Union Trade Marks Bulletin* No 2017/180 of 21 September 2017.
- 6 On 29 September 2017, a third party sent to EUIPO, in accordance with Article 40(1) of Regulation No 207/2009 (now Article 45(1) of Regulation 2017/1001), written observations explaining on which grounds the mark applied for should not be registered *ex officio*.
- 7 On 16 November 2017, the examiner raised objections against the application for registration as regards the goods in Classes 3, 9, 14, 18 and 25 on account of the absolute ground for refusal in Article 7(1)(b) of Regulation 2017/1001, read in conjunction with Article 7(2) of that regulation, and requested that the applicant submit its observations. In consequence of a request by the applicant to that effect, the time limit within which to reply was extended until 21 March 2018.
- 8 The applicant submitted its observations on 21 March 2018.
- 9 By decision of 24 May 2018, the examiner refused to register the mark applied for in respect of the goods in Classes 3, 9, 14, 18 and 25 on the basis of Article 7(1)(b) of Regulation 2017/1001 read in conjunction with Article 7(2) of that regulation. By contrast, she allowed the mark applied for to proceed to registration in respect of the services in Class 35.
- 10 On 23 July 2018, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against the examiner’s decision.
- 11 By decision of 11 April 2019 (‘the contested decision’), the First Board of Appeal of EUIPO dismissed the applicant’s appeal.
- 12 As regards the definition of the relevant public, the Board of Appeal found that the goods at issue were aimed at the general public and stated that it would take into account the perception of the English-speaking public in the United Kingdom, Malta and Ireland.
- 13 As regards the meaning of the mark applied for, the Board of Appeal observed that the applicant did not dispute the examiner’s assessment that the sequence of letters of which the mark applied for consisted would be understood by the relevant public as meaning ‘hugs and kisses’ and that it was an expression of love and affection.
- 14 So far as concerns the assessment of whether the mark applied for had any distinctive character with regard to the goods at issue, the Board of Appeal, in the first place, found that the examiner had been right in finding that the mark applied for would be perceived by the relevant public as a promotional statement the function of which was to inform consumers that those goods were offered in order to express love and affection.
- 15 In the second place, the Board of Appeal found that the goods at issue in Classes 3, 9, 14, 18 and 25 were typically offered as gifts and that, in that context, consumers would not perceive the sign associated with those goods as an indication of origin, but as a banal and merely promotional indication about feelings that those goods convey, namely love and affection. It therefore concluded that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001.
- 16 In the third place, the Board of Appeal rejected the applicant’s arguments that, first, the mark applied for was not a word, secondly, the feelings conveyed by the mark applied for were not characteristics of the goods at issue, thirdly, the mark applied for was not banal, fourthly, several marks consisting of the letters ‘x’ and ‘o’ had been accepted for registration, fifthly, it was illogical on the part of the examiner to allow the mark applied for to proceed to registration in respect of the services in Class 35 and to refuse registration in respect of the goods at issue and, sixthly, it had been using the mark applied for many of the goods at issue.

Forms of order sought

17 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs, including those incurred before the Board of Appeal.

18 EUIPO contends that the Court should:

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

Law

Admissibility of evidence produced for the first time before the General Court

19 EUIPO submits that Annexes A-4, A-5, A-12, A-13, A-15 and A-16 as well as certain parts of Annexes A-10 and A-11 must be rejected as inadmissible since they have been submitted for the first time before the Court.

20 In that regard, it must be borne in mind that the purpose of actions before the Court is to review the legality of decisions of the Boards of Appeal of EUIPO for the purposes of Article 72 of Regulation 2017/1001, so it is not the Court's function to review the facts in the light of evidence produced for the first time before it (see judgment of 30 September 2015, *Gat Microencapsulation v OHIM — BASF (KARIS)*, T-720/13, not published, EU:T:2015:735, paragraph 89 and the case-law cited).

21 As regards Annex A-4 to the application, containing extracts from the social network Instagram, Annex A-5, containing extracts from the social network Twitter, Annex A-12, containing an extract from the website Wikipedia relating to the television series *Gossip Girl*, Annex A-13, containing an extract from the website Wikipedia relating to the meaning of the term 'xoxo', Annex A-15, containing extracts from the social network Facebook and Annex A-16, containing a table recapitulating the various websites and press articles referring to the mark applied for, it must be stated that they relate to documents that were submitted for the first time before the Court, with the result that they must be declared inadmissible, in accordance with the case-law cited in paragraph 20 above.

22 Annexes A-10 and A-11, consisting of lists of trade marks registered in the European Union which contain the terms 'xoxo' and 'xo' respectively, must also be declared inadmissible in so far as they relate to trade marks registered in Member States of the European Union. It is apparent from an examination of the documents that the applicant submitted in the course of the proceedings before EUIPO that the applicant confined itself to highlighting only the existence of EU trade marks containing those terms.

Substance

23 In support of its action, the applicant puts forward three pleas in law, alleging infringement, first, of Article 7(1)(b) of Regulation 2017/1001, secondly, of the principles of equal treatment and of sound administration and, thirdly, of Article 7(3) of Regulation 2017/1001.

24 EUIPO contends that the pleas should be rejected.

The first plea, alleging infringement of Article 7(1)(b) of Regulation 2017/1001

25 The applicant submits that the Board of Appeal infringed Article 7(1)(b) of Regulation 2017/1001 by finding that the mark applied for was devoid of any distinctive character. In the first place, it claims that the sign constituting the mark applied for is used as a sign-off in informal communication to mean 'hugs and kisses' only by teenagers and very young women, who represent only part of the relevant public. It submits that it is perceived by the majority of the relevant public as a fanciful sign without

any specific meaning, which therefore has an intrinsic distinctive character. In the second place, it argues that the mark applied for has distinctive character even if it is not considered to be fanciful. The applicant states that many registered trade marks convey a feeling and adds that although the mark applied for may convey the feelings of love and affection of the persons who buy and offer the goods concerned, further reflection in the minds of the relevant public is necessary. Furthermore, it submits that consumers often purchase the goods for their personal use. It further states that it is the proprietor of many EU or national word or figurative marks containing the term ‘xoxo’.

- 26 EUIPO states that teenagers and very young women constitute a non-negligible part of the relevant public and argues that it is likely that a wider public will attribute the meaning ‘hugs and kisses’ to the mark applied for. It states that all the goods at issue may be given as gifts and that that is a relevant consideration with regard to the assessment of the absolute grounds for refusal. It adds that there are numerous examples in the case file of the use of the term ‘xoxo’ to express a message of love and affection.
- 27 Article 7(1)(b) of Regulation 2017/1001 provides that trade marks which are devoid of any distinctive character must not be registered.
- 28 According to settled case-law, the marks referred to in Article 7(1)(b) of Regulation 2017/1001 are those which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services at issue, thus enabling the consumer who acquired the goods or services designated by the mark to choose to acquire them again if it was a positive experience, or to avoid doing so, if it was negative (judgment of 5 December 2002, *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)*, T-130/01, EU:T:2002:301, paragraph 18; see, also, judgment of 21 March 2014, *FTI Touristik v OHIM (BigXtra)*, T-81/13, not published, EU:T:2014:140, paragraph 14 and the case-law cited).
- 29 The distinctive character of a sign must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, secondly, by reference to the relevant public’s perception of the sign (see judgments of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 34 and the case-law cited, and of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 24 and the case-law cited).
- 30 The registration of marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks is not excluded by virtue of such use (judgments of 21 October 2004, *OHIM v Erpo Möbelwerk*, C-64/02 P, EU:C:2004:645, paragraph 41, and of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 35).
- 31 Furthermore, for the purposes of assessing the distinctive character of such marks, it is inappropriate to apply to those marks criteria which are stricter than those applicable to other types of sign (see judgments of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 36 and the case-law cited, and of 12 July 2012, *Smart Technologies v OHIM*, C-311/11 P, EU:C:2012:460, paragraph 25 and the case-law cited).
- 32 However, it is apparent from the case-law that, while the criteria for the assessment of distinctive character are the same for different categories of marks, the relevant public’s perception is not necessarily the same in relation to each of those categories and that it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see judgments of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 37 and the case-law cited, and of 9 March 2017, *Puma v EUIPO (FOREVER FASTER)*, T-104/16, not published, EU:T:2017:153, paragraph 18 and the case-law cited).
- 33 In that regard, it must be pointed out that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood — perhaps even primarily understood — as a promotional formula has no

bearing on its distinctive character (judgment of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 45; see, also, judgment of 9 March 2017, *FOREVER FASTER*, T-104/16, not published, EU:T:2017:153, paragraph 19 and the case-law cited).

- 34 Furthermore, an advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness required under Article 7(1)(b) of Regulation 2017/1001 (see judgments of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 39 and the case-law cited, and of 17 September 2015, *Volkswagen v OHIM (COMPETITION)*, T-550/14, EU:T:2015:640, paragraph 16 and the case-law cited).
- 35 Consequently, a trade mark consisting of an advertising slogan must be regarded as being devoid of any distinctive character if it is liable to be perceived by the relevant public only as a mere promotional formula. By contrast, and according to settled case-law, such a mark must be recognised as having distinctive character if, apart from its promotional function, it may be perceived immediately by the relevant public as an indication of the commercial origin of the goods and services concerned (see, to that effect, judgments of 5 December 2002, *REAL PEOPLE, REAL SOLUTIONS*, T-130/01, EU:T:2002:301, paragraph 20, and of 15 September 2005, *Citicorp v OHIM (LIVE RICHLI)*, T-320/03, EU:T:2005:325, paragraph 66).
- 36 It is in the light of the foregoing considerations that it must be examined whether, as the applicant submits, the Board of Appeal infringed Article 7(1)(b) of Regulation 2017/1001 by finding, in the contested decision, that the mark applied for was devoid of any distinctive character.
- 37 As regards the definition of the relevant public, it must be pointed out that, in paragraph 20 of the contested decision, the Board of Appeal found, in essence, that that public corresponded to the general public.
- 38 That finding, which has not, moreover, been disputed by the applicant, must be endorsed. Furthermore, in paragraphs 21 to 23 of that decision, the Board of Appeal stated that it was basing its assessment on the relevant public in the countries in which English is an official language, namely the United Kingdom, Malta and Ireland. In that regard, it must be held that, since, according to Article 7(2) of Regulation 2017/1001, it is sufficient that an absolute ground obtains in part of the European Union for a mark to be refused registration, the Board of Appeal was entitled to rely on the perception of the general public in those countries.
- 39 It is therefore necessary to examine whether, in accordance with the case-law cited in paragraphs 28 to 35 above, there is, from the point of view of the relevant public thus defined, a sufficiently direct and specific relationship between the mark applied for and the goods at issue.
- 40 As regards, in the first place, the relevant public’s perception of the mark applied for, it must be pointed out that the Board of Appeal, in paragraphs 24 to 28 of the contested decision, endorsed the examiner’s assessment that the term ‘xoxo’ will be understood as meaning ‘hugs and kisses’ and that it is used to express feelings of affection and love.
- 41 The applicant does not dispute that the mark applied for might have that meaning, but submits that that is true only for part of the relevant public, namely teenagers and very young women, and not for the rest of the relevant public.
- 42 It must be stated that it is clear from the evidence in the file relating to the proceedings before EUIPO that the sign XOXO will be understood by the relevant public as meaning ‘hugs and kisses’. That is, in particular, shown by the online dictionaries *Urban dictionary* and *Internetslang* which the examiner mentioned in her decision, a decision to which the Board of Appeal expressly referred in paragraph 26 of the contested decision.
- 43 The point highlighted by the applicant that only a proportion of the general public attributes that meaning to the sign XOXO is irrelevant. It is clear from settled case-law that, for a sign to be caught by the prohibition in Article 7(1)(b) of Regulation 2017/1001, it is sufficient that a ground of refusal exists in relation to a non-negligible part of the target public and that it is unnecessary in that regard to

examine whether other consumers belonging to the relevant public are also aware of that sign (see judgment of 6 October 2017, *Karelia v EUIPO (KARELIA)*, T-878/16, not published, EU:T:2017:702, paragraph 27 and the case-law cited). Even if the sign XOXO is understood as meaning ‘hugs and kisses’ by only teenagers and very young women, as the applicant submits, the fact remains that they constitute a non-negligible part of the relevant public.

- 44 As regards, in the second place, the goods at issue, the Board of Appeal was also right in highlighting, in paragraphs 31 to 35 of the contested decision, that they have in common the fact that they are typically offered as gifts on many occasions.
- 45 In the third place and in consequence, the Board of Appeal could validly conclude in paragraphs 29 to 36 of the contested decision that the sign XOXO will, with regard to goods that are capable of being offered as gifts, be perceived as a promotional message conveying feelings of love and affection.
- 46 In that regard, EUIPO rightly states that there is extensive evidence in the file relating to the proceedings before it of the use of the term ‘xoxo’ on goods for the purpose of expressing a message of love and affection. That is the case with regard to the t-shirts marketed on Saint Valentine’s Day on which the term ‘xoxo’ is displayed as the sole or dominant decorative element, as is highlighted by the third party in its observations of 29 September 2017, or with regard to the jewellery on which that term appears, to which the examiner referred in her decision.
- 47 Furthermore, it must be pointed out that although, in accordance with the case-law cited in paragraph 33 above, a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods, the word sign at issue merely reproduces the term ‘xoxo’ as it is used by the relevant public to convey feelings of love and affection, but does not include any other elements that are capable of setting off a cognitive process in the minds of the relevant public and that make it possible to distinguish the goods covered by the mark applied for from those of a competitor. For a non-negligible part of the relevant public, the term ‘xoxo’ is, rather, an advertising message that lacks originality or resonance and is therefore an ordinary statement. That term does not, in addition, require any interpretative effort by that part of the relevant public, with the result that it can be held that the sign at issue does not include any elements that might, beyond its promotional meaning, enable the average consumer concerned to memorise it easily and instantly as a trade mark for the goods covered.
- 48 Consequently, the sign XOXO is not able to perform one of the main functions of a trade mark, namely that of enabling the relevant public to identify the goods of a particular undertaking.
- 49 It must therefore be held that the Board of Appeal was right in finding that the mark applied for has no distinctive character.
- 50 That finding is not invalidated by the applicant’s claim that further reflection on the part of the relevant public is necessary in order to attribute to the mark applied for the meaning associated with the use of the term ‘xoxo’. In that regard, it is sufficient to point out that, for the part of the relevant public which is used to using that term to mean ‘hugs and kisses’, the meaning of the mark applied for will immediately be apparent.
- 51 Likewise, the applicant’s argument that the goods at issue may be purchased for a purpose other than that of being offered as gifts is irrelevant. The fact remains that the relevant public will perceive the sign applied for when purchasing the goods at issue — even if only for its own use — as a promotional message conveying feelings of love and affection and not as an indication of the commercial origin of those goods.
- 52 Lastly, as regards the applicant’s criticism to the effect that it is the proprietor of many marks that include the term ‘xoxo’ and that the Board of Appeal should therefore have granted the application for the trade mark, it must be stated that that criticism is indissociable from the applicant’s second plea, alleging infringement of the principle of equal treatment. It must therefore be examined in the context of that plea.
- 53 The applicant’s first plea must therefore be rejected.

The second plea, alleging infringement of the principles of equal treatment and of sound administration

- 54 The applicant complains that the Board of Appeal disregarded EUIPO's previous decisions, which granted its applications for registration of EU trade marks including the term 'xoxo'. It also submits that the Board of Appeal erred in finding that one of the EU trade marks of which it is the proprietor was registered at a time when the term 'xoxo' did not have the same degree of repute as today. It maintains that the term 'xoxo' had the same repute when it was registered for the first time as an EU trade mark as it does at present, since it had, inter alia, been popularised by an American series for teenagers prior to the registration of that earlier mark. It adds that other EU and national trade marks containing the term 'xoxo' have been registered recently. It deduces from that that the Board of Appeal infringed the principles of equal treatment and of sound administration by refusing to register the mark applied for.
- 55 EUIPO contends that the present plea should be rejected.
- 56 According to settled case-law, the decisions concerning the registration of a sign as an EU trade mark which the Boards of Appeal take under Regulation 2017/1001 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of those decisions must be assessed solely on the basis of that regulation, as interpreted by the EU judicature, and not on the basis of a previous decision-making practice of those Boards of Appeal (judgments of 15 September 2005, *BioID v OHIM*, C-37/03 P, EU:C:2005:547, paragraph 47; of 27 June 2017, *Jiménez Gasalla v EUIPO (B2B SOLUTIONS)*, T-685/16, not published, EU:T:2017:438, paragraph 39; and of 26 September 2017, *Waldhausen v EUIPO (Representation of the silhouette of a horse's head)*, T-717/16, not published, EU:T:2017:667, paragraph 56).
- 57 It is also clear from the case-law that EUIPO is under a duty to exercise its powers in accordance with the general principles of European Union law (judgments of 27 June 2017, *B2B SOLUTIONS*, T-685/16, not published, EU:T:2017:438, paragraph 40, and of 26 September 2017, *Representation of the silhouette of a horse's head*, T-717/16, not published, EU:T:2017:667, paragraph 58). Accordingly, it is true that, in the light of the principles of equal treatment, legal certainty and sound administration, EUIPO must, when examining an application for registration of an EU trade mark, take into account the decisions already taken in respect of similar applications and, in particular, consider whether it should decide in the same way or not (judgments of 9 November 2016, *Smarter Travel Media v EUIPO (SMARTER TRAVEL)*, T-290/15, not published, EU:T:2016:651, paragraph 67, and of 20 July 2017, *Windfinder R&L v EUIPO (Windfinder)*, T-395/16, not published, EU:T:2017:530, paragraph 71). Nevertheless, the way in which those principles are applied must be consistent with respect for the principle of legality. Consequently, a person who applies for registration of a sign as an EU trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed in his favour or for the benefit of someone else (see judgment of 9 November 2016, *SMARTER TRAVEL*, T-290/15, not published, EU:T:2016:651, paragraph 68 and the case-law cited).
- 58 In addition, it is precisely for reasons of legal certainty and of sound administration that the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case, because the registration of a sign as an EU trade mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (judgments of 15 September 2017, *sheepworld v EUIPO (Beste Mama)*, T-422/16, not published, EU:T:2017:606, paragraph 46, and of 26 September 2017, *Representation of the silhouette of a horse's head*, T-717/16, not published, EU:T:2017:667, paragraph 59).
- 59 It is apparent from the case-law that the considerations set out in paragraphs 56 to 58 above apply even if the sign in respect of which registration as an EU trade mark is sought is composed in a manner identical to that of a mark in respect of which EUIPO has already approved registration as an EU trade mark and which relates to goods or services identical or similar to those in respect of which registration

of the sign in question is sought (see judgment of 9 November 2016, *SMARTER TRAVEL*, T-290/15, not published, EU:T:2016:651, paragraph 70 and the case-law cited).

60 In the present case, it is apparent from the examination carried out in paragraphs 27 to 39 above that the Board of Appeal was right in finding, on the basis of a thorough examination taking into account the perception of the relevant public, that the applicant's application for an EU trade mark was caught by one of the grounds for refusal set out in Article 7(1) of Regulation 2017/1001. Furthermore, the earlier decisions relied on by the applicant were adopted by EUIPO's examiners. However, neither the Board of Appeal nor the Court can be bound by the decisions adopted by those examiners (see, to that effect, judgment of 27 March 2014, *Oracle America v OHIM — Aava Mobile (AAVA MOBILE)*, T-554/12, not published, EU:T:2014:158, paragraph 65). In particular, it must be pointed out that it would be contrary to the Board of Appeal's task as a review body, as defined in recital 30 and Articles 66 to 71 of Regulation 2017/1001, for it to be bound by decisions of lower-ranking adjudicating bodies of EUIPO (judgments of 9 November 2016, *SMARTER TRAVEL*, T-290/15, not published, EU:T:2016:651, paragraph 73, and of 30 March 2017, *Apax Partners UK v EUIPO — Apax Partners Midmarket (APAX PARTNERS)*, T-209/16, not published, EU:T:2017:240, paragraph 31).

61 Furthermore, it must be stated that the Board of Appeal did not disregard the existence of decisions in which signs similar to that at issue had been accepted for registration as EU trade marks. In paragraph 44 of the contested decision, it pointed out, inter alia, that such decisions could have been incorrectly adopted. As regards, in particular, the EU trade mark of which the applicant is the proprietor, it stated that that registration had been granted at a time when, possibly, the term 'xoxo' did not have the same level of repute. It must therefore be held that the Board of Appeal took into account the earlier decisions relating to similar applications and, in particular, considered whether it had to decide in the same way or not, as it was required to do in accordance with the case-law cited in paragraph 57 above.

62 As regards the applicant's references to the registration in certain Member States of trade marks containing the term 'xoxo', it must be borne in mind that, according to settled case-law, the EU trade mark regime is an autonomous legal system which pursues objectives peculiar to it; it applies independently of any national system (judgments of 5 December 2000, *Messe München v OHIM (electronica)*, T-32/00, EU:T:2000:283, paragraph 47, and of 3 December 2015, *Infusion Brands v OHIM (DUALTOOLS)*, T-648/14, not published, EU:T:2015:930, paragraph 36). Consequently, the registrability or protectability of a sign as an EU mark must be assessed by reference only to the relevant EU rules. Accordingly, EUIPO and, if appropriate, the EU judiciary are not bound by a decision given in a Member State, or indeed in a third country, that the sign in question is registrable as a national trade mark (judgments of 27 February 2002, *Streamserve v OHIM (STREAMSERVE)*, T-106/00, EU:T:2002:43, paragraph 47, and of 3 December 2015, *DUALTOOLS*, T-648/14, not published, EU:T:2015:930, paragraph 36).

63 In view of the foregoing, the second plea must be rejected.

The third plea, alleging infringement of Article 7(3) of Regulation 2017/1001

64 The applicant states that, in the course of the proceeding before EUIPO, it invoked the use that it had made of the mark applied for and submits that, by such a reference, it sought to demonstrate that that mark had acquired distinctive character through use for the purposes of Article 7(3) of Regulation 2017/1001. The applicant maintains, in essence, that the Board of Appeal should have given it a time limit within which to clarify its line of argument, rather than finding that it had not relied on the existence of distinctive character acquired through use. The applicant maintains that it is for the Court to assess whether such acquired distinctiveness exists.

65 EUIPO contends that the present plea should be rejected.

66 In paragraph 46 of the contested decision, the Board of Appeal found that 'the applicant argues ... that it has been using the objected mark as a brand for many of the contested goods and that the relevant public is aware of that use[; t]he Board notes, in this regard, that the applicant did not rely on acquired distinctiveness within the meaning of Article 7(3) [of Regulation 2017/1001]'.

- 67 In the context of a first complaint, the applicant submits, in essence, that the Board of Appeal should have given it a time limit so that it could clarify its line of argument rather than finding that it had not relied on Article 7(3) of Regulation 2017/1001. In the context of a second complaint, the applicant submits that the Court should find that the mark applied for has acquired distinctive character through use.
- 68 Under Article 7(3) of Regulation 2017/1001, the absolute grounds for refusal laid down in Article 7(1) (b) to (d) of that regulation do not preclude the registration of a trade mark if that trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.
- 69 It is for the trade mark applicant to plead in the course of the proceedings before the adjudicating bodies of EUIPO that the mark applied for has acquired distinctive character through use and to provide evidence in support of such a claim (see, to that effect, judgments of 12 December 2002, *eCopy v OHIM (ECOPY)*, T-247/01, EU:T:2002:319, paragraph 47, and of 8 June 2017, *Bundesverband Deutsche Tafel v EUIPO — Tiertafel Deutschland (Tafel)*, T-326/16, not published, EU:T:2017:380, paragraph 49).
- 70 In the present case, it must be pointed out that the applicant had, on several occasions in the course of the proceedings before the adjudicating bodies of EUIPO, the opportunity to plead that the mark applied for had acquired distinctive character through use and to provide evidence in support of such a claim. That was the case when it submitted its observations on 21 March 2018 in response to the examiner's objections against registration of the mark applied for. The same was true as regards the statement of grounds for its appeal before the Board of Appeal.
- 71 However, the applicant did not rely on Article 7(3) of Regulation 2017/1001 in either of those two documents. Furthermore, it did not attempt to show, in connection with the evidence submitted, that the mark applied for had become capable of identifying the goods concerned as coming from a particular undertaking and therefore of distinguishing those goods from those of other undertakings.
- 72 It is true that both the applicant's observations of 21 March 2018 and its statement of grounds for its appeal before the Board of Appeal contain some references to its use of the mark applied for, since it submitted, in essence, that some of the examples of use of the term 'xoxo' in connection with the goods at issue which had been highlighted by the examiner concerned goods which it markets under the mark applied for.
- 73 However, the fact remains that those references were made for the purposes of disputing the examiner's assessment that the mark applied for is devoid of any intrinsic distinctive character in relation to the goods at issue, and not with a view to showing distinctive character acquired through use, for the purposes of Article 7(3) of Regulation 2017/1001.
- 74 It cannot therefore be held that the applicant's line of argument was sufficiently clear and precise for the Board of Appeal to be able to identify without difficulty a claim that the mark applied for has, for the purposes of Article 7(3) of Regulation 2017/1001, distinctive character acquired through use.
- 75 In that regard, it must be pointed out that the applicant itself appears to concede that the line of argument which it submitted in that regard in the course of the proceedings lacks clarity. Although it claims that it sought 'to demonstrate that its trademark applied for had acquired the distinctive character by use', it does not request that the contested decision be annulled on the ground that the Board of Appeal should have found that there was, for the purposes of Article 7(3) of Regulation 2017/1001, distinctive character acquired through use, but on the ground that the Board of Appeal should have 'issued a letter and give[n] a time limit to the applicant to clarify this claim'.
- 76 However, since, first, the Board of Appeal was required to examine whether there was distinctive character acquired through use only on condition that the applicant had made a claim to that effect and had provided evidence and since, secondly, for the reasons set out in paragraphs 71 to 75 above, the unavoidable conclusion is that that condition was not satisfied in the present case, it must be held that the Board of Appeal was not subject to the obligation to investigate the case further in that regard.

- 77 The first complaint must therefore be rejected.
- 78 As regards the second complaint, it is apparent from settled case-law that the purpose of Article 72(2) of Regulation 2017/1001 is a review of the legality of decisions of the Boards of Appeal. Pursuant to Article 95 of that regulation, that review must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (see judgment of 1 February 2005, *SPAG v OHIM — Dann and Backer (HOOLIGAN)*, T-57/03, EU:T:2005:29, paragraph 17 and the case-law cited). It follows that the Court may not annul or alter a decision against which an action has been brought on grounds which come into existence subsequent to its adoption (judgments of 11 May 2006, *Sunrider v OHIM*, C-416/04 P, EU:C:2006:310, paragraph 55, and of 13 March 2007, *OHIM v Kaul*, C-29/05 P, EU:C:2007:162, paragraph 53).
- 79 Furthermore, Article 188 of the Rules of Procedure of the General Court provides that the pleadings of the parties in proceedings before the General Court may not change the subject matter of the proceedings before the Board of Appeal.
- 80 Consequently, since it has been held that the applicant did not, in the course of the proceedings before the Board of Appeal, rely on Article 7(3) of Regulation 2017/1001, the present complaint must be rejected as inadmissible.
- 81 The third plea must therefore be rejected and, in consequence, the action must be dismissed in its entirety.

Costs

- 82 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by EUIPO.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Global Brand Holdings, LLC to pay the costs.**

Tomljenović

Škvařilová-Pelzl

Nõmm

Delivered in open court in Luxembourg on 13 May 2020.

E. Coulon

S. Papasavvas

Registrar

President

[*](#) Language of the case: English.