

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

30 June 2004 *

In Case T-107/02,

GE Betz Inc., formerly BetzDearborn Inc., whose registered office is in Treviso, Pennsylvania (United States of America), represented by G. Glas and K. Manhaeve, lawyers, with an address for service in Luxembourg,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by E. Joly and subsequently by G. Schneider, acting as Agents,

defendant,

* Language of the case: English.

the other party to the proceedings before the OHIM Board of Appeal, and intervention before the Court of First Instance, being **Atofina Chemicals Inc.**, whose registered office is in Philadelphia, Pennsylvania (United States of America), represented by M. Edenborough, barrister, and M. Medyckyj, solicitor, ACTION brought against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 17 January 2002 (Case R 1003/2000-1), relating to opposition proceedings between Atofina Chemicals Inc. and GE Betz Inc.,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Second Chamber),

composed of: N.J. Forwood, President, J. Pirrung and A.W.H. Meij, Judges,

Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Court Registry on 8 April 2002,

having regard to the response lodged at the Court Registry on 23 July 2002,

having regard to the response of the intervener Atofina Chemicals Inc. lodged at the Court Registry on 26 July 2002,

further to the hearing on 17 September 2003,

gives the following

Judgment

Relevant provisions

- Articles 42 and 73 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, provide as follows:

Article 42

Opposition

...

3. Opposition must be expressed in writing and must specify the grounds on which it is made ... Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.

...

Article 73

Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.'

- 2 Rules 15 to 18 and 20 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1; 'the Implementing Regulation') are worded as follows:

Rule 15

Contents of the notice of opposition

...

(2) The notice of opposition shall contain:

...

(b) as concerns the earlier mark or the earlier right on which the opposition is based:

- (i) where the opposition is based on an earlier mark, a statement to that effect and an indication that the earlier mark is a Community mark or an

indication of the Member State or Member States including, where applicable, the Benelux, where the earlier mark has been registered or applied for; or, where the earlier mark is an internationally registered mark, an indication of the Member State or Member States including, where applicable, the Benelux, to which protection of that earlier mark has been extended;

- (ii) where available, the file number or the registration number and the filing date, including the priority date of the earlier mark;

...

- (vi) a representation and, where appropriate, a description of the earlier mark or earlier right;

- (vii) the goods and services in respect of which the earlier mark has been registered ...; the opposing party shall, when indicating all the goods and services for which the earlier mark is protected, also indicate those goods and services on which the opposition is based;

...

Rule 16

Facts, evidence and arguments presented in support of the opposition

(1) Every notice of opposition may contain particulars of the facts, evidence and arguments presented in support of the opposition, accompanied by the relevant supporting documents.

(2) If the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration ...

(3) The particulars of the facts, evidence and arguments and other supporting documents as referred to in paragraph 1, and the evidence referred to in paragraph 2 may, if they are not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as the Office may specify pursuant to Rule 20(2).

Rule 17

Use of languages in opposition proceedings

(1) Where the notice of opposition is not filed in the language of the application for registration of the Community trade mark, if that language is one of the languages of the Office, or in the second language indicated when the application was filed, the

opposing party shall file a translation of the notice of opposition in one of those languages within a period of one month from the expiry of the opposition period.

(2) Where the evidence in support of the opposition as provided for in Rule 16(1) and (2) is not filed in the language of the opposition proceedings, the opposing party shall file a translation of that evidence into that language within a period of one month from the expiry of the opposition period or, where applicable, within the period specified by the Office pursuant to Rule 16(3).

...

Rule 18

Rejection of notice of opposition as inadmissible

(1) If the Office finds that the notice of opposition does not comply with the provisions of Article 42 of the Regulation, or where the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on the basis of which the opposition is being entered, the Office shall reject the notice of opposition as inadmissible unless those deficiencies have been remedied before expiry of the opposition period ...

(2) If the Office finds that the notice of opposition does not comply with other provisions of the Regulation or of these Rules, it shall inform the opposing party accordingly and shall call upon him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the notice of opposition as inadmissible.

...

Rule 20

Examination of opposition

...

(2) Where the notice of opposition does not contain particulars of the facts, evidence and arguments as referred to in Rule 16(1) and (2), the Office shall call upon the opposing party to submit such particulars within a period specified by the Office ...'

Background

3 By application given the filing date of 20 November 1997, the applicant requested the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office') to register the word mark BIOMATE.

4 The goods in respect of which the registration was sought fall within Class 1 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:

— Class 1: 'Chemical products for use as microbiocides in industrial water and process systems'.

- 5 The application was published in *Community Trade Marks Bulletin* No 72/98 of 21 September 1998.
- 6 By letter dated 21 December 1998, received by the Office on 22 December 1998, Atofina Chemicals Inc., the intervener, filed a notice of opposition against the registration applied for. The opposition was based on the figurative mark reproduced below:

bioMεT

- 7 This figurative mark has been the subject-matter of the following registrations:

— registration in the Benelux under No 39765, bearing a filing date of 28 June 1971, for goods falling within Classes 1 and 5 of the Nice Agreement, namely:

— Class 1: 'Chemical products for industrial, scientific, agricultural, horticultural and forestry purposes (except fungicides, herbicides and preparations for destroying vermin), in particular for destroying macro and micro-organisms';

— Class 5: 'Fungicides, herbicides and preparations for destroying vermin';

— registration in France (renewal No 1665517), bearing a filing date of 23 January 1980, for goods falling within Class 1 of the Nice Agreement, namely:

— Class 1: ‘Chemical products, chemical compositions for use as biocides’;

— international registration R 325543, with a registration date of 8 November 1966, originating in the Benelux and with effect in Austria, France, Italy and Portugal, for goods falling within Classes 1 and 5 of the Nice Agreement, namely:

— Class 1: ‘Chemical products for use in industry, science, agriculture, horticulture and forestry’;

— Class 5: ‘Chemical products, in particular those for destroying macro and micro-organisms’.

8 The opposition was also based on the word mark BIOMET registered in Italy (renewal No 400859) with a filing date of 30 May 1962, for goods falling within Class 5 of the Nice Agreement, namely:

— Class 5: ‘Chemical products and compositions for use as germicides’.

- 9 Finally, the opposition was based on the sign 'BIOMET' which is unregistered but used in the Benelux, France, Italy, Austria and Portugal.
- 10 The opposition was directed against all the goods covered by the application and was based on all the goods for which the earlier marks were registered.
- 11 As regards the earlier registered marks, the opposition was based on Article 8(1)(a) and (b) and (5) of Regulation No 40/94. In the case of the unregistered sign, the opposition was based on Article 8(4) thereof.
- 12 Copies of the registration certificates for the earlier marks were attached to the notice of opposition.
- 13 On 7 April 1999, the Opposition Division sent to the intervener a fax worded as follows:

'Notification of deficiencies in the notice of opposition (Rule 15 and 18(2) of the Implementing Regulation)

...

The examination of the notice of opposition has shown that the indication of the goods and services has not been provided in the language of the opposition proceedings (English).

This deficiency must be remedied within a non extendible period of two months from receipt of this notification, that is on or before 07/06/1999.

The notice of opposition will otherwise be rejected on grounds of inadmissibility.'

- 14 By fax of 28 May 1999, the intervener provided a translation of the lists of goods covered by the earlier marks. The fax also stated:

'If further information is required, please let us know.'

- 15 On 29 June 1999 the Opposition Division sent a further fax to the intervener, worded as follows:

'Communication to the opposing party of the date of commencement of the adversarial part of the opposition proceedings and of final date for submitting facts, evidence and arguments in support of the opposition (Rules 19(1), 16(3), 17(2) and 20(2) of the Implementing Regulation).

...

Your opposition has been communicated to the applicant.

...

The adversarial part of the proceedings will commence on 30/08/1999.

A final period of four months from receipt of this notification, that is until 29/10/1999, is allowed for you to furnish any further facts, evidence or arguments which you may feel necessary to substantiate your opposition ...

Please note that documents must be in the language of the proceedings or accompanied by a translation.'

- 16 The period of four months was extended until 23 March 2000. One day before the expiry of that period the intervener requested a further extension. Taking the view that the reasons put forward in support of that request were insufficient, the Office did not grant it. However, since the request was made one day before expiry of the period the Office granted the intervener one additional day to file evidence substantiating the opposition. In the period granted the intervener provided further evidence, that is to say a statutory declaration, some brochures and a label.
- 17 By decision of 7 September 2000, the Opposition Division held, with regard to the earlier unregistered sign, that the opposition was inadmissible and, as to the remainder, that the opposition failed under the terms of Article 8(1)(a) and (b) and (5) of Regulation No 40/94 on the ground in particular that, no translation of the registration certificates for the earlier marks having been filed within the time-limit laid down, the opposing party had not adduced proof of the validity and legal status of the earlier registrations on which the opposition was based.
- 18 On those grounds the Opposition Division rejected the opposition in its entirety and ordered the intervener to bear the costs.

19 On 13 October 2000 the intervener filed a notice of appeal against the Opposition Division's decision.

20 By decision of 17 January 2002 ('the contested decision'), which the applicant states was communicated to it by registered letter received on 8 February 2002, the Board of Appeal:

- dismissed the appeal in so far as it concerned the inadmissibility of the opposition in relation to the earlier non-registered sign;

- annulled the Opposition Division's decision as to the remainder;

- remitted the case to the Opposition Division for further prosecution;

- ordered that each party bear the costs which it had incurred in connection with the appeal.

21 The Board of Appeal partially annulled the Opposition Division's decision on the basis that, by sending to the opposing party the faxes cited in paragraphs 13 and 15 above, the Opposition Division had created a legitimate expectation on the part of the opposing party that the copies of the registration certificates attached to the notice of opposition were not tainted by any formal deficiency.

Procedure

- 22 By application lodged at the Registry of the Court of First Instance on 5 April 2002 the applicant brought the present action, in English.
- 23 Since the other parties did not object to English being the language of the case before the Court, the latter designated English as the language of the present proceedings.
- 24 On 23 July 2002 the Office lodged its response. On 26 July 2002 the intervener filed its response.
- 25 On 17 October 2002, the applicant submitted a pleading in reliance upon Article 135 (3) of the Rules of Procedure of the Court of First Instance. Since the applicant had not filed an application to lodge a reply and the responses of the intervener and the Office did not contain new pleas, or forms of order justifying the submission of a pleading pursuant to that provision, the Court decided not to add the pleading to the file.

Forms of order sought

- 26 The applicant claims that the Court should:

— annul the contested decision in so far as it:

(i) annuls the decision of the Opposition Division of 7 September 2000;

(ii) remits the case to the Opposition Division for further prosecution;

(iii) orders each party to bear the costs which they have incurred in connection with the proceedings before the Board of Appeal;

— order the Office to pay the costs, including those incurred by the applicant in connection with the proceedings before the Board of Appeal.

27 The Office contends that the Court should:

— grant the applicant's claim for annulment of the contested decision;

— order each party to bear its own costs.

28 The intervener contends that the Court should:

— dismiss the action;

- annul the Opposition Division's decision, in so far as it held that the opposition based upon the earlier trade mark registrations was not well founded;

- annul the Opposition Division's decision as to costs;

- remit the case to the Opposition Division for further prosecution;

- order the applicant to pay the costs incurred by the intervener in connection with the present proceedings.

Matters relating to the forms of order sought

The effect of the form of order sought by the Office

- 29 At the hearing the Office explained, first, that by its first head of claim it was seeking no more than what the applicant was claiming. Consequently, the Office's first head of claim should be understood as intended to support the applicant's first head of claim.
- 30 Secondly, the Office stated at the hearing by way of clarification that it was requesting in the alternative that the Court deliver such judgment as appeared to it to be appropriate in the light of the forms of order sought by the other parties and their arguments. Thus, the Office apparently proposes to leave the decision to the discretion of the Court.

31 The intervener has contended, including at the hearing, that since the Board of Appeal as such is not represented before the Court, it falls to the Office to represent it before the Court.

32 In that regard, it should be noted first of all that the Office was established by Regulation No 40/94 for the purpose in particular of the administration of Community trade mark law and that it is supposed to perform each of its various functions pursuant to that regulation in the general interest of this task.

33 Also, while the Boards of Appeal form an integral part of the Office (Case T-110/01 *Vedial v OHIM — France Distribution* (HUBERT) [2002] ECR II-5275, paragraph 19) and there is continuity in terms of their functions between the Board of Appeal, the examiner and/or the competent division (Case T-163/98 *Procter & Gamble v OHIM* (BABY-DRY) [1999] ECR II-2383, paragraph 38), Boards of Appeal and their members have functional independence in carrying out their tasks. The Office cannot therefore give them instructions.

34 In those circumstances, it must be recognised that, while the Office does not have the requisite capacity to bring an action against a decision of a Board of Appeal, conversely it cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed.

35 While the Office is admittedly designated in Article 133(2) of the Rules of Procedure as the defendant before the Court of First Instance, that designation cannot alter the

consequences flowing from the broad logic of Regulation No 40/94 as regards Boards of Appeal. At the very most it enables the matter of costs to be settled, should the contested decision be annulled or altered, irrespective of the position adopted by the Office before the Court.

- 36 Accordingly, there is nothing to prevent the Office from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate, in performance of its task referred to in paragraph 32 above, for giving guidance to the Court.
- 37 Also, while a new claim put forward only at the hearing is necessarily out of time and therefore inadmissible, the subsidiary clarification provided in the present case at the hearing cannot be considered a claim in the strict sense and its admissibility does not therefore have to be assessed.

The effect of the forms of order sought by the intervener

- 38 At the hearing, the intervener explained that it had set out its second, third and fourth heads of claim solely in order to avoid any ambiguity and that, in actual fact, since they follow automatically from its first head of claim, it was requesting from the Court no more than what it requests by its first and fifth heads of claim. Consequently, the forms of order sought by the intervener should be understood as seeking dismissal of the action and an order that the applicant pay the costs incurred by the intervener in connection with the present proceedings.

Substance

Arguments of the parties

- 39 In support of its action, the applicant relies on a single plea in law, concerning infringement of Rule 17(2) of the Implementing Regulation.
- 40 It argues that the Board of Appeal agreed with the Opposition Division's finding that the registration certificates were not filed in the language of the opposition proceedings and a translation of those certificates was not filed in good time. Since there was no evidence of the validity and legal status of the earlier marks, the opposition based on them had to be rejected on the merits.
- 41 It further contends that the Board of Appeal erroneously decided, relying upon the Opposition Division's faxes of 7 April 1999 and 29 June 1999, that the Opposition Division had frustrated the applicant's legitimate expectation.
- 42 The applicant argues that, as the fax of 7 April 1999 explicitly refers to Rules 15 and 18(2) of the Implementing Regulation and to the possibility of rejecting the notice of opposition on grounds of inadmissibility, and given that the notice of opposition did not meet the requirements of Rule 15(2)(b)(vii) of the Implementing Regulation, that fax could only be interpreted as relating to inadmissibility of the notice of opposition, and not to the evidence to be provided in support of the opposition for which, according to the applicant, there are no grounds of inadmissibility. By fax of 28 May 1999 the intervener remedied the defect in the notice of opposition referred to by the Opposition Division.

- 43 Unlike the case of rejecting the notice of opposition on grounds of inadmissibility, the Opposition Division was not obliged to inform the opposing party of any failure to provide a translation covered by Rule 17(2) of the Implementing Regulation.
- 44 It is the opposing party's responsibility to file any evidence in support of the opposition that it deems necessary. In the present case, the intervener could not remedy defects in that respect by simply requesting the Opposition Division, in vague terms, to let it know if it required further information, in the way that it did in its fax of 28 May 1999, especially since that fax was sent in reply to the fax of 7 April 1999 regarding admissibility of the notice of opposition. To accept the contrary argument would impose an obligation on the Opposition Division to assist the opposing party.
- 45 As to the fax of 29 June 1999, its only purpose was to enable the intervener under Article 42(3) of Regulation No 40/94 and Rule 16(3) of the Implementing Regulation to provide, if it considered it necessary, further evidence to substantiate its opposition.
- 46 Neither the fax of 7 April 1999 nor that of 29 June 1999, taken separately or together, could give rise to any legitimate expectation on the part of the intervener as to the language requirements in Rule 17(2) of the Implementing Regulation. On the contrary, the fax of 29 June 1999 drew its attention to those requirements.
- 47 The Office submits that the Board of Appeal rightly held that Rule 17(2) of the Implementing Regulation had not been complied with in the present case. In Case T-232/00 *Chef Revival USA v OHIM — Massagué Marin (Chef)* [2002] ECR II-2749, at paragraph 42, the Court of First Instance confirmed the distinction between, first, the obligation under Rule 15(2)(b)(vii) of the Implementing Regulation to indicate

the goods covered by the earlier trade mark and, second, the presentation of particulars of the facts, evidence and arguments, as referred to by Article 42(3) of Regulation No 40/94 and by Rules 16(1) and (2) and 20(2) of the Implementing Regulation. Under Rule 18(2) of the Implementing Regulation, failure to comply with the former obligation results in inadmissibility of the notice of opposition, whereas failure to present the particulars leads to their not being taken into account in the consideration of the merits of the opposition.

- 48 Since Rule 17(2) of the Implementing Regulation requires the opposing party to provide a translation in the language of the proceedings of the evidence filed in support of the opposition, failure to produce such a translation amounts to failure to submit the evidence. In those circumstances, the Opposition Division cannot but reject the opposition in question.
- 49 The Office considers, on the other hand, that the Board of Appeal wrongly held that the intervener's legitimate expectation had been frustrated.
- 50 First, the intervener could not legitimately ignore the relevant provisions, which are clear and have remained unchanged since their adoption.
- 51 Second, neither in its fax of 7 April 1999 nor in that of 29 June 1999 did the Opposition Division give the intervener specific assurances, explicitly or implicitly, that the evidence provided complied with the language requirements.

- 52 Third, the very nature of notifications such as the fax of 29 June 1999 prevents them from being precise or specific. It follows from Article 42(3) of Regulation No 40/94 and Rules 16(3) and 20(2) of the Implementing Regulation that the role of the Office consists in inviting the opposing party, in general terms, to submit facts, evidence and arguments, and not in pointing out particular irregularities. The pointing out of such irregularities would require the Office to examine the substance of each case before the facts, evidence and arguments are submitted, a situation that the legislature did not contemplate and which is excluded by the *inter partes* nature of opposition proceedings. In addition, it follows from Article 74 of Regulation No 40/94 and Rule 16(3) of the Implementing Regulation that once the notice of opposition has been deemed admissible, the parties are free as to the manner in which they present their case. Finally, it follows from Article 74(1) of Regulation No 40/94 that the Office is not allowed to assist the opposing party in determining what facts, evidence or arguments to submit. Those principles apply by analogy to the language requirements.
- 53 Referring to several decisions of the Boards of Appeal, the Office observes that there is no consensus on the issue whether the standard wording, used in the fax of 29 June 1999, is sufficiently clear. Nevertheless, the answer to that question must be affirmative.
- 54 The intervener argues that once each party knows unambiguously the essential facts, evidence and arguments upon which the other party intends to rely, the opposition must be considered to be sufficiently pleaded.
- 55 In the present case, the notice of opposition stated that a copy of the registration certificates was attached to the opposition form and that the opposition was based on all the goods for which the earlier marks had been registered. The natural meaning of the fax of 7 April 1999 was that the specification of goods in those certificates formed part of the notice of opposition and had to be translated into the language of the opposition proceedings. That translation was provided on 28 May

1999. Thus, the essential information for determining the substantive merits of the opposition was either in the notice of opposition directly or included by reference to the translation of the goods in question supplied in the fax of 28 May 1999.

56 The intervener observes that it is unnecessary to translate all the information contained in a registration certificate, because some such information is irrelevant or is untranslatable, for example names and numbers, nor is it necessary to translate information, such as a priority date, where no reliance is placed on it. The intervener added at the hearing that where just a small part of a long document was relied upon, it appeared to it to be disproportionate and unreasonable to have to translate the entire document.

57 Referring to Rule 16(1) and (2) of the Implementing Regulation, the intervener adds that there is no mandatory requirement to provide a full translation of the registration certificates for the earlier trade marks.

58 At the hearing it also submitted that evidence of the validity, and the legal status, of the mark upon which the opposition is based did not stem from the translation of the registration certificates but from the registration certificates themselves.

59 The intervener further contends that the natural meaning of the fax of 29 June 1999 was that the deficiency noted in the fax of 7 April 1999 had been corrected and that the notice of opposition would therefore not be rejected on the grounds of inadmissibility. The observation in the fax of 29 June 1999 concerning the language

of the proceedings refers to further facts, evidence or arguments, and not to those already filed. If the Opposition Division took the view that the deficiency had not been remedied, the logical consequence was to reject the notice of opposition as inadmissible, which it did not do.

60 The intervener supports the reasoning of the Board of Appeal that it had a legitimate expectation, based on the indications which it had received from the Opposition Division, that it had complied with the necessary requirements for the opposition to be well founded.

61 Finally, it cites five decisions of the Boards of Appeal in which it was held that there was no need to translate all the information in the registration certificates concerned, and in two of those decisions it was found that the opposing party had a legitimate expectation induced by the conduct of the Opposition Division that it had fulfilled the requirements in that regard.

Findings of the Court

62 In its arguments in support of its single plea in law, the applicant distinguishes the question of the language requirements of the opposition procedure, in particular that of breach of Rule 17(2) of the Implementing Regulation, from the question of whether the Opposition Division frustrated the intervener's legitimate expectation. The same distinction is adopted by the Office and the intervener. The distinction should be adopted when examining the single plea.

The language requirements of the opposition procedure

- 63 As regards the language requirements relating to the earlier trade marks on which the opposition is based, the Board of Appeal held in paragraph 23 of the contested decision that ‘the opponent [the intervener before the Court] should therefore reproduce, in the procedural language, the exact data which appears on the register’. It added that in this instance there could be no doubt that the opponent had not submitted comprehensive translations of the documents issued or published by the competent authorities. This last finding is not contested by any of the parties.
- 64 In the present case it is common ground that the notice of opposition stated that a copy of the registration certificates was attached to the opposition form, that the opposition was based on all the goods for which the earlier marks had been registered, but that the lists of those goods were not accompanied by a translation into the language of the opposition proceedings.
- 65 Accordingly, the notice of opposition did not comply with the language requirement resulting from Rules 15(2)(b)(vii) and 17(1) of the Implementing Regulation as the notice of opposition did not contain a translation, into the language of the proceedings, of the lists of goods and services for which the earlier marks were registered. This situation is not included among the cases referred to in Rule 18(1) of the Implementing Regulation, but comes under Rule 18(2) which concerns cases where the notice of opposition does not comply with provisions of Regulation No 40/94 or of the Implementing Regulation other than those referred to by Rule 18(1), those other provisions being, in the present case, Rules 15(2)(b)(vii) and 17(1) of the Implementing Regulation.

- 66 Consequently, by calling upon the intervener by fax of 7 April 1999 to provide a translation, into the language of the proceedings, of the lists of goods and services for which the earlier marks were registered, the Opposition Division acted in conformity with Rules 15(2)(b)(vii), 17(1) and 18(2) of the Implementing Regulation. The heading of that fax indeed refers to 'Rule 15 and 18(2) of the Implementing Regulation'.
- 67 It is also common ground that on 28 May 1999 the intervener provided a translation, into the language of the proceedings, of the lists of goods and services for which the earlier marks were registered. Thus, the notice of opposition became consistent with the 'other provisions of ... Regulation [No 40/94] or of [the Implementing Regulation]', as referred to by Rule 18(2) of the Implementing Regulation.
- 68 By fax of 29 June 1999 the Opposition Division then allowed the intervener a period for the submission of further facts, evidence or arguments that it might consider necessary to support the opposition, while indicating that documents had to be drafted in the language of the proceedings or accompanied by a translation.
- 69 This fax is consistent with Article 42 of Regulation No 40/94 and Rules 16(2) and (3) and 17(2) of the Implementing Regulation inasmuch as those provisions lay down that the facts, evidence or arguments to be submitted in support of the opposition may be submitted within a period fixed by the Office. The heading of that fax indeed refers to Rules 19(1), 16(3), 17(2) and 20(2) of the Implementing Regulation.

- 70 It is also true that the Opposition Division did not inform the opposing party that a translation of the registration certificates, as envisaged by Rule 17(2) of the Implementing Regulation, was lacking. However, as is apparent from *Chef*, cited above, at paragraphs 52 and 53, the legal requirements concerning the evidence and its translation into the language of the opposition proceedings are substantive conditions of the opposition and, consequently, the Opposition Division was not obliged to point out to the intervener the deficiency constituted by its failure to produce a translation of the registration certificates for the earlier marks. It is to be remembered that the absence of a translation of the lists of goods and services covered by the registered marks is contrary to Rules 15(2)(b)(vii) and 17(1) of the Implementing Regulation and therefore comes under Rule 18(2) of the Implementing Regulation. By contrast, the absence of a translation of the registration certificates for the earlier marks is not contrary to any provision of Regulation No 40/94 or the Implementing Regulation that is covered by Rule 18(2) of the Implementing Regulation.
- 71 It is necessary to examine in light of the foregoing the arguments put forward by the intervener, set out above at paragraph 54 et seq.
- 72 It is to be noted at the outset that, as is apparent from the case-law, the rule that evidence filed in support of the opposition must be submitted in the language of the opposition proceedings or be accompanied by a translation into that language is justified by the necessity to observe the *audi alteram partem* rule and to ensure equality of arms between the parties in *inter partes* proceedings. While it is true that, as the intervener submits, the opposing party is not in any way obliged to provide a full translation of the registration certificates for the earlier trade marks, that does not mean that the Opposition Division is obliged to take into account, when considering the substance of the opposition, registration certificates provided in a language other than that of the opposition proceedings. In the absence of a translation of the registration certificates into the language of the proceedings, the Opposition Division may lawfully reject the opposition as unfounded unless, in

accordance with Rule 20(3) of the Implementing Regulation, it can give a ruling on the opposition on the basis of evidence which it may already have before it (*Chef*, paragraphs 42, 44, 60 and 61). This last exception has not been pleaded in the present case.

- 73 As regards the argument that the evidence concerning the trade marks upon which the opposition is based stems not from the translation of the registration certificates but from the very certificates, it should be observed that, while the evidence does stem from the registration certificates and not from a translation of them, the fact remains that if that evidence is to be taken into account it must comply with the language requirements laid down by Rule 17(2) of the Implementing Regulation.
- 74 As regards the need, which the intervener disputes, to translate documents in their entirety, the question whether certain parts of documents may be considered irrelevant for the opposition at issue and therefore not be translated is a matter for the discretion of the opposing party; however, only the parts actually translated into the language of the proceedings are to be taken into consideration by the Opposition Division. Furthermore, in the present case it is apparent from the case-file that the length of the documents provided in Dutch, Italian and French is not such, in particular compared with the translated list of goods, that the obligation to provide a translation thereof may be regarded as disproportionate and unreasonable.
- 75 As to the argument derived by the intervener from decisions of the Office's Boards of Appeal, it need merely be pointed out that decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of that regulation, as interpreted by the

Community judicature, and not on the basis of a previous decision-making practice of those boards (see, inter alia, Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 32).

- 76 So far as concerns, finally, the intervener's argument that if the Opposition Division took the view that the deficiency noted in the fax of 7 April 1999, namely the absence of a translation of the lists of the goods covered by the registrations, had not been corrected, the logical consequence was to reject the notice of opposition as inadmissible, which it did not do, suffice it to state that the present dispute relates not to the absence of a translation of the lists of goods and services covered by the earlier marks but to the absence of a translation of the registration certificates for those earlier marks.
- 77 None of the intervener's arguments can therefore be upheld.
- 78 It follows from the foregoing that the finding of the Board of Appeal referred to in paragraph 63 above, that the intervener should have reproduced, in the procedural language, the exact data which appear on the register, is not vitiated by an error of law.

The intervener's legitimate expectation

- 79 At paragraph 24 of the contested decision, the Board of Appeal concluded:

'the Opposition Division, in sending its aforementioned notifications to the opponent, created a legitimate expectation on the part of the opponent that the

copies of registration certificates attached to the notice of opposition were not tainted by any formal deficiency. The opponent was therefore entitled to assume that, having provided the necessary translation of the goods in question, it had complied with the formal requirements laid down in the Regulation’.

80 According to well-established case-law, the right to rely on the principle of the protection of legitimate expectations, which is one of the fundamental principles of the Community, extends to any individual in a situation where the Community authorities, in particular by giving him precise assurances, have caused him to entertain legitimate expectations (see, in particular, Case T-273/01 *Innova Privat-Akademie v Commission* [2003] ECR II-1093, paragraph 26, and the case-law cited).

81 It is not apparent from the contested decision or the documents before the Board of Appeal that the intervener pleaded any breach of the principle of the protection of legitimate expectations before the Board of Appeal. In order to determine whether the Board of Appeal was right in holding, of its own motion, that the Opposition Division had caused the intervener to entertain a legitimate expectation, the relevant factors in the case must be examined.

82 The first factor is constituted by the Opposition Division’s fax of 7 April 1999 calling on the intervener to provide a translation into English of the goods covered by the earlier marks, failing which the notice of opposition would be rejected as inadmissible. According to the Board of Appeal, the wording of that letter was misleading inasmuch as it implied that all that was missing was the translation into English of the list of goods without indicating that it was necessary to provide a full translation of the registration certificates.

83 The second factor is to be found in the sentence of the intervener's fax of 28 May 1999 requesting the Office to inform the intervener if further information was required. Referring to that sentence, the Board of Appeal found, at paragraph 21 of the contested decision, that 'in the absence of a meaningful response from the Opposition Division the opponent understandably (but erroneously) concluded that all was in order with the Opposition'.

84 The third factor concerns the sentence contained in the Opposition Division's fax of 29 June 1999 informing the intervener that 'a final period of ... [was] allowed for [it] to furnish any further facts, evidence or arguments which [it might] feel necessary to substantiate [its] opposition', read in conjunction with the Opposition Division's fax of 7 April 1999. According to the Board of Appeal, that communication did not clear up the misunderstanding created by the two earlier communications.

85 The Court is unable to agree with the Board of Appeal's analysis of those three factors.

86 First of all, the Opposition Division's fax of 7 April 1999 refers expressly to Rules 15 and 18(2) of the Implementing Regulation and points out solely that the indication of the goods and services had not been provided in the language of the opposition proceedings. In the absence of specific references to Rules 16 and 17 of the Implementing Regulation in particular, that fax was not capable of providing the basis for a legitimate expectation on the part of the intervener that it had complied with the requirement prescribed by Rule 17(2) concerning the filing of evidence in the language of the proceedings. This assessment is borne out by the fact that the intervener itself did not rely on that fax in order to invoke a legitimate expectation.

- 87 As to the second factor referred to above, such a communication, emanating from the intervener itself, cannot be treated as conduct on the part of the Community authorities that is capable of causing the opposing party to entertain legitimate expectations. A legitimate expectation cannot be founded on unilateral action by the party who would entertain the expectation. Furthermore, as the Office has correctly pointed out, this hypothesis would require the Opposition Division to assist the opposing party, an obligation incompatible with that system.
- 88 As regards the third factor referred to, namely the sentence in the fax of 29 June 1999 that is cited in paragraph 84 above, that sentence — having regard in particular to the use of the word ‘further’ — read in conjunction with the fax of 7 April 1999 was likewise not such as to cause the intervener to entertain a legitimate expectation that the registration certificates submitted complied with the relevant language requirements. That letter states nothing in this regard. If the letter was not capable of dispelling any misunderstanding or doubt on the part of the intervener, it was for the latter to make inquiries of the Office as necessary.
- 89 Furthermore, the Board of Appeal was wrong in finding, at paragraph 22 of the contested decision, that the fax of 29 June 1999 informed the intervener that it had a period of four months to submit further facts, evidence or arguments which it might feel necessary to substantiate its opposition and that ‘the documents’ had to be in the language of the proceedings or accompanied by a translation. That fax in fact states that ‘documents’ must be drafted in the language of the opposition proceedings or accompanied by a translation (‘Please note that documents must be in the language of the proceedings or accompanied by a translation’). This indication regarding the language of the proceedings cannot therefore be interpreted as referring solely to the ‘further facts, evidence or arguments’. On the contrary, it is

general and thus also precludes the fax of 29 June 1999 from being interpreted as signifying that the copies of the registration certificates that were attached to the notice of opposition met the language requirements.

90 Finally, in contending that the natural meaning of the fax of 29 June 1999 was that the deficiency noted in the fax of 7 April 1999, namely the absence of a translation of the lists of goods covered by the earlier marks into the language of the proceedings, had been corrected, the intervener itself acknowledges that that fax cannot be interpreted as signifying that the registration certificates also met the language requirements.

91 The intervener further submits that, in two of the five Board of Appeal decisions which it cites, it was found that the opposing party had a legitimate expectation induced by the conduct of the Opposition Division that it had fulfilled the requirements concerning translation of the information contained in the registration certificates in question.

92 As held above, and regardless of whether or not those decisions are consistent with the case-law already cited concerning legitimate expectations, the legality of decisions of the Boards of Appeal cannot be assessed on the basis of previous Board of Appeal decisions (*Kit Pro and Kit Super Pro*, cited above, paragraph 32).

93 Accordingly, it must be concluded that the Board of Appeal erred in law in holding that the Opposition Division had created a legitimate expectation on the part of the intervener as to the fact that the copies of registration certificates attached to the notice of opposition were not tainted by any formal deficiency.

94 It follows from all of the foregoing that the single plea for annulment must be upheld. The contested decision must therefore be annulled to the extent claimed.

Costs

95 Under Article 87(2) 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.

96 In the present case the intervener has been unsuccessful inasmuch as the contested decision must be annulled, in accordance with the form of order sought by the applicant. However, the applicant has not applied for costs from the intervener, but for an order that the Office pay the costs, including those incurred by the applicant in connection with the proceedings before the Board of Appeal.

97 Even though the Office has supported the applicant's first head of claim, it should be ordered to pay the costs incurred by the applicant since the contested decision was made by its Board of Appeal. It must therefore be ordered, in accordance with the form of order sought by the applicant, that the Office bear the costs incurred by the applicant, including those incurred by it in connection with the proceedings before the Board of Appeal, and that the intervener bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 17 January 2002 (Case R 1003/2000-1) in so far as it annuls the decision of the Opposition Division of 7 September 2000, remits the case to the Opposition Division for further prosecution and orders each party to bear the costs which they have incurred in connection with the proceedings before the Board of Appeal;**
- 2. Orders the Office to pay the costs incurred by the applicant, including those incurred by it in connection with the proceedings before the Board of Appeal;**
- 3. Orders the intervener to bear its own costs.**

Forwood

Pirrung

Meij

Delivered in open court in Luxembourg on 30 June 2004.

H. Jung

J. Pirrung

Registrar

President