

Case T-107/02

GE Betz Inc.

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Community trade mark — Opposition procedure — Earlier figurative mark — Application for Community word mark BIOMATE — Failure to produce evidence in the language of the opposition proceedings — Legitimate expectation — Rules 16, 17 and 18 of Regulation (EC) No 2868/95)

Judgment of the Court of First Instance (Second Chamber), 30 June 2004 . . . II - 1849

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Procedural role of the Office — Right of the Office, although designated as the defendant, to support the applicant's claims — Functional independence of Boards of Appeal and their members*

(Rules of Procedure of the Court of First Instance, Art. 133(2))

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Failure to produce a translation of the registration certificate for an earlier mark — Obligation on the Office to inform the opposing party — None*
(Council Regulation No 40/94, Arts 42 and 43; Commission Regulation No 2868/95, Art. 1, Rule 18(2))
3. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Failure to produce a translation of the registration certificate for an earlier mark — Power of the Opposition Division to reject the opposition as unfounded*
(Commission Regulation No 2868/95, Art. 1, Rules 17(2) and 20(3))
4. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Communication sent by the opposing party to the Office to which there is no reply — Communication not capable of giving rise to legitimate expectations on the part of the opposing party*
(Council Regulation No 40/94, Arts 42 and 43)

1. In Community trade mark proceedings brought against a decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), 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 — the administration of Community trade mark law — for giving guidance to the Court.

examiner and/or the competent division, Boards of Appeal and their members have functional independence in carrying out their tasks. The Office cannot therefore give them instructions.

While the Boards of Appeal form an integral part of the Office and there is continuity in terms of their functions between the Board of Appeal, the

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.

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.

tion, according to which the Office is to inform the opposing party of deficiencies in the notice of opposition and call upon him to remedy them, failing which the notice will be rejected as inadmissible.

(see para. 70)

(see paras 32-36)

2. In opposition proceedings brought pursuant to Article 42 et seq. of Regulation No 40/94 against registration of a Community trade mark, the legal requirements concerning the evidence and its translation into the language of the opposition proceedings are substantive conditions of the opposition. Accordingly, the Opposition Division is not obliged to point out to the opposing party a deficiency constituted by his failure to produce a translation of the registration certificates for earlier marks, since its absence is not contrary to any provision of Regulation No 40/94, or of Regulation No 2868/95 implementing Regulation No 40/94, that is covered by Rule 18(2) of that implementing regula-
3. Rule 17(2) of Regulation No 2868/95 implementing Regulation No 40/94 on the Community trade mark, under which 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 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 Regulation No 2868/95, it can give a ruling on the opposition on the basis of evidence which it may already have before it.

(see para. 72)

4. In opposition proceedings brought pursuant to Article 42 et seq. of Regulation No 40/94 against registration of a Community trade mark, a communication emanating from the opposing party himself which requests the Opposition Division to inform him if further infor-

mation is required and to which there is no reply cannot be treated as conduct on the part of the Community authorities, in this instance the Office for Harmonisation in the Internal Market (Trade Marks and Designs), 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, this hypothesis would require the Opposition Division to assist the opposing party, an obligation incompatible with that system.

(see para. 87)