

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

15 June 2005*

In Case T-186/04,

Spa Monopole, compagnie fermière de Spa SA/NV, established in Spa (Belgium),
represented by L. de Brouwer, E. Cornu, É. De Gryse and D. Moreau,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM), represented by G. Schneider, acting as Agent,

defendant,

* Language of the case: English.

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

Spaform Ltd, established in Southampton (United Kingdom), represented by J. Gardner and A. Howard, Barristers,

APPLICATION for annulment of the decision of the Fourth Board of Appeal of OHIM of 25 February 2004 (Case R 827/2002-4) relating to opposition proceedings between Spa Monopole, compagnie fermière de Spa SA/NV and Spaform Ltd,

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

composed of J. Pirrung, President, N.J. Forwood and S. S. Papasavvas, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Registry of the Court of First Instance on 25 May 2004,

having regard to the response of OHIM lodged at the Registry of the Court on 13 October 2004,

having regard to the response of the intervener lodged at the Registry of the Court on 7 October 2004,

further to the hearing on 1 February 2005,

gives the following

Judgment

Background to the dispute

- 1 On 5 August 1997 the intervener made an application for a Community trade mark to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.
- 2 The mark sought to be registered is the word sign SPAFORM.
- 3 The goods for which registration was sought are within Classes 7, 9 and 11 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. They correspond to the following descriptions:

- ‘pumps, pressure regulators, pressure valves’, in Class 7;

 - ‘apparatus and instruments for measuring pressure’, in Class 9;

 - ‘baths; whirlpool baths; spa baths; wash basins; bathing facilities fitted with pressure jets; showers, water pipes’, in Class 11.
- 4 On 27 July 1998 the application for registration was published in *Community Trade Marks Bulletin* No 55/1998.
- 5 On 27 October 1998 the applicant brought an opposition to registration of the trade mark applied for.
- 6 The opposition was based in particular on the SPA THERMES and SPA marks, which were the subject of the following registrations:
- Benelux registration No 555229 of 26 July 1994 of the trade mark SPA THERMES for the following goods and services:

- ‘bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices’, in Class 3;

 - ‘apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, including water distribution, treatment, purification and filtration systems’, in Class 11;

 - ‘services provided as part of a spa centre, including health-related services; baths, showers and massages’, in Class 42;

 - Benelux registration No 389230 of 21 February 1983 of the trade mark SPA for ‘mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages’, in Class 32.
- 7 The notice of opposition did not contain a representation of the latter mark. Moreover, the applicant referred to ‘the reputation of its trade marks for goods in Class 32 in Benelux’.
- 8 In support of its opposition, the applicant relied on Article 8(1)(b) of Regulation No 40/94 in respect of registration No 555229. In addition, it relied on an infringement of Article 8(5) of that regulation concerning registration No 389230.

- 9 On 4 October 2000 the Opposition Division requested the applicant to present facts, evidence and arguments in support of its opposition, while informing it that a thorough examination of the notice of opposition had disclosed that the opposition was inadmissible as regards Article 8(5) of Regulation No 40/94, since the sign which was the subject of the trade mark having a reputation was not indicated there and no certificate of registration had been annexed from which it could be identified.
- 10 On 1 December 2000 the applicant provided the Opposition Division with a copy of the registration relied on in support of the opposition based on Article 8(5) of Regulation No 40/94.
- 11 By decision of 31 July 2002, the Opposition Division rejected the opposition, on the ground that the claim based on Article 8(5) of Regulation No 40/94 was inadmissible. It relied on Article 42 of Regulation No 40/94 and Rule 18(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 (OJ 1995 L 303, p. 1, 'the implementing regulation'). The Opposition Division considered that the information available to OHIM at the expiry of the opposition period, which was 27 October 1998, did not enable the earlier trade mark with a reputation to be identified. Moreover, the Opposition Division considered that there was no likelihood of confusion between the mark applied for and the earlier mark SPA THERMES within the meaning of Article 8(1)(b) of Regulation No 40/94.
- 12 On 30 September 2002 the applicant appealed to OHIM against that decision under Articles 57 to 59 of Regulation No 40/94.
- 13 By decision of 25 February 2004 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed the applicant's appeal. The Board of Appeal considered that the ground of refusal based on Article 8(5) of Regulation No 40/94 did not have

to be examined, as it was inadmissible. In this respect, it pointed out that 'the sign which was the subject of the registration in question was not specified'. The Fourth Board of Appeal also found that there was no likelihood of confusion between the mark SPAFORM and the earlier mark SPA THERMES within the meaning of Article 8(1)(b) of Regulation No 40/94.

Forms of order sought by the parties

14 The applicant claims that the Court should:

- annul the contested decision;

- order OHIM to pay the costs.

15 OHIM contends that the Court should:

- allow the applicant's claim for annulment of the contested decision;

- order each party to bear its own costs.

16 The intervener contends that the Court should:

- confirm the contested decision;
- dismiss the action in its entirety;
- order the applicant to pay the costs.

17 At the hearing the intervener asked for OHIM to be ordered to pay the costs relating to the hearing, on the ground that it would not have appeared at the hearing if OHIM had sought for the application to be dismissed.

Law

Form of order sought by OHIM

18 OHIM contends that the Court should allow the applicant's claim for annulment of the contested decision. It refers to Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraphs 26 and 27. It says that the Court of Justice held in that case that OHIM was designated under Article 133(2) of the Rules of Procedure of the Court of First Instance as the defendant before the Court of First Instance and did not have the power to alter the terms of the dispute before the Court as delimited in the

respective claims and contentions of the applicant for registration and the opposing party. It states, however, that it is not obliged systematically to defend the contested decisions of the Boards of Appeal. It refers in this respect to Case T-107/02 *GE Betz v OHIM — Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 29 et seq.

- 19 The Court recalls that, in proceedings concerning an action brought against a decision of a Board of Appeal adjudicating in opposition proceedings, OHIM does not have power to alter, by the position it adopts before the Court, the terms of the dispute as delimited in the respective claims and contentions of the applicant for registration and of the opposing party (*Vedial v OHIM*, paragraph 26, upholding on appeal the judgment of the Court of First Instance in Case T-110/01 *Vedial v OHIM — France Distribution (HUBERT)* [2002] ECR II-5275).
- 20 However, it does not follow from those decisions that OHIM is obliged to claim that an action brought against a decision of one of its Boards of Appeal should be dismissed. While OHIM 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 (*BIOMATE*, paragraph 34).
- 21 Consequently, OHIM may, as in the present case, without altering the terms of the dispute, contend that the applicant's claim for annulment of the contested decision should be allowed.

Substance

- 22 In support of its application, the applicant relies on a single plea in law, based on an alleged breach of Rule 18(1) of the implementing regulation.

Arguments of the parties

- 23 The applicant submits that in the present case the deficiency found first by the Opposition Division and then by the Fourth Board of Appeal of OHIM concerned only the application of Rule 18(1) of the implementing regulation. The question which arose was therefore, in its view, whether or not the notice of opposition clearly identified the earlier mark having a reputation on which the opposition was based.
- 24 It concedes that the notice of opposition did not 'represent' the sign which was the subject of the registration of the earlier mark with a reputation on which the opposition was based. However, that registration was precisely indicated by the mention of Benelux as country of registration, with the registration number and date, and the indication of the goods designated.
- 25 The applicant points out that the notice of opposition sent by its representative to the Opposition Division of OHIM on 27 October 1998 contained, on page 5, in entries 69, 70 and 71 of the form, which relate to an 'earlier registered mark with a reputation', the following statements:

— 'Reputation: in a Member State';

- ‘Member State: Benelux (Registration No 389230 of 21 February 1983)’;

 - ‘The opposition is based on: Class 32: Mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages’.
- 26 Moreover, the other entries in the notice of opposition, in particular those relating to the ‘grounds of opposition’, stated on page 6 that ‘there [was] a likelihood of confusion, including a likelihood of association, between the Community trade mark SPAFORM and the SPA marks [registered for the applicant], on which the opposition is based’, while point 3 on page 6 of the notice of opposition stated that the applicant ‘enjoy[ed] a reputation for its trade marks for goods in Class 32 in Benelux’.
- 27 The applicant takes the view that Rule 18(1) of the implementing regulation does not require the mark on which the opposition is based to be ‘represented’. By requiring a ‘representation’ of the mark on which the opposition was based, even though that rule requires only that the mark is ‘clearly identified’, the Board of Appeal went beyond the conditions laid down by that provision.
- 28 The applicant considers that the requirements of Rule 18(1) of the implementing regulation were satisfied in the present case. In its view, the primary objective of Rule 18(1) is to enable the applicant for the Community trade mark, who is the defendant in the opposition proceedings, to exercise his rights of defence by allowing him to identify the rights relied on against him.

- 29 It submits that in the present case that objective was achieved. Since the trade mark with a reputation on which the opposition was based was identified clearly by means of the full references to its registration, the applicant for a Community trade mark, who was the defendant in the opposition proceedings, was able easily to understand and ascertain the basis on which the opposition was brought.
- 30 The applicant also submits that the requirements specified in the contested decision do not appear to be consistent with the previous practice of the Boards of Appeal of OHIM on the application of Rule 18(1) of the implementing regulation, in particular the decision of the Third Board of Appeal of 6 March 2002 (Case R 870/2001-3, *Bridgewater / Bridgewater*).
- 31 According to OHIM, the clear identification of the earlier right prescribed in Rule 18 (1) of the implementing regulation is an absolute condition of admissibility of the opposition. It is not possible to remedy a deficiency in the identification of the earlier mark, and the Opposition Division is not obliged to call on the opponent to do so. OHIM also refers to the guidelines for opposition proceedings adopted on 10 May 2004, Part I Chapter 1 A VI of which distinguishes between 'absolute' and 'relative' identification elements. If an absolute identification element is absent from a notice of opposition, the earlier mark cannot be identified, and therefore cannot serve as a basis for the opposition. The registration or application number of the earlier mark is regarded as an absolute identification element. As for relative identification elements, these are the representation of the mark, the type of mark, the goods and services and other indications such as the date of filing or registration. With respect to these elements, the opponent must have a period of two months in which to remedy any deficiencies.
- 32 OHIM considers that, in view of the interests involved, the position of the Fourth Board of Appeal was too strict in relation to the minimum requirements allowing identification of the earlier mark, which in this case was a word mark. OHIM thus

submits that the decision of the Board of Appeal was not justified with respect to Rule 18(1) of the implementing regulation. The Opposition Division and the Board of Appeal should, it submits, have taken the view that the indication of the registration number and the reference to the Member State concerned were enough to identify the earlier mark. It would consequently have sufficed for the Opposition Division to request additional information pursuant to Rule 18(2) of the implementing regulation.

33 According to OHIM, the Opposition Divisions and Boards of Appeal did not originally always take the same approach as regards the elements necessary to identify clearly the earlier right relied on in support of an opposition. It admits that some Boards of Appeal adopted a strict approach (decision of the Second Board of Appeal of 25 February 2002 (Case R 1184/2000-2, *P-51 Mustang / Ford Mustang*) and *Bridgewater / Bridgewater*). It points out, however, that those decisions concerned earlier rights which had not been registered, and that there are decisions of Boards of Appeal to the contrary (decision of the Second Board of Appeal of 19 December 2003 (Case R 704/2002-2, *Myo Max by CEFAR / cefar-centro de estudos de farmacoepidemiologia*). It notes, finally, that the guidelines for opposition proceedings follow the approach it argues for.

34 The intervener recalls the conditions relating to the content of the notice of opposition set out in Rule 15(2) of the implementing regulation, which states that '[t]he notice of opposition shall contain ... a representation and, where appropriate, a description of the earlier mark or earlier right'. In the intervener's view, Rule 15(2) of the implementing regulation thus expressly requires the notice of opposition to include a representation of the earlier mark, that is, more than just a description of it. Consequently, the applicant cannot criticise OHIM for introducing an additional condition of admissibility of the opposition, since that requirement is explicitly stated in the implementing regulation.

- 35 The intervener refers to the previous practice of OHIM, more particularly the decision of the First Board of Appeal of OHIM of 4 March 2002 (Case R 662/2001-1, *ORANGEX / Orange X-PRESS*, paragraph 21), according to which any notice of opposition 'should be sufficiently clear and precise so as not to give rise to any ... misunderstanding concerning its meaning and scope'. It also cites the decision of the Opposition Division of 6 July 2004 (Case 2218/2004, *Atlas Copco AB v The Black & Decker Corp.*), according to which '[t]he minimum requirements to consider a trade mark or other earlier right clearly identified are the representation of the mark or sign, an indication of the country where the mark is registered or filed or where the earlier right exists and the filing or registration number (in relation to a registered trade mark or an application for registration of a trade mark)'.
- 36 In addition, the intervener submits that, unlike Rule 18(2) of the implementing regulation, Rule 18(1) of that regulation does not require OHIM to call on the opponent to rectify the deficiencies referred to in that paragraph (decision of the First Board of Appeal of 9 January 2004 (Case R 129/2003-1 *Weekenders Worldwide Trade and Service Kft v Gregor Kohlruss*, paragraph 24).
- 37 It adds that those deficiencies can be remedied only before the expiry of the opposition period. OHIM is not thus required to take account of information presented after that deadline. It refers in this respect to Case T-232/00 *Chef Revival USA v OHIM — Massagué Marín (Chef)* [2002] ECR II-2749, paragraphs 34 and 36, according to which, '[i]f the notice of opposition does not comply with the conditions of admissibility referred to in Rule 18(1) of the implementing regulation, the opposition is to be rejected as inadmissible unless the deficiencies found are remedied before the expiry of the opposition period'.
- 38 According to the intervener, the applicant has oversimplified the Board of Appeal's reasoning. It points out that paragraphs 2, 3 and 13 of the contested decision show, first, that the applicant did not include a representation of the SPA THERMES mark

or a certificate of registration of that mark in the notice of opposition, second, that it provided information in respect of one only of the earlier marks, although the notice of opposition referred to several marks relating to goods in Class 32, and, third, that the deadline for opposition expired on 27 October 1998. The applicant did not provide the necessary information before that date, as prescribed by Rule 18(1) of the implementing regulation. The applicant did not produce a certificate of registration until 1 December 2000, and also omitted to provide a representation of the earlier mark concerned.

- 39 The intervener observes, moreover, that the applicant conceded before the Fourth Board of Appeal of OHIM that a clear identification of the earlier mark concerned is different from mere identification. It is unreasonable for the opponent to expect OHIM to search the register in the Member State concerned to identify that mark when that information is available to the opponent. Identification of the mark must enable the Board of Appeal of OHIM to adjudicate on the disputes before it. The function of OHIM is to determine, on the basis of a clear identification of the earlier right relied on in support of the opposition, whether an application for registration which is *prima facie* acceptable should be rejected. The notice of opposition should facilitate that task.
- 40 The intervener states that the aim pursued by Rule 18(1) of the implementing regulation is not only to provide information for the applicant for the mark against which the opposition is brought but also to inform OHIM of the factual circumstances relating to the opposition, and hence to enable it to adjudicate on the dispute. According to the intervener, the applicant did not fulfil that objective of Rule 18(1) of the implementing regulation.
- 41 Finally, the intervener recalls that the Opposition Division rejected the opposition as inadmissible because 'the file did not contain any clear indication as to the exact form of the unregistered trade mark'.

Findings of the Court

— Interpretation of Rule 18(1) of the implementing regulation

- 42 Under Rule 18(1) of the implementing regulation, '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, [OHIM] shall reject the notice of opposition as inadmissible unless those deficiencies have been remedied before expiry of the opposition period'.
- 43 It is common ground that in the present case the applicant omitted to represent in the notice of opposition the word mark SPA registered in Benelux under No 389 230, whose reputation it relies on in support of its opposition on the basis of Article 8(5) of Regulation No 40/94. It must therefore be determined whether the clear identification required by Rule 18(1) of the implementing regulation required a representation of that mark.
- 44 It should be observed, first, that the French-language version of Rule 18(1) of the implementing regulation refers to a clear indication ('l'acte d'opposition n'indique pas clairement') while the English-language version of that rule refers to a clear identification ('the notice of opposition does not clearly identify'). The need for a uniform interpretation of the language versions of a provision of Community law requires that, in the case of divergence between them, the provision must be interpreted by reference to the general scheme and purpose of the rules of which it forms part (Case C-449/93 *Rockfon* [1995] ECR I-4291, paragraph 28, and Case C-72/95 *Kraaijeveld and Others* [1996] ECR I-5403, paragraph 28). In the present case, the aim of Rule 18 of the implementing regulation is that the indication of the

earlier mark on which the opposition is based should be sufficiently clear for OHIM and the other party to the proceedings to be able to identify it. In the light of that objective, the terminological divergence between those two language versions does not give rise to any contradiction.

- 45 It must be noted, next, that under Rule 18(1) of the implementing regulation the Opposition Division has no obligation to call on the opponent to remedy the lack of a clear indication of an earlier mark.
- 46 Moreover, contrary to the intervener's submissions, in the absence of any express reference, it is not possible to infer from Rule 15(2)(b)(vi) of the implementing regulation an obligation to represent the earlier mark in the context of Rule 18(1) of that regulation.
- 47 Accordingly, Rule 18(1) of the implementing regulation must be interpreted as requiring a sufficiently clear indication of the earlier mark on which the opposition is based to enable it to be identified, before expiry of the opposition period.

— Clear indication of the SPA mark

- 48 The Court must therefore ascertain whether, in the present case, the notice of opposition contained enough sufficiently precise information to allow a clear identification of the SPA mark registered in Benelux under No 389230.

- 49 The Court considers that the indication of the registration number of the mark on which the opposition is based and of the Member State in which it is registered constitutes a clear identification for the purposes of Rule 18(1) of the implementing regulation.
- 50 In the present case, it is common ground that the notice of opposition included the following statements:
- ‘Reputation: in a Member State’;

 - ‘Member State: Benelux (Registration No 389 230 of 21 February 1983)’;

 - ‘The opposition is based on: Class 32: Mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages’.
- 51 Moreover, the Court observes that other sections of the notice of opposition, in particular those relating to the grounds of opposition, indicated that ‘there [was] a likelihood of confusion, including a likelihood of association, between the Community trade mark SPAFORM and the SPA marks ... on which the opposition is based’ and that ‘SPA Monopole ... enjoy[ed] a reputation for its trade marks for goods in Class 32 in Benelux’.
- 52 In the light of that evidence, the conclusion must be that the earlier mark concerned was clearly identified in the notice of opposition. That conclusion cannot be called into question by the arguments put forward by the intervener.

- 53 As regards, first, the argument concerning confusion between the marks on which the opposition was based, the Court points out that the case-file shows that the applicant did not rely, in the context of Article 8(5) of Regulation No 40/94, on the SPA THERMES mark registered in Benelux under No 555 229 but on the SPA mark registered in Benelux under No 389 230. Moreover, the reference to several marks in the notice of opposition does not lead to confusion, since, even if that document does indeed refer to several SPA marks, each of them bears a different registration number.
- 54 As regards, next, the argument that the applicant did not produce a certificate of registration of the SPA mark, it suffices to recall that Rule 18(1) of the implementing regulation does not require, for the purposes of a clear identification of the earlier mark, the production of a certificate of registration (see paragraph 49 above). That conclusion is confirmed by Rule 16(2) of the implementing regulation, which provides that '[i]f 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'. Non-compliance with that rule can be regularised, as in the present case, in accordance with Rule 16(3), within a period following commencement of the opposition proceedings.
- 55 As regards, moreover, the argument concerning the earlier practice of the Boards of Appeal, the Court points out that the decisions of OHIM are not binding on the Community judicature (see, to that effect, Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 32). In any event, the decisions mentioned by the intervener concerned marks which had not been the subject of earlier registration, so that a representation of them appeared essential to ensure that they were clearly identified. That is not so in the present case, since the earlier mark is a registered word mark whose registration number and Member State of registration are clearly indicated (see paragraph 49 above).

- 56 It follows from all the foregoing that the intervener's plea in law is well founded. The contested decision must therefore be annulled in so far as it declares inadmissible the opposition based on Article 8(5) of Regulation No 40/94 as regards the SPA mark registered in Benelux under No 389 230.

Costs

- 57 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. Since OHIM has been unsuccessful, in that the decision of the Board of Appeal has been annulled in part, it must be ordered to pay the applicant's costs, as applied for by the applicant. Since the intervener has been unsuccessful, it must bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby :

- 1. Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 25 February 2004 (Case R 827/2002-4) in part, in so far as it declares**

inadmissible the opposition based on Article 8(5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, as regards the SPA mark registered in Benelux under No 389230;

- 2. Dismisses the remainder of the application;**

- 3. Orders OHIM to bear its own costs and to pay those incurred by the applicant;**

- 4. Orders the intervener to bear its own costs.**

Pirrung

Forwood

Papasavvas

Delivered in open court in Luxembourg on 15 June 2005.

H. Jung

Registrar

J. Pirrung

President