

Joined Cases T-466/04 and T-467/04

Elisabetta Dami

v

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

(Community trade mark — Word mark GERONIMO STILTON — Opposition — Stay of proceedings — Restriction of the list of goods designated by the mark for which registration is sought — Withdrawal of the opposition)

Judgment of the Court of First Instance (Fourth Chamber), 1 February 2006 II - 186

Summary of the Judgment

1. *Community trade mark — Appeals procedure*
(*Rules of Procedure of the Court of First Instance, Art. 133(2)*)

2. *Community trade mark — Registration procedure — Withdrawal, restriction and amendment of the trade mark application*
(Council Regulation No 40/94, Art. 44(1); Commission Regulation No 2868/95, Art. 1, Rule 20(5))
3. *Community trade mark — Observations of third parties and opposition — Withdrawal of the opposition*
(Council Regulation No 40/94, Arts 42 and 43)

1. In proceedings concerning an action brought against a decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) 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 party who has lodged the opposition. However, OHIM is not obliged to contend 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. There is nothing to prevent OHIM 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 for giving guidance to the Court. On the other hand, it may not seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application or put

forward pleas in law not raised in the application.

(see paras 29-33)

2. Under Rule 20(5) of Commission Regulation (EC) No 2868/95 implementing Regulation No 40/94 on the Community trade mark if, pursuant to Article 44(1) of Regulation No 40/94, the applicant restricts the list of goods and services, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) is to communicate this to the opposing party and call upon him, within such period as it may specify, to submit to it observations stating whether he maintains the opposition and, if so, against which of the remaining goods and services. According to case-law, the power provided for in that provision to restrict the list of goods or services is vested solely in the applicant for the Community trade mark who may, at any time, apply to OHIM for that purpose.

In that context, the withdrawal, in whole or part, of an application for a Community trade mark must be made expressly and unconditionally.

(see paras 38, 39)

Although it is true that in the first sentence of Article 44(1) of Regulation No 40/94 the legislature has made express provision for withdrawal only of a trade mark application, the applicant for a Community trade mark and the opponent are however, according to the scheme of the regulation, placed on an equal footing in opposition proceedings with the result that that equality must extend to the possibility of withdrawing procedural documents.

3. In opposition proceedings brought against the registration of a Community trade mark pursuant to Article 42 et seq. of Regulation No 40/94 on the Community trade mark, the opposition may in principle be withdrawn at any time.

(see para. 40)