JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
13 June 2002 *

In Case T-232/00,

Chef Revival USA Inc., established in Lodi, New Jersey (United States), represented by N. Jenkins, Solicitor, with an address for service in Luxembourg,

applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) being

Joachín Massagué Marín, of Sabadell (Spain),

* Language of the case: English.

ACTION brought against the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 26 June 2000 (Case R 181/1999-3), as corrected by corrigendum of 6 July 2000,

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

composed of: M. Vilaras, President, V. Tiili and P. Mengozzi, Judges,

Registrar: J. Palacio González, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 4 September 2000,

having regard to the response of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) lodged at the Registry of the Court of First Instance on 2 February 2001,

further to the hearing on 10 January 2002,

gives the following

Judgment

Legal background

1 Article 42(1) and (3) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, provides as follows:

'1. Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8...

3. Opposition must be expressed in writing and must specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.'

2 Articles 73 and 74 of Regulation No 40/94 provide as follows:

'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.

Article 74

Examination of the facts by the Office of its own motion

1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.'

3 Rules 15 to 18, 20, 71 and 96 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 (OJ 1995 L 303, p. 1) (hereinafter 'the implementing regulation') state as follows:

'Rule 15

Contents of the notice of opposition

(1) ...

(2) The notice of opposition shall contain:

(a) as concerns the application against which opposition is entered...

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

(c) as concerns the opposing party...

(d) a specification of the grounds 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 Regulation [No 40/94], 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. If the opposition fee has not been paid within the opposition period, the notice of opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

(2) If the Office finds that the notice of opposition does not comply with other provisions of Regulation [No 40/94] 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

(1) ...

(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. Any submission by the opposing party shall be communicated to the applicant who shall be given an opportunity to reply within a period specified by the Office.

(3) If the applicant files no observations, the Office may give a ruling on the opposition on the basis of the evidence before it.

...

Rule 71

Duration of time limits

(1) Where [Regulation No 40/94] or these Rules provide for a period to be specified by the Office, such period shall... be not less than one month.... The Office may, when this is appropriate under the circumstances, grant an extension of a period specified if such extension is requested by the party concerned and the request is submitted before the original period expired.

...

Rule 96

Written proceedings

(1) ...

(2) Unless otherwise provided for in these Rules, documents to be used in proceedings before the Office may be filed in any official language of the Community. Where the language of such documents is not the language of the proceedings the Office may require that a translation be supplied, within a period specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office.'

Background to the dispute

4 On 1 April 1996, the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (hereinafter 'the Office').

5 The trade mark applied for is a figurative trade mark consisting of the word 'Chef' and various graphic elements.

6 The goods in respect of which registration of the trade mark was sought come within Classes 8, 21 and 25 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 are described, for each of those classes, as follows:

— Class 8: 'Cutlery; kitchen knives';

— Class 21: 'Household utensils and containers';

— Class 25: 'Clothing, boots, shoes and slippers; clothing for use by persons involved in the preparation, distribution and serving of food and beverages; coats, jackets, tunics, trousers, shorts, culottes, shirts,

T-shirts, vests, smocks, aprons, neckties, bow ties, neckerchiefs, hats, caps, cummerbunds, belts, clogs and shoes, all for use by persons involved in the preparation, distribution and serving of food and beverages'.

7 The application was submitted in English. French was designated as the second language in accordance with Article 115(3) of Regulation No 40/94.

8 On 1 September 1997, the application was published in the Community Trade Marks Bulletin.

9 On 27 October 1997 Joachín Massagué Marín (hereinafter 'the opponent') filed, in Spanish, a notice of opposition under Article 42 of Regulation No 40/94.

10 The opposition was based on a trade mark previously registered in Spain. It is a figurative trade mark consisting of the word 'Cheff' in script with additional figurative elements. The goods designated by that mark fall within class 25 of the Nice Agreement and are described as follows: 'manufactured clothing, not included in other classes'.

11 On 11 November 1997, the opponent provided an English translation of the notice of opposition. English thus then became the language of the opposition proceedings in accordance with Article 115(6) of Regulation No 40/94.

12 On 5 June 1998, pursuant to Rules 16(3), 17(2) and 20(2) of the implementing regulation, the Opposition Division of the Office (hereinafter 'the Opposition Division') sent to the opponent a letter which stated as follows:

'You are invited to submit all facts, evidence and arguments, not yet provided, which you consider necessary for the support of your opposition.

In particular, you are requested to provide a copy of [the] registration certificate for the mark No 1081534 on which the opposition is based.

...

All the information requested above is to be presented in the language of the opposition proceedings within two months of receipt of this notification, that is on or before 5 August 1998.

In the absence of such information or, where relevant, the requested translations, the Office shall give a ruling on the opposition on the basis of the evidence before it.'

13 On 18 June 1998 the opponent sent to the Office a copy, in Spanish, of the registration certificate for the prior trade mark on which the opposition was based.

14 On 8 September 1998, that is to say after the expiry of the period allowed by the Opposition Division, the opponent sent a letter to the Office, the penultimate sentence of which stated as follows:

'... the opposed trade marks designate identical products and are found in the same class of the International Nomenclature of Trade marks, class 25.'

15 By decision of 24 February 1999 the Opposition Division rejected the opposition under Article 43 of Regulation No 40/94 on the ground that the opponent had not proved the existence of the earlier national trade mark on which the opposition was based.

16 On 14 April 1999 the opponent lodged an appeal at the Office under Article 59 of Regulation No 40/94 against the Opposition Division's decision.

17 By decision of 26 June 2000 (hereinafter 'the contested decision'), notified to the applicant on 4 July 2000, the Third Board of Appeal annulled the Opposition Division's decision. By corrigendum of 6 July 2000 the Board of Appeal rectified, of its own motion and pursuant to Rule 53 of the implementing regulation, a manifest error in the contested decision concerning the description of the trade marks of the applicant and of the opponent.

18 In essence the Board of Appeal considered that, by rejecting the opposition without having allowed the opponent a further two months in which to provide a translation of the Spanish registration certificate in the language of the opposition

proceedings for the earlier trade mark, the Opposition Division had infringed Rule 18(2) of the implementing regulation. The Board of Appeal also considered that the Opposition Division had thus infringed the opponent's right to be heard in accordance with Rule 18.

Forms of order sought

19 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to reject the opposition lodged by the opponent;

— order the Office to pay the costs.

20 The Office contends that the Court should:

— adopt whatever order that appears appropriate under the circumstances at the end of the oral proceedings;

— award costs in consideration of the outcome of the action.

21 At the hearing the applicant withdrew the second head of the form of order sought, namely that the Court should order the Office to reject the opposition lodged by the opponent, and the Court formally noted the withdrawal in the minutes of the hearing.

Law

22 The applicant submits a single plea in law, alleging infringement of Rule 18(2) of the implementing regulation.

Arguments of the parties

23 The applicant submits that Rule 18 of the implementing regulation is applicable only where the notice of opposition does not fulfil the requirements laid down in Article 42 of Regulation No 40/94 and Rule 15 of the implementing regulation. Amongst those requirements, Rule 18 draws a distinction between requirements which, if not complied with, automatically result in the rejection of the notice of opposition as inadmissible unless the deficiencies in question have been remedied before the expiry of the opposition period (paragraph 1) and requirements which, if not complied with, may be made good within a two-month period from the date of a request to that effect from the Office (paragraph 2). However, Rule 18(2) of the implementing regulation does not apply to cases where facts, evidence, arguments or supporting documents have not been produced within the period specified by the Office pursuant to Rules 16(3), 17(2) and 20(2) of that regulation.

24 On the basis of that reasoning, the applicant submits that the Board of Appeal erred in law by annulling the Opposition Division's decision on the ground that it had infringed Rule 18(2) of the implementing regulation by rejecting the opposition without allowing the opponent a further period of two months, in accordance with the same rule, within which to submit the translation of the registration certificate in the language of the opposition proceedings.

25 The Office contends that the Opposition Division acted correctly in rejecting the opposition on the ground that the opponent had failed to provide evidence of the earlier right in the language of the opposition proceedings within the period specified by the Office in accordance with Rule 17(2) of the implementing regulation. On the other hand, the Board of Appeal erred in law in finding that the Office has an obligation, under Rule 18(2) of the implementing regulation, to invite an opponent who has not submitted the required evidence within the time-limit laid down pursuant to Rule 17(2) of that regulation to provide or supplement the required evidence and to allow him an additional period of two months for that purpose.

26 In that context, the Office points out the importance in opposition proceedings of strict compliance with the time-limits which it sets. The logical consequence of non-compliance with such a time-limit has to be that evidence or arguments submitted late will be disregarded for the purposes of the further course of the opposition proceedings. That is the corollary of the failure to comply with the time-limit. In that regard, the Office submits that in opposition proceedings Article 74(2) of Regulation No 40/94, according to which the Office may disregard facts or evidence which are not submitted in due time by the parties concerned, can be applied only where the Office has not set a time-limit, it not being open to the Office to take account of them where this is not the case.

27 Nor, according to the Office, can an obligation on its part to call upon an opponent to provide or supplement the required evidence within an additional

period be derived from an application by analogy of Rule 18(2) of the implementing regulation. According to the Office, an application by analogy of that rule, which concerns examination of the admissibility of the opposition, is so far outside the meaning and purpose of that rule that it is clearly not possible.

28 Likewise, according to the Office, Rule 20 of the implementing regulation does not provide a basis, either directly or indirectly, for obliging or permitting the Opposition Division to invite an opponent who has failed to submit the required evidence pursuant to Rules 16(3) and 20(2) of the implementing regulation to submit it within a further time-limit set by the Opposition Division.

29 Moreover, the Office contends that the Opposition Division did not infringe Article 73 of Regulation No 40/94, according to which decisions of the Office may be based only on reasons on which the parties have had an opportunity to present their comments. On the contrary, by calling upon the opponent to submit evidence in the language of the opposition proceedings within a specific time-limit, the Opposition Division did everything to provide the opponent with an opportunity to submit evidence.

30 Nor, finally, the Office submits, did the Opposition Division, by communicating with the parties in the course of the proceedings and especially by sending each party's observations to the other party, cause the opponent to entertain the expectation that the missing translation of the registration certificate would not become relevant.

Findings of the Court

31 It must be observed at the outset that it follows from Article 42 of Regulation No 40/94, read in conjunction with Rules 16, 17, 18 and 20 of the implementing

regulation, that the legislature makes a distinction between, on one hand, the conditions which the notice of opposition must satisfy, which are laid down as conditions of admissibility of the opposition, and, on the other hand, the submission of the facts, evidence and arguments and of the documents supporting the opposition, which are matters falling within the scope of the examination of the opposition.

32 Amongst the conditions of admissibility of the opposition set out in Article 42 of Regulation No 40/94 and in Rule 18 of the implementing regulation are, in particular, the period of three months within which notice of the opposition must be given, the opponent's interest in initiating the opposition proceedings, and the formal and procedural conditions, the statement of grounds and the minimum information which the notice of opposition must contain.

33 Next, as regards the conditions which, if not complied with in the notice of opposition, lead to rejection of the opposition as inadmissible, Rule 18 of the implementing regulation draws a distinction between two types of conditions of admissibility.

34 If 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. That period may not be extended.

35 On the other hand, if the notice of opposition does not comply with the conditions of admissibility referred to in Rule 18(2) of the implementing regulation, the opposition is to be rejected as inadmissible only if the opponent, after having been called upon by the Office to remedy the deficiencies noted within a period of two months, has not remedied those deficiencies within that period. That period is mandatory and may not be extended.

36 Accordingly, it is only in cases in which the notice of opposition does not comply with one or more conditions of admissibility of the opposition other than those expressly referred to in Rule 18(1) of the implementing regulation that the Office is required, by virtue of Rule 18(2), to inform the opponent of this and call upon him to remedy the deficiency within a period of two months before it rejects the opposition as inadmissible.

37 However, as has already been observed (paragraph 31 above), the legal requirements concerning the presentation of the facts, evidence and arguments and of the supporting documents are not conditions of admissibility of the opposition but conditions relating to the examination of its substance.

38 Under Article 42(3) of Regulation No 40/94, the opponent is not required to submit, at the same time as the notice of opposition, the facts, evidence and arguments supporting the opposition but may submit them within a period to be fixed by the Office for that purpose. Similarly, according to Rule 16(1) of the implementing regulation, the notice of opposition 'may' contain particulars of the facts, evidence and arguments presented in support of the opposition, accompanied by supporting documents.

39 Next, Rule 16(3) of the implementing regulation, which lays down the detailed rules for the application of Article 42(3) of Regulation No 40/94, states that the particulars of the facts, evidence and arguments and other supporting documents as referred to in Rule 16(1), and the evidence referred to in Rule 16(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).

40 That interpretation is not invalidated by Rule 16(2) of the implementing regulation, which states 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...'. That rule does not affect the option given to the opponent by Rule 16(1) and (3) and Article 42(3) of Regulation No 40/94 to present the evidence in question either at the same time as the notice of opposition or subsequently within a period laid down for that purpose by the Office. Rule 16(2) of the implementing regulation cannot therefore be interpreted as meaning that it requires the evidence to be presented at the same time as the lodging of the notice of opposition or that concurrent presentation of the evidence is a condition of admissibility of the opposition.

41 Moreover, it must be pointed out that where the evidence and documents in support of the opposition are not filed in the language of the opposition proceedings, the opponent must, pursuant to Rule 17(2) of the implementing regulation, 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).

42 Rule 17(2) of the implementing regulation thus derogates from the language regime generally applicable to the presentation and use of documents in proceedings before the Office, as laid down in Rule 96(2) of that regulation, according to which, where those documents are not in the language of the proceedings, the Office may require a translation to be produced in that language or, at the option of the party to the proceedings, in one of the languages of the Office within the period laid down by it. Rule 17(2) therefore places on the party

originating *inter partes* proceedings a heavier burden than that placed, as a general rule, on parties in proceedings before the Office. That difference is justified by the necessity to observe fully the principle of the right to be heard and to ensure equality of arms between the parties in *inter partes* proceedings.

43 Furthermore, unlike the periods laid down in Rule 18 of the implementing regulation and, in particular, the two-month period specified by the Office under Rule 18(2), the periods laid down by the Office under Rules 16(3), 17(2) and 20(2) of the implementing regulation may be extended by the Office subject to the conditions and rules laid down in Rule 71(1), *in fine*, of that regulation.

44 If the opponent does not present the evidence and documents in support of the opposition and a translation of them into the language of the opposition proceedings before the expiry of the period initially laid down for that purpose by the Office or before the expiry of any extension of that period under Rule 71(1) of the implementing regulation, the Office may lawfully reject the opposition as unfounded unless, in accordance with Rule 20(3) of the implementing regulation, it can give a ruling on it on the basis of the evidence which it may already have before it. The rejection of the opposition in such a case is not merely the result of the opponent's failure to comply with the period laid down by the Office but is also the consequence of his failure to comply with a substantive condition of opposition, since the opponent, by failing to present, within the period laid down, the relevant evidence and supporting documents — which must also be presented for the reasons set out in paragraph 42 above — fails to prove the existence of the facts or the rights on which his opposition is based.

45 Moreover, the same result follows from Article 74(1), *in fine*, of Regulation No 40/94, which provides that, in proceedings relating to relative grounds for refusal of registration, examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought. Although the French version of that provision does not expressly refer to the presentation of evidence

by the parties, it nevertheless follows from it that it is also for the parties to provide the evidence in support of the relief sought. That interpretation is confirmed by an analysis of other language versions of the same provision and, in particular, the English version, which refers to 'the facts, evidence and arguments provided by the parties', the German version, which refers to 'das Vorbringen... der Beteiligten', and the Italian version, which refers to '[ai] fatti, prove ed argomenti addotti... dalle parti'.

46 It is in the light of the above considerations that it is necessary to examine whether, in the present case, the single plea raised by the applicant is well founded and the contested decision lawful.

47 According to the file, by letter of 5 June 1998 the Opposition Division requested the opponent, in accordance with Rules 16(3), 17(2) and 20(2) of the implementing regulation, to provide within a period of two months and in the language of the opposition proceedings, that is to say in English, the facts, evidence and arguments not yet produced in support of his opposition. The application by that letter of both Rule 20(2) and Rule 17(2) of the implementing regulation is not contrary to any of the provisions of the implementing regulation and appears to be in accordance with the principles of procedural economy and good administration. Amongst the evidence and supporting documents requested were, in particular, the registration certificate for the opponent's earlier Spanish trade mark, on which he based his opposition, that certificate being, for the purposes of Rule 16(2) of the implementing regulation, a preferred mode of proof of the registration of the earlier trade mark.

48 It is undisputed that in reply to that letter the opponent produced, on 18 June 1998, only the Spanish version of the registration certificate. He did not produce, within the period fixed, a translation of the certificate into the language of the opposition proceedings, nor did he request an extension of that period under Rule 71(1) of the implementing regulation.

49 In those circumstances, by decision of 24 February 1999 the Opposition Division rejected the opposition as unfounded on the ground that the opponent had not proved, by evidence and relevant supporting documents, the existence of the earlier national trade mark on which his opposition was based.

50 Nevertheless, the Third Board of Appeal annulled the decision of the Opposition Division, finding, in paragraphs 20 to 22 of the contested decision, that the Opposition Division was required under Rule 18(2) of the implementing regulation to grant the opponent an additional period of two months within which to submit the abovementioned certificate of registration in the language of the opposition proceedings, and that, in failing, before it rejected the opposition, to inform the opponent of the deficiency and requesting him to remedy it within that period, the Opposition Division had infringed his right to be heard.

51 Those findings of the Board of Appeal are vitiated by an error of law and cannot be upheld.

52 First, as has already been stated, the legal requirements concerning, in particular, the evidence, the supporting documents and their translation into the language of the opposition proceedings are not conditions of admissibility of the opposition falling within the scope of Rule 18(2) of the implementing regulation but substantive conditions of the opposition.

53 Consequently, contrary to the view of the Board of Appeal, the Opposition Division was not under any obligation in this case, by virtue of Rule 18(2) of the implementing regulation, to point out to the opponent the deficiency constituted by his failure to produce, within the period laid down for that purpose, the

translation of the registration certificate for the earlier Spanish mark into the language of the opposition proceedings or to grant him an additional period of two months within which to produce that translation.

54 Nor, as the Office rightly points out in its response, can Rule 18(2) of the implementing regulation be applied by analogy in this case. Such an approach would be contrary to the fundamental distinction drawn by the legislature between, on the one hand, the conditions which the notice of opposition must satisfy in order to be admissible and, on the other hand, the conditions concerning the production of the facts, evidence and arguments and of the documents in support of the opposition, which fall within the scope of the examination of that opposition.

55 Second, contrary to the conclusion reached by the Third Board of Appeal in the contested decision, the Opposition Division did not infringe the opponent's right to be heard, held to exist under Rule 18(2) of the implementing regulation, by failing to inform him of the deficiency found and by not calling on him to remedy that deficiency within the additional period of two months provided for by that rule. Nor did the Opposition Division infringe Article 73, second sentence, of Regulation No 40/94, which provides that the decisions of the Office can be based only on reasons on which the parties have had an opportunity to present their comments.

56 In that regard, it must be observed that, in its letter of 5 June 1998 calling upon the opponent to produce the necessary evidence and supporting documents, the Opposition Division clearly and unequivocally indicated that the evidence and supporting documents had to be produced within the period of two months and in the language of the opposition proceedings. Accordingly, it was open to the opponent to comply with that request and to present his comments on the reason on which the Opposition Division's decision was based. Consequently, as the

Office has rightly stated in its response, the opponent could not have been caught unawares by that decision.

57 The failure by the opponent to produce within the time allowed by the Opposition Division, in accordance with Rules 16(3), 17(2) and 20(2) of the implementing regulation and in the language of the opposition proceedings, the translation of the registration certificate for the earlier national trade mark falls within the scope of the substantive examination of the opposition and does not therefore constitute a deficiency in the notice of opposition within the meaning of Rule 18(2) of the implementing regulation.

58 Having regard to the foregoing, the Board of Appeal erred in law in holding that the Opposition Division was required to apply Rule 18(2) of the implementing regulation before rejecting the opposition. The applicant's single plea alleging infringement of that rule must therefore be upheld and the contested decision annulled.

59 The Court considers, moreover, that there is nothing in the file to show that the decision of the Opposition Division was vitiated by any other defects which would justify its annulment by the Board of Appeal.

60 First, it cannot be argued, as the opponent did in the proceedings before the Board of Appeal (see point 13 of the contested decision), that in the present case he was not required to produce a translation, into the language of the opposition proceedings, of the registration certificate for the earlier Spanish trade mark on which the opposition was based. According to the opponent, the number of that trade mark, its holder, the date of application and its object were intelligible

without the need for a translation of the certificate. He also contended that the certificate mentions the class of the nomenclature, which was also evident without translation.

61 It must be pointed out in that regard that a translation, into the language of the opposition proceedings, of the evidence and supporting documents presented in support of the opposition is required of an opponent by virtue of Rule 17(2) of the implementing regulation, which introduces a derogation from the language regime generally applicable to the submission and use of documents in proceedings before the Office.

62 Second, that finding with regard to the need to produce, within the time-limit set by the Opposition Division, a translation of the registration certificate into the language of the opposition proceedings cannot be altered by the fact that in the last sentence of its letter of 5 June 1998 the Opposition Division indicated that in the event of a failure to produce the information and translations requested the Office would give a ruling on the opposition on the basis of the evidence before it. It cannot be argued that by that sentence the Opposition Division caused the opponent to entertain an expectation that, in the absence of a translation of the registration certificate for the earlier Spanish mark into the language of the opposition proceedings, it would give a ruling on the basis solely of the Spanish version of the certificate. On the contrary, that sentence must be interpreted as meaning that in such a case the Opposition Division intended to give a ruling on the opposition without taking the Spanish version of the document in question into account as evidence.

63 Nor, finally, did the opponent produce a translation of the registration certificate into the language of the opposition proceedings after the expiry of the period granted to him by the Opposition Division's letter of 5 June 1998.

64 It is clear from the fourth indent of point 13 of the contested decision that the opponent claimed before the Board of Appeal that he had indicated in his letter of 8 September 1998 (paragraph 14 above) both the class of the nomenclature and, in English, the list of products designated by the earlier national trade mark. It must be observed, however, that in that letter the opponent exclusively referred to the fact that the two trade marks designated identical products and fell within class 25. Such a reference does not constitute, nor can it be treated as equivalent to, a translation of the registration certificate for the earlier Spanish trade mark for the purposes of the relevant provisions of the implementing regulation.

65 In those circumstances, it is not necessary to rule in these proceedings on the question raised by the Office (paragraph 26 above) as to the scope of application *ratione materiae* of Article 74(2) of Regulation No 40/94 and, in particular, the question whether and to what extent facts or evidence produced after the expiry of a time-limit set by the Office may or may not be taken into account by it under that article.

Costs

66 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 the Office has been unsuccessful, it must be ordered to pay the applicant's costs in accordance with the form of order sought by the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Annuls the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 26 June 2000 (Case R 181/1999-3), as rectified by corrigendum of 6 July 2000;**

2. **Orders the Office to pay the costs.**

Vilaras Tiili Mengozzi

Delivered in open court in Luxembourg on 13 June 2002.

H. Jung

Registrar

M. Vilaras

President