

ORDER OF THE COURT OF FIRST INSTANCE (First Chamber)  
18 November 2003 \*

In Case T-383/02,

**G.D. Searle LLC**, established in Skokie, Illinois (United States), represented by  
W.A. Hoyng, lawyer,

applicant,

v

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

defendant,

the intervener before the Court of First Instance being

**Phyto-Esp SL**, established in Saragossa (Spain), represented by S.H. Poelmann-  
Teijgeler, lawyer,

\* Language of the case: English.

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 1 October 2002 (Case R 627/2001-1) relating to proceedings between G.D. Searle LLC and Phyto-Esp SL for a declaration of invalidity,

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

composed of: B. Vesterdorf, President, P. Mengozzi and M.E. Martins Ribeiro,  
Judges,

Registrar: H. Jung,

makes the following

**Order**

- 1 On 14 May 1998 the applicant filed an application for a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to 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 whose registration was sought is the word mark CELEBREX.
  
- 3 The goods and services in respect of which registration was sought fall within Class 5 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.
  
- 4 The mark applied for was registered as a Community trade mark on 28 February 2000 and published in *Community Trade Marks Bulletin* No 34/2000 of 2 May 2000.
  
- 5 On 29 August 2000, Phyto-Esp SL ('the intervener') filed an application with OHIM to have the Community trade mark CELEBREX declared invalid in respect of all the products designated by it. The application for a declaration of invalidity was based on Article 52(1)(a) of Regulation No 40/94 and on the alleged existence of a likelihood of confusion, within the meaning of Article 8(1)(b) of the regulation, between that mark and the earlier word mark CEREBRESP, which was registered in Spain on 21 December 1998 in respect of products in Class 5 of the Nice Agreement.
  
- 6 On 27 April 2001, after finding that there was a likelihood of confusion, including the likelihood of association, on the part of the relevant public between the Community trade mark and the earlier mark, the Cancellation Division of OHIM granted in full the application for a declaration of invalidity.
  
- 7 On 22 June 2001, the applicant brought an appeal against the decision of the Cancellation Division.

- 8 By decision of 1 October 2002 ('the contested decision'), the Board of Appeal dismissed that appeal.
- 9 By application lodged at the Registry of the Court of First Instance on 13 December 2002, the applicant brought the present action.
- 10 By order of 8 April 2003 of the President of the Fourth Chamber of the Court of First Instance, at the request of the applicant and with the consent of the other parties, the present proceedings were stayed until 8 July 2003.
- 11 On 10 April 2003, the applicant and the intervener each informed the Court that they had concluded an agreement for the transfer of the earlier trade mark CEREBRESP and that the intervener would withdraw its action for a declaration of invalidity in respect of the Community trade mark CELEBREX. They also pointed out that since, following their agreement, the applicant now owned both the trade marks in question, there could no longer be any likelihood of confusion as to the commercial origin of the products designated by those trade marks. The intervener added that it concurred with the submissions contained in the application and that it thus no longer invoked any of the arguments which it had raised before the Cancellation Division and the Board of Appeal.
- 12 The applicant and the intervener therefore requested the Court to set aside the contested decision and to declare that the application for a declaration of invalidity has been withdrawn and/or to take any other measure necessary to maintain the validity of the registration of the Community trade mark CELEBREX.

- 13 On 8 July 2003 OHIM informed the Court that by document of 1 July 2003 the intervener had validly withdrawn the application for a declaration of invalidity in respect of the Community trade mark CELEBEX. In addition, it points out that as a result of the transfer of the earlier mark to the applicant, the two marks now indicate the same commercial origin. It concludes that the present action has become devoid of purpose.
- 14 In the light of the foregoing, it is apparent that, following the agreement reached between the applicant and the intervener, the intervener withdrew its application for a declaration of invalidity before the decision of the Cancellation Division declaring the Community trade mark CELEBEX invalid could take effect and become final in accordance with the combined provisions of Article 56(6), 57(1) and 62(3) of Regulation No 40/94. In those circumstances, that decision, which was found to be valid by the contested decision, has become inoperative. Pursuant to Article 113 of the Rules of the Procedure of the Court of First Instance, it must be held that the present action has become devoid of purpose. It follows that there is no longer any need to adjudicate.

### Costs

- 15 Article 87(6) of the Rules of Procedure provides that where a case does not proceed to judgment the costs are in the discretion of the Court.
- 16 In the present case, the decision not to proceed to judgment is the result of an amicable settlement between the applicant and the intervener rather than an agreement between the applicant and the defendant. Accordingly, the applicant and the intervener must be ordered to bear their own costs and the applicant is to pay the costs incurred by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (First Chamber),

hereby orders:

1. There is no need to adjudicate.
2. The applicant shall pay its own costs and those incurred by OHIM.
3. The intervener shall pay its own costs.

Luxembourg, 18 November 2003.

H. Jung

Registrar

B. Vesterdorf

President