JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

9 September 2010 *

In Case T-70/08,

Axis AB, established in Lund (Sweden), represented by J. Norderyd, lawyer,

applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM being

* Language of the case: English.

Etra Investigación y Desarrollo, SA, established in Valencia (Spain),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 27 November 2007 (Case R 334/2007-2) relating to opposition proceedings between Etra Investigación y Desarrollo, SA and Axis AB,

THE GENERAL COURT (Fifth Chamber),

composed of M. Vilaras, President, M. Prek and V.M. Ciucă (Rapporteur), Judges,

Registrar: N. Rosner, Administrator,

having regard to the application lodged at the Court Registry on 12 February 2008,

having regard to the response lodged at the Court Registry on 9 June 2008,

further to the hearing on 29 April 2010,

gives the following

Judgment

Background to the dispute

1 On 17 June 2004, the applicant — Axis AB ('Axis') — filed an application for registration of a Community trade mark at 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 ('Regulation No 40/94'; replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p.1)).

2 The mark for which registration was sought is the word mark ETRAX.

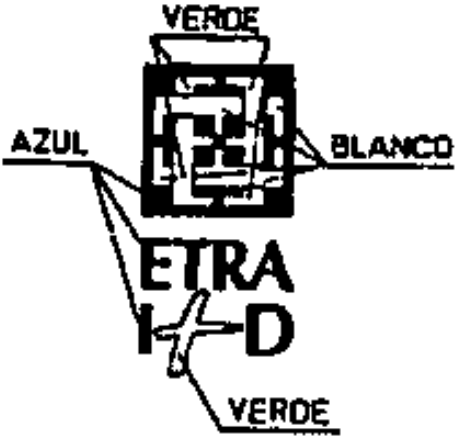
3 The goods and services in respect of which registration was sought fall, following the restriction made during the proceedings before OHIM, within Classes 9 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 31/2005 of 1 August 2005.

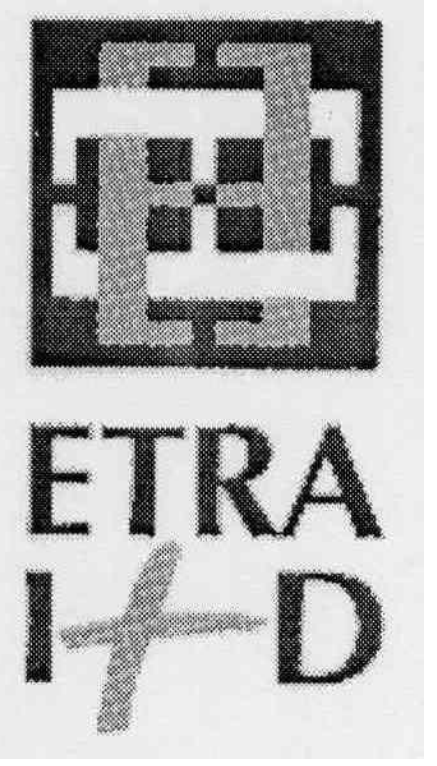
5 On 14 October 2005, Etra Investigación y Desarrollo, SA filed a notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) to registration of the trade mark applied for in respect of the goods and services referred to in paragraph 3 above.

6 The opposition was based on the following earlier marks:

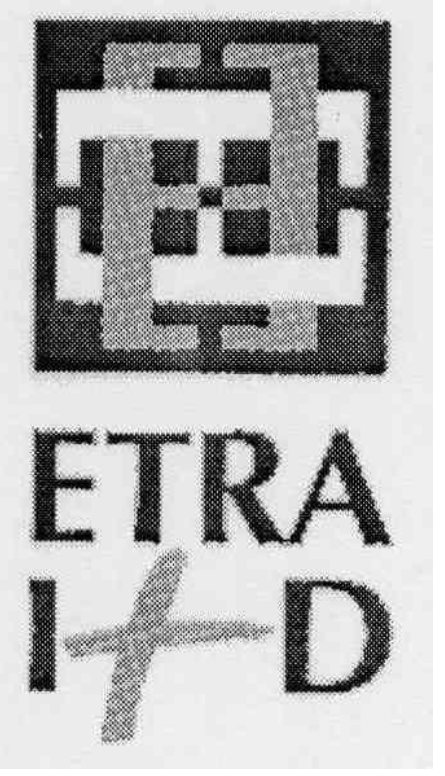
— Spanish figurative mark No 2 194 122, filed on 5 November 1998 and registered on 22 November 1999 in respect of goods in Class 9 ('Scientific, nautical, surveying, electrical, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus'), represented as follows:



— Spanish figurative mark No 2 413 572, filed on 9 July 2001 and registered on 8 January 2002 in respect of goods in Class 9 ('Scientific, nautical, surveying, electrical, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus'), represented as follows:



— Spanish figurative mark No 2 413 574, filed on 9 July 2001 and registered on 22 April 2002 in respect of services in Class 42 ('Engineering services; industrial, electrical and electronic analysis and research services'), represented as follows:



7 The ground relied on in support of the opposition was the likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).

8 On 11 December 2006, the Opposition Division rejected the opposition in its entirety, holding that the differences between the signs were such as to preclude a likelihood of confusion between the earlier marks and the mark applied for.

9 An undated notice of appeal, filed against the Opposition Division's decision, was received by OHIM on 21 February 2007.

10 By decision of 27 November 2007 ('the contested decision'), the Second Board of Appeal of OHIM upheld the appeal, annulling the Opposition Division's decision and refusing the application for registration in its entirety.

11 In particular, the Board of Appeal first of all examined the issue of admissibility and held that, although the undated notice of appeal had been received by OHIM on 21 February 2007, that is to say, after the time allowed for filing an appeal had expired on 12 February 2007, the payment of the appeal fee by bank transfer '[had] fulfilled the role of the Appeal Notice for admissibility purposes', since it had been made in time and contained the details required under Rule 48(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1).

Forms of order sought

12 Axis claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

13 OHIM contends that the Court should:

— dismiss the action;

— order Axis to pay the costs.

14 At the hearing, following a question put by the Court, OHIM stated that it was requesting the Court either to dismiss the action on its merits or to vary the contested decision on the basis of the fax transmission report sent by the other party to the proceedings before the Board of Appeal.

Law

15 In support of its action, Axis relies, in essence, on two pleas in law, alleging (i) infringement of Rule 49(1) and (2) of Regulation No 2868/95 and (ii) infringement of Article 8(1)(b) of Regulation No 40/94.

16 The first plea in law, alleging infringement of Rule 49(1) and (2) of Regulation No 2868/95, should be examined first.

Arguments of the parties

17 Axis submits that the Board of Appeal infringed Rule 49(1) and (2) of Regulation No 2868/95. In particular, it submits that the Board of Appeal erred in finding that the appeal was admissible in accordance with Rule 49(1) of Regulation No 2868/95, when the bank transfer note in settlement of the appeal fee was in Spanish, contrary to Rule 48(2) of Regulation No 2868/95, which provides that the notice of appeal must be filed in the language of the proceedings in which the decision under appeal was taken, which in the present case was English.

18 OHIM acknowledges that the Board of Appeal infringed Rule 49(1) and (2) of Regulation No 2868/95. However, it maintains that, in accordance with a principle of European Union law, the error made by the Board of Appeal is not sufficient to warrant annulment of the contested decision, because that 'procedural irregularity' could not have had a 'decisive effect' on the admissibility of the appeal before the Board of Appeal.

19 OHIM contends that the appeal before the Board of Appeal was admissible on the ground that, on 21 February 2007, the opponent had submitted a fax transmission report showing that a notice of appeal satisfying all the requirements under Rule 48 of Regulation No 2868/95 had been sent on 8 February 2007. Although OHIM could not trace having received that fax, case-law exists (Joined Cases T-380/02 and T-128/03 *Success-Marketing* v *OHIM - Chipita (PAN & CO)* [2005] ECR II-1233) to the effect that the date of receipt of a document may be established by a fax transmission report.

Findings of the Court

20 It is appropriate, first of all, to consider the plea in law alleging infringement of Rule 49(1) of Regulation No 2868/95.

21 Under Rule 49(1) of Regulation No 2868/95, if the appeal does not comply, inter alia, with the conditions laid down in Article 59 of Regulation No 40/94 (now Article 60 of Regulation No 207/2009), the Board of Appeal is to reject it as inadmissible, unless those deficiencies have been remedied before the period laid down in that provision has expired, that is to say, within two months of the date of notification of the contested decision.

22 Under Article 59 of Regulation No 40/94, notice of appeal must be filed in writing at OHIM within two months of the date of notification of the decision under appeal, and is to be deemed to have been filed only when the fee for appeal has been paid.

23 In that connection, it is clear from the case-law of the General Court that, while Article 59 of Regulation No 40/94 provides that the appeal is deemed to be filed only when the fee for appeal has been paid, the mere payment of the corresponding amount cannot be considered to be equivalent to the notice required under that provision (Case T-373/03 *Solo Italia* v *OHIM - Nuova Sala (PARMITALIA)* [2005] ECR II-1881, paragraph 58).

24 In the present case, the Board of Appeal held that, although the undated notice of appeal had been received by OHIM on 21 February 2007, that is to say, after the time allowed for filing an appeal had expired on 12 February 2007, the payment of the

appeal fee by bank transfer '[had] fulfilled the role of the Appeal Notice for admissibility purposes', since it had been made in time and contained the details required under Rule 48(1) of Regulation No 2868/95.

25 Thus, the Board of Appeal failed to have regard to the condition concerning the existence of a notice of appeal within the meaning of Article 59 of Regulation No 40/94, as interpreted by the above case-law, and therefore failed to have regard to Rule 49(1) of Regulation No 2868/95.

26 As regards OHIM's contention that that error on the part of the Board of Appeal must be regarded as an irregularity which does not entail annulment of the contested decision, because, even without that irregularity, the contents of the decision would not have been different, it must be observed that, in its response, OHIM contended only that the action brought by Axis should be dismissed. It was not until the hearing that OHIM stated that it was requesting the Court either to dismiss the action or to vary the contested decision on the basis of the fax transmission report sent by the other party to the proceedings before the Board of Appeal.

27 If that statement falls to be construed as the submission — made for the first time at the hearing — of a head of claim seeking variation of the decision, that head of claim must be dismissed as inadmissible, regardless even of whether it may be out of time. Although Article 134(3) of the Rules of Procedure of the General Court provides that '[a]n intervener … may, in his response …, seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application', it follows from that provision — by dint of *a contrario* reasoning — that OHIM is not entitled,

for its part, to seek such a form of order (Case C-106/03 P *Vedial* v *OHIM* [2004] ECR I-9573, paragraph 34).

28 Additionally, in so far as, by such an argument, OHIM is calling on the Court to dismiss the action and thus to uphold the contested decision, while substituting other grounds for the reasons stated, that argument cannot succeed.

29 It should be borne in mind that the General Court reviews the legality of the decisions of OHIM bodies. If it holds that such a decision, called into question in an action brought before it, is vitiated by illegality, it must annul it. It may not dismiss the action while substituting its own reasoning for that of the competent OHIM body which is the author of the contested act (Case T-402/07 *Kaul* v *OHIM - Bayer (ARCOL)* [2009] ECR II-737, paragraph 49).

30 In the present case, it has already been noted that the Board of Appeal's finding that the action brought before it was admissible was based exclusively on the bank transfer note, which it assimilated to a notice of appeal. It has also been noted that that finding on the part of the Board of Appeal in the contested decision was vitiated by an error of law (see paragraph 25 above).

31 By contrast, the Board of Appeal did not in any way base its findings on the fax transmission report, relied on by OHIM in its arguments. In paragraph 9 of the contested decision, the Board of Appeal confined itself to stating the following in that regard:

'The opponent maintains that the appeal was filed on 8 February 2007, within the time limit, and provides a fax report in support of this argument; however, [OHIM] can find no trace of such a document being received on that day.'

32 In those circumstances, the contested decision must be annulled. It is for the Board of Appeal, where appropriate, to assess whether — and, if so, to what extent — the above document, relied on by OHIM in its arguments, is likely to have an effect on the admissibility of the opponent's appeal before it.

33 In the light of the above considerations, Axis's first plea in law must be upheld and the contested decision fall to be annulled on that basis, it being unnecessary to examine the plea in law alleging infringement of Rule 49(2) of Regulation No 2868/95, or the second plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

Costs

34 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, it must be ordered to pay the costs, in accordance with the form of order sought by Axis.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

1. **Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 27 November 2007 (Case R 334/2007-2) relating to opposition proceedings between Etra Investigación y Desarrollo, SA and Axis AB;**

2. **Orders OHIM to bear its own costs and to pay those incurred by Axis AB.**

Vilaras Prek Ciucă

Delivered in open court in Luxembourg on 9 September 2010.

[Signatures]