Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

13 July 2017*

(Internal market — Decision of EUIPO rejecting a request for inclusion on the list of professional representatives — Condition relating to the existence of a place of business within the European Union — Article 93(2)(b) of Regulation (EC) No 207/2009 — Freedom to provide services — Article 36 of the EEA Agreement — Consistent interpretation)

In Case T-527/14,

Paul Rosenich, residing in Triesenberg (Liechtenstein), represented by A. von Mühlendahl and C. Eckhartt, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented initially by G. Schneider, and subsequently by D. Walicka, acting as Agents,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 29 April 2014 (Case R 2063/2012-4), concerning the refusal of EUIPO to enter the applicant on the list of professional representatives provided for in Article 93 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

THE GENERAL COURT (Fifth Chamber),

composed of A. Dittrich, President, J. Schwarcz (Rapporteur) and V. Tomljenović, Judges,

Registrar: A. Lamote, Administrator,

having regard to the application lodged at the Registry of the General Court on 15 July 2014,

having regard to the response lodged at the Registry of the Court on 19 December 2014,

having regard to the reply lodged at the Registry of the Court on 10 March 2015,

having regard to the rejoinder lodged at the Registry of the Court on 11 May 2015,

further to the hearing on 14 January 2016,

gives the following

* Language of the case: German.

Judgment

Legal context

Agreement on the EEA

1 Article 1 of the Agreement on the European Economic Area (EEA), which came into force in Liechtenstein on 1 May 1995 by Decision of the EEA Council No 1/95 of 10 March 1995 on the entry into force of the [EEA Agreement] for the Principality of Liechtenstein (OJ 1995 L 86, p. 58), provides:

'The aim of this Agreement of association is to promote a continuous and balanced strengthening of trade and economic relations between the Contracting Parties with equal conditions of competition, and the respect of the same rules, with a view to creating a homogeneous European Economic Area, hereinafter referred to as the EEA.'

2 In accordance with Article 2 of the EEA Agreement:

'For the purposes of this Agreement:

(a) the term "Agreement" means the main Agreement, its Protocols and Annexes as well as the acts referred to therein;

…'

3 As regards the interpretation of the EEA Agreement, Article 6 sets out the principle of homogeneity as follows:

'Without prejudice to future developments of case-law, the provisions of this Agreement, in so far as they are identical in substance to corresponding rules of the Treaty establishing the European Economic Community and the Treaty establishing the European Coal and Steel Community and to acts adopted in application of these two Treaties, shall, in their implementation and application, be interpreted in conformity with the relevant rulings of the Court of Justice of the European Communities given prior to the date of signature of this Agreement.'

4 Article 7 of the EEA Treaty provides:

'Acts referred to or contained in the Annexes to this Agreement or in decisions of the EEA Joint Committee shall be binding upon the Contracting Parties and be, or be made, part of their internal legal order as follows:

(a) an act corresponding to an EEC regulation shall as such be made part of the internal legal order of the Contracting Parties; …'

5 Article 36(1) of the EEA Agreement, on the freedom to provide services, provides:

'Within the framework of the provisions of this Agreement, there shall be no restrictions on freedom to provide services within the territory of the Contracting Parties in respect of nationals of [European Union] Member States and [European Free Trade Association] States who are established in [a European Union] Member State or an EFTA State other than that of the person for whom the services are intended.'

6 Article 65(2) of the EEA Agreement provides:

‘Protocol 28 and Annex XVII contain specific provisions and arrangements concerning intellectual, industrial and commercial property, which, unless otherwise specified, shall apply to all products and services.’

7 Protocol 1 to the EEA Agreement, concerning horizontal adaptations, states:

‘The provisions of the acts referred to in the Annexes to the Agreement shall be applicable in accordance with the Agreement and this Protocol, unless otherwise provided in the respective Annex. The specific adaptations necessary for individual acts are set out in the Annex where the act concerned is listed.

…

8. References to Territories Whenever the acts referred to contain references to the territory of the “Community” or of the “common market” the references shall for the purposes of the Agreement be understood to be references to the territories of the Contracting Parties as defined in Article 126 of the Agreement.’

8 According to Annex XVII to the EEA Agreement, when the acts referred to in that annex contain notions or refer to procedures which are specific to the European Union legal order, Protocol 1 on horizontal adaptations is to apply, unless otherwise provided for in that annex. In that respect, it does not refer to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1) and has also never referred to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), which was repealed and replaced by Regulation No 207/2009.

Regulation No 207/2009

9 Article 93(1) to (3) of Regulation No 207/2009, in the version in force at the material time, provides:

‘1. Representation of natural or legal persons before the Office may only be undertaken by:

…

(b) professional representatives whose names appear on the list maintained for this purpose by the Office …

…

2. Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he must be a national of one of the Member States;

(b) he must have his place of business or employment in the Community;

(c) he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a Member State …

3. Entry shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in paragraph 2 are fulfilled.'

10 By Article 1(87) of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation No 40/94, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21), Article 93(2) of Regulation No 207/2009 was replaced by the following provisions, which now refer to the territory of the EEA:

'Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) being a national of one of the Member States of the [EEA];

(b) having his place of business or employment in the [EEA];

(c) being entitled to represent natural or legal persons in trade mark matters before the Benelux Office for Intellectual Property or before the central industrial property office of a Member State of the [EEA] …'

11 In accordance with Article 4 of Regulation 2015/2424, those amendments entered into force on 23 March 2016.

Background to the dispute

12 The applicant, Paul Rosenich, an Austrian national, who is a professional representative before the Österreichisches Patentamt (Austrian Patent Office), operates a patent agency at his place of business, located in Liechtenstein.

13 On 17 January 2011, the applicant submitted a request for inclusion on the list of professional representatives before the European Union Intellectual Property Office (EUIPO), under Article 93(2) of Regulation No 207/2009.

14 By decision of 7 September 2012, the Director of the Operations Support Department of EUIPO, in his capacity as a Member of the Administration of Trade Marks and Designs and Legal Division, rejected that request on the ground that the applicant did not satisfy the condition of having a place of business within the European Union as required by Article 93(2)(b) of Regulation No 207/2009.

15 On 7 November 2012, the applicant filed a notice of appeal against that decision.

16 By decision of 29 April 2014 ('the contested decision') the Fourth Board of Appeal dismissed that appeal.

17 In that regard, in the first place, the Board of Appeal rejected the applicant's argument that, in essence, under Article 93 of Regulation No 207/2009, any person entitled to represent a client before a national office is automatically also entitled to do so before EUIPO, since, in the applicant's view, 'authorisation to provide representation before a national office constitutes the point of reference making it possible to ascertain which of the rules of Article 93(2)(c) of [Regulation No 207/2009] applies'.

18 In the second place, the Board of Appeal considered that the argument that the geographical reference to the European Union should be replaced by a geographical reference to an EEA Member State did not follow from the EEA Agreement, as Regulation No 207/2009 did not appear in Annex XVII to that agreement, which meant, in particular, that Protocol 1 to that agreement, concerning horizontal adaptations, was not applicable to it. The Board of Appeal stated that, although Annex XVII referred to Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), it did so only in so far as, for the purposes of the 'principle of the exhaustion of trade mark rights' at EU level, the reference to entering into circulation within the European Union was replaced by a reference to entering into circulation within an EEA Member State. According to the Board of Appeal, that provision has a bearing on Article 13 of Regulation No 207/2009. In its view, Protocol 28 to the EEA Agreement likewise contains no provision relevant to the present case.

19 In the third place, as regards the application of rules relating to the freedom to provide services provided for in EEA law, the Board of Appeal took the view that the provision of services was not restricted by the contested provision, since the advisory services provided for consideration by the applicant from Liechtenstein to clients established in the European Union are not affected by Article 93 of Regulation No 207/2009. Accordingly, the applicant is subject to no restriction in exercising his profession as a patent agent other than any he might himself impose. The Board of Appeal pointed out, to that effect, that Article 36 of the EEA Agreement referred to specific provisions on the freedom to provide services contained in Annexes IX to XI to the EEA Agreement, which do not refer to the right of representation.

20 The Board of Appeal considers that Articles 92 and 93 of Regulation No 207/2009 seek to guarantee that representatives before EUIPO have a certain qualifications and that EUIPO communicates only with parties or representatives who have an address within the European Union.

21 In the fourth place, Article 4 of the EEA Agreement, which prohibits any discrimination on grounds of nationality, is not relevant in the present case, as the applicant is a national of a Member State of the European Union and the refusal to include him on the list is not based on that ground.

22 The Board of Appeal also pointed out that Liechtenstein law on representation accorded no reciprocity, but provides that a foreign holder of a trade mark applied for with the Amt für Volkswirtschaft (Intellectual Property Office, Liechtenstein) must instruct a lawyer or a patent agent from Liechtenstein as his representative.

23 In the fifth and last place, the Board of Appeal took the view that EUIPO could not disregard a provision of Regulation No 207/2009 on the ground that it is not consistent with a higher-ranking rule. Only the Court of Justice can do so. Similarly, it is not possible to envisage an interpretation which is consistent with the meaning and objective of higher-ranking rules, since Article 93(2)(c) of Regulation No 207/2009 is worded clearly and unequivocally.

Procedure and forms of order sought

24 By application lodged at the Registry of the General Court on 15 July 2014, the applicant brought the present action.

25 The applicant claims that the Court should:

– annul the contested decision;

– annul the decision of the Director of the Operations Support Department of EUIPO of 7 September 2012;

– order EUIPO to pay the costs, including the costs of the proceedings before the Board of Appeal.

26 EUIPO claims that the Court should:

– dismiss the action;

– order the applicant to pay the costs.

27 On 20 November 2015, the Court (Fifth Chamber) asked EUIPO to provide the Court with certain documents to clarify, first, the relationship between Regulations Nos 40/94 and 207/2009 and the EEA Agreement, and, secondly, the nature of professional representation in European Union trade mark matters. EUIPO replied by letter of 7 December 2015. By letter of 22 December 2015, the applicant responded to that reply.

28 Acting on a proposal from the Judge-Rapporteur, the Court decided to open the oral part of the procedure. The parties presented oral argument and answered the questions put to them by the Court at the hearing on 14 January 2016.

29 Taking note of the amendment of Article 93(2)(b) of Regulation No 207/2009 (see paragraphs 10 and 11 above), the parties stated at the hearing that the action would become devoid of purpose if the applicant were to be entered on the list of professional representatives in question following the entry into force of Regulation 2015/2424.

30 Consequently, the Court did not close the oral part of the procedure at the end of the hearing and asked the parties to inform the Court, before 15 April 2016, whether the applicant had indeed been entered on that list.

31 By letters of 14 and 15 April 2016, the applicant and EUIPO stated that the applicant had not yet been entered on the list of professional representatives and that they would inform the Court if and when the listing procedure was closed.

32 By letter of 16 June 2016, EUIPO informed the Court that it had asked the applicant, for a second time, to produce a recent certificate in accordance with Article 93(3) of Regulation No 207/2009 and that, if he failed to produce that document, he could not be entered on the list of professional representatives.

33 The Court gave the applicant until 24 August 2016 to submit his observations concerning that letter.

34 By letter of 24 August 2016, the applicant informed the Court that he had not yet been entered on the list in question. He also submitted to the Court the exchanges of correspondence which he had had with EUIPO.

35 Taking formal notice that the applicant had not been included on the list of professional representatives and taking the view that a settlement of the case between the parties was unlikely, the Court closed the oral part of the procedure on 6 September 2016.

Law

36 In support of his action, the applicant raises a single plea in law, alleging an infringement of Article 93 of Regulation No 207/2009 as it was, in his view, to be interpreted in the light of the freedom to provide services guaranteed within the EEA under the EEA Agreement.

37 The applicant submits that the purpose of the EEA Agreement is, in particular, to provide for the fullest possible realisation of the freedom to provide services, which should, according to the case-law (see judgments of 1 April 2004, *Bellio F.lli*, C-286/02, EU:C:2004:212, paragraphs 34 and 35 and the case-law cited, and of 28 October 2010, *Établissements Rimbaud*, C-72/09, EU:C:2010:645, paragraph 20 and the case-law cited), be interpreted and applied in the same way as the freedom to provide services guaranteed between the Member States of the European Union. However, as regards relations between the Member States of the European Union, the Court of Justice ruled that the requirement that a patent agent, already established and qualified in another Member State and wishing to supply services, have a residence or a place of business in the host Member State constituted a restriction of the freedom to provide services that went beyond what is necessary to attain objectives such as that of determining which court has territorial jurisdiction over proceedings relating to patents registered in the host Member State and that of ensuring the efficient conduct of such proceedings (judgments of 13 February 2003, *Commission* v *Italy*, C-131/01, EU:C:2003:96, paragraphs 42 to 45, and of 11 June 2009, *Commission* v *Austria*, C-564/07, not published, EU:C:2009:364, paragraphs 47 to 53). Consequently, the freedom to provide services, guaranteed by the EEA Agreement and intended to be an individually and directly applicable right, either renders ineffective the provisions adopted by the Contracting Parties to the EEA Agreement making the free exercise of a profession conditional upon the existence of a place of business or registered office in the European Union or requires an interpretation of those provisions to the effect that a place of business in an EEA Member State is sufficient.

38 The obligations arising from the EEA Agreement bind not only the Member States of the European Union, but also the European Union itself, the institutions and bodies of which are directly required to respect the fundamental freedoms enshrined in that agreement, such as the freedom to provide services.

39 The applicant submits that the fact that Regulation No 207/2009 is not expressly referred to in the instruments of the EEA Agreement, in particular in Protocol 28 and Annex XVII, does not call into question that conclusion. Article 1(2) of Protocol 28 to the EEA Agreement, according to which the Contracting Parties should take into account the principles of the freedom to provide services, precludes the requirement to have a place of business in the European Union. In addition, it is generally acknowledged that a first entry into circulation within an EEA State leads to the exhaustion of the rights within the European Union.

40 In response to EUIPO, first of all, the applicant states that, under Liechtenstein law, patent agents who qualified in an EEA Member State are authorised, for the purpose of carrying out certain formalities, to pursue cross-border activities as agents and representatives in Liechtenstein. Liechtenstein law is, in that regard, entirely consistent with Regulation No 207/2009. Furthermore, even in the absence of reciprocity, the direct application of the provisions of the EEA Agreement cannot be called into question.

41 Next, the applicant takes the view that EUIPO's argument that the requirement to have a place of business in the territory of the European Union is justified for reasons relating to liability and to the protection of the other party in bilateral proceedings is novel and, therefore, inadmissible. Moreover, although the requirement to provide, where appropriate, proof of professional indemnity insurance is not contrary to the freedom to provide services, agents also being required under Liechtenstein law to take out such insurance, that requirement cannot, in itself, justify the requirement to have a place of business in the European Union.

42 Lastly, the applicant takes the view that once a lawyer authorised to practise in an EEA State has been granted a right of representation before the Court of Justice under the fourth paragraph of Article 19 of the Statute of the Court of Justice of the European Union, there can be no reason for the application of stricter provisions to representation before EUIPO, since the latter body is subject to lower-ranking rules.

43 EUIPO points out that the applicant asks for Article 93(2)(b) of Regulation No 207/2009 not to be applied, since it infringes a higher-ranking rule, namely the EEA Agreement. However, referring to the judgment of 12 July 2001, *Kik* v *OHIM (Kik)* (T-120/99, EU:T:2001:189, paragraph 55), EUIPO argues that it does not have jurisdiction to decide not to apply a clearly worded rule without disregarding the presumption of legality principle.

44 EUIPO also takes the view that none of the applicant's arguments demonstrates that the geographical reference to the European Union in Article 93 of Regulation No 207/2009 should be interpreted as a reference to the EEA, as Annex XVII to the EEA Agreement does not refer to that regulation as forming part of the acts to which Protocol 1 to that agreement applies.

45 Even though Article 1(2) of Protocol 28 to that agreement contains an obligation for the European Union to adjust its legal provisions, in particular Article 93 of Regulation No 207/2009, such an obligation rests not with EUIPO but with the European Free Trade Association (EFTA) Surveillance Authority or the European Commission.

46 According to EUIPO, even assuming that the requirement for professional representatives to have a place of business within the European Union must be regarded as being a restriction on the freedom to provide services within the EEA, it is justified for reasons relating to the law governing liability and for the purpose of protecting the other party in bilateral proceedings.

47 EUIPO also claims that the applicant's observations on the reciprocity of Liechtenstein law submitted in the reply constitute novel, and therefore inadmissible, arguments. In any event, there is no reciprocity, in so far as Liechtenstein law provides only for the 'temporary' or 'cross-border' exercise of the activity of a patent agent, whereas Regulation No 207/2009 provides for a permanent representation carried out in the Member State in which the representative has his place of business. EUIPO states, however, that the reference to the legal situation in Liechtenstein in paragraph 18 of the contested decision is intended only to illustrate that the Liechtenstein legislature assesses the legal situation no differently than does the EU legislature.

48 In that regard, it should be noted that, although Regulation No 207/2009 contains the reference 'Text with EEA relevance', the applicant does not dispute that neither the EEA Agreement nor its protocols or annexes makes any reference to it.

49 Accordingly, under Article 2(a) of the EEA Agreement, which defines that agreement as 'the main Agreement, its Protocols and Annexes as well as the acts referred to therein', it must be noted that Regulation No 207/2009 does not form part of the EEA Agreement.

50 Therefore, the Board of Appeal rightly held that paragraph 8 of Protocol 1 to the EEA Agreement, to which Annex XVII to the latter applies and according to which, 'whenever the acts referred to contain references to the territory of the [European Union] or of the "common market" the references shall for the purposes of the Agreement be understood to be references to the territories of the Contracting Parties as defined in Article 126 of the Agreement', does not apply in the present case.

51 However, by its arguments, the applicant claims, in essence, that the contested decision is contrary to Article 93(2)(b) of Regulation No 207/2009 as it should, in its view, have been interpreted and applied in the light of the freedom to provide services as enshrined in the EEA Agreement. Where it is impossible to make such an interpretation in conformity with the agreement, the applicant takes the view that the contested requirement relating to establishment in the European Union, provided for by that provision, should have been disregarded as unlawful, in favour of a direct application of the principle of the freedom to provide services within the EEA, from which it follows that there can be no restriction on, or even discrimination in relation to, persons established outside the territory of the European Union, but in an EFTA State within the EEA, such as Liechtenstein. The applicant therefore raises a plea of illegality within the meaning of Article 277 TFEU.

52 It is clear from Article 216(2) TFEU that the international agreements concluded by the European Union bind the institutions of the European Union and the Member States.

53 It is clear from the settled case-law that the provisions of such agreements form an integral part of the legal order of the European Union as from their entry into force (judgments of 30 April 1974, *Haegeman*, 181/73, EU:C:1974:41, paragraph 5; of 21 December 2011, *Air Transport Association of America and Others*, C-366/10, EU:C:2011:864, paragraphs 73 and 79; and of 18 March 2014, *Z.*, C-363/12, EU:C:2014:159, paragraph 73).

54 On that basis, the Court of Justice has already stated that the primacy of international agreements concluded by the European Union over provisions of secondary EU legislation meant that such provisions must, so far as is possible, be interpreted in a manner that is consistent with those agreements (judgment of 10 September 1996, *Commission* v *Germany*, C-61/94, EU:C:1996:313, paragraph 52).

55 It is also clear from the settled case-law that the provisions of such an agreement may have direct effect if they are unconditional and sufficiently precise (see, to that effect, judgments of 5 February 1976, *Conceria Bresciani*, 87/75, EU:C:1976:18, paragraph 25, and of 26 October 1982, *Kupferberg*, 104/81, EU:C:1982:362, paragraph 23). However, in order for the Courts of the European Union to be able to undertake an examination of the alleged incompatibility of an act of the European Union with the provisions of such an agreement, it is also necessary that the nature and the broad logic of that act do not preclude it (see, to that effect, judgment of 16 July 2015, *ClientEarth* v *Commission*, C-612/13 P, EU:C:2015:486, paragraph 35 and the case-law cited).

56 As regards the EEA Agreement, the Courts of the European Union have already confirmed that its provisions, including as regards Liechtenstein, form an integral part of the EU legal system (see, to that effect, judgments of 28 October 2010, *Établissements Rimbaud*, C-72/09, EU:C:2010:645, paragraphs 13 and 19, and of 22 January 1997, *Opel Austria* v *Council*, T-115/94, EU:T:1997:3, paragraph 101).

57 In accordance with the fifth paragraph of its preamble, the EEA Agreement is intended, in particular, to provide for the fullest possible realisation of the free movement of goods, persons, services and capital within the whole EEA, so that the internal market established within the European Union is extended to the EFTA States (see judgment of 28 October 2010, *Établissements Rimbaud*, C-72/09, EU:C:2010:645, paragraph 20 and the case-law cited, and judgment of 26 September 2013, *United Kingdom* v *Council*, C-431/11, EU:C:2013:589, paragraph 50).

58 In that regard, the rules applicable to relations between the Contracting Parties in the fields covered by the EEA Agreement essentially correspond to the parallel provisions of the TFEU and the measures adopted in pursuance of that treaty (see, to that effect, judgment of 22 January 1997, *Opel Austria* v *Council*, T-115/94, EU:T:1997:3, paragraph 107).

59 From that angle, several provisions of the EEA Agreement are intended to ensure as uniform an interpretation as possible thereof throughout the EEA. It is for the Courts of the European Union, in that context, to ensure that the rules of the EEA Agreement which are identical in substance to those of the TFEU are interpreted uniformly in the EU legal order (see, to that effect, judgments of 28 October 2010, *Établissements Rimbaud*, C-72/09, EU:C:2010:645, paragraph 20 and the case-law cited, and of 22 January 1997, *Opel Austria* v *Council*, T-115/94, EU:T:1997:3, paragraphs 106 to 108).

60 In the present case, the applicant wishes to offer his services as a professional representative before EUIPO, while remaining established in Liechtenstein. It is clear from the case-law of the Court of Justice that such an activity is capable of falling within the scope of the freedom to provide services, as provided for in the EEA Treaty (see, to that effect, judgment of 13 February 2003, *Commission* v *Italy*, C-131/01, EU:C:2003:96, paragraphs 21 to 25).

61 It has already been held that the rules prohibiting restrictions on the freedom to provide services laid down in Article 36(1) of the EEA Agreement have the same legal scope as those imposed by Article 56 TFEU. The Court of Justice has accordingly specified that, in the field at issue, the rules laid down by the EEA Agreement and those laid down by the TFEU must be given a uniform interpretation (judgments of 5 July 2007, *Commission* v *Belgium*, C-522/04, EU:C:2007:405, paragraphs 45 and 46, and of 6 October 2009, *Commission* v *Spain*, C-153/08, EU:C:2009:618, paragraph 48).

62 However, the Court of Justice qualified that principle by stating that EU case-law relating to restrictions on the exercise of freedom of movement within the European Union cannot be transposed in its entirety to the freedoms guaranteed by the EEA Agreement, since those latter freedoms are exercised within a different legal context (see judgment of 18 July 2013, *Commission* v *Denmark*, C-261/11, not published, EU:C:2013:480, paragraph 44 and the case-law cited).

63 That said, in the present case, it is sufficient to note that neither the Board of Appeal nor EUIPO has submitted and, still less, demonstrated that the freedom to provide services in relation to representation before intellectual property offices was exercised, in the present case, in a different legal context, which would mean that the relevant EU case-law which relates to restrictions on the exercise of freedom to provide services within the European Union cannot be transposed in its entirety to that same freedom as guaranteed by the EEA Agreement (see, to that effect, judgment of 16 April 2015, *Commission* v *Germany*, C-591/13, EU:C:2015:230, paragraph 82).

64 It is therefore necessary to determine whether the condition relating to a place of business within the European Union set out in Article 93(2)(b) of Regulation No 207/2009, as interpreted by the Board of Appeal, namely that the term ‘Community’ cannot refer to the EEA, is compatible with Article 36(1) of the EEA Agreement, which enshrines the freedom to provide services at EEA level.

65 In that context, the Court of Justice has repeatedly held that Article 56 TFEU, which, like Article 36(1) of the EEA Agreement, enshrines the freedom to provide services, is sufficiently precise and unconditional, so that it has direct effect (judgments of 3 December 1974, *van Binsbergen*, 33/74, EU:C:1974:131, paragraph 27, and of 14 July 1976, Donà, 13/76, EU:C:1976:115, paragraph 20). As regards the nature and the broad logic of the EEA Agreement, neither the Board of Appeal nor EUIPO has put forward any arguments capable of demonstrating that it cannot be relied on directly by individuals. On the contrary, that possibility arises from the eighth paragraph of the preamble to the EEA Agreement, which emphasises the important role that individuals play in the EEA through the exercise of the rights conferred on them by that agreement and through the judicial defence of those rights. Furthermore, it is important to point out the Court of Justice has already examined the compatibility of an EU act in the light of the EEA Agreement (judgment of 1 April 2004, *Bellio F.lli*, C-286/02, EU:C:2004:212, paragraphs 57 to 63).

66 Article 56 TFEU requires not only the elimination of all discrimination on grounds of nationality against providers of services who are established in another Member State, but also the abolition of any restriction — even if it applies to national providers of services and to those of other Member States alike — which is liable to prohibit, to impede or to render less advantageous the activities of a provider of services established in another Member State in which he lawfully provides similar services (see judgment of 17 March 2011, *Peñarroja Fa*, C-372/09 and C-373/09, EU:C:2011:156, paragraph 50 and the case-law cited).

67 It is clear from the case-law of the Court of Justice that the requirement that a patent agent, qualified as a representative before the patent office in another Member State and wishing to supply services, have a place of business in the host Member State, or even that he appoint a person authorised to accept service, constitutes a restriction on the freedom to provide services (see, to that effect,

judgment of 13 February 2003, *Commission* v *Italy*, C-131/01, EU:C:2003:96, paragraph 42 and the case-law cited, and judgment of 11 June 2009, *Commission* v *Austria*, C-564/07, not published, EU:C:2009:364, paragraph 47).

68 The condition set out in Article 93(2)(b) of Regulation No 207/2009, as interpreted by the Board of Appeal, therefore constitutes a restriction on the freedom to provide services within the EEA.

69 Nevertheless, it also follows from the case-law of the Court of Justice that national measures liable to hinder or make less attractive the exercise of fundamental freedoms guaranteed by the TFEU are considered to be compatible with that treaty if they fulfil four conditions: they must be applied in a non-discriminatory manner, they must be justified by imperative requirements in the general interest, they must be suitable for securing the attainment of the objective which they pursue, and they must not go beyond what is necessary to attain it (judgments of 30 November 1995, *Gebhard*, C-55/94, EU:C:1995:411, paragraph 37, and of 11 June 2009, *Commission* v *Austria*, C-564/07, not published, EU:C:2009:364, paragraph 31).

70 In the first place, in paragraph 16 of the contested decision, the Board of Appeal noted that Article 93 of Regulation No 207/2009 ensured, first, that persons whose professional activity consists in representing third parties before EUIPO have professional qualifications, the determination of which varies according to the Member State, and, secondly, read in conjunction with Article 92 of that regulation, that EUIPO must communicate only with parties or representatives who have an address within the European Union. The applicant, whose place of business is in Liechtenstein, is not capable of fulfilling that condition.

71 As regards the first objective, namely that relating to professional qualifications, EUIPO has not explained how a place of business within the European Union ensures that a person is better qualified than does a place of business in an EFTA State within the EEA. It should also be noted that, in order to attain that objective, there is a less restrictive measure than that with which the present dispute is concerned, namely the requirement for proof of professional qualifications.

72 As regards the second objective, it could be likened to the need to ensure the proper conduct of the proceedings. Thus, it could be relied on as an overriding reason in the public interest capable of justifying a restriction on the freedom to provide services (see, to that effect, judgment of 11 June 2009, *Commission* v *Austria*, C-564/07, not published, EU:C:2009:364, paragraph 49 and the case-law cited).

73 However, the requirement to have a place of business in the territory of the European Union, as provided for in Article 93(2)(b) of Regulation No 207/2009, as interpreted by the Board of Appeal, goes beyond what is necessary to attain that objective. It is sufficient to note that modern methods of electronic communication enable professional representatives to communicate appropriately with EUIPO. It is common ground that there are several technical means, such as fax, electronic mail, or even online digital methods (programs), namely e-filing, which make it possible to ensure the communication of documents between EUIPO and the persons concerned.

74 In the second place, in its submissions before the Court, EUIPO argued that the requirement to have a place of business in the European Union is justified in the interests of justice, namely for reasons relating to the law governing liability and for the purpose of protecting the other party in bilateral proceedings.

75 Those arguments must be rejected.

76 First, as regards the objective relating to the law governing liability, in its line of argument EUIPO merely refers to paragraphs 22 et seq. of the judgment of 11 June 2009, *Commission* v *Austria* (C-564/07, not published, EU:C:2009:364), concerning the requirement to obtain professional

insurance. However, the residence requirement, in itself, does not ensure that professional representatives have adequate professional insurance, since, in addition, EUIPO has not claimed, and still less demonstrated, that all of the EU Member States imposed an obligation to obtain professional insurance, while this is not the case in certain EFTA States within the EEA. Moreover, if the objective of the EU legislature was to ensure that professional representatives have such insurance, it could have used measures which constituted less of a restriction on the freedom to provide services, such as an express requirement for all professional representatives to obtain professional insurance which also covers the services they provide before EUIPO.

77 Secondly, EUIPO has in no way explained how the establishment of professional representatives in an EU Member State, rather than in an EFTA State within the EEA, such as Liechtenstein, offered greater protection to the other party in bilateral proceedings.

78 Therefore, neither the Board of Appeal nor EUIPO relied on overriding reasons in the public interest capable of justifying the restriction on the freedom to provide services, referred to in paragraph 68 above. Thus, it must be held that the condition of having a place of business in the European Union provided for in Article 93(2)(b) of Regulation No 207/2009, as interpreted by the Board of Appeal, is contrary to Article 36(1) of the EEA Agreement.

79 The Board of Appeal further stated, as is also pointed out by EUIPO, that Liechtenstein accorded no reciprocity in the matter. However, first, neither the Board of Appeal nor EUIPO has demonstrated that entry in the register of professional representatives before the Intellectual Property Office was conditional upon the person concerned having a place of business in that State. The parties' arguments concerned, rather, the issue of whether, and to what extent, a professional representative in an EU Member State could represent a client before the Intellectual Property Office. Secondly, neither the Board of Appeal nor EUIPO considered that that alleged lack of reciprocity was capable of justifying that restriction on the freedom to provide services. In EUIPO's view, that is an argument intended only to illustrate that the Liechtenstein legislature assesses the legal situation no differently than does the EU legislature. Thirdly, and in any event, it is sufficient to point out that, in accordance with the case-law of the Court of Justice (see judgment of 13 February 2003, *Commission* v *Italy*, C-131/01, EU:C:2003:96, paragraph 46 and the case-law cited), a Member State cannot plead failure to observe the principle of reciprocity or rely on a possible infringement of the Treaty by another Member State to justify its own default. EUIPO has put forward no facts or points of law that would result in the non-application of that case-law on the freedoms of movement, as enshrined in the EEA Agreement. Furthermore, application of the principle of reciprocity is contrary to the specific measures concerning surveillance and dispute-settlement procedures provided for in Articles 109 and 111 of the EEA Agreement.

80 In the third place, the Board of Appeal stated, as EUIPO also pointed out, that EUIPO did not have the power not to apply the condition relating to place of business provided for in Article 93(2)(b) of Regulation No 207/2009.

81 In that regard, it is sufficient to note that it is clear from the case-law cited in paragraph 54 above that the primacy of international agreements concluded by the European Union, such as the EEA Agreement, over provisions of secondary EU legislation means that such provisions must, so far as is possible, be interpreted in a manner that is consistent with those agreements.

82 Accordingly, without there having been any need to disregard the condition at issue, it was for EUIPO to interpret and apply it in accordance with the obligations resulting from the EEA Agreement.

83 Although it is true that a conforming interpretation of secondary EU law cannot serve as the basis for an interpretation of that law that is *contra legem* (see order of 17 July 2015, *EEB* v *Commission*, T-685/14, not published, EU:T:2015:560, paragraph 31 and the case-law cited), such an interpretation is not possible in the present case.

84 It is not apparent from Regulation No 207/2009 in the version applicable before the entry into force of Regulation 2015/2424 or from the elements of fact and of law put forward by EUIPO that it was the specific intention of the EU legislature to prevent persons with a place of business in an EFTA State within the EEA, such as Liechtenstein, from being entered on the list of professional representatives.

85 As the Board of Appeal has, in essence, stated, the intention of the EU legislature was, rather, to ensure that the communications between EUIPO and the interested parties are of a specific quality and reliability. As is clear from paragraph 73 above, such an objective does not necessarily require the person concerned to have a place of business in the territory of the European Union.

86 That interpretation is supported by Regulation 2015/2424, by which references to the territory of the European Union were replaced by references to the territory of the EEA with regard, in particular, to conditions for inclusion on the list of professional representatives in Article 93 of Regulation No 207/2009. Although that is an amendment with a significant practical impact, there is nothing to indicate that it is the result of a will for political change in relation to EFTA States within the EEA. First, that amendment does not appear in the Commission's legislative proposal COM(2013) 161 final of 27 March 2013, and was introduced only later in the legislative process. Secondly, the legislature in no way clarified its approach in the preamble to Regulation 2015/2424. Accordingly, that amendment must be regarded as a technical adjustment, with no purpose other than to bring secondary EU law in line with the obligations arising from the EEA Agreement.

87 It follows that the single plea in law must be upheld, with the result that the contested decision must be annulled.

88 As regards the applicant's second head of claim, it seeks the annulment of the decision of the Director of the Operations Support Department of EUIPO of 7 September 2012. Thus, by that head of claim, the applicant asks the Court, in essence, to adopt the decision which, in his view, the Board of Appeal should have taken. Consequently, the applicant requests that the contested decision be altered, as provided for in Article 65(3) of Regulation No 207/2009.

89 Furthermore, it should be pointed out that the power to alter decisions, granted to the Court pursuant to Article 65(3) of Regulation No 207/2009, does not have the effect of conferring on that Court the power to carry out an assessment on which that Board of Appeal has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (judgment of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraph 72).

90 In the present case, the conditions have been fulfilled for the exercise by the Court of the power to alter decisions. It is clear from paragraph 2 of the contested decision that the refusal of the Director of the Operations Support Department of EUIPO was based on the applicant's failure to comply with the criterion provided for in Article 93(2)(b) of Regulation No 207/2009. It is clear from the considerations set out in paragraphs 36 to 87 above that the Board of Appeal was required to find that, contrary to the view of the Director of the Operations Support Department of EUIPO, that provision did not preclude the applicant's inclusion on the list of professional representatives. Consequently, it is necessary, by way of alteration of the contested decision, also to annul the decision of the Director of the Operations Support Department of EUIPO.

Costs

91 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

92 Under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal of EUIPO are to be regarded as recoverable costs.

93 Since EUIPO has been unsuccessful, it must be ordered to pay the costs, including those incurred before the Board of Appeal, in accordance with form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Fifth Chamber),

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 29 April 2014 (Case R 2063/2012-4);**

2. **Annuls the decision of the Director of the Operations Support Department of EUIPO of 7 September 2012;**

3. **Orders EUIPO to pay the costs.**

Dittrich Schwarcz Tomljenović

Delivered in open court in Luxembourg on 13 July 2017.

[Signatures]