JUDGMENT OF THE COURT (Grand Chamber)

5 July 2011 *

In Case C-263/09 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 14 July 2009,

Edwin Co. Ltd, established in Tokyo (Japan), represented by D. Rigatti, M. Bertani, S. Verea, K. Muraro and M. Balestriero, avvocati,

appellant,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto, L. Rampini and J. Crespo Carrillo, acting as Agents,

defendant at first instance,

Elio Fiorucci, residing in Milan (Italy), represented by A. Vanzetti and A. Colmano, avvocati,

applicant at first instance,

* Language of the case: Italian.

THE COURT (Grand Chamber),

composed of V. Skouris, President, A. Tizzano, J.N. Cunha Rodrigues, K. Lenaerts, J.-C. Bonichot, K. Schiemann and D. Šváby, Presidents of Chambers, A. Rosas, E. Juhász, T. von Danwitz, M. Berger (Rapporteur), A. Prechal and E. Jarašiūnas, Judges,

Advocate General: J. Kokott,
Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 23 November 2010,

after hearing the Opinion of the Advocate General at the sitting on 27 January 2011,

gives the following

Judgment

1 By its appeal, Edwin Co. Ltd seeks to have set aside the judgment of the Court of First Instance of the European Communities (now 'the General Court') of 14 May 2009 in Case T-165/06 *Fiorucci* v *OHIM* ? *Edwin (ELIO FIORUCCI)* [2009] ECR II-1375; 'the judgment under appeal'), by which that Court upheld in part the action brought by Mr Fiorucci against the decision of the First Board of Appeal of the Office for

Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 6 April 2006 (Case R 238/2005-1) concerning invalidity and revocation proceedings between Mr Fiorucci and Edwin ('the contested decision').

Legal context

European Union law

The Statute of the Court of Justice

2 Article 58 of the Statute of the Court of Justice provides:

'An appeal to the Court of Justice shall be limited to points of law. It shall lie on the grounds of lack of competence of the General Court, a breach of procedure before it which adversely affects the interests of the appellant as well as the infringement of Union law by the General Court.

No appeal shall lie regarding only the amount of the costs or the party ordered to pay them.'

The Rules of Procedure of the General Court

3 Article 135(4) of the Rules of Procedure of the General Court provides that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

Regulation (EC) No 40/94

4 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1). However, Regulation No 40/94, as amended by Council Regulation (EC) No 422/2004 of 19 February 2004 (OJ 2004 L 70, p. 1; 'Regulation No 40/94'), continues to apply to this case.

5 Article 50(1)(c) of Regulation No 40/94 provided, under the heading 'Grounds for revocation':

'The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to [OHIM] or on the basis of a counterclaim in infringement proceedings:

…

(c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.'

6 Under the heading 'Relative grounds for invalidity', Article 52(2) of that regulation provided:

'A Community trade mark shall also be declared invalid on application to [OHIM] or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:

(a) a right to a name;

(b) a right of personal portrayal;

(c) a copyright;

(d) an industrial property right,

under the Community legislation or national law governing the protection.'

7 Article 63 of Regulation No 40/94, concerning actions before the Court of Justice, provided:

'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

3. The Court of Justice has jurisdiction to annul or to alter the contested decision.

…

6. [OHIM] shall be required to take the necessary measures to comply with the judgment of the Court of Justice.'

Regulation (EC) No 2868/95

8 Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4; 'the implementing regulation'), lays down inter alia the rules governing the way in which proceedings for the revocation or invalidation of a Community trade mark are to be conducted before OHIM.

9 In that regard, Rule 37(b)(iii) of the implementing regulation, in its original version, which has remained unchanged, provides:

'An application to [OHIM] for revocation or for a declaration of invalidity … shall contain:

…

(b) as regards the grounds on which the application is based:

…

(iii) in the case of an application pursuant to Article 52(2) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article 52(2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right.'

National law

10 Article 8(3) of the Italian Industrial Property Code (Codice della Proprietà Industriale; 'the CPI'), in the version applying at the date of the decision of the Board of Appeal, provided:

'If they are well known, the following may be registered as a trade mark by the proprietor, or with the consent of the latter or of the persons referred to in paragraph 1: personal names, signs used in the artistic, literary, scientific, political or sporting fields, the designations and acronyms of events and those of non-profit making bodies and associations, including their characteristic emblems.'

Background to the dispute and the contested decision

11 Fiorucci SpA, a company governed by Italian law set up by Mr Fiorucci, a fashion designer who had achieved certain renown in Italy during the 1970s, sold to the appellant on 21 December 1990 the entirety of its 'creative assets', including all the trade marks which it owned, among which were numerous marks containing the element 'FIORUCCI'.

12 On 6 April 1999, on application by the appellant, OHIM registered the word mark ELIO FIORUCCI for a series of goods in Classes 3, 18 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.

13 On 3 February 2003, Mr Fiorucci filed an application for revocation and an application for a declaration of the invalidity of that mark, based on Article 50(1)(c) and Article 52(2)(a), respectively, of Regulation No 40/94.

14 By decision of 23 December 2004, the Cancellation Division of OHIM allowed the application for a declaration of invalidity, on the grounds, first, that, according to Article 8(3) of the CPI, Mr Fiorucci's consent was required for the registration of his name as a Community trade mark and, second, that no such consent had been given. The Cancellation Division held that in those circumstances there was no need to rule on the application for revocation.

15 The appellant brought an appeal against that decision. By the contested decision, the First Board of Appeal of OHIM allowed that appeal and annulled the decision of the Cancellation Division. With regard, in the first place, to the application for a declaration of invalidity filed by Mr Fiorucci, the Board of Appeal held that his situation did

not fall within the scope of Article 8(3) of the CPI, the *raison d'être* of which was to prevent third parties from exploiting for commercial purposes the name of a person who had become famous in a non-commercial sector and that, therefore, Mr Fiorucci could not rely on a right to a name under that provision. With regard, in the second place, to the application for revocation filed by Mr Fiorucci, the Board of Appeal noted that the *raison d'être* of Article 50(1)(c) of Regulation No 40/94 was to protect public confidence, and held that neither the trade mark at issue in itself nor the use made of it could mislead the public.

The action before the General Court and the judgment under appeal

16 By application lodged at the Registry of the General Court on 19 June 2006, Mr Fiorucci brought an action against the contested decision.

17 By the judgment under appeal, the General Court upheld that action in part.

18 After rejecting, in paragraphs 21 to 25 of the judgment under appeal, a number of pleas as inadmissible because they were new pleas, the General Court held, in paragraph 27 of that judgment, that Mr Fiorucci had put forward in essence two pleas in law, alleging infringement of Article 52(2)(a) and Article 50(1)(c), respectively, of Regulation No 40/94.

19 Examining first of all the second plea, relating to the application for revocation, the General Court upheld the Board of Appeal's findings, holding in paragraphs 33 to 35 of the judgment under appeal that the mark ELIO FIORUCCI is not, in itself, liable to mislead the public as to the origin of the goods for which it is registered within the meaning of Article 50(1)(c) of Regulation No 40/94. Moreover, it held in paragraphs 36

and 37 of that judgment that, in the absence of evidence showing any use whatsoever of the mark at issue, there could be no question of use liable to mislead the public. The Court therefore rejected that plea.

20 Examining next the first plea, relating to the application for a declaration of invalidity, the General Court confirmed, in paragraph 41 of the judgment under appeal, that under Article 52(2)(a) of Regulation No 40/94 OHIM may declare a Community trade mark to be invalid, on application by an interested party, if its use can be prohibited pursuant to, in particular, a right to a name protected by a national law. As regards the interpretation of Article 8(3) of the CPI, the Court however rejected the Board of Appeal's finding. In that regard, it held:

'50 First, it must be held that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal is not confirmed by the wording of that provision, which refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired.

…

53 Second, contrary to what is suggested by the Board of Appeal …, even on the assumption that the name of a well-known person has already been registered or used as a de facto trade mark, the protection given by Article 8(3) of the [CPI] is not in any way superfluous or irrelevant.

…

55 …, it is not ruled out that the name of a well-known person, registered or used as a mark for certain goods or services, can be the subject of a new registration for different goods or services which are not in any way similar to those covered by the earlier registration. …

…

57 Third, the extracts from some of the academic writings cited in paragraphs 41 to 43 of the contested decision also do not allow the conclusion to be drawn that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal in the contested decision is correct.

58 Thus, Mr Vanzetti, author … of the work cited in paragraph 41 of the contested decision, took part in the hearing as lawyer for [Mr Fiorucci] and stated that the thesis adopted by the Board of Appeal did not follow at all from what he had written in the work in question …

59 Mr Ricolfi … refers, according to the Board of Appeal, to the "renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character", which does not at all exclude renown resulting from an "entrepreneurial" use, even if that is less frequent.

60 Only Mr Ammendola … refers to a use in a "sector outside the market", without thereby expressly concluding that Article 8(3) of the [CPI] cannot be invoked to protect the name of a person whose renown was not acquired in such a field. In any case, having regard to all of the foregoing considerations, the Court cannot, only on the basis of the opinion of that one author, make the application of

the provision in question subject to a condition which does not follow from its wording.'

21 In paragraph 61 of the judgment under appeal, the General Court concluded from this that the Board of Appeal had erred in law in its interpretation of Article 8(3) of the CPI and had ruled out, incorrectly, the application of that provision in the case of Mr Fiorucci.

22 Lastly, with regard to the alternative argument presented by the appellant and by OHIM, that the mark ELIO FIORUCCI was included in the assignment, by Mr Fiorucci to the appellant, of all his marks, the General Court stated that the Board of Appeal had not examined that argument and that, in the context of the review of legality which it is required to conduct, it may not substitute its own reasoning for that of the Board of Appeal. On that ground, in paragraphs 64 and 65 of the judgment under appeal, it rejected that argument as irrelevant.

23 On the same ground, the General Court rejected Mr Fiorucci's application for a declaration that the trade mark ELIO FIORUCCI was invalid. Refraining from exercising its power to alter the Board of Appeal's decision, the Court, in paragraph 67 of the judgment under appeal, merely annulled it.

24 According to the operative part of the judgment under appeal, the General Court:

'1. Annuls the [contested decision] in so far as it contains an error of law in the interpretation of Article 8(3) of the [CPI];

2. Dismisses the action as to the remainder;

3. Orders OHIM to bear its own costs and two thirds of the costs incurred by Mr Elio Fiorucci;

4. Orders Edwin Co. Ltd to pay its own costs and one third of those incurred by Mr Elio Fiorucci.'

Forms of order sought

25 The appellant claims that the Court of Justice should:

— set aside point 1 of the operative part of the judgment under appeal on all the grounds set out in its appeal;

— in the alternative, set aside point 1 of the operative part of the judgment under appeal for failure to state adequate grounds;

— in the further alternative, set aside the judgment under appeal since it constitutes a denial of justice or infringes Article 63 of Regulation No 40/94;

— refer for examination by the Board of Appeal of OHIM the arguments put forward in the abovementioned alternative claims for the judgment under appeal to be set aside; and, lastly,

— order that the appellant should be reimbursed in full for the costs of the proceedings at first instance and of the appeal proceedings or at least that each party should bear its own costs in full.

26 OHIM contends that the Court should:

— set aside the judgment under appeal;

— in the alternative, refer the case back to the General Court for further examination of the disputed matters that were, in error, not examined; and

— order Mr Fiorucci to pay the costs.

27 Mr Fiorucci contends that the Court should:

— dismiss the appeal and, thus, uphold points 1, 3 and 4 of the operative part of the judgment under appeal;

— amend paragraphs 33 to 35 of the judgment under appeal; and

— order the reimbursement of the costs of the appeal proceedings.

The appeal

28 In support of its appeal, the appellant puts forward four substantive pleas and a fifth plea concerning allocation of the costs.

29 With regard to the substantive pleas, it is appropriate to examine first the second part of the first plea, relating to the error allegedly made by the General Court in the interpretation and application of Article 52(2)(a) of Regulation No 40/94 and then, secondly and together, the first part of the first plea and the second plea, by which the appellant criticises the General Court for incorrectly interpreting and applying Article 8(3) of the CPI, which, in the appellant's submission, constitutes an infringement of Article 52(2)(a) of Regulation No 40/94. Finally, in third and last place, the third and fourth pleas, by which the appellant complains that the General Court failed to comply with its obligation to state adequate grounds and failed to do justice, will be dealt with together.

Second part of the first plea: infringement of Article 52(2)(a) of Regulation No 40/94

Arguments of the parties

30 By the second part of the first plea, the appellant claims that Article 52(2)(a) of Regulation No 40/94, where it refers to the 'right to a name', is referring to an attribute of personality. However, the right provided for in Article 8(3) of the CPI is a right intended to protect not an attribute of personality but purely pecuniary interests in the economic exploitation of renown acquired outside the commercial sector. By holding that the condition required for the application of Article 52(2)(a) of Regulation No 40/94 was fulfilled, the General Court therefore infringed that provision.

31 According to Mr Fiorucci, that argument is groundless.

Findings of the Court

32 In order to assess the merits of the appellant's interpretation, it is necessary to take into consideration the wording and structure of Article 52(2) of Regulation No 40/94.

33 As regards the wording of that provision, it should be noted that the words 'right to a name' do not provide any support for the restrictive interpretation proposed by the appellant, to the effect that the provision concerns only that right as an attribute of personality and does not cover commercial exploitation of a name.

34 The structure of Article 52(2) of Regulation No 40/94, for its part, is inconsistent with such an interpretation. According to that provision, a Community trade mark may be declared invalid on application by a person concerned claiming 'another earlier right'. In order to clarify the nature of such an earlier right, that provision lists four rights, while indicating, by the use of the adverb 'in particular', that that list is not exhaustive. The examples given include, besides the right to a name and the right of personal portrayal, a copyright and an industrial property right.

35 It is apparent from that non-exhaustive list that the rights cited by way of examples are intended to protect interests of different types. It should be noted that for some of them, such as copyright and industrial property rights, the economic aspects are protected, both under the national legal systems and under European Union law, against commercial infringements (see, inter alia, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45)).

36 It follows that, contrary to what the appellant maintains, the wording and structure of Article 52(2) of Regulation No 40/94 do not, where a right to a name is asserted, allow application of that provision to be restricted merely to situations where the registration of a Community trade mark conflicts with a right intended exclusively to protect a name as an attribute of the personality of the person concerned.

37 In those circumstances, the General Court cannot be criticised for making an error of law in the interpretation of Article 52(2)(a) of Regulation No 40/94.

38 The second part of the first plea must therefore be rejected as unfounded.

The first part of the first plea and the second plea: infringement of Article 52(2)(a) of Regulation No 40/94 and Article 8(3) of the CPI

Arguments of the parties

39 By the first part of the first plea, the appellant claims that the General Court incorrectly held that the conditions for applying Article 52(2)(a) of Regulation No 40/94 were satisfied. According to the appellant, Article 8(3) of the CPI does not confer on Mr Fiorucci, solely because it is his own surname which is involved, the right to have the use of his name as a trade mark prohibited, but grants him solely the right to apply

for it to be registered as a trade mark. According to the appellant, Mr Fiorucci can no longer exercise that right since he has already registered marks including the element 'FIORUCCI' and subsequently assigned them to the appellant.

40 By its second plea, the appellant claims, first, that the General Court manifestly misinterpreted Article 8(3) of the CPI, which applies only to names which have become well-known outside the commercial sector. By holding in paragraph 50 of the judgment under appeal that Article 8(3) of the CPI refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired, the General Court misinterpreted the wording of that provision.

41 Secondly, the appellant claims that, by holding, in paragraphs 53 and 55 of the judgment under appeal, that the protection given by Article 8(3) of the CPI to the name of a well-known person could be broader than that afforded by the registration of a well-known trade mark, in that it may apply to different goods or services, the General Court also misinterpreted the scope of that provision. The appellant complains that, in that regard, the General Court totally disregarded or manifestly misinterpreted the extracts from academic writings which had been submitted to it concerning that provision.

42 OHIM complains that the General Court failed to take into consideration in its interpretation and application of Article 8(3) of the CPI the possible exhaustion of the right under that provision, exhaustion resulting in the present case from Mr Fiorucci's registration, and subsequent assignment to the appellant, of trade marks containing the element 'FIORUCCI'. In so far as Article 52(2)(a) of Regulation No 40/94 refers to national law, misapplication of the Italian provision might constitute infringement of Article 52 of the regulation. However, OHIM considers that, in the context of an appeal, review by the Court of Justice of the General Court's application of national law should be limited to checking that the General Court has not made a manifest error on the basis of the documents and evidence available to it.

43 Mr Fiorucci contends that the General Court's interpretation and application of Article 8(3) of the CPI are in accordance both with the wording of that provision and with the interpretation given it in Italian academic writings. Furthermore, the consequence of a reference to a rule of national law made in a provision of European Union law cannot be that the rule concerned must be regarded as being incorporated into European Union law.

Findings of the Court

44 It is apparent from the arguments of the parties that they disagree over the existence both of an infringement by the General Court of the national rule applied to the substance of the case and of the jurisdiction of the Court of Justice to examine such an infringement.

45 It is therefore appropriate to determine whether the Court of Justice does have such jurisdiction.

46 The jurisdiction of the Court of Justice ruling on an appeal against a decision given by the General Court is defined by the second subparagraph of Article 256(1) TFEU. That provision states that an appeal is to be on points of law only and that it must be made 'under the conditions and within the limits laid down by the Statute'. In a list setting out the grounds that may be relied upon in that context, the first paragraph of Article 58 of the Statute of the Court of Justice states that an appeal may be based on infringement of European Union law by the General Court.

47 In the present case, the rule which the appellant claims has been infringed is a rule of national law made applicable to the dispute by the reference made in a provision of European Union law.

48 It is apparent from the wording of Article 52(2) of Regulation No 40/94 that when that provision refers to the situation in which the existence of an earlier right makes it possible to prohibit the use of a Community trade mark it distinguishes clearly between two situations, depending on whether the earlier right is protected under the Community legislation 'or' under national law.

49 As regards the procedural arrangements laid down by the implementing regulation in the case of an application pursuant to Article 52(2) of Regulation No 40/94, based on an earlier right protected under national law, Rule 37 of the implementing regulation provides, in a situation such as that in the present case, that the applicant must provide particulars showing that he is entitled under the national law applicable to lay claim to that right.

50 That rule requires the applicant to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law.

51 Where, as in the present case, an application for a Community trade mark to be declared invalid is based on an earlier right protected by a rule of national law, the competent OHIM bodies must first assess the authority and scope of the particulars submitted by the applicant in order to establish the content of that rule.

52 Secondly, according to Article 63(2) of Regulation No 40/94, actions may be brought before the General Court against decisions of the Boards of Appeal on grounds of infringement of the Treaty, of Regulation No 40/94 or of any rule of law relating to their application. It follows from this, as the Advocate General stated in points 61 to 67 of her Opinion, that the General Court has jurisdiction to conduct a full review of the

legality of OHIM's assessment of the particulars submitted by an applicant in order to establish the content of the national law whose protection he claims.

53 As regards the examination, in the context of an appeal, of the findings made by the General Court with regard to that national law, the Court of Justice has jurisdiction to determine, first of all, whether the General Court, on the basis of the documents and other evidence submitted to it, distorted the wording of the national provisions at issue or of the national case-law relating to them, or of the academic writings concerning them; second, whether the General Court, as regards those particulars, made findings that were manifestly inconsistent with their content; and, lastly, whether the General Court, in examining all the particulars, attributed to one of them, for the purpose of establishing the content of the national law at issue, a significance which is not appropriate in the light of the other particulars, where that is manifestly apparent from the documentation in the case-file.

54 In the present case, the appellant has claimed that the General Court interpreted Article 8(3) of the CPI in a way that was inconsistent with the wording of that provision and with academic writings concerning it that were produced before that Court. It is appropriate to examine whether its argument relates to errors allegedly made by the General Court in its findings with regard to the national legislation at issue, which would be open to review by the Court of Justice on the basis of the considerations set out in the preceding paragraph.

55 As regards, in the first place, the assertion that, in holding that Article 8(3) of the CPI confers on the proprietor of a name the right to have the use of that name as a trade mark prohibited, the General Court interpreted that provision in a way that was inconsistent with its wording, it should be noted that, according to the terms of the provision, the names of well-known persons may be registered as a trade mark only 'by the proprietor, or with the consent of the latter'. Since the wording of Article 8(3) of the CPI makes registration of the names of well-known persons as trade marks conditional on consent being given by the proprietor of the name, it was possible for the General Court, without distorting that text, to infer from it that the proprietor of

a well-known name is entitled to prevent the use of that name as a trade mark where he maintains that he has not given his consent to registration of that mark.

56 In the second place, as regards the complaint that, by holding that Article 8(3) of the CPI applies irrespective of the sector in which the renown of the name in question was acquired, the General Court interpreted that provision in a way that was inconsistent with its wording, it must be held that, as the General Court observed in paragraph 50 of the judgment under appeal, the wording of that provision, in so far as it refers to the names of well-known persons, makes no distinction according to the sector in which that renown was acquired. Nor did the General Court distort the content of Article 8(3) of the CPI in holding in paragraph 56 of the judgment under appeal that there is no justification for excluding the application of that provision where the name of a well-known person has already been registered or used as a trade mark. Article 8(3) of the CPI, as the General Court observed, does not lay down any condition other than that the personal name concerned must be well known.

57 With regard to academic writings, the General Court, in the context of its review of legality, examined the assessment made by the Board of Appeal. It is apparent from paragraphs 58 to 60 of the judgment under appeal that the General Court did not disregard the fact that certain views on which the Board of Appeal relied might have supported the appellant's case. The General Court stated however, in paragraph 58 of that judgment, that the opinion attributed by the Board of Appeal to Mr Vanzetti, as the author of a work, was disputed by the author himself at the hearing before the General Court, at which he was present as Mr Fiorucci's lawyer. The General Court also held, in paragraph 59 of that judgment, that the terms used by Mr Ricolfi in his writings, in particular the reference to 'the renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character', was not sufficiently clear to support a restrictive interpretation of Article 8(3) of the CPI. In the case of Mr Ammendola, referred to in paragraph 60 of the judgment, the General Court held that the opinion expressed by that author did not by itself have sufficient authority to make application of Article 8(3) of the CPI subject to a condition which does not follow from the actual wording of that provision. Nor can the General Court

be criticised in those circumstances for distorting those particulars that were submitted to it.

58 Therefore, the first part of the first plea and the second plea must be rejected as unfounded.

Third and fourth pleas: failure to state adequate grounds, and infringement of Article 63 of Regulation No 40/94 and failure to do justice, respectively

Arguments of the parties

59 By its third plea, the appellant recalls that, in its statement in intervention before the General Court, it claimed that it was incumbent on Mr Fiorucci to prove that he had refused his consent to registration of the trade mark ELIO FIORUCCI. By failing to respond to that plea, the General Court infringed its obligation to state adequate grounds for its decision.

60 In that regard, Mr Fiorucci considers that the grounds stated in paragraph 64 of the judgment under appeal are adequate. Moreover, he alleges, the plea is totally unfounded.

61 By its fourth plea, the appellant criticises the General Court for failing to examine the argument it put forward in the alternative, that the trade mark ELIO FIORUCCI was included in the assignment by Mr Fiorucci to the appellant of all his trade marks, and

for merely finding in that regard that the Board of Appeal had not ruled on that question. The General Court should have used its power to alter decisions by examining and accepting that argument, which should have led it to uphold the operative part of the contested decision whilst amending the reasoning on which it was based. At the very least, the General Court should have expressly referred examination of that argument to the Board of Appeal. By failing to rule in that way, the General Court infringed Article 63(3) of Regulation No 40/94 and failed to do justice.

62 Mr Fiorucci observes that, under the rules of procedure of the Boards of Appeal, if the measures necessary to comply with a judgment of the Court of Justice annulling a decision of a Board of Appeal include re-examination of the case, the case is to be referred automatically to a Board of Appeal.

Findings of the Court

63 The question, raised in the context of the third plea, whether the grounds of a judgment of the General Court are inadequate is a question of law which is amenable, as such, to review on appeal (see, inter alia, Joined Cases C-120/06 P and C-121/06 P *FIAMM and FIAMM Technologies* v *Council and Commission* [2008] ECR I-6513, paragraph 90, and Case C-47/07 P *Masdar (UK)* v *Commission* [2008] ECR I-9761, paragraph 76).

64 It is clear from established case-law that the obligation on the General Court, under Article 36 of the Statute of the Court of Justice, applicable to the General Court by virtue of the first paragraph of Article 53 thereof, and Article 81 of the Rules of Procedure of the General Court, to state reasons does not require the General Court to provide an account which follows exhaustively and one by one all the arguments put forward by the parties to the case and that the Court's reasoning may therefore be implicit on condition that it enables the persons concerned to know why the General

Court has not upheld their arguments and provides the Court of Justice with sufficient material for it to exercise its power of review (see, inter alia, *FIAMM and FIAMM Technologies* v *Council and Commission*, paragraph 91, and Case C-440/07 P *Commission* v *Schneider Electric* [2009] ECR I-6413, paragraph 135).

65 It is apparent from the statement in intervention lodged by the appellant before the General Court that it had put forward an alternative argument based, in essence, as the General Court summarised it in paragraph 64 of the judgment under appeal, on the assertion that the trade mark ELIO FIORUCCI was included in the assignment by Mr Fiorucci to the appellant of all his marks and all his distinctive signs. Among the arguments set out in connection with that alternative argument, the appellant maintained, inter alia, as it recalls in its third plea, that it was incumbent on Mr Fiorucci to prove that he had refused his consent to registration of the trade mark ELIO FIORUCCI.

66 It is true that the General Court rejected as irrelevant all of the arguments submitted in the alternative, without examining their merits.

67 However, that rejection came at the end of reasoning comprising two stages. In paragraph 64 of the judgment under appeal, the General Court held that the Board of Appeal had not based its decision to dismiss the application for a declaration of invalidity submitted by Mr Fiorucci on the grounds set out in the alternative by the appellant. In paragraph 65 of that judgment, the General Court added that, in so far as it carries out a review of the legality of the decisions of OHIM bodies, it may not, in any event, substitute its own reasoning for that of the OHIM body which adopted the contested act.

68 The General Court thus provided adequate grounds in so far as it enables the appellant to know the reasons why the General Court has not upheld its arguments and the Court of Justice to exercise its power of review.

69 The third plea must therefore be rejected as unfounded.

70 By its fourth plea, the appellant calls into question the merits of the grounds provided by the General Court, in that it claims that the refusal of that Court to examine its alternative arguments and to alter the grounds of the contested decision constitutes an infringement of Article 63(3) of Regulation No 40/94 and a denial of justice.

71 As a preliminary point, it should be noted that the General Court was right to point out that the review it carries out under Article 63 of Regulation No 40/94 is a review of the legality of the decisions of the Boards of Appeal of OHIM and that it may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of the grounds for annulment or alteration set out in Article 63(2) of that regulation (Case C-16/06 P *Les Éditions Albert René* v *OHIM* [2008] ECR I-10053, paragraph 123).

72 It follows that the power of the General Court to alter decisions does not have the effect of conferring on that Court the power to substitute its own reasoning for that of a Board of Appeal or 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 General 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.

73 In the present case, the Board of Appeal based the annulment of the Cancellation Division's decision merely on the finding that Mr Fiorucci, according to the interpretation it gave of Article 8(3) of the CPI, could not rely on a right to a name within the meaning of Article 52(2)(a) of Regulation No 40/94. The Board of Appeal did not therefore rule on the effect which the alleged assignment of the trade mark at issue by contract to the appellant might have as regards the validity of that trade mark.

74 In those circumstances, the General Court was right not to examine that part of the appellant's alternative arguments.

75 In so far as the appellant criticises the General Court for not expressly referring examination of that argument to the Board of Appeal, suffice it to note that, in the context of an action before the Court of Justice against the decision of a Board of Appeal, OHIM is required, under Article 63(6) of Regulation No 40/94, to take the necessary measures to comply with the judgment of the Court of Justice. Furthermore, in pointing out in paragraph 67 of the judgment under appeal, with an express reference to paragraph 64 of that judgment, that that argument was not examined by the Board of Appeal, the General Court gave that Board a clear indication as to the measures it should take.

76 It follows from the above that the fourth plea must be rejected as unfounded.

Fifth plea: the order for costs

77 The appellant claims that the order for costs made against it by the General Court, which is unfair, must be set aside as a consequence of the judgment under appeal being set aside. In the event of the appeal being dismissed, the costs should at least be shared between the parties.

78 In that regard, suffice it to note that, according to settled case-law, where all the other pleas put forward in an appeal have been rejected, any plea challenging the decision of the General Court on costs must be rejected as inadmissible by virtue of the second paragraph of Article 58 of the Statute of the Court of Justice, which provides that no appeal is to lie regarding only the amount of the costs or the party ordered to pay them (see, inter alia, Joined Cases C-302/99 P and C-308/99 P *Commission and France* v *TF1* [2001] ECR I-5603, paragraph 31, and Case C-485/08 P *Gualtieri* v *Commission* [2010] ECR I-3009, paragraph 111).

79 Therefore, since all the other pleas put forward in the appeal brought by the appellant have been rejected, the last plea concerning the allocation of costs must be declared inadmissible.

80 It follows from all the foregoing considerations that the appellant's appeal must be dismissed.

The claim for amendment of the judgment under appeal submitted by Mr Fiorucci

Arguments of the parties

81 In his response, Mr Fiorucci contends that the Court of Justice should amend paragraphs 33 to 35 of the judgment under appeal. In his submission, the General Court was wrong to hold, in the context of the examination of the application for revocation, that the trade mark ELIO FIORUCCI is not, in itself, liable to mislead the public as to the origin of the goods for which it is registered.

82 The appellant argues that that claim for amendment does not satisfy the requirements of Article 116 of the Rules of Procedure of the Court of Justice and must therefore be declared inadmissible.

Findings of the Court

83 Article 116 of the Rules of Procedure of the Court of Justice provides that a response must seek to dismiss, in whole or in part, the appeal or to set aside, in whole or in part, the decision of the General Court or the same form of order as that sought at first instance. Article 113 of the Rules of Procedure of the Court of Justice lays down the same requirements as regards an appeal.

84 In the present case, Mr Fiorucci's claim seeks not to have the judgment under appeal set aside, even in part, but amendment of a finding made by the General Court in the context of its examination of Mr Fiorucci's second plea, a plea which it rejected moreover.

85 Such a claim can, therefore, only be rejected as inadmissible.

Costs

86 Under Article 69(2) of the Rules of Procedure of the Court of Justice, which, under Article 118 thereof, applies to the procedure on appeal, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. However, under the first subparagraph of Article 69(3) of those rules, where

each party succeeds on some and fails on other heads, the Court may order that the parties bear their own costs.

87 In the present case, the appellant has failed in all its pleas, except in respect of Mr Fiorucci's claim for amendment of the judgment under appeal. OHIM has failed on all heads. Mr Fiorucci has been successful in his claims, apart from his claim for amendment of the judgment under appeal.

88 In those circumstances, the appellant and OHIM must each be ordered to bear its own costs and to pay jointly three quarters of the costs of Mr Fiorucci. Mr Fiorucci must be ordered to bear one quarter of his own costs.

On those grounds, the Court (Grand Chamber) hereby:

1. Dismisses the appeal;

2. Dismisses the claim for amendment of the judgment of the Court of First Instance of the European Communities of 14 May 2009 in Case T-165/06 *Fiorucci* v *OHIM – Edwin (ELIO FIORUCCI)*, submitted by Mr Fiorucci;

3. Orders Edwin Co. Ltd and the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) each to bear its own costs and to pay jointly three quarters of the costs of Mr Fiorucci;

4. Orders Mr Fiorucci to bear one quarter of his own costs.

[Signatures]