JUDGMENT OF THE GENERAL COURT (Second Chamber)

22 June 2010 *

In Case T-255/08,

Eugenia Montero Padilla, residing in Madrid (Spain), represented initially by G. Aguillaume Gandasegui and P. Linde Puelles, and subsequently by A. Salerno and M. Di Stefano, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by J.F. Crespo Carrillo, acting as Agent,

defendant,

* Language of the case: Spanish.

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court, being

José María Padilla Requena, residing in Santa Eulalia (Spain), represented by J.F. Gallego Jiménez and J.R. Gil Cantons, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 1 March 2008 (Case R 516/2007-2), concerning opposition proceedings between Eugenia Montero Padilla and José María Padilla Requena,

THE GENERAL COURT (Second Chamber),

composed of I. Pelikánová (Rapporteur), President, K. Jürimäe and S. Soldevila Fragoso, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 16 June 2008,

having regard to the response of OHIM lodged at the Court Registry on 22 October 2008,

having regard to the response of the intervener lodged at the Court Registry on 14 November 2008,

having regard to the order of 13 July 2009 granting the applicant legal aid,

having regard to the fact that no application for a hearing was submitted by the parties within the prescribed period, and having therefore decided, acting upon a report of the Judge-Rapporteur to give a ruling without an oral procedure pursuant to Article 135a of the Rules of Procedure of the Court,

gives the following

Judgment

Background

1 On 12 September 2002, the intervener, José María Padilla Requena, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (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 trade mark applied for is the word sign JOSE PADILLA.

3 The goods and services in respect of which registration was sought are in Classes 9, 25 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 9: 'Sound-recording, compact and magnetic discs; magnetic tapes, cassettes; video tapes';

— Class 25: 'Clothing, footwear, headgear';

— Class 41: 'Providing of education; training; entertainment; cultural activities, in particular writing, composing, recording and performing music'.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 64/2003 of 4 August 2003.

5 On 4 November 2003, the applicant, Eugenia Montero Padilla, 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 rights:

— Spanish word marks JOSE PADILLA Nos 2427480 and 2476324, applied for on 28 September 2001 and 16 May 2002, respectively, in respect of services and goods in Class 41 and Class 9, respectively;

— the mark with a reputation JOSE PADILLA;

— the well-known mark JOSE PADILLA;

— the rights attaching to the sign JOSE PADILLA used in trade.

7 The opposition related to all the goods and services covered by the trade mark application.

8 The grounds put forward in support of the opposition were those referred to in Article 8(1)(a) and (b), Article 8(2)(c) and Article 8(4) and (5) of Regulation No 40/94 (now Article 8(1)(a) and (b), Article 8(2)(c) and Article 8(4) and (5) of Regulation No 207/2009).

9 On 9 February 2007, the Opposition Division rejected the opposition on the ground that the existence of the earlier Spanish trade marks, the use of the name José Padilla as a trade mark and the well-known nature of that mark had not been proved and that the rights that the applicant relies on in relation to the earlier sign used in trade cannot be invoked in the context of opposition proceedings.

10 On 4 April 2007, the applicant filed a notice of appeal at OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009), against the decision of the Opposition Division.

11 By decision of 1 March 2008 ('the contested decision'), the Second Board of Appeal dismissed the appeal. In particular, it held that the applicant had not adduced proof that the earlier national marks had been registered, or proof of the use, for the purposes of Article 8(4) of Regulation No 40/94, that she had made of the other earlier rights relied on.

Forms of order sought

12 The applicant claims that the Court should:

— annul the contested decision;

— refuse to register the trade mark applied for in respect of the goods and services within Classes 9, 25 and 41.

13 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

14 The intervener contends that the Court should:

— dismiss the action and uphold the contested decision;

— order the applicant to pay the costs.

Law

15 In support of her action, the applicant puts forward five pleas in law, relating, first, to the 'legal effects of the contested decision", and alleging, second, infringement of Article 4 and Article 7(1)(a),(b) and (c) of Regulation No 40/94 (now Article 4 and Article 7(1)(a),(b) and (c) of Regulation No 207/2009), third, infringement of Article 7(1)(f) of Regulation No 40/94 (now Article 7(1)(f) of Regulation No 207/2009), fourth, infringement of Article 8(1) and (5) of Regulation No 40/94 (now Article 8(1) and (5) of Regulation No 207/2009) and, fifth, infringement of Article 8(4) of Regulation No 40/94 (now Article 8(4) of Regulation No 207/209).

First plea in law, relating to the 'legal effects of the contested decision'

Arguments of the parties

16 The applicant submits, in essence, that registration of the trade mark applied for would enable the intervener to preclude her from using the name José Padilla in exploiting her intellectual property rights.

17 The applicant complains that the Board of Appeal failed to take sufficient account of the importance for the commercial exploitation of intellectual property rights of indicating the name of the author of a work. Consequently, the Board of Appeal failed to have regard to Article 5 of 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), which lays down a presumption of ownership of copyright. The applicant submits that it follows from that provision that in order to be able properly to exploit her intellectual property rights in her uncle's works, the name José Padilla must appear on all phonographic and audiovisual media, in advertising, or in concert programmes.

18 Lastly, the applicant states that she is unable to rely on Article 12 of Regulation No 40/94 (now Article 12 of Regulation No 207/2009) which is intended, inter alia, to protect a third party who uses his own name in the course of trade, since José Padilla is her uncle's name, not her own.

19 OHIM contends that Directive 2004/48 was adopted after the date of filing of the notice of opposition and that this plea in law is inadmissible pursuant to Article 48(2) of the Rules of Procedure of the General Court, in conjunction with Article 135(4) thereof, which provides that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

20 The intervener contends that the use of the trade mark applied for does not preclude the applicant from exploiting the name José Padilla, providing that she 'identifies clearly' the author of the works protected by her copyright.

Findings of the Court

21 It should be borne in mind that the purpose of actions before the General Court under Article 63(2) of Regulation No 40/94 (now Article 65(2) of Regulation No 207/2009) is to obtain a review of the legality of decisions of the Boards of Appeal. In the context of that regulation, Article 74 thereof (now Article 76 of Regulation No 207/2009) requires that that review must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (see Case T-57/03 *SPAG* v *OHIM — Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 17 and the case-law cited). It follows that the Court may not annul or alter the decision against which an action has been brought on grounds which came into existence subsequent to its adoption (Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 55, and Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 53).

22 In addition, in accordance with Article 135(4) of the Rules of Procedure, the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

23 It is therefore necessary to consider whether, by claiming for the first time before the Court that the registration of the trade mark applied for would enable the intervener to preclude her from using the name José Padilla when exploiting her intellectual property rights, the applicant has changed the subject-matter of the proceedings.

24 In that connection, it must be noted that, even though certain arguments relating to the scope of the exclusive right which would be conferred on the intervener if the trade mark applied for were registered were raised by the applicant in her appeal before the Board of Appeal, those arguments were relied on in the context of pleas, based on the existence of earlier marks and an earlier sign, raised in support of an appeal against a decision of the Opposition Division of 9 February 2007. As stated at paragraph 8 above, the pleas in law relied on in support of the opposition were those referred to in Article 8(1)(a) and (b), Article 8(2)(c) and Article 8(4) and (5) of Regulation No 40/94.

25 However, by the present plea in law, the applicant requests, in essence, that the Court should review the legality of the contested decision in the light of Article 9 of Regulation No 40/94 (now Article 9 of Regulation No 207/2009).

26 Therefore, in accordance with the provisions of Regulation No 40/94 and of the Rules of Procedure, referred to at paragraphs 21 and 22 above, the first plea in law must be rejected as inadmissible.

27 For the sake of completeness, it should be noted that, even if, as the applicant contends, Article 9(1) of Regulation No 40/94 (now Article 9(1) of Regulation No 207/2009) enabled the intervener, in the event of registration of the trade mark applied for, to preclude her from using the name José Padilla for the purpose of exploiting her intellectual property rights, that could not affect the legality of the contested decision rejecting the applicant's opposition.

28 The grounds on which opposition may be based, as laid down in Article 42(1) of Regulation No 40/94 (Article 41(1) of Regulation No 207/2009), are solely the relative grounds for refusal in Article 8 of the regulation (Case T-224/01 *Durferrit* v *OHIM — Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 72). By contrast, Article 9 of Regulation No 40/94 defines the scope of the right conferred by a Community trade mark and, therefore, the effects of its registration, but does not concern the conditions for registration. Consequently, Article 9 does not form part of the legal framework to be taken into consideration by OHIM when it examines an application for registration or a notice of opposition.

29 It follows from the foregoing that, even if the first plea in law had not been inadmissible in the present case, it would then have had to be dismissed as ineffective.

The second and third pleas in law, alleging infringement of Article 4 and Article 7(1)(a), (b) and (c) of Regulation No 40/94 and infringement of Article 7(1)(f) of Regulation No 40/94, respectively

Arguments of the parties

30 The applicant submits that the name José Padilla is not sufficiently distinctive to enable consumers to distinguish goods and services within Classes 9 and 41 on the market, given that it is a common name in Spain. Consequently, the Board of Appeal failed to have regard to the provisions of Article 4 of Regulation No 40/94, under

which the sign used must enable the goods or services to be distinguished on the market, and the provisions of Article 7(1)(a),(b) and (c), which preclude registration of, respectively, signs which do not conform to the requirements of Article 4 of that regulation, trade marks devoid of any distinctive character, and trade marks consisting exclusively of signs which may serve to designate characteristics of the goods or services concerned.

31 The applicant also submits that the trade mark applied for is contrary to public policy since it restricts the exercise of her copyright in her uncle's works and its registration is, therefore, contrary to Article 7(1)(f) of Regulation No 40/94.

32 OHIM contends that those pleas in law are inadmissible on the ground that they were not raised by the applicant before the Opposition Division or before the Board of Appeal. OHIM submits that those pleas must, therefore, be rejected as inadmissible.

33 The intervener contends that the name José Padilla fulfils all the conditions in order to distinguish the goods and services in question and that it cannot be classified as a generic name.

34 In addition, the intervener contends that the registration of the trade mark applied for is not contrary to public policy and states that Article 7(1)(f) of Regulation No 40/94 is not applicable to opposition proceedings and was not, moreover, relied on in that context.

Findings of the Court

35 As regards the second and third pleas in law, it follows from the wording of Article 42(1), and from the scheme of Article 42 and Article 43 (now Article 42 of Regulation No 207/2009) of Regulation No 40/94, that the absolute grounds for refusal in Article 7 of that regulation (now Article 7 of Regulation No 207/2009) do not fall to be examined in opposition proceedings. The grounds on which opposition may be based, as laid down in Article 42(1) of Regulation No 40/94, are solely the relative grounds for refusal in Article 8 of the regulation. In addition, the registration procedure is characterised by various stages, which may be summarised as follows. First, in the examination procedure, OHIM examines of its own motion whether registration of the mark applied for is precluded by an absolute ground for refusal, in accordance with Article 38(1) of Regulation No 40/94 (now Article 37(1) of Regulation No 207/2009) and, if that is not the case, the trade mark application is published in accordance with Article 38(1) and Article 40(1) of the regulation (now Article 39(1) of Regulation No 207/2009). Then, if a notice of opposition is filed pursuant to Article 42(1) of Regulation No 40/94 within the period of three months following the date of publication of the trade mark application, OHIM examines, as part of the opposition proceedings, the relative grounds for refusal put forward by the opponent, in accordance with Article 74(1) *in fine* of the regulation (now Article 76(1) of Regulation No 207/2009) (see, to that effect, *NU-TRIDE*, paragraph 72, and Case T-186/02 *BMI Bertollo* v *OHIM — Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 71).

36 It should also be noted that, although under Article 41(1) of Regulation No 40/94 (now Article 40(1) of Regulation No 207/2009) third parties may submit observations to OHIM concerning, inter alia, absolute grounds for refusal, the fact remains that it is not apparent from the case-file that in the present case the applicant submitted such observations to OHIM concerning Article 7(1)(f) of that regulation. Moreover, even if she had done so, the effect of those observations would be limited to an examination by OHIM as to whether there are grounds to reopen the examination procedure to

check whether the absolute ground for refusal put forward by the applicant precludes registration of the mark applied for. Accordingly, it is not in the context of opposition proceedings that OHIM has to take account of the observations submitted by third parties pursuant to Article 41(1) of Regulation No 40/94, and this remains true even if such observations have been submitted to it (*NU-TRIDE*, paragraph 73).

37 Therefore, Article 4, Article 7(1)(a),(b) and (c) and Article 7(1)(f) of Regulation No 40/94 are not provisions in the light of which the legality of the contested decision must be appraised.

38 In the light of the foregoing, the second and third pleas in law must be rejected.

The fourth plea in law, alleging infringement of Article 8(1) and (5) of Regulation No 40/94

Arguments of the parties

39 The applicant submits that the name José Padilla constitutes an earlier well-known trade mark, of which she is the proprietor, which must therefore be protected, meaning that the application for registration of the word sign JOSE PADILLA as a Community trade mark must be refused.

40 In addition, the applicant complains that the Board of Appeal erred in finding that the documents provided showed the prestige, renown and reputation of the deceased composer, while in no way demonstrating the 'reputation of the earlier mark', in failing to have regard to the evidence which she had furnished concerning the volume of sales, and the duration, intensity or geographical extent of the earlier mark's use, and in failing to analyse in detail all the documents for reasons of economy of procedure, whereas those documents were capable of demonstrating that the earlier mark was well-known.

41 Lastly, the applicant submits that the trade mark applied for and the earlier well-known mark are entirely identical, the latter having been used continuously since the works were created, both locally and internationally in the course of trade, and therefore there exists an absolute likelihood of confusion.

42 OHIM contends that the applicant confuses the well-known nature of the composer, which it does not dispute, with the use of his name as a trade mark.

43 OHIM argues that, even if the broadcasting of the composer's melodies on the radio, on television or in the cinema could be regarded as amounting to exploiting a trade mark, only the melody, the title of the song or the name of the singer is connected with the mark. It maintains that it is only in exceptional cases that the public associates a melody with its composer, as illustrated by a number of Internet searches. OHIM submits therefore that the applicant has failed to show any commercial use of the name José Padilla as a trade mark.

44 In addition, OHIM acknowledges that, although the wording in relation to the absence, for reasons of economy of procedure, of an exhaustive examination of the documents provided by the applicant is awkward and somewhat confused, that wording does not conceal any contradiction or a failure to state reasons, since the documents were assessed in the light of clearly defined criteria, such as the market share held by the mark, the intensity, geographical extent and duration of its use, and the size of

the investment made in promoting it. Since the applicant has failed to provide any document containing information relating to those criteria, OHIM contends that it has not been proved that the name José Padilla has been used as a trade mark. In particular, the use of that name as a trade mark is not demonstrated by its use in film credits, nor by the CD (compact disc) covers, cue sheets, stamps bearing the likeness of the composer, the creation of a house museum or the declaration by the United Nations Educational, Scientific and Cultural Organization (UNESCO) that the deceased composer's works are of universal interest. Consequently, OHIM contends that the applicant has made only 'institutional use' of the name, not commercial use.

45 Lastly, OHIM contends that the name José Padilla is used only to identify the author of the musical compositions and not to designate the commercial origin of the goods and services at issue. Consequently, it cannot be inferred from the composer's reputation that there is exploitation of his name as a well-known trade mark. Such exploitation is not demonstrated by any of the documents produced by the applicant.

46 The intervener contends that the applicant has failed to prove the existence of a registered trade mark, of which she is the proprietor, or of an earlier well-known trade mark.

Findings of the Court

47 As regards the plea in law alleging infringement of Article 8(5) of Regulation No 40/94, in so far as the applicant sought to rely on the reputation of the earlier trade mark JOSE PADILLA, for the purposes of that provision, it has been held that it follows

from the wording of Article 8(5) of Regulation No 40/94, which uses the expression 'for which the earlier trade mark is registered', that this provision applies to earlier trade marks within the meaning of Article 8(2) of that regulation only in so far as they have been registered (Case T-150/04 *Mülhens* v *OHIM — Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraph 55; see also, to that effect and by analogy, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23, and Case C-408/01 *Adidas-Salomon and Adidas Benelux* [2003] ECR I-12537, paragraph 22).

48 Consequently, in contrast to Article 8(1)(b) of Regulation No 40/94, which allows, as regards identical or similar goods or services, opposition based on marks for which no proof of registration has been provided, but which are well known within the meaning of Article 6 bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised and amended ('the Paris Convention'), Article 8(5) of Regulation No 40/94 protects, in relation to goods or services which are not similar, only those well-known marks within the meaning of Article 6 bis of the Paris Convention for which proof of registration has been provided (*TOSCA BLU*, paragraph 56).

49 In the present case, proof of the registration of the earlier mark JOSE PADILLA, relied on by the applicant, has not, however, been provided. In that connection, it should be observed that, in the context of the present action, the applicant does not invoke the earlier national registered trade marks which she had relied on before OHIM (see paragraph 6 above), but merely contends that the unregistered mark JOSE PADILLA is well known.

50 Therefore, the plea in law alleging infringement of Article 8(5) of Regulation No 40/94 must be rejected.

51 As regards the plea in law alleging infringement of Article 8(1) of Regulation No 40/94, on the ground that the Board of Appeal erred in finding that the documents provided did not show that the earlier mark JOSE PADILLA was well known, it should be recalled that, under Article 8(2)(c) of Regulation No 40/94, for the purposes of Article 8(1) thereof, 'earlier trade marks' means trade marks which, on the date of application for registration of the Community trade mark or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6 bis of the Paris Convention.

52 Under Article 6 bis of the Paris Convention, that convention's Member States undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trade mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of that convention and used for identical or similar goods.

53 It was therefore for the applicant to adduce proof that, at the date of application for registration of the mark applied for, the earlier mark JOSE PADILLA relied on by her was well known in a Member State and used for goods which are identical or similar to those covered by the trade mark applied for.

54 However, in the present case, the applicant has not put forward any evidence providing information on use of the name José Padilla as a trade mark. Although the documents provided by the applicant evidence the success of the music composed by José Padilla and his renown and reputation as a composer, the fact remains that these are no more than indications of the artistic nature of the musical works of the deceased composer, not indications of the commercial origin of the goods and services which

are marketed with the reference to the name José Padilla, in particular films, DVDs (Digital Versatile Discs) or television programmes.

55 In particular, the examples cited of what the applicant claims is the 'considerable financial or commercial exploitation' of José Padilla's works cannot prove that that name has been used as a trade mark. The applicant submits that that exploitation consisted in the publication of the composer's scores, the performance of his works on phonographic and audiovisual media (CD and DVD), the appearance of his music in film soundtracks, the production of textile goods associated with José Padilla and the museum dedicated to him, and the labelling of a wine with a label bearing that name. However, it must be found that, in the context of all those activities, the name José Padilla has not been used for the purposes of identifying the commercial origin of those goods. The relevant public will certainly not have thought that the CDs, DVDs, textile goods and wine were produced by José Padilla or by an undertaking bearing that name, but either that the CDs and DVDs reproduce one of José Padilla's works, or that the textile goods and the wine bearing his name or image are intended to pay tribute to him. In addition, it must be noted that the applicant has not provided any evidence to show the market share held by the allegedly well-known trade mark JOSE PADILLA, the intensity or geographical extent of its use, or the size of the investment made in promoting it.

56 In the light of the foregoing, the applicant has failed to prove that the name José Padilla was used as a trade mark, and the Board of Appeal, in adopting the Opposition Division's reasoning, at paragraph 16 of the contested decision, was correct to conclude that the documents provided demonstrated only the renown of the deceased composer and the use of his name to identify the author of the musical compositions, not the use of that name as a trade mark.

57 As regards the applicant's argument alleging the Board of Appeal's failure, 'for reasons of economy of procedure', to examine all the documents provided, it is apparent from paragraph 7 of the contested decision summarising the reasons for the Opposition Division's decision, reasons which the Board of Appeal adopted, that the Board of Appeal did appraise in their entirety the documents submitted by the applicant before rightly concluding that those documents had no connection with use of the name José Padilla as a trade mark and were therefore of no relevance. OHIM cannot therefore be criticised for having failed to take due account of the evidence furnished by the applicant.

58 Therefore, in the light of the foregoing, the fourth plea in law must be rejected as unfounded.

The fifth plea in law, alleging infringement of Article 8(4) of Regulation No 40/94

Arguments of the parties

59 The applicant submits that the name José Padilla is used in the course of trade since the exploitation of a musical work constitutes an economic activity. In the present case, that activity is of international and not merely local significance. She also submits that under Spanish and European Union law the use of a trade mark may be restricted by copyright.

60 OHIM contends that the right to a name is not an earlier right as referred to in Article 8(4) of Regulation No 40/94, and that it may serve as a basis only for an application that a registered mark should be declared invalid, not for opposition proceedings. Moreover, Spanish law does not recognise unregistered marks, contrary to what the applicant maintains.

61 In addition, OHIM contends that the applicant's interpretation of Article 9(1) of the Ley de marcas (Spanish Trade Mark Law), to the effect that a person is precluded from using his own name as a trade mark where that name identifies another person known to the public, is difficult to reconcile with the fact that the intervener is the proprietor of the Spanish word mark JOSE PADILLA, registered on 1 July 2000 under number 2 272 097 for goods within Class 9.

62 The intervener points out that the applicant has not adduced proof of the distinctive character of the name José Padilla, given that it was used for the purpose of designating the author of musical compositions, not as a trade mark.

Findings of the Court

63 As regards, first, the protection of the right to a name as a sign used in the course of trade, of more than mere local significance, it should be observed, as the applicant correctly pointed out, that José Padilla is not her name, and so she does not have a right over that name. Therefore, she cannot invoke such protection.

64 It follows that, in so far as the applicant sought to rely on an infringement of Article 8(4) of Regulation No 40/94 on the basis of the right to a name, the fifth plea in law must be rejected.

65 As regards, next, the protection which should be afforded to her copyright in her uncle's works, it must be found that copyright cannot constitute a 'sign used in the course of trade' within the meaning of Article 8(4) of Regulation No 40/94. It is apparent from the scheme of Article 52 of that regulation (now Article 53 of Regulation No 207/2009) that copyright is not such a sign. Article 52(1)(c) (now Article 53(1)(c) of Regulation No 207/2009) provides that a Community trade mark is to be declared invalid where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled. Article 52(2)(c) (now Article 53(2)(c) of Regulation No 207/2009) provides that a Community trade mark is also to be declared invalid where the use of such trade mark may be prohibited pursuant to any 'other' earlier right and in particular a copyright. It follows that copyright is not one of the earlier rights as referred to in Article 8(4) of Regulation No 40/94.

66 As regards, lastly, the use of the name José Padilla in the context of the sale, by the applicant, of textiles and wine bearing the name José Padilla, the complete lack of evidence showing the true nature and size of such economic activity has already been pointed out at paragraph 55 above.

67 Therefore, the argument alleging infringement of Article 8(4) of Regulation No 40/94 must be rejected.

68 For the sake of completeness, the applicant's argument alleging restriction of the use of a subsequent trade mark as a result of her rights, in accordance with national and European Union law, must also be rejected.

69 First, the applicant has not shown that Spanish law entitled copyright holders to prohibit the use of a subsequent trade mark. In that connection, it must be recalled that, for the purposes of the application of Article 8(4) of Regulation No 40/94, both the national legislation applicable by virtue of the reference made by that provision and the judicial decisions delivered in the Member State concerned must be taken into consideration (see Joined Cases T-114/07 and T-115/07 *Last Minute Network* v *OHIM — Last Minute Tour (LAST MINUTE TOUR)* [2009] ECR II-1919, paragraph 47 and the case-law cited; see also, to that effect, Joined Cases T-318/06 to T-321/06 *Moreira da Fonseca* v *OHIM — General Óptica (GENERAL OPTICA)* [2009] ECR II-663, paragraphs 32 and 34). In the present case, it is clear from the file that the action brought by the applicant to have declared invalid the Spanish word mark JOSE PADILLA, of which the intervener is the proprietor, was based, inter alia, on her copyright. That action was dismissed by judgment No 523/2002 of the Juzgado de Primera Instancia de Palma de Mallorca (Court of First Instance, Palma de Mallorca, Spain) of 29 October 2004, which has become final.

70 Second, as regards European Union law, it is sufficient in the present case to note that, in the context of opposition proceedings, copyright cannot be invoked in order to oppose registration of a Community trade mark, as set out at paragraph 65 above.

71 It follows that the applicant's copyright in the works of José Padilla cannot be invoked to oppose registration of the Community trade mark applied for either under Spanish law or under Community law.

72 The fifth plea in law must therefore be rejected.

73 Accordingly, the action must be dismissed in its entirety, without it being necessary to rule on the applicant's second head of claim, in so far as it seeks to have the Court refuse to register the trade mark applied for in respect of the goods and services within Classes 9, 25 and 41.

Costs

74 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, she must be ordered to pay the costs in accordance with the forms of order sought by OHIM and the intervener.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. Dismisses the action;

2. Orders Eugenia Montero Padilla to bear her own costs and to pay those incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and by José María Padilla Requena.

Pelikánová Jürimäe Soldevila Fragoso

Delivered in open court in Luxembourg on 22 June 2010.

[Signatures]