JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
20 April 2005 *

In Case T-318/03,

Atomic Austria GmbH, established in Altenmarkt (Austria), represented by G. Kucsko and C. Schumacher, lawyers,

applicant,

v

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

defendant,

* Language of the case: German.

the other party to the proceedings before the Board of Appeal having been

Fabricas Agrupadas de Muñecas de Onil, SA, established in Onil (Spain),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 9 July 2003 (Case R 95/2003-2), relating to opposition proceedings between Atomic Austria GmbH and Fabricas Agrupadas de Muñecas de Onil, SA,

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

composed of J. Pirrung, President, A.W.H. Meij and I. Pelikánová, Judges,

Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Court Registry on 15 September 2003,

having regard to the response lodged at the Court Registry on 3 February 2004,

further to the hearing on 9 November 2004,

gives the following

Judgment

Background to the dispute

1 On 13 November 2000, the Spanish company Fabricas Agrupadas de Muñecas de Onil, SA ('FAMO') filed an application for 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.

2 The mark sought was the word mark ATOMIC BLITZ.

3 The goods in respect of which registration was applied for are within Class 28 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, and correspond to the following description: 'Games and playthings; gymnastic and sporting articles not included in other classes'.

4 That application was published in *Community Trade Marks Bulletin* No 60/2001 of 9 July 2001.

5 On 3 October 2001, the company Atomic Austria GmbH ('the applicant') gave notice of opposition to the application for registration, relying on Article 8(1)(b) of Regulation No 40/94. The opposition was based on five earlier marks consisting of the sign ATOMIC ('the earlier marks') which were the subject of the following registrations in Austria:

— word mark No 75 086, filed on 16 March 1973 and registered on 23 August 1973;

— word mark No 76 640, filed on 8 February 1974 and registered on 15 March 1974;

— word mark No 85 558, filed on 2 March 1977 and registered on 16 May 1977;

— word mark No 97 370, filed on 27 March 1981 and registered on 22 July 1981;

— word mark No 106 849, filed on 28 June 1984 and registered on 10 September 1984.

6 The applicant's opposition was accompanied, in respect of each of the earlier marks, by extracts from the Austrian trade mark register together with an English translation as well as a certificate drawn up by the patent agent who represented the applicant before OHIM, confirming that '... all five trademark registrations are full in force for all goods to be seen from the excerpts and my translation, respectively'. The extracts were dated 19 April 1999.

7 By letter dated 23 November 2001, the Opposition Division of OHIM informed the applicant that its opposition had been communicated to FAMO, and that the applicant was allowed four months, ending on 23 March 2002, to provide any further facts, evidence or arguments it considered necessary to support its opposition.

8 That letter was accompanied by an information sheet on the evidence required to support an opposition ('the information sheet'). Neither the letter nor the information sheet included an explicit request for clearly specified missing documents to be produced.

9 The applicant did not produce any additional supporting documents to justify its opposition within the time allowed.

10 By decision of 9 December 2002, the Opposition Division of OHIM rejected the opposition in its entirety on the ground that the applicant had failed to produce within the specified period evidence of the renewal of the earlier marks, proving their current validity.

11 On 17 January 2003, the applicant filed a notice of appeal against the decision of the Opposition Division of OHIM. The applicant argued that the Opposition Division had failed to take account of the certificate given by the patent agent, that the copy extracts filed contained nothing to suggest that the registrations had expired, and that the Opposition Division should have explicitly requested that the applicant produce the missing documents.

12 By decision of 9 July 2003 ('the contested decision'), the Second Board of Appeal of OHIM dismissed the appeal against the decision of the Opposition Division.

13 The Board of Appeal pointed out that the information sheet which accompanied the letter from OHIM of 23 November 2001 indicated clearly and unequivocally that the renewal of earlier marks had to be proved by a renewal certificate or other equivalent evidence. It held that the certificate confirming the validity of the earlier marks, which was drawn up by the patent agent who represented the applicant before OHIM, could not be accepted as evidence equivalent to an official renewal certificate. Finally, the Board of Appeal stated that the fact that the information sheet had been attached to the letter of 23 November 2001 permitted this case to be distinguished from those cited by the applicant in which the Boards of Appeal had held that the Opposition Division should have sent a supplementary request.

Procedure

14 By a letter dated 27 October 2004, OHIM submitted certain observations on the report for the hearing.

15 On 16 November 2004, following the hearing, the Court invited the parties to make submissions on the legal rules governing the period of protection for trade marks under Austrian law. The applicant and OHIM responded to that request by letters dated 25 November 2004 and 29 November 2004 respectively.

16 Following the parties' responses, the oral procedure was closed on 10 December 2004.

Submissions of the parties

17 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

18 OHIM claims that the Court should:

— dismiss the appeal;

— order the applicant to pay the costs.

Law

19 The applicant puts forward three pleas in support of its action: principally, that the Board of Appeal did not find against the Opposition Division for failing to take account of the evidence the applicant had produced; in the alternative, that the Board of Appeal failed to find that the Opposition Division's failure to draw the applicant's attention to the missing documents constituted a procedural irregularity; and, likewise in the alternative, that the Board of Appeal failed to hold that the Opposition Division's failure to point out the change in its practice was an infringement of the principle of the protection of legitimate expectations.

The first plea: failure by the Opposition Division to take account of the evidence provided

20 The first plea can be divided into two parts. In relation to the first part, the applicant submits that the extracts from the Austrian trade mark register which it had filed constituted sufficient evidence of the validity of the earlier marks. In relation to the second part, the applicant argues, in the alternative, that it had provided such evidence in the form of the certificate drawn up by the patent agent.

21 The first part of this plea should be considered first.

Arguments of the parties

22 The applicant submits that the file accompanying its notice of opposition of 3 October 2001 was complete. According to the applicant, the evidence required under Rule 16(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1) had been provided, since the official extracts from the register in respect of the earlier marks showed that the marks in question were still valid. Indeed, the applicant considers that if protection for the earlier marks had, for example, expired by the time the extracts were issued, the Österreichisches Patentamt (Austrian Patent Office) would have inserted a reference to that effect in the extracts. Given that the extracts submitted by the applicant in relation to the earlier marks did not contain such references, the Opposition Division had no reason to suppose that the registrations were no longer valid.

23 Between the date on which the register extracts were issued and the date on which the notice of opposition was filed, no renewal of the earlier marks was necessary except in respect of trade mark No 97 370. Thus, according to the applicant, there was no need to submit a renewal certificate or equivalent evidence as referred to in the information sheet.

24 At the hearing, the applicant stated that the period of protection for a trade mark according to an official document did not guarantee that the mark would be protected for that precise period. On the one hand, protection could be renewed; indeed, in Austria, renewal can take place within a period which expires only six months after the end of the period of protection. On the other hand, a mark can be cancelled by judicial decision before the end of the period, or the proprietor can surrender his trade mark. The applicant concludes from this that even stating the period of protection is no guarantee that the mark will in fact be protected until the specified date, and that, as a result, the period of protection does not have the same significance as other characteristics of the mark, such as the list of goods and services covered.

25 Furthermore, the applicant stated at the hearing that the Österreichisches Patentamt does not issue certificates specifically for the renewal of a trade mark. That being the case, the applicant decided to prove the validity of the earlier marks by using the register extracts.

26 OHIM recalls that it is for the opponent to provide evidence of the existence of earlier rights on which its opposition is based. Evidence of an earlier mark could also include evidence of its renewal, if applicable. Indeed, if it is not renewed, the mark becomes invalid and can therefore no longer be used to prevent the registration of new trade marks.

27 According to OHIM, it was not possible to determine the date on which protection for the earlier marks ended — an essential aspect of the rights granted by the mark — from the register extracts from the Österreichisches Patentamt in respect of those earlier marks which accompanied the applicant's notice of opposition. In the absence of any specific explanation by the applicant of the period of protection for the earlier marks, OHIM considered that the period was 10 years. That period had expired between 1973 and 1984 in respect of all the earlier marks registered.

28 Suggesting the application (mutatis mutandis) of the principles established in the order of the Court of 17 November 2003 in Case T-235/02 *Strongline* v *OHIM — Scala (SCALA)* [2003] ECR II-4903, OHIM also argues that the other party in the opposition procedure and the Board of Appeal are prevented from verifying with sufficient certainty the legal status and proprietorship of the earlier marks by the fact that the expiry date of the protection period is not apparent from the register extracts. Thus, according to OHIM, the extracts produced are not suitable as the only evidence of the existence of the earlier marks.

29 At the hearing, OHIM added that the extracts submitted by the applicant were out of date when they were submitted to OHIM. It also argued that even if it was impossible for the applicant to submit an official renewal certificate, it could nevertheless have proved the renewal of the earlier marks either by citing the provisions of Austrian law that govern the period of protection for trade marks, or by producing the covering letters from the Österreichisches Patentamt which accompanied the registration certificates for the earlier marks.

30 In addition, OHIM puts forward a number of arguments in support of the first part of the present plea, and thereby the claim for annulment of the contested decision.

Findings of the Court

31 The Court recalls at the outset that, as is apparent from the fifth recital in the preamble to Regulation No 40/94, the Community law relating to trade marks does not replace the laws of the Member States on trade marks. Under the system created by that regulation OHIM must take into account the existence of earlier national marks or rights.

32 Thus, Article 8(1) of that regulation, read in conjunction with Article 8(2)(a)(ii) and (iii), provides that the proprietor of an earlier national or international trade mark which has effect in a Member State may oppose the registration of a Community trade mark in specified circumstances.

33 It follows, in particular, from Article 74(1) of Regulation No 40/94 in fine that in proceedings relating to relative grounds for refusal of registration, the onus is upon the party opposing the registration of a Community trade mark in reliance on an earlier national trade mark, to prove its existence and, as the case may be, the extent of protection.

34 On the other hand, it is for OHIM to examine whether, in the context of opposition proceedings, the conditions for the application of the ground for refusal of registration which has been pleaded have been fulfilled. In that context, it is necessary to assess the correctness of the facts pleaded, and the probative value of the evidence submitted by the parties.

35 OHIM may be called upon to take account, in particular, of the national law of the Member State in which the earlier mark on which the opposition is based is protected. In that case, it must, of its own motion and by whatever means considered appropriate, obtain information about the national law of the Member State concerned, where such information is necessary to assess the applicability of the ground for refusal of registration in question and, in particular, the correctness of the facts pleaded or the probative value of the documents lodged. Restricting the factual basis of the examination by OHIM does not preclude it from taking into consideration, in addition to the facts which have been expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, facts which are likely to be known by anyone or which may be learnt from generally accessible sources (judgment of 22 June 2004 in Case T-185/02 *Ruiz-Picasso and Others* v *OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 29, not appealed on that point).

36 OHIM may also, if it considers it helpful, invite the parties to provide it with guidance on certain specific points of national law. The interested party is not, however, obliged to provide, on its own initiative, general information on the law of intellectual property in force in the Member State concerned.

37 The examination of the facts and evidence submitted to OHIM must be conducted in such a way as to respect the right to a fair hearing of the parties to the opposition proceedings and the right to procedural equity. If an applicant for a Community trade mark doubts the probative value of documents submitted by the opponent to prove the existence of a claimed earlier right, or even the extent of that right, he may say so in the proceedings before OHIM, which is required to consider the relevant observations carefully.

38 However, OHIM cannot avoid conducting a comprehensive assessment of the facts and documents presented to it by arguing that it is for the opponent, on his own initiative, to provide OHIM with supporting evidence in the form of detailed information on the law of the Member State in which there is protection for the earlier mark on which the opposition is based.

39 Furthermore, it must be noted that neither Regulation No 40/94 nor Regulation No 2868/95 specifies a compulsory form of evidence to be lodged by the opponent to prove the existence of his earlier right. Regulation No 2868/95 merely stipulates in Rule 16(2) that 'if the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration'. Furthermore, Article 76(1) of Regulation No 40/94, which relates to the taking of evidence in proceedings before OHIM, provides only a non-exhaustive list of possible measures ('... the means of giving or obtaining evidence shall include the following ...').

40 It follows from this that, on the one hand, an opponent is free to choose the evidence he considers useful to submit to OHIM in support of his opposition and, on the other hand, OHIM is obliged to examine all the evidence submitted to it in order to determine whether it does prove that the earlier mark was registered or filed, and cannot reject out of hand a particular type of evidence on the basis of the form it takes.

41 That conclusion is supported by the variations which exist between administrative practices in Member States. If OHIM could impose conditions as to the form of the evidence to be produced, the result would be that the parties would find it impossible to produce such evidence in certain cases. That would be so in this case, given that the applicant submits, without the point being contested by OHIM, that the Österreichisches Patentamt does not issue official documents to certify the renewal of a mark and that it was not, therefore, in a position to submit such a document.

42 In the present case, the applicant submitted extracts issued by the Österreichisches Patentamt on 19 April 1999. On the five extracts, each one corresponding to an earlier mark, the box marked 'expired on' was empty. Therefore, those documents confirm the validity of the earlier marks on the date of the extracts, which was 19 April 1999. It is also apparent from the extracts that the earlier marks were registered on 23 August 1973 (mark No 75086), 15 March 1974 (mark No 76640), 16 May 1977 (mark No 85558), 22 July 1981 (mark No 97370) and 10 September 1984 (mark No 106849) respectively.

43 In the absence of specific guidance from the applicant, the Board of Appeal assumed that, under Austrian law, the protection period for marks was 10 years from registration. Even if, as is apparent from the national rules of law submitted by the parties at the invitation of the Court, the parties agree that OHIM was correct in its assumption, it should be noted in that respect that OHIM, which is a Community institution specialising in the field of intellectual property and which therefore has a considerable degree of expertise in the subject, should not have been content simply to assume essential facts relating to the protection of earlier marks. First, the Board of Appeal acted in a contradictory fashion in relying, on the one hand, on the presumption of a protection period of 10 years for Austrian trade marks, and in refusing, on the other hand, to apply that presumption fully to the duration of the

protection period when assessing the significance of the register extracts submitted by the applicant. Secondly, it follows from paragraphs 31 to 41 above that the Board of Appeal should have verified the duration of the period for which trade marks are protected in Austria, according to the law of that State.

44 Under Article 19(1) of the Markenschutzgesetz (Law on the Protection of Trade Marks) of 1970, the period for which an Austrian trade mark is protected expires 10 years after the end of the month in which the mark was registered. That period is renewable. In the event of renewal, the new protection period, also 10 years, begins the day after the end of the previous period, regardless of the effective date of renewal.

45 It follows that, for their protection to continue, each of the earlier marks had to be renewed every 10 years. The fact that, as set out in paragraph 42 above, all the earlier marks were valid on 19 April 1999 means that the renewals which should have occurred in 1991 (mark No 97370), 1993 (mark No 75086), 1994 (marks Nos 76640 and 106849) and 1997 (mark No 85558) respectively did indeed occur. It also means that the period of protection was extended until 31 August 2003 for mark No 75086, 31 March 2004 for mark No 76640, 31 May 2007 for mark No 85558, 31 July 2001 for mark No 97370 and 30 September 2004 for mark No 106849.

46 Thus, contrary to the assertions of OHIM, it was possible to determine from the extracts submitted by the applicant the date on which protection for the earlier marks ended, and it was possible, furthermore, to conclude that four of the five earlier marks (the exception being mark No 97370) were valid at the time of the Board of Appeal's decision, 9 July 2003.

47 The fact that the extracts were dated more than 29 months before the date they were presented to OHIM cannot undermine that conclusion. Even if it would have been preferable for the applicant to have provided more recent extracts, the assessment set out in paragraphs 45 and 46 above applies regardless of the age of the extracts. Furthermore, it is not disputed that the status of the five earlier marks did not change between the issue of the extracts and their submission. Finally, it was to cover that last period, which is inevitable when producing official documents, that the applicant's patent agent decided to enclose with the extracts his certificate confirming the continued validity of the earlier marks.

48 It is appropriate also to reject OHIM's argument that in order to prove the renewal of the five earlier marks the applicant could have submitted relevant extracts of Austrian law or the covering letters from the Österreichisches Patentamt which accompanied the registration certificates of the earlier marks.

49 As set out in paragraphs 31 to 41 and 43 above, the applicant was not obliged to submit, on its own initiative, general information on Austrian trade mark law.

50 The covering letters, judging by the one cited as an example by OHIM at the hearing, are phrased in general terms and do no more than reiterate the provisions relating to the period of protection which are contained in the 1970 Markenschutzgesetz. Therefore, the possible submission of those letters has no relevance to this case.

51 Finally, as regards the case-law cited by OHIM in relation to the obligation to produce an adequate translation of the evidence and supporting documents (order in *SCALA*, cited above), the Court notes that, even if the rule that the parties should

be heard means that the other party to the opposition proceedings should be in a position to see the evidence submitted by the applicant in the language of the proceedings, it cannot be interpreted as meaning that the evidence must, by itself, enable that party to verify the existence of the earlier marks, without recourse to the assistance of an adviser or to generally accessible sources of information, beyond the evidence produced.

52 The first part of the first plea must therefore be upheld.

53 Therefore, the contested decision should be annulled without any need to take up the arguments put forward by OHIM in support of the first part of the applicant's first plea, and consequently, without the Court needing to determine their admissibility.

54 The appeal having been upheld on the first plea, it is not necessary to examine the pleas which the applicant submitted in the alternative.

Costs

55 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has been unsuccessful, it must be ordered to pay the costs, as applied for by the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. **Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 9 July 2003 (Case R 95/2003-2);**

2. **Orders the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to pay the costs.**

Pirrung Meij Pelikánová

Delivered in open court in Luxembourg on 20 April 2005.

H. Jung
Registrar

J. Pirrung
President