JUDGMENT OF THE COURT OF FIRST INSTANCE (First Chamber)

31 May 2005 *

In Case T-373/03,

Solo Italia Srl, established in Ossona (Italy), represented by A. Bensoussan, M.-E. Haas and L. Tellier-Loniewski, lawyers, with an address for service in Luxembourg,

applicant,

v

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

defendant,

* Language of the case: French.

the other party to the proceedings before the Board of Appeal of OHIM and intervener before the Court of First Instance being

Nuova Sala Srl, established in Brescia (Italy), represented by E. Gavuzzi, S. Hassan and C. Pastore, lawyers,

APPLICATION brought against the decision of the Second Board of Appeal of OHIM of 10 September 2003 (Case R 208/2003-2), confirming the refusal to register the word mark PARMITALIA,

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

composed of J.D. Cooke, President, I. Labucka and V. Trstenjak, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 12 November 2003,

having regard to the response lodged at the Registry of the Court of First Instance on 18 March 2004,

having regard to the statement in intervention of the intervener lodged at the Registry of the Court of First Instance on 8 March 2004,

further to the hearing on 16 November 2004,

gives the following

Judgment

Background

1 On 14 January 2000, Solo Italia Srl ('the applicant') filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office') 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 trade mark for which registration was sought is the word sign PARMITALIA.

3 The products in respect of which registration was sought are in Class 29 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the description: 'Cheese'.

4 On 26 December 2000, the trade mark application was published in the *Community Trade Marks Bulletin.*

5 On 16 March 2001, Nuova Sala Srl ('the intervener') filed a notice of opposition to the registration of the trade mark applied for, pursuant to Article 8(1)(a) and (b) of Regulation No 40/94, in respect of all the goods referred to in the application for registration. The opposition was based on an earlier Community figurative mark PARMITAL, registered on 1 December 1998, for products in the same class and corresponding to the same description as those referred to in paragraph 3 above.

6 By decision of 26 November 2002, notified to the parties on the same day by fax, the Opposition Division upheld the opposition. It essentially held that the marks in question were visually, phonetically and conceptually similar.

7 On 4 December 2002, the sum of EUR 800 was transferred to the Office's bank account by a French company named OK SA, a company which the Office did not know to be connected with the applicant, under the reference PARMITALIA. Instructions for the transfer had been given on 29 November 2002. In addition, the applicant sent a cheque for EUR 1 375 to its representative for lodging a statement of opposition at the Office. It transpires, however, that the representative did not lodge the statement.

8 On 17 January 2003, the Office's Accounting Department, believing that it was writing to the applicant, sent a letter to a French company named Solo Italia France seeking information as to the purpose of the payment received on 4 December 2002 and stating that a time-limit of one month, expiring on 17 February 2003, had been set for identifying the purpose of the payment, failing which it would be deemed to be of no effect and would then be refunded.

9 On 17 February 2003, the Office received a letter from the applicant, stating that the fee paid related to the appeal brought against the decision of 26 November 2002. That letter was accompanied by a statement of grounds of appeal in French. A translation of that document into the language of the case (English) was lodged on 20 February 2003.

10 On 3 March 2003, the applicant's representative sent to the Office a copy of the payment order of 29 November 2002. On 14 March 2003, the Office was notified of the appointment of a new representative, who lodged fresh submissions on 21 March 2003.

11 On 24 March 2003, the Office notified the applicant of the receipt of its appeal and referred the case to the Board of Appeal. On 14 May 2003, the Office sent the applicant the opponent's submissions of 9 May 2003. The applicant responded to those submissions on 10 June 2003 and the Office acknowledged receipt of its response on 17 June 2003. It sent a further response to the Office on 21 August 2003, receipt of which was confirmed to it on 10 September 2003.

12 By decision of 10 September 2003, served on the applicant on 17 September 2003, the Second Board of Appeal ruled on the appeal and rejected it as inadmissible by reason of the failure to comply with the time-limit laid down under Article 59 of Regulation No 40/94. The Board of Appeal held that the prescribed period had expired on 26 January 2003 and that the communications after that date could not cure the defect in the appeal.

Forms of order sought

13 The parties presented oral argument and answered the questions put to them by the Court at the hearing on 16 November 2004.

14 The applicant claims that the Court should:

— declare this action to be admissible and annul the decision of 10 September 2003;

— order the Office to pay the costs.

15 The Office contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

16 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

17 As the intervener was unable to be present at the hearing, it submitted its observations by fax. With the consent of the applicant and the Office, those observations were added to the Court file.

Law

18 The applicant relies on three pleas in law, based, first, on infringement of Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms ('the ECHR'), second, on infringement of Rules 55, 61 and 65 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 (OJ 1995 L 303, p. 1) and, third, on infringement of Article 59 of Regulation No 40/94.

Admissibility of the first two pleas in law

The first plea: infringement of Article 6 of the ECHR

— Arguments of the parties

19 According to the applicant, Article 6 of the ECHR requires that defendants are to be properly notified of proceedings brought against them. The service of the decision of 26 November 2002 by fax infringed that provision, as it failed to have regard to the requirement that notification be made in a secure manner. As it was invalid, the notification could not have set time running; it follows, according to the applicant,

that the appeal should have been declared admissible. At the hearing, the applicant reiterated that the first plea related to the lack of legal certainty and that a fax which not only had not been signed, but also, as the applicant added, for which the Office provided no form of acknowledgement of receipt, could not guarantee that legal certainty.

20 The Office takes the view that the first plea is inadmissible, on the ground that it does not state adequate reasons and accordingly fails to comply with Article 44(1)(c) of the Rules of Procedure.

21 The Office added at the hearing that the plea based on infringement of Article 6 of the ECHR is, on any basis, inadmissible, as it was not put forward before the Board of Appeal.

— Findings of the Court

22 Before the Board of Appeal, the applicant relied only on its ignorance of the Rules of Procedure of the Office, the absence of a likelihood of confusion between Parmital and Parmitalia, and the argument set out below under the third plea in law, namely that the payment of the fee for appeal was sufficient to render the appeal formally valid.

23 It is therefore not in dispute that the plea based on a potential infringement of Article 6 of the ECHR was at no stage raised by the applicant before the Office and that, accordingly, the latter did not examine it.

24 It should also be pointed out, first, that, under Article 74 of Regulation No 40/94, 'in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties' (Case T-311/01 *Éditions Albert René* v *OHIM — Trucco* (*Starix*) [2003] ECR II-4625, paragraph 69).

25 Second, it must be borne in mind that the purpose of actions before the Court is to obtain a review of the legality of decisions of the Boards of Appeal of the Office within the meaning of Article 63 of Regulation No 40/94 (Case T-237/01 *Alcon* v *OHIM — Dr Robert Winzer Pharma* (*BSS*) [2003] ECR II-411, paragraph 61; Case T-128/01 *DaimlerChrysler* v *OHIM* (*Grille*) [2003] ECR II-701, paragraph 18; Case T-129/01 *José Alejandro* v *OHIM — Anheuser-Busch* (*BUDMEN*) [2003] ECR II-2251, paragraph 67; and *Starix*, paragraph 70). While the Court, under Article 63(3) of Regulation No 40/94, 'has jurisdiction to annul or to alter the contested decision', that paragraph must be construed in the light of Article 63(2), which provides that an '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', and in the context of Articles 229 EC and 230 EC. The Court's review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal (*Starix*, paragraph 70).

26 Furthermore, Article 135(4) of the Rules of Procedure expressly states that '[t]he parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal' (*Starix*, paragraph 71).

27 The applicant cannot therefore call on the Court to rule on the present plea based on a potential infringement of Article 6 of the ECHR, when that plea was not put forward during the administrative phase of the proceedings before the Office.

28 Although the Office did not rely in its written pleadings on the fact that that plea was a new one, but referred to the point only during the hearing, that point is irrelevant to the outcome of the dispute, since the question whether the appeal before the Board of Appeal and the action brought before the Court are based on the same subject-matter is one of public policy, which falls to be examined *ex officio*.

29 The first plea must therefore be rejected as being inadmissible.

The second plea: infringement of Rules 55, 61 and 65 of Regulation No 2868/95

— Arguments of the parties

30 The applicant argues in the alternative that, even if the notification of the decision of the Opposition Division of 26 November 2002 does fall to be treated as having complied with the principles set out in Article 6 of the ECHR, that notification is nevertheless invalid, since it fails to satisfy the conditions laid down under Rules 55, 61 and 65 of Regulation No 2868/95.

31 The applicant states that scrutiny of that notification shows that both the covering letter and the decision are unsigned and that the latter does not bear the seal referred to in Rule 55 of Regulation No 2868/95, as the logo which appears on the first page cannot of itself be the equivalent of the seal which the relevant provisions require.

32 The Office contends that the applicant must also be objecting that the decision of the Board of Appeal, although signed, does not bear a seal either.

33 It maintains that the second plea is inadmissible.

34 It contends that the plea, which in its view concerns the decision of the Opposition Division and which was raised for the first time before the Court, should be declared to be inadmissible, as Article 135(4) of the Rules of Procedure states that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

35 As regards the notification of the decision of the Board of Appeal, a finding of an infringement of the Rules of Procedure would not suffice to annul the contested decision, since irregularities in the procedure for notifying a decision are extraneous to the decision and therefore cannot invalidate it (Case 48/49 *ICI* v *Commission* [1972] ECR 619, paragraph 39; and Joined Cases T-78/96 and T-170/96 *W* v *Commission* [1998] ECR-SC I-A-239 and II-745, paragraph 183). In any event, there has been no infringement of a substantial procedural requirement, since the decision was in fact notified to the applicant, which was not prevented from defending its rights (Case T-323/00 *SAT.1* v *OHIM* (*SAT.2*) [2002] ECR II-2839).

36 Lastly, an applicant has no legitimate interest in the annulment of a decision on the ground of a procedural defect, where annulment of the decision can only lead to the adoption of another decision identical in substance to the decision annulled (see, to that effect, Case 117/81 *Geist* v *Commission* [1983] ECR 2191, paragraph 7; Case T-43/90 *Díaz García* v *Parliament* [1992] ECR II-2619, paragraph 54; Case T-261/97 *Orthmann* v *Commission* [2000] ECR-SC I-A-181 and II-829, paragraphs 33 and 35; and Case T-16/02 *Audi* v *OHIM* (*TDI*) [2003] ECR II-5167).

— Findings of the Court

37 It should be pointed out, first, that a reading of the applicant's second plea in law does not show that the applicant seeks to object to the fact that the decision of the Board of Appeal does not bear a seal. Its application shows that it is in fact the notification of the decision of the Opposition Division of 26 November 2002 that is at issue. On the contrary, the applicant refers to the decision of the Board of Appeal as a model of the correct approach, stating that 'a comparison with the decision of the Board of Appeal of 10 September 2003 is instructive, because, in that case, the documents notified include on the first page, purely by way of identification, the same logo, but, as far as that decision is concerned, both the covering letter and the decision are signed'.

38 As regards the notification of the decision of 26 November 2002, it is not in dispute that the plea based on a potential infringement of Rules 55, 61 and 65 of Regulation No 2868/95 was at no stage raised by the applicant before the Office and that, accordingly, the latter did not examine it.

39 For the reasons set out at paragraphs 24 to 26 above, and as the Office rightly pointed out, the applicant cannot call on the Court to rule on the present plea based on a potential infringement of those rules, when that plea was not put forward during the administrative phase of the proceedings before the Office.

40 Moreover, the applicant did not respond to the Office on that point at the hearing.

41 The second plea must therefore be rejected as inadmissible.

Substance of the third plea in law: infringement of Article 59 of Regulation No 40/94

Arguments of the parties

42 The applicant argues in the further alternative that its payment order of 29 November 2002 clearly informed the Office that it had decided to bring an appeal. It states that it was only on 17 January 2003 that the Office asked the applicant for details as to the purpose of that payment. It then responded to the Office, on 17 February 2003, when it referred to the mistake of its representative, who had failed to proceed as it had instructed him to do.

43 The applicant maintains, as it had already stated to the Office by letter on 21 August 2003, that there is no provision laying down any particular formal requirement for the bringing of an appeal before the Office and that the bank transfer of the sum of EUR 800 made on 4 December 2002 and referring to the PARMITALIA trade mark was clearly identified by the Office as having been submitted by the applicant, as it was the subject of the letter of 17 January 2003.

44 The applicant accordingly takes the view that the payment of the fee renders the appeal formally valid. It adds that the Office acknowledges having collected that amount and identified the sender of the payment.

45 The appeal was accordingly brought in time and should be declared to be admissible, since a statement of grounds was moreover submitted within four months, on 17 and 20 February 2003 and on 21 March 2003, and the defect in the procedure was cured within the prescribed periods.

46 The applicant states lastly that, if the Office has elected to notify its decisions by informal means involving the use of faxes and introduced that flexible method of notification into the appeal procedure, it cannot at the same time restrict the conditions under which those appeals operate and the procedure for *restitutio in integrum* laid down under Article 78 of Regulation No 40/94. The strict interpretation adopted by the Office of the conditions set out in Article 59 of that regulation and of the procedures for the implementation of Article 78 has the result that a party which is the victim of the mistake of its representative is deprived of all remedy, and this did not allow the applicant to defend itself fairly.

47 At the hearing, the applicant stated that in its request for details sent to Solo Italia France — which the applicant described as being a 'good party to speak to' — the Office should have referred to the time-limit of two months and started time running again from the date of that request. Moreover, the fact that the Office did not refund the sum of EUR 800 proves that it considered the appeal to have been properly brought.

48 At the hearing, the applicant also stated that it did not, in fact, seek to have Article 78 of Regulation No 40/94 applied, but that it wished to point out that the procedure of *restitutio in integrum* could not apply to cases where a mistake had been made by a representative.

49 The Office takes the view that, in the light of Rules 48(1)(c) and 49 of Regulation No 2868/95 and of Article 59 of Regulation No 40/94, in order for an appeal to be admissible, it must satisfy the following three cumulative conditions: first, it must be lodged within two months of the date of notification of the decision appealed from, identify the decision which is contested and the extent to which amendment or cancellation of the decision is requested; second, the fee for appeal must be paid within that two-month period; third, a statement setting out the grounds of appeal must be filed within four months of the date of notification of the decision which is contested.

50 Although the point was not the subject of arguments raised by the applicant, the Office also states that the period allowed for rectifying any failure to pay the fee for appeal cannot have the result of extending the period allowed for lodging of the statement.

51 It notes lastly that no application for *restitutio in integrum* was made by the applicant.

52 At the hearing, the Office stated that it had been impossible for it to identify the connection between OK SA and Solo Italia, that the sum of EUR 800 could represent payment in respect of various different fees or applications, that, as the time-limit of two months was mandatory, it was not open to its Accounting Department to extend it, and that that department was unable to inform the applicant that a two-month period was running, since it could not know that a time-limit for bringing an appeal was involved. Generally speaking, it is not for its Accounting Department, which, moreover, has its own computer system, to undertake investigations of that kind; furthermore, even if it had realised that the sum in question represented payment of a fee for appeal, it was not required to warn the applicant of the existence of the time-limit for lodging a notice of appeal.

53 Lastly, as regards *restitutio in integrum*, the Office stated at the hearing that the application of that principle is not in any way excluded where the mistake has been committed by a representative; indeed, two judgments of the Community judicature allow for that possibility.

54 The intervener adds to the Office's arguments that, on the payment order of 29 November 2002, the name of the company 'OK SA' appeared, which would not have

allowed any connection to be made with the company Solo Italia Srl; it points out that the Office moreover sent its request for clarification of 17 January 2003 to an entirely different company, namely 'Solo Italia France', having its registered office in France and not in Italy.

55 The intervener states lastly that, apart from the fact that *restitutio in integrum* is possible under Article 78(2) of Regulation No 40/94 only where a written application is made and payment is made at the same time of the corresponding fee, such an application could not now be made, as the one-year period for doing so has expired.

Findings of the Court

56 Article 59 of Regulation No 40/94 provides that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision appealed from.

57 It must be held in the present case that no written document of that nature was sent to the Office during the prescribed period.

58 While that article provides that the appeal is deemed to be filed only when the fee for appeal has been paid, the mere payment of the corresponding amount cannot be considered to be equivalent to the notice required by the article.

59 Moreover, neither the legislation nor the case-law imposes a duty on the Office and, more particularly, on its Accounting Department to alert potential appellants to a Board of Appeal to the consequences of failure to comply with the formalities laid down by Regulation No 40/94.

60 With regard to *restitutio in integrum*, Article 78 of Regulation No 40/94 does not exclude the application of that principle to cases involving a mistake made by a representative. However, it is necessary for the requirements under it to be satisfied, in particular that all due care required by the circumstances has been taken (see, as regards the error of an assistant employed by an applicant's representative, Case T-146/00 *Ruf and Stier* v *OHIM* (*'Dakota' Image*) [2001] ECR II-1797, paragraphs 55 to 61).

61 As the conditions laid down in Article 59 of Regulation No 40/94 were not complied with in the present case, the third plea must also be rejected and, accordingly, the action dismissed in its entirety.

Costs

62 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 parties' pleadings. Since the applicant has been unsuccessful and OHIM and the intervener have applied for costs, it must be ordered to pay their costs.

On those grounds,

THE COURT OF FIRST INSTANCE (First Chamber)

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Cooke Labucka Trstenjak

Delivered in open court in Luxembourg on 31 May 2005.

H. Jung J.D. Cooke

Registrar President