Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

25 June 2015*

(Community trade mark — Opposition proceedings — Application for Community word mark LUCEA LED — Earlier Community word mark LUCEO — Lack of precedence — Claiming of priority — Priority date entered in the register — Priority documents — Examination by OHIM of its own motion — Rights of the defence)

In Case T-186/12,

Copernicus-Trademarks Ltd, established in Borehamwood (United Kingdom), authorised to replace Verus EOOD, represented initially by S. Vykydal and subsequently by F. Henkel, lawyers,

applicant,

v

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

defendant,

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

Maquet SAS, established in Ardon (France), represented by N. Hebeis, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 13 February 2012 (Case R 67/2011-4), relating to opposition proceedings between Capella EOOD and Maquet SAS,

THE GENERAL COURT (Ninth Chamber),

composed of G. Berardis, President, O. Czúcz (Rapporteur) and A. Popescu, Judges,

Registrar: E. Coulon,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur and pursuant to Article 135a of the Rules of Procedure of the General Court, to rule on the action without an oral procedure,

gives the following

* Language of the case: English.

Judgment

Background to the dispute and the contested decision

1 On 29 July 2009, the intervener, Maquet SAS, 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 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 The trade mark in respect of which registration was sought is the word sign LUCEA LED.

3 The goods in respect of which registration was sought are in Class 10 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: 'surgical lights'.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 31/2009 of 17 August 2009.

5 On 12 November 2009, Capella EOOD filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009, to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

6 The opposition was based on the application for registration No 8554974 of the Community word mark LUCEO of 16 September 2009, designating, inter alia, goods in Class 10 and corresponding to the description 'surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopedic articles; suture materials', together with a priority claim by virtue of a trademark application No 1533/2009, filed with the Österreichisches Patentamt (Austrian Patent Office) on 16 March 2009 for the same goods.

7 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009.

8 By letter of 21 December 2009, entitled 'Invitation to submit priority documents in accordance with Article 30 of Regulation [No 207/2009] and Rule 6 of [Commission Regulation (EC) No 2868/95]' of 13 December 1995 laying down detailed rules for implementing Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), the examiner invited Capella to submit 'exact copies of the application' for the Austrian mark by 22 February 2010 at the latest and stated that, if Capella failed to comply with that request, it would be deprived of the right of priority.

9 By letter of 22 February 2010, Capella submitted a copy of the application for registration of the Austrian mark.

10 On 26 October 2010 the mark on which the opposition was based was registered by the examiner. The examiner accepted the priority which Capella had claimed for that mark and entered 16 March 2009 in the register as the priority date.

11 On 8 November 2010, the Opposition Division upheld the opposition in its entirety and ordered the intervener to pay the costs. The Opposition Division found that the mark on which the opposition was based pre-dated the mark applied for and that there was a likelihood of confusion between them.

12 On 4 January 2011, the intervener filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division. On 7 March 2011, it submitted its statement setting out the grounds of appeal.

13 On 16 August 2011, Capella submitted its observations.

14 On 12 October 2011, the intervener produced the judgment of the Landgericht Mannheim (Mannheim Regional Court, Germany) of 23 September 2011, reference 7 O 186/11, which ordered Capella to pay damages of EUR 1 780.20 to the intervener for having issued an unfounded cease-and-desist request on the basis of the mark on which the opposition was based. In that judgment, the Landgericht Mannheim ruled that Capella had acted abusively. In that regard, it noted in particular that registration of the mark on which the opposition was based had been applied for solely with a view to presenting cease-and-desist requests, and that the registration of the Austrian mark, on which the priority claim was based, had been applied for several times without payment of the filing fee. On 19 October 2011, the intervener produced an English translation of that judgment.

15 On 25 November 2011, the Registry of the Board of Appeal requested Capella to submit its observations on that judgment.

16 Capella submitted its observations on 6 December 2011.

17 By decision of 13 February 2012 ('the contested decision'), the Fourth Board of Appeal of OHIM annulled the decision of the Opposition Division, rejected the opposition and ordered Capella to pay the costs of the opposition and appeal proceedings. It found that the mark on which the opposition was based was not earlier than the mark applied for. In that regard, first, it established that the date on which the mark applied for had been filed was 29 July 2009, whereas that on which the mark on which the opposition was based had been filed was 16 September 2009, which was thus a later date. Next, it noted that the right of priority for the mark on which the opposition was based had not been validly claimed. Capella it stated, had not filed the required priority document and the completed application form submitted by it did not bear any stamp or indication that it had in fact been received by the Österreichisches Patentamt. In addition, the Board of Appeal found that it was entitled to examine the validity of a priority claim in the context of opposition proceedings.

Procedure, facts subsequent to the lodging of the application and forms of order sought

18 By application lodged at the Court Registry on 26 April 2012, Verus EOOD, which, on 6 September 2011, had been entered in the register of Community trade marks as being the proprietor of the mark on which the opposition had been based by Capella, brought the present action.

19 On 27 August 2012, Copernicus-Trademarks Ltd was entered in the register of Community trade marks as the new proprietor of that mark.

20 By order of the General Court (Ninth Chamber) of 23 October 2013, Copernicus-Trademarks was authorised to replace Verus as the applicant.

21 On 13 November 2013, Ivo Kermartin GmbH was entered in the register of Community trade marks as the new proprietor of the mark on which the opposition was based.

22 By letter lodged at the Court Registry on 1 April 2014, the intervener drew the Court's attention to the fact that the mark on which the opposition was based had been transferred from the applicant to Ivo Kermartin.

23 By letter of 14 October 2014, the Court requested the parties to answer questions by way of measures of organisation of procedure pursuant to Article 64 of its Rules of Procedure. The parties complied with those requests within the period prescribed.

24 The applicant, Copernicus-Trademarks, claims that the Court should:

— annul the contested decision and refer the case back to the Board of Appeal;

— order OHIM to pay the costs of the proceedings before the Court and before the Board of Appeal.

25 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order Copernicus-Trademarks to pay the costs.

Law

Admissibility of the action

26 As the intervener has pointed out in its letter of 1 April 2014, the mark on which the opposition was based no longer belongs to the applicant.

27 According to the parties, that fact does not have the consequence of rendering the action inadmissible, as the applicant's interest in bringing proceedings exists by reason of its obligations arising from the contract which forms the basis of the transfer of the mark to Ivo Kermartin.

28 In that regard, suffice it to note that the European Union Courts are entitled to assess, depending on the circumstances of each case, whether the proper administration of justice justifies the dismissal of the action on the merits, without first ruling on its admissibility (judgment of 26 February 2002 in *Council* v *Boehringer*, C-23/00 P, ECR, EU:C:2002:118, paragraphs 51 and 52).

29 In the circumstances of the present case, the Court takes the view that, for reasons of procedural economy, it is appropriate to consider at the outset the merits of the action for annulment, without first ruling on its admissibility, since the action is, in any event and for the reasons set out below, unfounded.

Merits of the action

30 The action is based, in particular, on four pleas in law.

31 The first plea alleges, in particular, infringement of Article 76(2) of Regulation No 207/2009, the second alleges, in particular, infringement of the second sentence of Article 75 of that regulation, the third alleges, in particular, infringement of Rule 6(4) of Regulation No 2868/95, read in conjunction with Decision No EX-05-5 of the President of OHIM of 1 June 2005 concerning the evidence to be provided when claiming priority or seniority, while the fourth plea in law alleges, in particular, infringement of Articles 41 and 42 of Regulation No 207/2009.

32 Moreover, without presenting it independently, the applicant, in essence, also submits a fifth plea in law, to the effect that the Board of Appeal erred in law in basing the contested decision on the finding that Capella had acted in bad faith when it lodged the application for the mark on which the opposition was based, whereas, first, in the context of opposition proceedings, such a circumstance cannot be taken into account, and, second, Capella had not acted in bad faith.

33 The Court considers it useful first to examine the first plea in law and then to examine the fourth, third, second and fifth pleas.

The first plea in law

34 The applicant submits that the Board of Appeal infringed Article 76(2) of Regulation No 207/2009 by examining whether Capella had filed the document required in support of its priority claim for the mark on which the opposition was based. Such a claim had not been made by the intervener, which confined itself to alleging that Capella had acted in bad faith. The applicant also submits that the priority date which the examiner entered in the register cannot be called into question in the context of opposition proceedings.

35 OHIM and the intervener dispute that argument.

36 In this regard, in the first place, it should be recalled that, under Article 76(1) of Regulation No 207/2009, OHIM examines facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, its examination is restricted to the facts, evidence and arguments provided by the parties. Article 76(2) of that regulation provides that OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

37 In the second place, it should be recalled that, even in proceedings relating to relative grounds for refusal, Article 76(2) of Regulation No 207/2009 does not preclude the Board of Appeal from examining certain matters of its own motion. Issues of law which require to be resolved in order to ensure a correct application of Regulation No 207/2009 having regard to the facts, evidence and arguments presented by the parties must be ruled on by OHIM, even when they have not been raised by the parties (judgment of 1 February 2005 in *SPAG* v *OHIM — Dann and Backer (HOOLIGAN)*, T-57/03, ECR, EU:T:2005:29, paragraph 21).

38 In the present case, Capella filed a notice of opposition to registration of the mark applied for on the basis of Article 41(1)(a) and Article 8(1)(b) of Regulation No 207/2009. Under those provisions, the proprietor of an earlier mark may seek refusal to register a mark applied for if there is a likelihood of confusion between those marks.

39 In opposition proceedings, the existence of relative grounds for refusal within the meaning of Article 8 of Regulation No 207/2009 presupposes that the mark on which the opposition is based exists and pre-dates the mark applied for. These are factors which must therefore be examined by OHIM of its own motion and cannot be left to the free assessment of the parties (see, to that effect, judgment of 17 June 2008 in *El Corte Inglés* v *OHIM — Abril Sánchez and Ricote Saugar (BoomerangTV)*, T-420/03, ECR, EU:T:2008:203, paragraph 77).

40 It follows that, in the present case, even if the intervener has not contested the claim for priority for the mark on which the opposition was based, Article 76 of Regulation No 207/2009 would not have prevented the Board of Appeal from examining, of its own motion, whether that claim was well founded.

41 In the third place, it must be noted that, in any event, contrary to what the applicant argues, the intervener did not, in the proceedings before OHIM, confine itself to alleging that Capella had acted in bad faith but also disputed the priority claim for the mark on which the opposition was based and therefore its precedence as pre-dating the mark applied for. In its statement of grounds of 7 March 2011, the intervener argued that the priority claim for the mark on which the opposition was based was vitiated by a number of errors and that only the date of the application for registration of that mark, namely 16 September 2009, could therefore be taken into account. In that context, the intervener stated, inter alia, that that claim was based on the application for an Austrian mark and that Capella had paid the filing fee for that mark to the Österreichisches Patentamt only after it had lodged its application for registration of a Community trade mark.

42 It follows that the argument alleging infringement of Article 76(2) of Regulation No 207/2009 must be rejected.

43 Accordingly, the first plea in law must be rejected, subject to the head of claim alleging that, in the context of opposition proceedings, a Board of Appeal has no right to call into question a priority date entered in the register, which will be examined in the context of the analysis of the fourth plea in law.

The fourth plea in law

44 The applicant submits that, in the present case, the precedence of the mark on which the opposition was based was established by reason of the priority date of 16 March 2009 entered in the register. In its view, the Board of Appeal's finding that, in the context of opposition proceedings, it was entitled to examine the validity of the priority claim is erroneous. In the context of such proceedings, the Board of Appeal does not have the right to call into question the validity of information entered in the register. Therefore, in the applicant's view, by not limiting itself to accepting the date of 16 March 2009 entered in the register, but by examining whether, in the present case, the conditions for the priority claim laid down in Articles 29 and 30 of Regulation No 207/2009, in Rule 6 of Regulation No 2868/95 and in Articles 1 and 2 of Decision No EX 05-5 were satisfied, the Board of Appeal infringed Articles 41 and 42 of Regulation No 207/2009.

45 OHIM and the intervener dispute those arguments.

46 In that regard, in the first place, it should be borne in mind that, in the present case, the date of filing of the application for registration of the mark on which the opposition is based, namely 16 September 2009, post-dates that of the mark applied for, namely 29 July 2009. The precedence of the mark on which the opposition is based therefore depends on the merits of the claim that 16 March 2009 is the priority date.

47 In the second place, as regards the question of whether a Board of Appeal is required to base itself on the priority date which the examiner has entered in the register, without being able to examine whether the conditions for the priority claim are satisfied, first of all, it should be recalled that, in the context of opposition proceedings, OHIM is, in principle, required to assess the correctness of the facts pleaded and the probative value of the evidence submitted by the parties (see, to that effect, judgment of 20 April 2005 in *Atomic Austria* v *OHIM — Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, T-318/03, ECR, EU:T:2005:136, paragraphs 34 and 35).

48 That principle, however, has limits. Thus, as the applicant correctly submits, the validity of a Community trade mark on which an opposition is based cannot be called into question in the context of opposition proceedings. When a trade mark applicant facing an opposition based on a Community trade mark wishes to challenge the validity of that Community mark, it is required to do so in the context of invalidity proceedings before OHIM (see, to that effect, judgment of 13 April 2011 *in Bodegas y Viñedos Puerta de Labastida* v *OHIM — Unión de Cosecheros de Labastida (PUERTA DE LABASTIDA)*, T-345/09, EU:T:2011:173, paragraph 65).

49 However, contrary to what the applicant claims, that case-law, which concerns the validity of a Community trade mark on which an opposition is based, cannot be transposed to a claim for priority in respect of such a mark.

50 In that context, first of all, it should be noted that the entry in the register of a priority date for a Community trade mark cannot, or at least cannot effectively, be challenged in the context of invalidity proceedings. First, this does not concern an absolute ground for invalidity within the meaning of Article 52 of Regulation No 207/2009. Second, Article 53 of Regulation No 207/2009, which governs relative grounds for invalidity, does not allow for an effective challenge to the priority date which the

examiner has entered in the register. It is, admittedly, true that, under Article 53(1)(a), a declaration of invalidity of a registered trade mark may be applied for when there is a likelihood of confusion between that mark and an earlier mark within the meaning of Article 8(1) of that regulation. It should also be noted that, according to Article 8(2)(b) of Regulation No 207/2009, trade mark applications may constitute 'earlier trade marks' for the purposes of Article 8(1). However, Article 8(2)(b) of Regulation No 207/2009 states that that is the case 'subject to their registration.' It follows that applications for a declaration of invalidity of a registered mark which are based on applications for registration can be blocked by an opposition based on that registered mark and covering those applications for registration. Consequently, in the present case, an application for a declaration of invalidity of the mark on which the opposition is based cannot be regarded as an effective action for the purpose of challenging the priority claim made in respect of that mark.

51 Next, it is appropriate to note that there is no other specific procedure which, first, allows a third party to challenge the priority date entered in the register for a Community trade mark and, second, can be compared to invalidity proceedings, one of the features of which is that they cannot be opened by OHIM of its own motion.

52 First, an appeal within the meaning of Articles 58 to 61 of Regulation No 207/2009 does not constitute such proceedings. Under Article 59 of that regulation, only the parties to the proceedings which have led to a decision by OHIM's divisions may appeal against that decision before the Boards of Appeal. The applicant for a separate Community trade mark will not generally be a party to the procedure for registration of a Community trade mark on which the opposition to its application is based and will therefore be unable to dispute the priority claim in respect of that latter mark by way of an action. Thus, in the present case, the intervener was unable to bring proceedings before OHIM to challenge the examiner's decision regarding the priority of the mark on which the opposition to its application for a Community trade mark was based.

53 Secondly, as regards the proceedings, invoked by the applicant for cancellation or revocations, which are provided for in Article 80 of Regulation No 207/2009, read in conjunction with Rule 53a of Regulation No 2868/95, or those allowing corrections, which are provided for in Rules 27 and 53 of Regulation No 2868/95, suffice it to note that these cannot, in any event, be compared to invalidity proceedings, as OHIM can open of its own motion cancellation, revocation or correction proceedings within the meaning of those provisions, whereas such a possibility does not exist in respect of invalidity proceedings. Moreover, as regards cancellation or revocation proceedings under Article 80 of Regulation No 207/2009, assuming that they were applicable in the present case, it should be noted that, under Article 80(2), these may be requested only by a party to the proceedings which led to the decision at issue. However, as was stated in paragraph 52 above, the applicant for a Community trade mark will not generally be a party to the procedure for registration of the other Community trade mark on which the opposition to its application is based. As regards the procedures for correction within the meaning of Rule 27 of Regulation No 2868/95, assuming that they were applicable to the present case, it must be stated that Rule 27 merely provides that OHIM is to correct an error of its own motion or at the request of the proprietor.

54 It follows that the case-law mentioned in paragraph 48 above, according to which the validity of a Community trade mark cannot be challenged in the context of opposition proceedings, cannot be transposed to the dispute as to whether a priority claim for such a mark is well founded.

55 Consequently, contrary to what the applicant submits, the Board of Appeal did not, in the present case, err in examining whether the conditions for the priority claim laid down in Articles 29 and 30 of Regulation No 207/2009, in Rule 6 of Regulation No 2868/95 and in Articles 1 and 2 of Decision No EX-05-5 were satisfied.

56 It follows that the fourth plea in law must be rejected in so far as the applicant alleges that the Board of Appeal infringed Articles 41 and 42 of Regulation No 207/2009 by examining whether the conditions for the priority claim had been satisfied. The head of claim raised by the applicant as part of the first plea in law alleging that, in the context of opposition proceedings, the Board of Appeal has no right to call into question a priority date entered in the register (see paragraph 43 above), must also be rejected.

57 To the extent to which, by certain arguments put forward in the context of the fourth plea in law, the applicant again disputes the fact that the question as to whether the priority claim was well founded formed part of the subject-matter of the dispute before the Board of Appeal, those arguments must be rejected for the reasons set out in the examination of the first plea in law.

58 The first and fourth pleas in law must accordingly be rejected in their entirety.

The third plea in law

59 By the third plea in law, the applicant calls into question the Board of Appeal's conclusion that Capella did not file the document required to demonstrate that the priority claim for the mark on which the opposition was based was well founded. The applicant takes the view that, in the present case, the requirements laid down in Rule 6(4) of Regulation No 2868/95, read in conjunction with Decision No EX-05-5, were satisfied.

60 OHIM and the intervener take issue with those arguments.

61 In that regard, first, it should be recalled that Article 29(1) of Regulation No 207/2009 provides that a person who has duly filed an application for a trade mark in or in respect of any State party to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised and amended, or to the Agreement establishing the World Trade Organisation (WTO), or his successors in title, is to enjoy, for the purpose of filing a Community trade mark application for the same mark in respect of goods or services which are identical with or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application. Under Article 29(2), every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements is to be recognised as giving rise to a right of priority. It follows from Article 29(3) that a regular national filing is meant to refer to any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application. Article 29(4) provides that a subsequent application for a trade mark which was the subject of a previous first application in respect of the same goods or services and which is filed in or in respect of the same State is to be regarded as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

62 Under the first sentence of Article 30 of Regulation No 207/2009, entitled 'Claiming priority', an applicant desiring to take advantage of the priority of a previous application must file a declaration of priority and a copy of the previous application.

63 Under Rule 6(1) of Regulation No 2868/95, where the priority of one or more previous applications, within the meaning of Article 29 of Regulation No 207/2009, is claimed in the application pursuant to Article 29 of Regulation No 207/2009, the applicant is required to indicate the file number of the previous application and to file a copy of it within three months from the filing date. According to Rule

6(1) of Regulation No 2868/95, the copy must be certified to be an exact copy of the previous application by the authority which received it and must be accompanied by a certificate issued by that authority stating the date on which the previous application was filed.

64 Under Rule 6(4) of Regulation No 2868/95, the President of OHIM may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to OHIM from other sources.

65 On the basis of that provision, first, the President of OHIM adopted Decision No EX-05-5, Article 1 of which, entitled 'Substitution of priority certificates by information from [Internet sites]', provides:

'The evidence to be provided by the applicant when claiming priority may consist of less than what is required under Rule 6 (1) of … Regulation No 2868/95, provided that the information required is available to [OHIM] from a[n] [Internet site] of a central industrial property office of a State party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organisation.'

66 Article 2 of that decision, entitled 'Procedure', reads as follows:

'(1) Where priority is claimed, and where the documents referred to in Rule 6(1) of … Regulation No 2868/95 have not already been submitted by the applicant, [OHIM] will verify of its own motion whether information on the file number, the filing date, the name of the applicant or proprietor, the representation of the mark and the list of goods and services of the earlier trade mark application the priority of which is claimed is available on the [Internet site] of the central industrial property office of the State in or for which that earlier trade mark application is claimed to have been filed.

(2) Where the required information is available to [OHIM] on such [Internet site], [OHIM] will make a note to this extent in the file of the Community trade mark application. Otherwise, [OHIM] will issue an invitation pursuant to Rule 9(3)(c) of … Regulation No 2868/95 to furnish the documents referred to in Rule 6(1) of … Regulation No 2868/95.'

67 On the basis of Rule 6(4) of Regulation No 2868/95, second, the President of OHIM adopted Decision No EX-03-5 of 20 January 2003 concerning the formal requirements of a priority or seniority claim, Article 1 of which, entitled 'Priority documents for Community trade marks', provides:

'The applicant for a Community trade mark may file the documents in support of a priority claim issued by the authority which received the previous application as provided for in Rule 6(1) of … Regulation No 2868/95 ("priority document") in the original or in the form of an accurate photocopy. …'

68 It is in the light of those provisions that the applicant's arguments seeking to demonstrate that Capella submitted the required priority document must be examined.

69 In the first place, the applicant submits that the information required by Articles 1 and 2 of Decision No EX-05-5 were available on the Internet site of the Österreichisches Patentamt.

70 OHIM and the intervener take issue with that contention.

71 In that regard, it should be borne in mind that, under Article 2 of Decision No EX-05-5, the list of goods and services in the application for the mark on which the priority claim is based forms part of the information which must be available on the Internet site of the office at issue when the validity of the priority claim is examined. In the present case, it is therefore appropriate to examine whether the

list of services and goods for which registration of the Austrian mark had been sought was available on the Internet site of the Österreichisches Patentamt at the time when the examiner examined the priority claim for the mark on which the opposition was based.

72 The applicant submits that that information was available on the Internet site of the Österreichisches Patentamt. However, the intervener, which disputes that claim, produced a notification of 29 April 2013 from the Österreichisches Patentamt which shows that, in 2009, and thus at the time when the examiner examined the priority claim for the mark on which the opposition was based, two sources of information existed with regard to Austrian marks, namely, first, a free search engine accessed through the Österreichisches Patentamt's Internet site and, second, a search engine of a private undertaking controlled by that office. It is also apparent from that notification that, as the application for registration of an Austrian mark was unsuccessful, neither the free search engine accessible through the Österreichisches Patentamt's Internet site nor the search engine of the undertaking controlled by that office provides access to the detailed list of goods and services, but only to the numbers of the classes in respect of which registration had been sought.

73 In response to a question put by the Court, the applicant stated that the application for registration of an Austrian trade mark on which the priority claim is based was not successful and that no Austrian mark has therefore been registered.

74 In view of those circumstances and the fact that the applicant has not put forward any argument capable of calling into question the credibility of the document submitted by the intervener, the Court considers that it has been established to the requisite legal standard that, at the time when the examiner analysed the soundness of the priority claim for the mark on which the opposition was based, the exact list of goods and services for which registration of the Austrian mark had been sought was not available either on the Österreichisches Patentamt's Internet site or on the site of the private undertaking controlled by that office.

75 Accordingly, the Board of Appeal did not err in concluding that, in the present case, the conditions laid down in Articles 1 and 2 of Decision No EX-05-5 had not been satisfied, without it being necessary to rule on the question whether the abovementioned search engine offered by the private undertaking controlled by the Österreichisches Patentamt could be considered to be part of that office's Internet site within the meaning of those provisions. Therefore, to the extent to which it alleges an infringement of those provisions, the present plea in law must be rejected.

76 In the second place, the applicant submits that when, on 21 December 2009, the examiner called on Capella, in accordance with Article 2(2) of Decision No EX-05-5, to produce exact copies of the application for the Austrian mark relied on in support of the priority claim, it submitted the document required. The applicant contends that, under Article 1 of Decision No EX-03-5, it is sufficient to submit an accurate copy of the trade-mark application.

77 In that regard, it is clear from Article 2(2) of Decision No EX-05-5 that the required information which is not available on the Internet site of the office at issue must, in principle, be submitted in the form of the document referred to in Rule 6(1) of Regulation No 2868/95, that is to say, in the form of a copy certified to be an exact copy of the previous application by the authority which received that application, accompanied by a certificate issued by that authority stating the date on which the previous application was filed.

78 The applicant is, admittedly, correct in its submission that Article 1 of Decision No EX-03-5 lessens those requirements, since it merely requires an accurate copy of the priority document within the meaning of Rule 6(1) of Regulation No 2868/95. However, contrary to what the applicant submits, it cannot be inferred from that provision that a copy of the application form for registration completed by Capella meets those requirements. Even if the copy of the priority document need not be certified by the authority with which the application was filed, it must none the less be a document from

which the examiner must be able to determine whether and when the application for the trade mark was received by the office concerned. The copy of the application form for registration submitted by Capella did not, however, record that it had been received by the Österreichisches Patentamt.

79 Accordingly, the Board of Appeal's conclusion that Capella did not submit the required priority documents is not flawed.

80 In the third place, it is necessary to reject the applicant's argument that it has been, and remains, normal practice for OHIM's examiners to accept copies of applications for registration such as that submitted by Capella. In this regard, suffice it to note that the decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal of OHIM are called on to take under Regulation No 207/2009 are adopted in the exercise of circumscribed powers and are not a matter of discretion (judgments of 26 April 2007 in *Alcon* v *OHIM*, C-412/05 P, ECR, EU:C:2007:252, paragraph 65, and of 24 November 2005 in *Sadas* v *OHIM — LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, ECR, EU:T:2005:420, paragraph 71). Accordingly, the legality of the contested decision must be assessed solely on the basis of the applicable provisions, as interpreted by the EU Courts, and not on the basis of what may be OHIM's previous decision-making practice.

81 In so far as the applicant, by invoking the principle of legitimate expectations, also seeks to argue that, before departing from OHIM's normal practice, the Board of Appeal ought to have informed Capella of its doubts concerning the documents which Capella had submitted, that argument will be examined in the context of the second plea in law.

82 In the fourth place, as regards the applicant's argument that it would have been possible, for the examiner, to request notification from Österreichisches Patentamt of the exact list of goods and services in respect of which registration of an Austrian mark had been sought, suffice it to state that it is clear from Articles 1 and 2 of Decision No EX-05-5 and from Rule 6(1) of Regulation No 2868/95 that, with the exception of the situation in which the required information is available on the Internet site of the office with which the application was filed, the onus is on the applicant which claims a right of priority for a mark to submit the priority documents required. There is no relevant provision that provides that, if the required information is not available on the Internet site of the authority with which the application was filed, it is for the examiner to contact that office directly. On the contrary, in that case, if necessary, after having been invited by the examiner pursuant to Article 2(2) of Decision No EX-05-5 and Rule 9(3)(c) of Regulation No 2868/95, as was the case here, it is up to the applicant itself to submit those documents.

83 That head of claim must therefore be rejected, without it being necessary to rule on the question of whether, having regard to the fact that it was put forward for the first time as part of a response by the applicant to a question put by the Court, it can be considered to be admissible.

84 Consequently, the third plea in law must be rejected, subject to the examination of the head of claim – assuming that it was raised – alleging that, because of its legitimate expectation based on OHIM's normal practice, the Board of Appeal ought to have informed Capella of its doubts regarding the documents which Capella had submitted (see paragraph 81 above).

The second plea in law

85 The applicant submits that the Board of Appeal infringed the second sentence of Article 75 of Regulation No 207/2009 when it concluded that Capella had not submitted the priority documents required, without having previously invited it to state its position in that regard. It is true that, by decision of 25 November 2011, the Registry of the Board of Appeal invited Capella to submit its observations on the intervener's letter of 12 October 2011. However, as the claimed priority date had been accepted and entered in the register by the examiner, and as the intervener did not dispute the

priority claim, Capella had no reason to assume that the Board of Appeal might call that matter into question. Moreover, in the absence of an indication from the Board of Appeal, Capella could not have imagined that the Board of Appeal it would not be satisfied by the examiner's analysis, which corresponded to OHIM's normal practice. Consequently, in the applicant's view, the Board of Appeal should have informed Capella of its doubts.

86 OHIM and the intervener contest those arguments.

87 At the outset, it should be noted that, by the present plea in law, the applicant submits, in essence, that the Board of Appeal should have informed Capella of its doubts as to whether the documents which Capella had submitted were sufficient. In that context, it is necessary to examine not only the arguments directly alleging infringement of the second sentence of Article 75 of Regulation No 207/2009 and those alleging infringement of the principle of legitimate expectations, but also whether the error committed by the examiner was such as to impose an obligation on the Board of Appeal to inform Capella of its doubts.

– The arguments relating to the second sentence of Article 75 of Regulation No 207/2009

88 In this regard, first of all, it should be pointed out that, according to the wording of the second sentence of Article 75 of Regulation No 207/2009, decisions of OHIM may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

89 Next, as regards the head of claim alleging that Capella could not have expected that the Board of Appeal would depart from the priority date that the examiner had entered in the register, suffice it, first, to bear in mind that, in the context of opposition proceedings, the Board of Appeal is required to consider whether the mark on which the opposition was based is earlier than the mark applied for (see paragraphs 37 to 40 above) and, in that context, where appropriate, it is also required to examine whether the conditions governing the priority claim are satisfied (see paragraphs 46 to 55 above). Secondly, it should be noted that, in the present case, in its statement of grounds of 7 March 2011, the intervener disputed the priority claim for the mark on which the opposition was based and therefore its precedence in relation to the mark applied for (see paragraph 41 above). Consequently, that question formed part of the dispute brought before the Board of Appeal and, even in the absence of an express indication by the Board of Appeal, Capella had to expect that the examiner's conclusion regarding the priority claim for the mark on which the opposition was based would be reviewed by the Board of Appeal.

90 In that context, it should also be noted that Capella was authorised to submit observations on the intervener's statement of grounds of 7 March 2011 and it even had another opportunity to state its position in that regard when the Board of Appeal invited it, on 25 November 2011, to submit its observations in response to the intervener's observations of 12 and 19 October 2011 regarding the judgment of the Landgericht Mannheim of 23 September 2011 (see paragraph 14 above).

91 Furthermore, the Board of Appeal was not obliged to inform Capella that it was not going to confirm the examiner's conclusion as to the soundness of the priority claim. The right to be heard within the meaning of the second sentence of Article 75 of Regulation No 207/2009 extends to the factual or legal factors on which the decision-making act is based, but not to the final position which the administration intends to adopt (judgment of 7 September 2006 in *L & D* v *OHIM — Sämann (Aire Limpio)*, T-168/04, ECR, EU:T:2006:245, paragraph 116).

92 Accordingly, the arguments alleging infringement of the second sentence of Article 75 of Regulation No 207/2009 must be rejected.

– The arguments relating to the principle of legitimate expectations

93 In this regard, first, in so far as the applicant relies on legitimate expectations in the entries in the register, suffice it to note that, by reason of what is set out in paragraph 89 above, the applicant could not exclude the possibility that the Board of Appeal might examine the validity of the priority claim.

94 Second, in so far as the applicant also seeks to rely on the contention that, before departing from OHIM's normal practice, under which documents such as those which Capella had submitted have been accepted as priority documents, the Board of Appeal ought to have informed Capella of its doubts, it should be noted that the applicant does not put forward any evidence capable of demonstrating the existence of such a practice. The documents which the applicant submits in support of its argument are letters in which OHIM's examiner invited Capella to submit the priority documents 'in accordance with Article 30 of Regulation No 207/2009 and Rule 6 of Regulation No 2868/95' and in some of which the examiner stated that, pursuant to Decision No EX-03-5, certified copies were not necessary. It does not, however, follow from either that information or the provisions to which the examiner referred that a completed application form for registration from which it cannot be inferred whether and when it was received by the office at issue, can be regarded as being an adequate priority document for the purposes of Rule 6(1) of Regulation No 2868/95 and Article 1 of Decision No EX-03-5 (see paragraph 78 above).

95 The Court accordingly rejects the arguments alleging infringement of the principle of legitimate expectations, without it being necessary to rule on the admissibility of the documents produced in support of those arguments, which the applicant submitted after the application and the reply as part of a response to a question from the Court.

– The consequences resulting from the error committed by the examiner

96 Even if, by its arguments, the applicant also seeks to rely on the submission that, because of the error committed by the examiner, the Board of Appeal ought to have informed Capella of its doubts, these must also be rejected.

97 In this regard, first of all, it must be stated that, in the present case, the examiner's error was limited to the incorrect conclusion that the documents submitted by Capella satisfied the requirements laid down in Article 1 of Decision No EX-03-5.

98 In the present case, that error on the part of the examiner did not oblige the Board of Appeal to invite Capella to present its comments specifically on that issue or to inform it of its doubts in that regard, since, by reason of what is set out in paragraphs 89 to 91 above, the question whether the examiner's conclusion concerning the priority claim was wrong had been raised by the intervener.

99 Next, if, by its arguments, the applicant seeks to avail itself of the contention that, because of the examiner's error, Capella was unable to submit the documents required, that head of claim must also be rejected.

100 The fact remains that the examiner's error did not in any way limit the possibilities open to Capella to submit the priority documents required, but that, in that regard, the examiner complied in full with the procedure laid down by the relevant provisions.

101 As is apparent from Articles 1 and 2 of Decision No EX-05-5, the onus was, in principle, on Capella to examine whether the required information was available on the Internet site of the Österreichisches Patentamt and, if that was not the case, to submit the priority document required. This reading is confirmed by the twelfth recital in the preamble to that decision, which states that 'the applicant himself is in a position to verify, when claiming priority or seniority, whether the required information

is available on a Website so that he knows in advance whether he needs to furnish a priority or seniority document'. As was stated in paragraphs 76 to 79 above, Capella did not, however, submit the document required.

102 In accordance with Rule 9(3)(c) of Regulation No 2868/95, the examiner, by letter of 21 December 2009, requested Capella to submit the priority document required by Rule 6(1) of Regulation No 2868/95 by 22 February 2010 at the latest, while specifying that, by virtue of Article 1 of Decision No EX-03-5, it was sufficient to submit an accurate copy and that, in the event that Capella did not comply with that request, it would be deprived of the right of priority. As has been stated in paragraphs 76 to 78 above, the document which Capella submitted on 22 February 2010, that is to say, on the last day of the period prescribed for it by the examiner, was not the priority document required.

103 In those circumstances, the onus was not on the examiner to re-invite Capella to submit the document required. On the contrary, as is clear from Rule 9(6) of Regulation No 2868/95, if the priority document requested has not been lodged within the period allowed by the examiner, the party concerned loses the right of priority claimed.

104 Consequently, in the circumstances of the present case, the error committed by the examiner did not oblige the Board of Appeal to inform Capella of its doubts as to the validity of the priority claim for the mark on which the opposition was based.

105 Accordingly, none of the circumstances relied on by the applicant placed an obligation on the Board of Appeal to inform Capella of its doubts and to invite it to state its position in that regard.

106 Moreover, and in any event, even if such an obligation existed, its infringement could not be capable of leading to annulment of the contested decision.

107 In that context, it should be borne in mind that applicants have 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 (judgments of 3 December 2003 in *Audi* v *OHIM (TDI)*, T-16/02, ECR, EU:T:2003:327, paragraphs 97 to 99, and of 12 December 2007 in *DeTeMedien* v *OHIM (suchen.de)*, T-117/06, EU:T:2007:385, paragraph 49).

108 In the present case, even if the Board of Appeal had informed Capella of its doubts concerning the priority claim and Capella had submitted the priority document required during the opposition proceedings, that would not have been such as to change the operative part of the decision which the Board of Appeal would have been required to adopt. Since Capella had not filed that document within the period prescribed, even though its procedural rights had been fully guaranteed, the Board of Appeal would in any event have had to find that the priority right had been forfeited pursuant to Rule 9(6) of Regulation No 2868/95.

109 Accordingly, it is also necessary to reject the second plea in law and the heads of claim concerning infringement of the principle of legitimate expectations put forward in the third plea in law.

The fifth plea in law

110 It follows that it is also necessary to reject the fifth plea in law, which alleges that, in the contested decision, the Board of Appeal took account of Capella's bad faith, even though such a matter cannot be taken into account in opposition proceedings. As is clear from the foregoing, since the contested decision is based on the finding that the mark applied for was earlier than the mark on which the opposition was based, the priority claim for the latter mark had to be rejected.

111 In view of all of the foregoing considerations, the action must therefore be dismissed in its entirety.

Costs

112 Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it 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 (Ninth Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders Copernicus-Trademarks Ltd to bear its own costs and to pay the costs incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and by Maquet SAS.**

Berardis Czúcz Popescu

Delivered in open court in Luxembourg on 25 June 2015.

[Signatures]