Reports of Cases

JUDGMENT OF THE COURT (Second Chamber)

18 October 2012 *

(Appeal — Community trade mark — Opposition — Regulation (EC) No 2868/95 — Rule 18(1) — Legal nature of a communication from OHIM informing a party that an opposition has been found to be admissible — Right to an effective legal remedy)

In Case C-402/11 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 25 July 2011,

Jager & Polacek GmbH, established in Vienna (Austria), represented by A. Renck, Rechtsanwalt,

appellant,

the other party to the proceedings being:

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

defendant at first instance,

THE COURT (Second Chamber),

composed of A. Rosas U. Lõhmus, acting as President of the Second Chamber, U. Lõhmus, T. von Danwitz, A. Arabadjiev and C.G. Fernlund (Rapporteur), Judges,

Advocate General: Y. Bot,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 24 May 2012,

after hearing the Opinion of the Advocate General at the sitting on 5 July 2012,

gives the following

Judgment

1 By its appeal, Jager & Polacek GmbH ('Jager & Polacek') seeks to have set aside the judgment of the General Court of the European Union of 12 May 2011 in Case T-488/09 *Jager & Polacek* v *OHIM (REDTUBE)* ('the judgment under appeal'), by which that court dismissed its action for annulment of

* Language of the case: German.

the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 29 September 2009 (Case R-442/2009-4) ('the contested decision') concerning opposition proceedings between that company and RT Mediasolutions s.r.o. ('RT Mediasolutions').

2 By the contested decision, the Fourth Board of Appeal of OHIM rejected the application for annulment of the decision of 22 January 2009 by which the Opposition Division found that notice of opposition No B 1 299 033 lodged by Jager and Polacek was to be treated as not having been duly entered.

Legal context

3 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Nevertheless, in view of the time at which the events in question occurred, the present case remains governed by Regulation No 40/94, as amended by Council Regulation (EC) No 1891/2006 of 18 December 2006 (OJ 2006 L 386, p. 14) ('Regulation No 40/94').

4 The rules implementing Regulation No 40/94 are laid down by Commission Regulation (EC) No 2868/95 of 13 December 1995 (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 1995 L 172, p. 4) ('the Implementing Regulation').

Regulation No 40/94

5 Article 42 of Regulation No 40/94, entitled 'Opposition', is worded as follows:

'1. Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:

...

(c) by the proprietors of earlier marks or signs referred to in Article 8(4) and by persons authorised under the relevant national law to exercise these rights.

...

3. Opposition must be expressed in writing and must specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by [OHIM], the opponent may submit in support of his case facts, evidence and arguments.'

6 Article 57 of Regulation No 40/94, entitled 'Decisions subject to appeal', provides as follows:

'1. An appeal shall lie from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Divisions and Cancellation Divisions. It shall have suspensive effect.

2. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.'

7 Article 77a of Regulation No 40/94, entitled 'Revocation of decisions', is worded as follows:

'1. Where [OHIM] has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to [OHIM], it shall ensure that the entry is cancelled or the decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.

2. Cancellation or revocation as referred to in paragraph 1 shall be determined, *ex officio* or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. Cancellation or revocation shall be determined within six months from the date on which the entry was made in the Register or the decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the Community trade mark in question that are entered in the Register.

3. This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 57 and 63, or to the possibility, under the procedures and conditions laid down by the [Implementing Regulation] referred to in Article 157(1), of correcting any linguistic errors or errors of transcription and obvious errors in [OHIM's] decisions or errors attributable to [OHIM] in registering the trade mark or in publishing its registration.'

8 It should be noted that Articles 42, 57 and 77a of Regulation No 40/94 have become, respectively, Articles 41, 58 and 80 of Regulation No 207/2009 and that there is no change in the wording of those provisions.

The Implementing Regulation

9 Under the heading 'Examination of admissibility', Rule 17 of the Implementing Regulation is worded as follows:

'1. If the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

2. If the notice of opposition has not been filed within the opposition period, … [OHIM] shall reject the opposition as inadmissible.

...

5. Any finding pursuant to paragraph 1 that the notice of opposition is deemed not to have been entered and any decision to reject an opposition as inadmissible under paragraphs 2, 3 and 4 shall be notified to the applicant.'

10 Rule 18 of the Implementing Regulation, entitled 'Commencement of opposition proceedings', provides, in paragraph 1 thereof, as follows:

'When the opposition is found admissible pursuant to Rule 17, [OHIM] shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. This period may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires.'

11 Rule 53a of the Implementing Regulation, entitled 'Revocation of a decision or entry in the Register', states, in paragraphs 1 to 3 thereof, as follows:

'1. Where [OHIM] finds of its own motion or pursuant to corresponding information by the parties to the proceedings that a decision or entry in the Register is subject to revocation pursuant to Article 77a of the Regulation, it shall inform the party affected about the intended revocation.

2. The affected party may submit observations on the intended revocation within a period specified by [OHIM].

3. Where the affected party agrees to the intended revocation or where he does not submit any observations within the period, [OHIM] shall revoke the decision or entry. If the affected party does not agree to the revocation, [OHIM] shall take a decision on the revocation.'

12 Rule 62 of the Implementing Regulation is worded, in paragraph 1 thereof, as follows:

'Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of [OHIM] shall be notified by registered letter with advice of delivery. All other notifications shall be by ordinary mail.'

The facts of the dispute

13 The facts of the case are set out at paragraphs 1, 3 to 13 and 16 to 19 of the judgment under appeal as follows:

'1 On 12 July 2007, [RT Mediasolution's] predecessor in law filed an application for registration of a Community trade mark with [OHIM] under [Regulation No 40/94].

...

3 The application for the Community trade mark was published in *Community Trade Marks Bulletin* No 068/2007 of 24 December 2007.

4 On 25 March 2008, the applicant [Jager & Polacek] filed a notice of opposition, pursuant to Article 42 of Regulation No 40/94, … to registration of the mark applied for in respect of all the goods and services covered by the application.

5 The opposition was based on the earlier non-registered trade mark Redtube and on the use of the www.redtube.com website. The ground relied on in support of the opposition was that set out in Article 8(4) of Regulation No 40/94 … .

6 The applicant stated on the opposition form that the opposition fee was to be transferred to OHIM's account on 26 March 2008.

7 By letter of 10 April 2008, OHIM's Trade Marks Department informed the applicant that OHIM had received the opposition fee only on 1 April 2008, after the expiry of the opposition period, and that it therefore took the view that the opposition had not been duly entered. OHIM also stated that the opposition period would be deemed to have been complied with if the transfer order had been given before the expiry of that period. In addition, OHIM stated that if the applicant had made the payment within the last ten days of the opposition period, it would be required to pay a surcharge of 10% on the opposition fee by no later than 11 May 2008.

8 By letter of 8 May 2008, the applicant furnished evidence that, on 26 March 2008, it had given its banking establishment the order to transfer the opposition tax. It also furnished evidence of payment of the 10% surcharge on 6 May 2008. In addition, it stated that it became aware of the trade mark application only on the afternoon of 25 March 2008, that is, on the last day of the opposition period. It therefore requested RT Mediasolutions to withdraw its trade mark application, but the request was not complied with. When it filed its notice of opposition (at 17.07 by fax), the Austrian banks had been closed for more than two hours and there was no longer anyone present in the applicant's accounting department. It was therefore not possible for it to give the order to transfer the opposition fee to a banking establishment that day. … Moreover, the applicant maintained that, according to the German version of Article 8 of Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 1995 L 303, p. 33), the period for payment was deemed to have been complied with in the present case because the surcharge had been paid.

9 By letters of 20 May 2008, OHIM's Trade Marks Department sent a communication to the applicant and to RT Mediasolutions ("the communication of 20 May 2008"). In those letters OHIM stated that the opposition was found to be admissible in so far as it was based on the earlier non-registered mark Redtube and notified the applicant and RT Mediasolutions of the period within which the contentious part of the opposition proceedings was to commence, in accordance with Rule 18(1) of the [Implementing Regulation]. In particular, OHIM pointed out that the cooling off period was to expire on 21 July 2008 and that the contentious part of the opposition proceedings was to commence on 22 July 2008. Moreover, it fixed periods within which the applicant was to provide evidence to substantiate its opposition and RT Mediasolutions to reply to that evidence.

10 By letter of 10 September 2008, RT Mediasolutions submitted that the opposition fee had not been paid in sufficient time and requested OHIM to annul the communication of 20 May 2008 and find that the opposition was to be treated as not having been duly entered.

11 On 2 October 2008, OHIM's Trade Marks Department sent a letter headed "Correction" (Korrektur) to the applicant. In that letter OHIM informed the applicant that the [communication of 20 May 2008] had been sent in error and that it was to be regarded as having no effect. OHIM also notified the applicant that the opposition fee was deemed not to have been paid within the opposition period and the opposition was to be treated as not having been duly entered. Furthermore, OHIM drew the applicant's attention to the fact that it was possible to request the adoption of a formal written decision. The applicant submitted such a request on 28 November 2008.

12 On 22 January 2009, the Opposition Division adopted a decision to the effect that the opposition was to be treated as not having been duly entered. The Opposition Division considered that the two conditions laid down in Article 8(3) of Regulation No 2869/95, that is, requiring that the transfer order be given within the opposition period and the surcharge paid, were cumulative. …

13 On 20 March 2009, the applicant lodged an appeal against the Opposition Division's decision. In the statement setting out the grounds of the appeal of 22 May 2009, the applicant submitted that, on 20 May 2008, OHIM had adopted a decision to the effect that the opposition was admissible and that decision had not been properly revoked in accordance with the procedure laid down in Article [77a of Regulation No 40/94]. The applicant also maintained that the two conditions laid down in Article 8(3) of Regulation No 2869/95 were alternative, not cumulative.

…

16 By the [contested decision], the Fourth Board of Appeal of OHIM dismissed the appeal.

17 The Board of Appeal stated that the opposition period expired on 25 March 2008, since 24 March 2008 was a public holiday. The opposition fee was paid after the expiry of the opposition period, contrary to the provisions of [the second sentence of] Article [42(3) of Regulation No 40/94]. It was also established that the applicant gave the transfer order to its banking establishment only after the expiry of the opposition period, namely on 26 March 2008. Consequently, in accordance with [the second sentence of] Article [42(3) of Regulation No 40/94], the opposition was to be treated as not having been duly entered.

18 The Board of Appeal considered that the Opposition Division had correctly interpreted Article 8(3) of Regulation No 2869/95.

19 According to the Board of Appeal, the [communication of 20 May 2008] did not constitute a decision capable of being revoked under Article [77a of Regulation No 40/94], but a simple measure of organisation of procedure.'

The proceedings before the General Court and the judgment under appeal

14 By application lodged at the Registry of the General Court on 4 December 2009, the appellant brought an action for annulment of the contested decision.

15 In support of its action, the appellant relied on three pleas in law, the response to the second of which alone forms the subject of the appeal.

16 The first plea alleged breach of Article 8(2) of Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 1996 L 28, p. 11). The General Court rejected that plea on the ground that that provision is applicable only to *inter partes* proceedings and that the decision of 22 January 2009 was adopted in accordance with the rules laid down for *ex parte* proceedings.

17 By the third plea in support of its action, the appellant contested the fact that its opposition had been treated as not having been duly entered on account of the late payment of the opposition fee. The General Court rejected that plea, taking the view that the Opposition Division was entitled to find that the opposition had not been duly entered due to the late payment of the opposition fee, in accordance with Rule 17(1) of the Implementing Regulation.

18 The second plea was based on alleged infringement of Article 77a(1) and (2) of Regulation No 40/94. The appellant submitted in support of that plea that, since the communication of 20 May 2008 found that its opposition was admissible, it constituted a decision. Since, under Rule 17(5) of the Implementing Regulation, it is a decision which establishes that the notice of opposition is to be deemed not to have been entered or which rejects the opposition as inadmissible, the effect of the legal principle of parallelism of procedural requirements and of the *actus contrarius* is that the act which establishes that an opposition is admissible must also be categorised as a decision.

19 Consequently, that decision could be revoked only in accordance with the conditions laid down in Article 77a of Regulation No 40/94, in conjunction with Rule 53a of the Implementing Regulation. The revocation of that decision failed to have regard to the procedural requirements laid down in Rule 53a and came about after the six-month period prescribed in Article 77a.

20 In that regard, at paragraphs 91 to 93 of the judgment under appeal, the General Court took the view that the letter of 20 May 2008 was simply a communication addressed to the appellant concerning the date on which the contentious part of the proceedings was to commence and an invitation to submit facts, evidence and arguments and that, accordingly, such a communication was not intended to

produce legal effects. It is not apparent from the form of that letter that it constitutes the adoption of a definitive position by OHIM on the admissibility of the opposition. At paragraph 102 of that judgment, the General Court concluded that the communication of 20 May 2008 constituted not a decision but a simple measure of organisation of procedure.

21 The General Court also rejected the appellant's arguments, considering that the principle of parallelism of procedural requirements and of the *actus contrarius* was irrelevant for the purpose of determining whether the communication of 20 May 2008 constituted a decision.

22 The General Court stated that Rule 18(1) of the Implementing Regulation refers to a communication which does not produce binding legal effects vis-à-vis the person to whom it is addressed. Lastly, since the communication of 20 May 2008 is not a decision, the appellant cannot invoke the protection of legitimate expectations which such a communication would have conferred on it.

23 At paragraph 132 of the judgment under appeal, the General Court also stated that the case did not involve an international registration and that it was not necessary to rule on the legal nature of OHIM's notification to the World Intellectual Property Organisation (WIPO) of admissible oppositions.

Forms of order sought by the parties

24 The appellant claims that the Court of Justice should:

— set aside the judgment under appeal, and

— order OHIM to pay the costs.

25 OHIM contends that the appeal should be dismissed as manifestly unfounded and the appellant be ordered to pay the costs.

The appeal

26 The appellant relies on a single ground of appeal, alleging breach of Article 77a(1) and (2) of Regulation No 40/94.

Arguments of the parties

27 The single ground of appeal relied on by the appellant can be divided into three parts. By the first part, the General Court is criticised for finding that the communication of 20 May 2008 does not constitute a decision. First, the General Court relied on case-law of the Court of Justice which is inapplicable in the present case, since it concerns decisions within the meaning of the fourth paragraph of Article 288 TFEU. That provision is not applicable to measures adopted by OHIM.

28 Second, the appellant submits that, by refusing to consider that communication as a decision, the General Court failed to afford it effective judicial protection.

29 The appellant maintains that, while it is open to OHIM to determine whether the opposition is admissible at any point in the proceedings, it can equally adopt a firm position on that question at any time, in particular in the letter by which it informs the parties of the commencement of the contentious part of the opposition proceedings. The terms used in the communication of 20 May

2008 show that one of its purposes was to give a decision on the admissibility of the opposition. Those terms were precise and unconditional. That communication did not state that OHIM might review the admissibility of the opposition or that it had not reached a definitive view on that question.

30 In accordance with the principle of effective judicial protection, the General Court should have concluded that, on the basis of both its form and substance, the communication of 20 May 2008 constituted a decision. Indeed, the finding of admissibility was made by a competent, responsible authority. That finding is unconditional, precise and without reservation.

31 That communication therefore gave to its addressee the impression that OHIM had considered the question of admissibility and adopted a definitive decision on that question. Admittedly, it was open to OHIM to withdraw the decision on admissibility if it was incorrect, but it should have done so within the periods and in the forms prescribed. In the absence of any such withdrawal, OHIM continued to be bound by the decision, because of the need to ensure legal certainty. In the event, the decision was not withdrawn within the six-month period laid down in Article 77a(1) and (2) of Regulation No 40/94. The opposition proceedings should therefore have been resumed and followed their course.

32 By the second part of the single ground of appeal, the appellant criticises the General Court for basing its reasoning on the fact that Rule 17(5) of the Implementing Regulation uses the word 'decision' where the notice of opposition is deemed not to have been entered, whereas Rule 18(1) of that regulation uses the word 'communication'. It is apparent from Rule 62 of the regulation that a communication may also contain a decision.

33 By the third part of the single ground of appeal relied on, the appellant complains that, in its response to the appellant's argument relating to the requirement to inform the WIPO, the General Court simply stated that the case concerned only the registration of a Community trade mark. However, any assessment of the legal nature of a communication concerning the admissibility of an opposition should be consistent. The General Court should have taken account of the fact that, if the communication on admissibility which is sent to the WIPO is a decision, that communication should be given the same categorisation where it is addressed to the person who has filed a notice of opposition to the registration of a Community trade mark.

34 OHIM is of the view that the single ground of appeal is manifestly unfounded.

35 As regards, first, the part of the ground of appeal concerning the case-law of the Court of Justice cited by the General Court, OHIM submits that it is a European Union body. The definitions of administrative law established for the European Union are also applicable to it.

36 With regard, next, to the part of the ground concerning the categorisation of the communication of 20 May 2008 as a decision, the General Court clearly stated, at paragraph 122 of the judgment under appeal, that it is not apparent from that communication that OHIM intended to give a definitive decision on admissibility. The principle of effective judicial protection is not applicable in the present case since that communication did not constitute, in OHIM's terms, an 'executive act', capable of infringing that right. The communication had no legal effect on the appellant's legal situation.

37 The appellant incorrectly claimed that the General Court failed to consider whether the communication of 20 May 2008 also contained a decision. The General Court considered that question at paragraphs 91 et seq. of the judgment under appeal.

38 As regards the third part of the ground of appeal concerning the procedure before the WIPO, OHIM states that the decision on the admissibility of an opposition in the case of an international registration gives rise to the entry of a provisional refusal of protection in the international register of trade marks. That procedure and the procedure before OHIM are therefore not comparable in so far as concerns their effects.

Findings of the Court

39 As a preliminary point, it should be noted, first, that the appellant does not rely before the Court of Justice on a ground alleging breach of Article 8(2) of Regulation No 216/96 or on a ground concerning payment of the opposition fee.

40 Second, it must be pointed out that the contested decision was given in response to a request for annulment of the decision of 22 January 2009, not of the communication of 20 May 2008.

41 The decision of 22 January 2009 is the decision by which OHIM's Opposition Division found that the opposition was to be treated as not having been duly entered because of the failure to pay the opposition fee within the period prescribed for that purpose.

The first part of the ground of appeal

42 The Board of Appeal found the request for annulment of the decision of 22 January 2009 admissible, but unfounded, on the ground that the Opposition Division was entitled, if not obliged, to point out at any stage in the proceedings any defect attaching to the payment of the opposition fee. According to the Board of Appeal, the communication stating that the opposition is deemed admissible and that the contentious part of the opposition proceedings has commenced does not constitute a decision which should be revoked under Article 77a of Regulation No 40/94 or a final decision within the meaning of Article 57 of that regulation but a simple preparatory communication.

43 The Board of Appeal and, subsequently, the General Court, at paragraphs 74 and 75 of the judgment under appeal, concluded from this that the decision of 22 January 2009 was adopted in accordance with the rules established for *ex parte* proceedings and that any appeal against that decision had to be made under those rules. The Board of Appeal considered that, logically, the Opposition Division had not ruled on costs and decided that there was no need to give a ruling on the costs incurred in connection with the appeal proceedings.

44 Before the General Court, the appellant argued that the communication of 20 May 2008 was a decision which could have been revoked only in accordance with the conditions laid down in Article 77a of Regulation No 40/94.

45 The General Court refused to categorise the communication of 20 May 2008 as a decision on the principal ground that it did not produce any binding legal effect. At paragraph 91 of the judgment under appeal, the General Court stated that that communication contained no indication capable of suggesting that it constituted a decision on the admissibility of the opposition, while at the same time noting, at paragraph 92 of the judgment, that, by that communication, OHIM notified the appellant that its opposition was deemed admissible in so far as it was based on the earlier non-registered mark. Lastly, the General Court stated, at paragraph 95 of the judgment, that the fact that OHIM expressed the view in that communication that the opposition was admissible explains why it informed the parties of the period within which the *inter partes* proceedings were to commence.

46 The General Court concluded, at paragraph 102 of the judgment under appeal, that the communication of 20 May 2008 did not constitute a decision but simply a measure of organisation of procedure.

47 However, that reasoning cannot be upheld.

48 First, it is apparent from Title II of the Implementing Regulation that proceedings to oppose registration of a trade mark comprise two separate stages. Rule 17 of that regulation sets out the conditions under which the opposition may be regarded as admissible and states, at paragraph 5 of that rule, that the decision which establishes that the opposition is deemed not to have been entered or that it must be declared inadmissible is to be notified to the applicant. It follows that the stage at which admissibility is examined may lead to the adoption of a decision terminating the proceedings, which, as such, is subject to appeal, pursuant to Article 57(1) of Regulation No 40/94.

49 Moreover, Rule 18(1) of the Implementing Regulation states that '[w]hen the opposition is found admissible pursuant to Rule 17, [OHIM] shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication'. It is apparent from the very wording of Rule 18 that the opposition proceedings themselves, that is, the *inter partes* stage, commence only when OHIM has verified that the opposition is admissible and that none of the grounds set out in Rule 17 precludes admissibility.

50 The use of the words 'jugée recevable' (found admissible) in the French version of the Implementing Regulation indicates that the European Union legislature intended that OHIM should examine, at that stage in the proceedings, whether the opposition is admissible and satisfy itself that the opposition fee has been duly paid.

51 The other language versions of the Implementing Regulation use the words 'se considere admisible' in Spanish, 'gilt' in German, 'found admissible' in English and 'considerata ammissibile' in Italian. The examination of those different versions – with the exception of the German version, in which the word 'gilt' does not have the same force as the words used in the other language versions – shows that the opposition must be found admissible before the *inter partes* proceedings can commence.

52 Lastly, it follows from Article 57(2) of Regulation No 40/94 that there may be measures which, while they are adopted in the course of the proceedings and do not terminate them, nevertheless constitute decisions.

53 The General Court was therefore wrong to hold, at paragraphs 91 and 95 of the judgment under appeal, that the communication of 20 May 2008, made in accordance with Rule 18 of the Implementing Regulation, was simply a letter by which OHIM notified the opposing party of the commencement of the *inter partes* proceedings, at the same time requesting it to supplement its application by submitting evidence, and that the communication to the effect that the opposition was judged admissible did not constitute the adoption of a definitive position by OHIM on the admissibility of the opposition.

54 Second, it should be noted that at the hearing, while it recognised that the communication of 20 May 2008 was sent in error, OHIM nevertheless claimed that the mere fact of stating that the opposition has been found to be admissible is simply a question of that body's practice and that the final decision on the admissibility of the opposition can be made only in the context of the *inter partes* proceedings. According to OHIM, it is essential to protect the rights of the defence.

55 However, the categorisation of that communication as a 'decision' on the admissibility of the opposition would not compromise the protection of the rights of the defence.

56 First, as the Advocate General pointed out at point 64 of his Opinion, the opposing party has no interest in bringing an action against a measure by which OHIM finds its opposition admissible.

57 Second, if OHIM errs in its assessment of the admissibility of the opposition by declaring, incorrectly, that it is admissible and thus initiates the *inter partes* proceedings, the defendant in the opposition proceedings is not deprived of the opportunity to assert its rights.

58 The defendant in the opposition proceedings may, first of all, submit to OHIM that an error has been made concerning the admissibility of the opposition and request that it withdraw the decision by which it found the opposition to be admissible, on the basis of Article 77a of Regulation No 40/94.

59 On that point, it is apparent from the Court's case-law that, in principle, the withdrawal of an unlawful measure is permissible, even though the principles of legal certainty and the protection of legitimate expectations require that the withdrawal should occur within a reasonable time and that regard be had to how far the person concerned might have been led to rely on the lawfulness of the measure (see, to that effect, Case C-508/03 *Commission* v *United Kingdom* [2006] ECR I-3969, paragraph 68 and the case-law cited).

60 As regards OHIM, the European Union legislature has regulated the procedure for the withdrawal of unlawful measures adopted by that body. In that regard, Article 77a(1) of Regulation No 40/94 states that where OHIM has taken a decision which contains an obvious procedural error attributable to it, it is to ensure that the decision is revoked.

61 Article 77a(2) of Regulation No 40/94 provides that revocation of the incorrect decision may be determined, *ex officio* or at the request of one of the parties, and must be effected within six months from the date on which the decision was taken, after consultation with, inter alia, the parties to the proceedings. It is therefore apparent that the withdrawal procedure may be initiated by the defendant in the opposition proceedings.

62 Lastly, Article 77a(3) of Regulation No 40/94 provides that the revocation procedure is without prejudice to the rights of the parties to submit an appeal under, inter alia, Article 57 of the regulation.

63 Secondly, it is open to the defendant in the opposition proceedings to seek annulment of the measure finding the opposition admissible. Such an application for annulment may be made in the appeal against the decision adopted at the conclusion of the *inter partes* proceedings. In so far as that measure does not terminate the proceedings, it can be appealed together with the final decision on the substance of the opposition, in accordance with Article 57(2) of Regulation No 40/94.

64 It is apparent from the examination of all those provisions that, where OHIM finds that the opposition is admissible, the *inter partes* stage of the proceedings commences. For a period of six months, where the decision by which opposition was found to be admissible contains an obvious procedural error, it may be withdrawn *ex officio* or at the request of one of the parties, which has the effect of terminating the opposition proceedings. Once that period has expired, the *inter partes* stage of the proceedings must be pursued and a decision must be given.

65 In the latter instance, the defendant to the opposition proceedings may bring an appeal before the Board of Appeal and argue that the opposition was inadmissible.

66 The Court has already held that it follows from Article 62(1) of Regulation No 40/94 that, following the examination as to the merits of the appeal, the Board of Appeal is to decide on it and that, in doing so, it may 'exercise any power within the competence of the department which was responsible for the contested decision', that is to say, in the present case, give a decision itself on the opposition by either rejecting it or declaring it to be founded, thereby either upholding or reversing the contested decision (Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 56).

67 Those powers on the part of the Board of Appeal also include the power to review the admissibility of the opposition in order to enable the defendant in the opposition proceedings, where appropriate, to challenge the finding of admissibility in the appeal which is available to it under Article 57(2) of Regulation No 40/94.

68 Thus, it is apparent that the rights of the defendant in the opposition proceedings are ensured protection by the withdrawal mechanism provided for in Article 77a of Regulation No 40/94 and the appeal mechanism in Article 57 of the regulation.

69 It follows from all the above considerations that the European Union legislature has provided, first, two separate stages in the opposition proceedings and, second, mechanisms to enable the defendant in the opposition proceedings to contest the decision by which OHIM incorrectly finds the opposition admissible.

70 It is apparent from all the foregoing that, by finding, at paragraphs 95 and 102 of the judgment under appeal, that the only purpose of the communication of 20 May 2008 was to inform the appellant of the date on which the contentious part of the opposition proceedings was to commence, at the same time requesting it to supplement the opposition by submitting facts, evidence and arguments, and that that communication did not constitute a decision but simply a measure of organisation of procedure lacking any binding legal effect, the General Court misconstrued the combined provisions of Rules 17 and 18 of the Implementing Regulation and Articles 55 and 77a of Regulation No 40/94.

71 It follows that the judgment under appeal must be set aside and that there is no need to respond to the other parts of the sole ground relied on in support of the appeal.

The action at first instance

72 Pursuant to the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, if the Court quashes the decision of the General Court it may itself give final judgment in the matter, where the state of the proceedings so permits.

73 In the present case, the Court observes that, at paragraphs 17 and 31 of the contested decision, the Board of Appeal took the view that the appeal was unfounded, since the Opposition Division had correctly concluded that the opposition was to be treated as not having been duly entered.

74 The Court also observes that, at paragraph 19 of the contested decision, the Board of Appeal took the view that the communication of 20 May 2008 notifying the appellant that the opposition was found to be admissible did not constitute a decision which could be revoked in accordance with the procedure laid down in Article 77a of Regulation No 40/94 but simply a preparatory communication and that such a communication was not binding on OHIM.

75 However, as is apparent from paragraphs 53, 64 and 68 above, the measure by which OHIM notified the opposing party that its opposition was found to be admissible is not simply a communication emanating from that body but constitutes a decision on the admissibility of the opposition which may be revoked only in accordance with the conditions laid down in Article 77a of Regulation No 40/94 or annulled in an appeal brought under Article 57 of that regulation.

76 It follows that, as the Board of Appeal found that that measure had not been revoked within a six-month period, it was wrong in holding that the Opposition Division was entitled, after the expiry of that period, to examine whether the opposition was to be treated as not having been duly entered on account of the late payment of the opposition fee.

77 It follows that the contested decision must be annulled.

Costs

78 Under the first paragraph of Article 122 of the Rules of Procedure, where the appeal is well founded and the Court of Justice itself gives final judgment in the case, it is to make a decision as to costs. Under Article 69(2) of those rules, applicable to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

79 In the present case, since the appeal is well founded and the appellant has applied for costs to be awarded against OHIM, OHIM must be ordered to pay the costs of both the proceedings at first instance and the appeal proceedings.

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

1. **Sets aside the judgment of the General Court of the European Union of 12 May 2011 in Case T-488/09 *Jager & Polacek* v *OHIM (REDTUBE);***

2. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 29 September 2009 (Case R 442/2009-4) concerning opposition proceedings between Jager & Polacek GmbH and RT Mediasolutions s.r.o.;**

3. **Orders the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to pay the costs of both the proceedings at first instance and the appeal proceedings.**

[Signatures]