

**Court of Justice EU, 5 July 2011, Edwin v OHIM**

ELIO FIORUCCI



**TRADEMARK LAW**

**Invalid trade mark because of “right to a name”, broad interpretation**

• As regards the wording of that provision, it should be noted that the words ‘right to a name’ do not provide any support for the restrictive interpretation proposed by the appellant, to the effect that the provision concerns only that right as an attribute of personality and does not cover commercial exploitation of a name.

34 The structure of Article 52(2) of Regulation No 40/94, for its part, is inconsistent with such an interpretation. According to that provision, a Community trade mark may be declared invalid on application by a person concerned claiming ‘another earlier right’. In order to clarify the nature of such an earlier right, that provision lists four rights, while indicating, by the use of the adverb ‘in particular’, that that list is not exhaustive. The examples given include, besides the right to a name and the right of personal portrayal, a copyright and an industrial property right.

**Examination of national law by Court of Justice**

• As regards the examination, in the context of an appeal, of the findings made by the General Court with regard to that national law, the Court of Justice has jurisdiction to determine, first of all, whether the General Court, on the basis of the documents and other evidence submitted to it, distorted the wording of the national provisions at issue or of the national case-law relating to them, or of the academic writings concerning them; second, whether the General Court, as regards those particulars, made findings that were manifestly inconsistent with their content; and, lastly, whether the General Court, in examining all the particulars, attributed to one of them, for the purpose of establishing the content of the national law at issue, a significance which is not appropriate in the light of the other particulars, where that is manifestly apparent from the documentation in the case-file.

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**Court of Justice EU, 5 July 2011**

(V. Skouris, President, A. Tizzano, J.N. Cunha Rodrigues, K. Lenaerts, J.-C. Bonichot, K. Schiemann and D. Šváby, Presidents of Chambers, A. Rosas, E. Juhász,

T. von Danwitz, M. Berger (Rapporteur), A. Prechal and E. Jarašiūnas)

Judgment of the Court (Grand Chamber)

5 July 2011 (\*)

*(Appeal – Community trade mark – Regulation (EC) No 40/94 – Article 52(2)(a) – Community word mark ELIO FIORUCCI – Application for a declaration of invalidity based on a right to a name under national law – Review by the Court of Justice of the interpretation and application of national law by the General Court – Power of the General Court to alter the decision of the Board of Appeal – Limits)*

In Case C-263/09 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 14 July 2009,

Edwin Co. Ltd, established in Tokyo (Japan), represented by D. Rigatti, M. Bertani, S. Vereá, K. Muraro and M. Balestrieri, avvocati, appellant,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto, L. Rampini and J. Crespo Carrillo, acting as Agents, defendant at first instance,

Elio Fiorucci, residing in Milan (Italy), represented by

A. Vanzetti and A. Colmano, avvocati, applicant at first instance,

The Court (Grand Chamber),

composed of V. Skouris, President, A. Tizzano, J.N. Cunha Rodrigues, K. Lenaerts, J.-C. Bonichot, K. Schiemann and D. Šváby, Presidents of Chambers, A. Rosas, E. Juhász, T. von Danwitz, M. Berger (Rapporteur), A. Prechal and E. Jarašiūnas, Judges,

Advocate General: J. Kokott,

Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 23 November 2010,

after hearing the Opinion of the Advocate General at the sitting on 27 January 2011,

gives the following

**Judgment**

1 By its appeal, Edwin Co. Ltd seeks to have set aside the judgment of the Court of First Instance of the European Communities (now ‘the General Court’) of 14 May 2009 in Case T-165/06 Fiorucci v OHIM ? Edwin (ELIO FIORUCCI) [2009] ECR II-1375; ‘the judgment under appeal’), by which that Court upheld in part the action brought by Mr Fiorucci against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 6 April 2006 (Case R 238/2005-1) concerning invalidity and revocation proceedings between Mr Fiorucci and Edwin (‘the contested decision’).

**Legal context**

**European Union law**

**The Statute of the Court of Justice**

2 Article 58 of the Statute of the Court of Justice provides:

*'An appeal to the Court of Justice shall be limited to points of law. It shall lie on the grounds of lack of competence of the General Court, a breach of procedure before it which adversely affects the interests of the appellant as well as the infringement of Union law by the General Court.*

*No appeal shall lie regarding only the amount of the costs or the party ordered to pay them.'*

The Rules of Procedure of the General Court

3 Article 135(4) of the Rules of Procedure of the General Court provides that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

Regulation (EC) No 40/94

4 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). However, Regulation No 40/94, as amended by Council Regulation (EC) No 422/2004 of 19 February 2004 (OJ 2004 L 70, p. 1; 'Regulation No 40/94'), continues to apply to this case.

5 Article 50(1)(c) of Regulation No 40/94 provided, under the heading 'Grounds for revocation':

*'The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to [OHIM] or on the basis of a counterclaim in infringement proceedings:*

...

*(c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.'*

6 Under the heading 'Relative grounds for invalidity', Article 52(2) of that regulation provided:

*'A Community trade mark shall also be declared invalid on application to [OHIM] or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:*

*(a) a right to a name;*

*(b) a right of personal portrayal;*

*(c) a copyright;*

*(d) an industrial property right, under the Community legislation or national law governing the protection.'*

7 Article 63 of Regulation No 40/94, concerning actions before the Court of Justice, provided:

*'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.*

*2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.*

*3. The Court of Justice has jurisdiction to annul or to alter the contested decision.*

...

6. *[OHIM] shall be required to take the necessary measures to comply with the judgment of the Court of Justice.'*

Regulation (EC) No 2868/95

8 Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4; 'the implementing regulation'), lays down inter alia the rules governing the way in which proceedings for the revocation or invalidation of a Community trade mark are to be conducted before OHIM.

9 In that regard, Rule 37(b)(iii) of the implementing regulation, in its original version, which has remained unchanged, provides:

*'An application to [OHIM] for revocation or for a declaration of invalidity ... shall contain:*

...

*(b) as regards the grounds on which the application is based:*

...

*(iii) in the case of an application pursuant to Article 52(2) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article 52(2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right'.*

#### **National law**

10 Article 8(3) of the Italian Industrial Property Code (Codice della Proprietà Industriale; 'the CPI'), in the version applying at the date of the decision of the Board of Appeal, provided:

*'If they are well known, the following may be registered as a trade mark by the proprietor, or with the consent of the latter or of the persons referred to in paragraph 1: personal names, signs used in the artistic, literary, scientific, political or sporting fields, the designations and acronyms of events and those of non-profit making bodies and associations, including their characteristic emblems.'*

#### **Background to the dispute and the contested decision**

11 Fiorucci SpA, a company governed by Italian law set up by Mr Fiorucci, a fashion designer who had achieved certain renown in Italy during the 1970s, sold to the appellant on 21 December 1990 the entirety of its 'creative assets', including all the trade marks which it owned, among which were numerous marks containing the element 'FIORUCCI'.

12 On 6 April 1999, on application by the appellant, OHIM registered the word mark ELIO FIORUCCI for a series of goods in Classes 3, 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

13 On 3 February 2003, Mr Fiorucci filed an application for revocation and an application for a declaration of the invalidity of that mark, based on Article 50(1)(c) and Article 52(2)(a), respectively, of Regulation No 40/94.

14 By decision of 23 December 2004, the Cancellation Division of OHIM allowed the application for a declaration of invalidity, on the grounds, first, that, according to Article 8(3) of the CPI, Mr Fiorucci's consent was required for the registration of his name as a Community trade mark and, second, that no such consent had been given. The Cancellation Division held that in those circumstances there was no need to rule on the application for revocation.

15 The appellant brought an appeal against that decision. By the contested decision, the First Board of Appeal of OHIM allowed that appeal and annulled the decision of the Cancellation Division. With regard, in the first place, to the application for a declaration of invalidity filed by Mr Fiorucci, the Board of Appeal held that his situation did not fall within the scope of Article 8(3) of the CPI, the *raison d'être* of which was to prevent third parties from exploiting for commercial purposes the name of a person who had become famous in a non-commercial sector and that, therefore, Mr Fiorucci could not rely on a right to a name under that provision. With regard, in the second place, to the application for revocation filed by Mr Fiorucci, the Board of Appeal noted that the *raison d'être* of Article 50(1)(c) of Regulation No 40/94 was to protect public confidence, and held that neither the trade mark at issue in itself nor the use made of it could mislead the public.

#### **The action before the General Court and the judgment under appeal**

16 By application lodged at the Registry of the General Court on 19 June 2006, Mr Fiorucci brought an action against the contested decision.

17 By the judgment under appeal, the General Court upheld that action in part.

18 After rejecting, in paragraphs 21 to 25 of the judgment under appeal, a number of pleas as inadmissible because they were new pleas, the General Court held, in paragraph 27 of that judgment, that Mr Fiorucci had put forward in essence two pleas in law, alleging infringement of Article 52(2)(a) and Article 50(1)(c), respectively, of Regulation No 40/94.

19 Examining first of all the second plea, relating to the application for revocation, the General Court upheld the Board of Appeal's findings, holding in paragraphs 33 to 35 of the judgment under appeal that the mark ELIO FIORUCCI is not, in itself, liable to mislead the public as to the origin of the goods for which it is registered within the meaning of Article 50(1)(c) of Regulation No 40/94. Moreover, it held in paragraphs 36 and 37 of that judgment that, in the absence of evidence showing any use whatsoever of the mark at issue, there could be no question of use liable to mislead the public. The Court therefore rejected that plea.

20 Examining next the first plea, relating to the application for a declaration of invalidity, the General Court confirmed, in paragraph 41 of the judgment under appeal, that under Article 52(2)(a) of Regulation No 40/94 OHIM may declare a Community trade mark to be invalid, on application by an interested party, if its use can be prohibited pursuant to, in particular, a right to a name protected by a national law. As regards the

interpretation of Article 8(3) of the CPI, the Court however rejected the Board of Appeal's finding. In that regard, it held:

*'50 First, it must be held that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal is not confirmed by the wording of that provision, which refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired.*

...

*53 Second, contrary to what is suggested by the Board of Appeal ..., even on the assumption that the name of a well-known person has already been registered or used as a de facto trade mark, the protection given by Article 8(3) of the [CPI] is not in any way superfluous or irrelevant.*

...

*55 ..., it is not ruled out that the name of a well-known person, registered or used as a mark for certain goods or services, can be the subject of a new registration for different goods or services which are not in any way similar to those covered by the earlier registration.*

...

*57 Third, the extracts from some of the academic writings cited in paragraphs 41 to 43 of the contested decision also do not allow the conclusion to be drawn that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal in the contested decision is correct.*

*58 Thus, Mr Vanzetti, author ... of the work cited in paragraph 41 of the contested decision, took part in the hearing as lawyer for [Mr Fiorucci] and stated that the thesis adopted by the Board of Appeal did not follow at all from what he had written in the work in question ...*

*59 Mr Ricolfi ... refers, according to the Board of Appeal, to the "renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character", which does not at all exclude renown resulting from an "entrepreneurial" use, even if that is less frequent.*

*60 Only Mr Ammendola ... refers to a use in a "sector outside the market", without thereby expressly concluding that Article 8(3) of the [CPI] cannot be invoked to protect the name of a person whose renown was not acquired in such a field. In any case, having regard to all of the foregoing considerations, the Court cannot, only on the basis of the opinion of that one author, make the application of the provision in question subject to a condition which does not follow from its wording.'*

21 In paragraph 61 of the judgment under appeal, the General Court concluded from this that the Board of Appeal had erred in law in its interpretation of Article 8(3) of the CPI and had ruled out, incorrectly, the application of that provision in the case of Mr Fiorucci.

22 Lastly, with regard to the alternative argument presented by the appellant and by OHIM, that the mark ELIO FIORUCCI was included in the assignment, by Mr Fiorucci to the appellant, of all his marks, the General Court stated that the Board of Appeal had not examined that argument and that, in the context of the



review of legality which it is required to conduct, it may not substitute its own reasoning for that of the Board of Appeal. On that ground, in paragraphs 64 and 65 of the judgment under appeal, it rejected that argument as irrelevant.

23 On the same ground, the General Court rejected Mr Fiorucci's application for a declaration that the trade mark ELIO FIORUCCI was invalid. Refraining from exercising its power to alter the Board of Appeal's decision, the Court, in paragraph 67 of the judgment under appeal, merely annulled it.

24 According to the operative part of the judgment under appeal, the General Court:

*'1. Annuls the [contested decision] in so far as it contains an error of law in the interpretation of Article 8(3) of the [CPI];*

*2. Dismisses the action as to the remainder;*

*3. Orders OHIM to bear its own costs and two thirds of the costs incurred by Mr Elio Fiorucci;*

*4. Orders Edwin Co. Ltd to pay its own costs and one third of those incurred by Mr Elio Fiorucci.'*

#### **Forms of order sought**

25 The appellant claims that the Court of Justice should:

– set aside point 1 of the operative part of the judgment under appeal on all the grounds set out in its appeal;

– in the alternative, set aside point 1 of the operative part of the judgment under appeal for failure to state adequate grounds;

– in the further alternative, set aside the judgment under appeal since it constitutes a denial of justice or infringes Article 63 of Regulation No 40/94;

– refer for examination by the Board of Appeal of OHIM the arguments put forward in the abovementioned alternative claims for the judgment under appeal to be set aside; and, lastly,

– order that the appellant should be reimbursed in full for the costs of the proceedings at first instance and of the appeal proceedings or at least that each party should bear its own costs in full.

26 OHIM contends that the Court should:

– set aside the judgment under appeal;

– in the alternative, refer the case back to the General Court for further examination of the disputed matters that were, in error, not examined; and

– order Mr Fiorucci to pay the costs.

27 Mr Fiorucci contends that the Court should:

– dismiss the appeal and, thus, uphold points 1, 3 and 4 of the operative part of the judgment under appeal;

– amend paragraphs 33 to 35 of the judgment under appeal; and

– order the reimbursement of the costs of the appeal proceedings.

#### **The appeal**

28 In support of its appeal, the appellant puts forward four substantive pleas and a fifth plea concerning allocation of the costs.

29 With regard to the substantive pleas, it is appropriate to examine first the second part of the first plea, relating to the error allegedly made by the General Court in the interpretation and application of Article 52(2)(a) of

Regulation No 40/94 and then, secondly and together, the first part of the first plea and the second plea, by which the appellant criticises the General Court for incorrectly interpreting and applying Article 8(3) of the CPI, which, in the appellant's submission, constitutes an infringement of Article 52(2)(a) of Regulation No 40/94. Finally, in third and last place, the third and fourth pleas, by which the appellant complains that the General Court failed to comply with its obligation to state adequate grounds and failed to do justice, will be dealt with together.

Second part of the first plea: infringement of Article 52(2)(a) of Regulation No 40/94

#### **Arguments of the parties**

30 By the second part of the first plea, the appellant claims that Article 52(2)(a) of Regulation No 40/94, where it refers to the 'right to a name', is referring to an attribute of personality. However, the right provided for in Article 8(3) of the CPI is a right intended to protect not an attribute of personality but purely pecuniary interests in the economic exploitation of renown acquired outside the commercial sector. By holding that the condition required for the application of Article 52(2)(a) of Regulation No 40/94 was fulfilled, the General Court therefore infringed that provision.

31 According to Mr Fiorucci, that argument is groundless.

#### **Findings of the Court**

32 In order to assess the merits of the appellant's interpretation, it is necessary to take into consideration the wording and structure of Article 52(2) of Regulation No 40/94.

33 As regards the wording of that provision, it should be noted that the words 'right to a name' do not provide any support for the restrictive interpretation proposed by the appellant, to the effect that the provision concerns only that right as an attribute of personality and does not cover commercial exploitation of a name.

34 The structure of Article 52(2) of Regulation No 40/94, for its part, is inconsistent with such an interpretation. According to that provision, a Community trade mark may be declared invalid on application by a person concerned claiming 'another earlier right'. In order to clarify the nature of such an earlier right, that provision lists four rights, while indicating, by the use of the adverb 'in particular', that that list is not exhaustive. The examples given include, besides the right to a name and the right of personal portrayal, a copyright and an industrial property right.

35 It is apparent from that non-exhaustive list that the rights cited by way of examples are intended to protect interests of different types. It should be noted that for some of them, such as copyright and industrial property rights, the economic aspects are protected, both under the national legal systems and under European Union law, against commercial infringements (see, inter alia, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45)).

36 It follows that, contrary to what the appellant maintains, the wording and structure of Article 52(2) of

Regulation No 40/94 do not, where a right to a name is asserted, allow application of that provision to be restricted merely to situations where the registration of a Community trade mark conflicts with a right intended exclusively to protect a name as an attribute of the personality of the person concerned.

37 In those circumstances, the General Court cannot be criticised for making an error of law in the interpretation of Article 52(2)(a) of Regulation No 40/94.

38 The second part of the first plea must therefore be rejected as unfounded.

The first part of the first plea and the second plea: infringement of Article 52(2)(a) of Regulation No 40/94 and Article 8(3) of the CPI

#### **Arguments of the parties**

39 By the first part of the first plea, the appellant claims that the General Court incorrectly held that the conditions for applying Article 52(2)(a) of Regulation No 40/94 were satisfied. According to the appellant, Article 8(3) of the CPI does not confer on Mr Fiorucci, solely because it is his own surname which is involved, the right to have the use of his name as a trade mark prohibited, but grants him solely the right to apply for it to be registered as a trade mark. According to the appellant, Mr Fiorucci can no longer exercise that right since he has already registered marks including the element 'FIORUCCI' and subsequently assigned them to the appellant.

40 By its second plea, the appellant claims, first, that the General Court manifestly misinterpreted Article 8(3) of the CPI, which applies only to names which have become well-known outside the commercial sector. By holding in paragraph 50 of the judgment under appeal that Article 8(3) of the CPI refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired, the General Court misinterpreted the wording of that provision.

41 Secondly, the appellant claims that, by holding, in paragraphs 53 and 55 of the judgment under appeal, that the protection given by Article 8(3) of the CPI to the name of a well-known person could be broader than that afforded by the registration of a well-known trade mark, in that it may apply to different goods or services, the General Court also misinterpreted the scope of that provision. The appellant complains that, in that regard, the General Court totally disregarded or manifestly misinterpreted the extracts from academic writings which had been submitted to it concerning that provision.

42 OHIM complains that the General Court failed to take into consideration in its interpretation and application of Article 8(3) of the CPI the possible exhaustion of the right under that provision, exhaustion resulting in the present case from Mr Fiorucci's registration, and subsequent assignment to the appellant, of trade marks containing the element 'FIORUCCI'. In so far as Article 52(2)(a) of Regulation No 40/94 refers to national law, misapplication of the Italian provision might constitute infringement of Article 52 of the regulation. However, OHIM considers that, in the context of an

appeal, review by the Court of Justice of the General Court's application of national law should be limited to checking that the General Court has not made a manifest error on the basis of the documents and evidence available to it.

43 Mr Fiorucci contends that the General Court's interpretation and application of Article 8(3) of the CPI are in accordance both with the wording of that provision and with the interpretation given in Italian academic writings. Furthermore, the consequence of a reference to a rule of national law made in a provision of European Union law cannot be that the rule concerned must be regarded as being incorporated into European Union law.

#### **Findings of the Court**

44 It is apparent from the arguments of the parties that they disagree over the existence both of an infringement by the General Court of the national rule applied to the substance of the case and of the jurisdiction of the Court of Justice to examine such an infringement.

45 It is therefore appropriate to determine whether the Court of Justice does have such jurisdiction.

46 The jurisdiction of the Court of Justice ruling on an appeal against a decision given by the General Court is defined by the second subparagraph of Article 256(1) TFEU. That provision states that an appeal is to be on points of law only and that it must be made 'under the conditions and within the limits laid down by the Statute'. In a list setting out the grounds that may be relied upon in that context, the first paragraph of Article 58 of the Statute of the Court of Justice states that an appeal may be based on infringement of European Union law by the General Court.

47 In the present case, the rule which the appellant claims has been infringed is a rule of national law made applicable to the dispute by the reference made in a provision of European Union law.

48 It is apparent from the wording of Article 52(2) of Regulation No 40/94 that when that provision refers to the situation in which the existence of an earlier right makes it possible to prohibit the use of a Community trade mark it distinguishes clearly between two situations, depending on whether the earlier right is protected under the Community legislation 'or' under national law.

49 As regards the procedural arrangements laid down by the implementing regulation in the case of an application pursuant to Article 52(2) of Regulation No 40/94, based on an earlier right protected under national law, Rule 37 of the implementing regulation provides, in a situation such as that in the present case, that the applicant must provide particulars showing that he is entitled under the national law applicable to lay claim to that right.

50 That rule requires the applicant to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law.

51 Where, as in the present case, an application for a Community trade mark to be declared invalid is based on an earlier right protected by a rule of national law, the competent OHIM bodies must first assess the authority and scope of the particulars submitted by the applicant in order to establish the content of that rule.

52 Secondly, according to Article 63(2) of Regulation No 40/94, actions may be brought before the General Court against decisions of the Boards of Appeal on grounds of infringement of the Treaty, of Regulation No 40/94 or of any rule of law relating to their application. It follows from this, as the Advocate General stated in points 61 to 67 of her Opinion, that the General Court has jurisdiction to conduct a full review of the legality of OHIM's assessment of the particulars submitted by an applicant in order to establish the content of the national law whose protection he claims.

53 As regards the examination, in the context of an appeal, of the findings made by the General Court with regard to that national law, the Court of Justice has jurisdiction to determine, first of all, whether the General Court, on the basis of the documents and other evidence submitted to it, distorted the wording of the national provisions at issue or of the national case-law relating to them, or of the academic writings concerning them; second, whether the General Court, as regards those particulars, made findings that were manifestly inconsistent with their content; and, lastly, whether the General Court, in examining all the particulars, attributed to one of them, for the purpose of establishing the content of the national law at issue, a significance which is not appropriate in the light of the other particulars, where that is manifestly apparent from the documentation in the case-file.

54 In the present case, the appellant has claimed that the General Court interpreted Article 8(3) of the CPI in a way that was inconsistent with the wording of that provision and with academic writings concerning it that were produced before that Court. It is appropriate to examine whether its argument relates to errors allegedly made by the General Court in its findings with regard to the national legislation at issue, which would be open to review by the Court of Justice on the basis of the considerations set out in the preceding paragraph.

55 As regards, in the first place, the assertion that, in holding that Article 8(3) of the CPI confers on the proprietor of a name the right to have the use of that name as a trade mark prohibited, the General Court interpreted that provision in a way that was inconsistent with its wording, it should be noted that, according to the terms of the provision, the names of well-known persons may be registered as a trade mark only 'by the proprietor, or with the consent of the latter'. Since the wording of Article 8(3) of the CPI makes registration of the names of well-known persons as trade marks conditional on consent being given by the proprietor of the name, it was possible for the General Court, without distorting that text, to infer from it that the proprietor of a well-known name is entitled to prevent the use of that name as a trade mark where he maintains that he has not given his consent to registration of that mark.

56 In the second place, as regards the complaint that, by holding that Article 8(3) of the CPI applies irrespective of the sector in which the renown of the name in question was acquired, the General Court interpreted that provision in a way that was inconsistent with its wording, it must be held that, as the General Court observed in paragraph 50 of the judgment under appeal, the wording of that provision, in so far as it refers to the names of well-known persons, makes no distinction according to the sector in which that renown was acquired. Nor did the General Court distort the content of Article 8(3) of the CPI in holding in paragraph 56 of the judgment under appeal that there is no justification for excluding the application of that provision where the name of a well-known person has already been registered or used as a trade mark. Article 8(3) of the CPI, as the General Court observed, does not lay down any condition other than that the personal name concerned must be well known.

57 With regard to academic writings, the General Court, in the context of its review of legality, examined the assessment made by the Board of Appeal. It is apparent from paragraphs 58 to 60 of the judgment under appeal that the General Court did not disregard the fact that certain views on which the Board of Appeal relied might have supported the appellant's case. The General Court stated however, in paragraph 58 of that judgment, that the opinion attributed by the Board of Appeal to Mr Vanzetti, as the author of a work, was disputed by the author himself at the hearing before the General Court, at which he was present as Mr Fiorucci's lawyer. The General Court also held, in paragraph 59 of that judgment, that the terms used by Mr Ricolfi in his writings, in particular the reference to 'the renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character', was not sufficiently clear to support a restrictive interpretation of Article 8(3) of the CPI. In the case of Mr Ammendola, referred to in paragraph 60 of the judgment, the General Court held that the opinion expressed by that author did not by itself have sufficient authority to make application of Article 8(3) of the CPI subject to a condition which does not follow from the actual wording of that provision. Nor can the General Court be criticised in those circumstances for distorting those particulars that were submitted to it.

58 Therefore, the first part of the first plea and the second plea must be rejected as unfounded.

Third and fourth pleas: failure to state adequate grounds, and infringement of Article 63 of Regulation No 40/94 and failure to do justice, respectively

#### **Arguments of the parties**

59 By its third plea, the appellant recalls that, in its statement in intervention before the General Court, it claimed that it was incumbent on Mr Fiorucci to prove that he had refused his consent to registration of the trade mark ELIO FIORUCCI. By failing to respond to that plea, the General Court infringed its obligation to state adequate grounds for its decision.

60 In that regard, Mr Fiorucci considers that the grounds stated in paragraph 64 of the judgment under



appeal are adequate. Moreover, he alleges, the plea is totally unfounded.

61 By its fourth plea, the appellant criticises the General Court for failing to examine the argument it put forward in the alternative, that the trade mark ELIO FIORUCCI was included in the assignment by Mr Fiorucci to the appellant of all his trade marks, and for merely finding in that regard that the Board of Appeal had not ruled on that question. The General Court should have used its power to alter decisions by examining and accepting that argument, which should have led it to uphold the operative part of the contested decision whilst amending the reasoning on which it was based. At the very least, the General Court should have expressly referred examination of that argument to the Board of Appeal. By failing to rule in that way, the General Court infringed Article 63(3) of Regulation No 40/94 and failed to do justice.

62 Mr Fiorucci observes that, under the rules of procedure of the Boards of Appeal, if the measures necessary to comply with a judgment of the Court of Justice annulling a decision of a Board of Appeal include re-examination of the case, the case is to be referred automatically to a Board of Appeal.

#### **Findings of the Court**

63 The question, raised in the context of the third plea, whether the grounds of a judgment of the General Court are inadequate is a question of law which is amenable, as such, to review on appeal (see, inter alia, Joined Cases C-120/06 P and C-121/06 P FIAMM and FIAMM Technologies v Council and Commission [2008] ECR I-6513, paragraph 90, and Case C-47/07 P Masdar (UK) v Commission [2008] ECR I-9761, paragraph 76).

64 It is clear from established case-law that the obligation on the General Court, under Article 36 of the Statute of the Court of Justice, applicable to the General Court by virtue of the first paragraph of Article 53 thereof, and Article 81 of the Rules of Procedure of the General Court, to state reasons does not require the General Court to provide an account which follows exhaustively and one by one all the arguments put forward by the parties to the case and that the Court's reasoning may therefore be implicit on condition that it enables the persons concerned to know why the General Court has not upheld their arguments and provides the Court of Justice with sufficient material for it to exercise its power of review (see, inter alia, FIAMM and FIAMM Technologies v Council and Commission, paragraph 91, and Case C-440/07 P Commission v Schneider Electric [2009] ECR I-6413, paragraph 135).

65 It is apparent from the statement in intervention lodged by the appellant before the General Court that it had put forward an alternative argument based, in essence, as the General Court summarised it in paragraph 64 of the judgment under appeal, on the assertion that the trade mark ELIO FIORUCCI was included in the assignment by Mr Fiorucci to the appellant of all his marks and all his distinctive signs. Among the arguments set out in connection with that alternative argu-

ment, the appellant maintained, inter alia, as it recalls in its third plea, that it was incumbent on Mr Fiorucci to prove that he had refused his consent to registration of the trade mark ELIO FIORUCCI.

66 It is true that the General Court rejected as irrelevant all of the arguments submitted in the alternative, without examining their merits.

67 However, that rejection came at the end of reasoning comprising two stages. In paragraph 64 of the judgment under appeal, the General Court held that the Board of Appeal had not based its decision to dismiss the application for a declaration of invalidity submitted by Mr Fiorucci on the grounds set out in the alternative by the appellant. In paragraph 65 of that judgment, the General Court added that, in so far as it carries out a review of the legality of the decisions of OHIM bodies, it may not, in any event, substitute its own reasoning for that of the OHIM body which adopted the contested act.

68 The General Court thus provided adequate grounds in so far as it enables the appellant to know the reasons why the General Court has not upheld its arguments and the Court of Justice to exercise its power of review.

69 The third plea must therefore be rejected as unfounded.

70 By its fourth plea, the appellant calls into question the merits of the grounds provided by the General Court, in that it claims that the refusal of that Court to examine its alternative arguments and to alter the grounds of the contested decision constitutes an infringement of Article 63(3) of Regulation No 40/94 and a denial of justice.

71 As a preliminary point, it should be noted that the General Court was right to point out that the review it carries out under Article 63 of Regulation No 40/94 is a review of the legality of the decisions of the Boards of Appeal of OHIM and that it may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of the grounds for annulment or alteration set out in Article 63(2) of that regulation ([Case C-16/06 P Les Éditions Albert René v OHIM \[2008\] ECR I-10053, paragraph 123](#)).

72 It follows that the power of the General Court to alter decisions does not have the effect of conferring on that Court the power to substitute its own reasoning for that of a Board of Appeal or to carry out an assessment on which that Board of Appeal has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take.

73 In the present case, the Board of Appeal based the annulment of the Cancellation Division's decision merely on the finding that Mr Fiorucci, according to the interpretation it gave of Article 8(3) of the CPI, could not rely on a right to a name within the meaning of Article 52(2)(a) of Regulation No 40/94. The Board of Appeal did not therefore rule on the effect which the

alleged assignment of the trade mark at issue by contract to the appellant might have as regards the validity of that trade mark.

74 In those circumstances, the General Court was right not to examine that part of the appellant's alternative arguments.

75 In so far as the appellant criticises the General Court for not expressly referring examination of that argument to the Board of Appeal, suffice it to note that, in the context of an action before the Court of Justice against the decision of a Board of Appeal, OHIM is required, under Article 63(6) of Regulation No 40/94, to take the necessary measures to comply with the judgment of the Court of Justice. Furthermore, in pointing out in paragraph 67 of the judgment under appeal, with an express reference to paragraph 64 of that judgment, that that argument was not examined by the Board of Appeal, the General Court gave that Board a clear indication as to the measures it should take.

76 It follows from the above that the fourth plea must be rejected as unfounded.

#### **Fifth plea: the order for costs**

77 The appellant claims that the order for costs made against it by the General Court, which is unfair, must be set aside as a consequence of the judgment under appeal being set aside. In the event of the appeal being dismissed, the costs should at least be shared between the parties.

78 In that regard, suffice it to note that, according to settled case-law, where all the other pleas put forward in an appeal have been rejected, any plea challenging the decision of the General Court on costs must be rejected as inadmissible by virtue of the second paragraph of Article 58 of the Statute of the Court of Justice, which provides that no appeal is to lie regarding only the amount of the costs or the party ordered to pay them (see, *inter alia*, Joined Cases C-302/99 P and C-308/99 P Commission and France v TF1 [2001] ECR I-5603, paragraph 31, and Case C-485/08 P Gualtieri v Commission [2010] ECR I-0000, paragraph 111).

79 Therefore, since all the other pleas put forward in the appeal brought by the appellant have been rejected, the last plea concerning the allocation of costs must be declared inadmissible.

80 It follows from all the foregoing considerations that the appellant's appeal must be dismissed.

#### **The claim for amendment of the judgment under appeal submitted by Mr Fiorucci**

##### **Arguments of the parties**

81 In his response, Mr Fiorucci contends that the Court of Justice should amend paragraphs 33 to 35 of the judgment under appeal. In his submission, the General Court was wrong to hold, in the context of the examination of the application for revocation, that the trade mark ELIO FIORUCCI is not, in itself, liable to mislead the public as to the origin of the goods for which it is registered.

82 The appellant argues that that claim for amendment does not satisfy the requirements of Article 116 of the

Rules of Procedure of the Court of Justice and must therefore be declared inadmissible.

#### **Findings of the Court**

83 Article 116 of the Rules of Procedure of the Court of Justice provides that a response must seek to dismiss, in whole or in part, the appeal or to set aside, in whole or in part, the decision of the General Court or the same form of order as that sought at first instance. Article 113 of the Rules of Procedure of the Court of Justice lays down the same requirements as regards an appeal.

84 In the present case, Mr Fiorucci's claim seeks not to have the judgment under appeal set aside, even in part, but amendment of a finding made by the General Court in the context of its examination of Mr Fiorucci's second plea, a plea which it rejected moreover.

85 Such a claim can, therefore, only be rejected as inadmissible.

#### **Costs**

86 Under Article 69(2) of the Rules of Procedure of the Court of Justice, which, under Article 118 thereof, applies to the procedure on appeal, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. However, under the first subparagraph of Article 69(3) of those rules, where each party succeeds on some and fails on other heads, the Court may order that the parties bear their own costs.

87 In the present case, the appellant has failed in all its pleas, except in respect of Mr Fiorucci's claim for amendment of the judgment under appeal. OHIM has failed on all heads. Mr Fiorucci has been successful in his claims, apart from his claim for amendment of the judgment under appeal.

88 In those circumstances, the appellant and OHIM must each be ordered to bear its own costs and to pay jointly three quarters of the costs of Mr Fiorucci. Mr Fiorucci must be ordered to bear one quarter of his own costs.

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

1. Dismisses the appeal;
2. Dismisses the claim for amendment of the judgment of the Court of First Instance of the European Communities of 14 May 2009 in Case T-165/06 Fiorucci v OHIM – Edwin (ELIO FIORUCCI), submitted by Mr Fiorucci;
3. Orders Edwin Co. Ltd and the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) each to bear its own costs and to pay jointly three quarters of the costs of Mr Fiorucci;
4. Orders Mr Fiorucci to bear one quarter of his own costs.

[Signatures]

\* Language of the case: Italian.

#### **Opinion of Advocate-General Kokott**

delivered on 27 January 2011 (1)

Case C-263/09 P

Edwin Co. Ltd



*(Appeal – Community trade mark – Word mark ‘ELIO FIORUCCI’ – Right to a name – Application for a declaration of invalidity lodged by the bearer of the name included in the mark – Article 52(2)(a) of Regulation (EC) No 40/94 – Rejection of that application by the Board of Appeal – Review by the General Court and Court of Justice of the application of national law)*

## **I – Introduction**

1. The appellant Edwin Co. Ltd and Mr Elio Fiorucci disagree on who may be proprietor of the Community word mark ELIO FIORUCCI. Mr Fiorucci relies on Italian legal rules which, in his view, give him the exclusive right to register the mark in question.

2. Mr Fiorucci and the appellant were initially in dispute in invalidity and appeal proceedings before the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (‘OHIM’). In those proceedings Mr Fiorucci sought to assert his right to his name which he claimed was given special protection under Italian law. The main dispute between the parties focused on the existence of such protection and whether under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (2) in conjunction with Italian law Mr Fiorucci was entitled to prevent a third party from becoming the proprietor of the Community word mark ELIO FIORUCCI. In the proceedings before the Board of Appeal Mr Fiorucci was unsuccessful in his legal argument.

3. By judgment of 14 May 2009 in *Fiorucci v OHIM* (3) (‘the judgment under appeal’), the Court of First Instance (now ‘the General Court’) annulled the decision of the First Board of Appeal of OHIM contested in those proceedings ‘in so far as it contains an error of law in the interpretation of Article 8(3) of the Codice della Proprietà Industriale (Italian Industrial Property Code) [“CPI”]’ (point 1 of the operative part). In the judgment under appeal that Italian provision in conjunction with Article 52(2)(a) of Regulation (EC) No 40/94 as amended (‘Regulation No 40/94’) is examined and interpreted.

4. The appellant appeals against that judgment complaining primarily that the General Court erred in its interpretation of the Italian provision concerned.

5. However, do questions on the interpretation of national legislation constitute a matter on which the Court of Justice may take a view in appellate proceedings?

## **II – Legal framework**

### **A – Law of the European Union**

#### **1. Treaty on the European Union (TEU)**

6. Article 19(1) TEU provides:

*‘The Court of Justice of the European Union shall include the Court of Justice, the General Court and specialised courts. It shall ensure that in the interpretation and application of the Treaties the law is observed. Member States shall provide remedies sufficient to ensure effective legal protection in the fields covered by Union law.’*

#### **2. Treaty on the Functioning of the European Union (TFEU)**

7. The second subparagraph of Article 256(1) TFEU provides:

*‘Decisions given by the General Court ... may be subject to a right of appeal to the Court of Justice on points of law only, under the conditions and within the limits laid down by the Statute.’*

8. Article 263 TFEU provides:

*‘The Court of Justice of the European Union shall review the legality of legislative acts, of acts of the Council, of the Commission and of the European Central Bank, other than recommendations and opinions, and of acts of the European Parliament and of the European Council intended to produce legal effects vis-à-vis third parties. It shall also review the legality of acts of bodies, offices or agencies of the Union intended to produce legal effects vis-à-vis third parties.’*

*It shall for this purpose have jurisdiction in actions brought by a Member State, the European Parliament, the Council or the Commission on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaties or of any rule of law relating to their application, or misuse of powers.’*

...’

#### **3. Statute of the Court of Justice**

9. Article 58, first paragraph, of the Statute of the Court of Justice (4) states:

*‘An appeal to the Court of Justice shall be limited to points of law. It shall lie on the grounds of lack of competence of the General Court, a breach of procedure before it which adversely affects the interests of the appellant as well as the infringement of Union law by the General Court.’*

#### **4. Regulation No 40/94**

##### **a) Version of Regulation No 40/94 which applies**

10. In substantive terms, the version of Regulation No 40/94 relevant to the present case is the version applicable at the time the decision of the Board of Appeal was issued.

11. The Board of Appeal of OHIM was required to reach its finding based on the facts and law applicable at the time of its decision. (5) In accordance with Article 63(1) of Regulation No 40/94, (6) an action was brought before the General Court contesting the decision of the Board of Appeal. Whether that decision contains an error of law had to be assessed simply in accordance with the legal position applicable at the time of the contested appeal decision. (7) Accordingly, the General Court based its assessment on the version of Regulation No 40/94 applicable at the time the appeal decision was adopted. (8) That version is applicable also in the present appeal.

##### **b) Relevant provisions**

12. Article 50(1) of Regulation No 40/94 (9) provides: *‘The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:’*

...

*(c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect*

of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.’

13. Article 52(2) of Regulation No 40/94 (10) provides: ‘A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:

(a) a right to a name;  
 (b) a right of personal portrayal;  
 (c) a copyright;  
 (d) an industrial property right;  
 under the Community legislation or national law governing the protection.’

14. Article 63 of Regulation No 40/94 (11) provides:

‘(1) Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.  
 (2) The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application [(12)] or misuse of power.  
 (3) The Court of Justice has jurisdiction to annul or to alter the contested decision.  
 ...  
 (6) The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.’

### 5. Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (13) (‘implementing regulation’)

15. In this Opinion, I shall refer to the provisions of the implementing regulation in the version which applied at the time of the decision of the Cancellation Division (14) and at the time of the decision of the Board of Appeal. (15)

16. Under the heading ‘Application for revocation or for a declaration of invalidity’, Rule 37 provides: ‘An application to the Office for revocation or for a declaration of invalidity ... shall contain:

(b) as regards the grounds on which the application is based,  
 ...

(iii) in the case of an application pursuant to Article 52(2) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing [(16)] that the applicant is the proprietor of an earlier right as referred to in Article 52(2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right;  
 ...’

### B – National law

17. According to Article 8(3) of the CPI (17) in the version applicable here, (18) personal names, signs used in the artistic, literary, scientific, political or sporting fields, the designations and acronyms of events and those of non-profit making bodies and associations,

including their characteristic emblems, may, if they are well known, be registered by the proprietor, or with the consent of the latter or of the persons referred to in paragraph 1. (19)

### III – Background to the case

18. The General Court described the background to the case as follows:

‘1 The applicant, the fashion designer Elio Fiorucci, achieved certain renown in the 1970s in Italy. Following financial difficulties in the 1980s, an administrator was appointed in respect of his company, Fiorucci SpA. 2 On 21 December 1990, Fiorucci sold to the intervener, Edwin Co. Ltd, a Japanese multinational, the entirety of its “creative assets”. Article 1 of the contract stipulates:

“The company Fiorucci assigns, sells and transfers to the company Edwin ... which, for its part, acquires:

– (i) trade marks wherever registered, or trade marks for which registration has been sought in any part of the world whatsoever, and all patents, ornamental and utility models and all other distinctive signs belonging to the company Fiorucci as listed in the annex to this contract ...

– (iv) all the rights exclusively to use the designation “FIORUCCI” and exclusively to manufacture and sell the clothes and other goods bearing the name “FIORUCCI”.

...

4 On 23 December 1997, the intervener filed an application with [OHIM] for registration of the word mark ELIO FIORUCCI as a Community trade mark ...

5 On 6 April 1999, the word mark ELIO FIORUCCI was registered by OHIM ...

6 On 3 February 2003, the applicant filed an application for revocation and for a declaration of the invalidity of that mark, pursuant to Article 50(1)(c) and Article 52(2)(a) of ... Regulation ... No 40/94 ... as amended.

7 By decision of 23 December 2004, the Cancellation Division of OHIM allowed the application for a declaration of invalidity of the mark ELIO FIORUCCI on the ground of infringement of Article 52(2) of Regulation No 40/94 ...

8 The Cancellation Division found that Article 21(3) of the Legge Marchi (Italian Law on trade marks) (now Article 8(3) of the [CPI]) was applicable and annulled the registration of the mark at issue because it was established that the name Elio Fiorucci was well known and because there was no evidence of ... consent to registration of that name as a Community trade mark. ...

9 The intervener then brought an appeal against that decision before the Board of Appeal of OHIM seeking the rejection of the application for a declaration of invalidity of the mark at issue and maintenance of the registration.

10 By decision of 6 April 2006 ..., the First Board of Appeal of OHIM allowed the intervener’s appeal and annulled the decision of the Cancellation Division, holding that the ground of invalidity referred to in Article 52(2) of Regulation No 40/94 did not apply in the present case, which did not fall within the cases pro-

vided for under national law (Article 8(3) of the [CPI]). The application brought by the applicant for revocation of the mark at issue, alleging infringement of Article 50(1)(c) of Regulation No 40/94, was also rejected by the Board of Appeal.

11 In particular, the Board of Appeal stated that the *raison d'être* of Article 8(3) of the [CPI] was to prevent third parties from exploiting for commercial purposes the name of a famous person. ... The Board of Appeal stated that there was not, to its knowledge, case-law on that point but that "the most authoritative Italian academic writings" seemed to confirm that the *raison d'être* of the provision cited ceases where that commercial potential is already fully exploited. The Board of Appeal stated that, in the present case, the renown of the name Elio Fiorucci with the Italian public could certainly not be regarded as arising from its first use in the non-commercial sector. ....

12 With regard to the application for revocation brought under Article 50(1)(c) of Regulation No 40/94, the Board of Appeal stated ...

13 ... [t]hat the public is aware that patronymics are commonly used as commercial marks, but that does not imply that those patronymics correspond to an actual person. In addition, the Board of Appeal held that, by the sale of 1990, the applicant had waived all rights of use pertaining both to the mark FIORUCCI and to the mark ELIO FIORUCCI. ...

14 ... In the present case, the Board of Appeal found that the mark ELIO FIORUCCI, representing only the name of a person, did not give any indication of a specific quality and that therefore there could not be any question of the public being misled.'

#### **IV – Judgment under appeal**

19. By his action, Mr Fiorucci sought from the General Court both the annulment of the decision of the Board of Appeal and a declaration revoking the contested Community trade mark, or in the alternative, deeming it invalid. To that extent, he alleged infringement of Article 50(1)(c) and Article 52(2)(a) of Regulation No 40/94.

20. His action was in part successful.

21. Admittedly, the General Court rejected the plea for revocation brought under Article 50(1)(c) of Regulation No 40/94. In its view, the particular requirements necessary for a designer name to be regarded as liable to mislead (20) were not satisfied. In addition, no evidence of misleading use of the mark was demonstrated. (21)

22. In examining the plea based on Article 52(2)(a) of Regulation No 40/94 the General Court considered in detail (22) the interpretation of Article 8(3) of the CPI and held, *inter alia*, on that point:

'50 First, it must be held that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal is not confirmed by the wording of that provision, which refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired.

...

53 Second, contrary to what is suggested by the Board of Appeal ..., even on the assumption that the name of a well-known person has already been registered or used as a *de facto* trade mark, the protection given by Article 8(3) of the [CPI] is not in any way superfluous or irrelevant.

...

55 ... [I]t is not ruled out that the name of a well known person, registered or used as a mark for certain goods or services, can be the subject of a new registration for different goods or services which are not in any way similar to those covered by the earlier registration. ...

56 It must be held, furthermore, that Article 8(3) of the [CPI] does not lay down, for its application, any condition other than that relating to the well-known character of the personal name concerned. ...

57 Third, the extracts from some of the academic writings cited in ... the contested decision also do not allow the conclusion to be drawn that the interpretation of Article 8(3) of the [CPI] adopted by the Board of Appeal in the contested decision is correct.

58 Thus, Mr Vanzetti, author with Mr Di Cataldo of the work cited in ... the contested decision, took part in the hearing as lawyer for the applicant and stated that the thesis adopted by the Board of Appeal did not follow at all from what he had written in the work in question ...

59 Mr Ricolfi ... refers, according to the Board of Appeal, to the "renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character", which does not at all exclude renown resulting from an 'entrepreneurial' use ...

60 Only Mr Ammendola ... refers to a use in a "sector outside the market", without thereby expressly concluding that Article 8(3) of the [CPI] cannot be invoked to protect the name of a person whose renown was not acquired in such a field. In any case, having regard to all of the foregoing considerations, the Court cannot, only on the basis of the opinion of that one author, make the application of the provision in question subject to a condition which does not follow from its wording.

61 It follows that the Board of Appeal committed an error of law in its interpretation of Article 8(3) of the [CPI]. As a result of that error it ruled out, incorrectly, the application of that provision to the case of the applicant's name, even though it is not disputed that that is the name of a well-known person.

...'

23. Although those considerations persuaded the General Court in point 1 of the operative part to annul the decision of the Board of Appeal in so far as it contained an error of law in the interpretation of Article 8(3) of the CPI they did not result in a declaration holding the contested mark to be invalid. In relation to the claim that the mark ELIO FIORUCCI was included in the assignment of all the marks and all the distinctive signs the General Court held simply that that argument had not been examined by the Board of Appeal and accordingly refused to grant the applicant's application to alter the contested decision stating that that would imply, in substance, the exercise of administrative and investi-



gatory functions specific to OHIM and would upset the institutional balance. (23)

#### **V – The appeal and forms of order sought by the parties**

24. In its appeal the appellant challenges the judgment under appeal and seeks to have set aside point 1 of the operative part. In the alternative, it bases its application for setting aside on an alleged failure to state adequate grounds. In the further alternative, it contends that at any rate the Court should refer that argument to OHIM for examination. In the further alternative, it bases its application for setting aside on an alleged denial of justice in the form of an infringement of Article 63(3) of Regulation No 40/94. Very much in the alternative, it contends that the Court should refer that argument to OHIM for examination. In addition, the appellant contends that the Court should order Mr Fiorucci to reimburse all the costs incurred by it at first and second instance or, in the event that the appeal is not upheld, order each party to bear its own costs.

25. OHIM contends that the Court should set aside the judgment under appeal and order Mr Fiorucci to pay the costs incurred by it.

26. Mr Fiorucci contends that the Court should uphold points 1, 3 and 4 of the operative part of the judgment under appeal, alter paragraphs 33 to 35 of that judgment and order that the costs of his appeal be reimbursed.

27. The appellant contends that the Court should dismiss Mr Fiorucci's plea seeking an alteration.

#### **VI – Appraisal of the grounds of appeal**

##### **A – First and second grounds of appeal: infringement of Article 52(2)(a) of Regulation No 40/94 and Article 8(3) of the CPI**

28. As the normative structure of Article 52(2) of Regulation No 40/94 results in an interdependence of the provisions concerned, and the arguments of the parties to that extent overlap, I consider it appropriate to undertake a joint examination of the first two grounds of appeal. In substantive terms, the arguments of the parties can be divided into those which contest in general the applicability of Article 52(2)(a) of Regulation No 40/94 to the present case and those which question the interpretation of Article 8 of the CPI in the context of applying Regulation No 40/94.

##### **1. Is Article 52(2)(a) of Regulation No 40/94 inapplicable?**

29. First, the material scope of Article 52(2)(a) of Regulation No 40/94 must be considered. The appellant contends that the registration entitlement established by Article 8 of the CPI protects purely pecuniary interests in signs which have become well-known in the non-commercial sector. On the other hand, Article 52(2)(a) of Regulation No 40/94 seeks to protect the personality interest of an individual in his right to his name. However, according to the appellant, Mr Fiorucci failed to show any infringement of that right.

##### **a) Material scope of Article 52(2)(a) of Regulation No 40/94**

30. According to Article 52(2) of Regulation No 40/94, an application for invalidity may be based 'in particu-

lar' on a right to a name (subparagraph (a)) but also on a right to personal portrayal (subparagraph (b)), a copyright (subparagraph (c)), an industrial property right (subparagraph (d)) or any other earlier right where pursuant to the law governing the protection of that right the use of the contested mark may be prohibited.

31. Accordingly, the scope of that provision is extremely wide and open. The rights expressly but not exhaustively mentioned in that provision all concern matters other than trade mark law. Apart from that, their only common feature is that they grant the rightholder – for whatever legal reason – the right to prohibit use of the mark.

32. Therefore, from the wording of the provision, its restriction to the imperilment of the personality interests or creative and intangible interests of the rightholder can hardly be presumed, particularly given that both in the case of copyright and industrial property rights in general the emphasis is likely to be on tangible interests. Thus, the grammatical and the schematic interpretation of Article 52(2)(a) of Regulation No 40/94 contradict a restrictive understanding of that provision.

33. The practice of the Boards of Appeal of OHIM confirms this interpretation. They granted applications for invalidity on the basis, for example, of rights to an image (24) and a copyright-protected depiction of a wine leaf (25) and considered the applicability of Article 52(2) of Regulation No 40/94 to film titles, (26) without engaging in a teleological reduction in the manner argued for by the appellant.

##### **b) Interim conclusion**

34. Accordingly, Article 52(2) of Regulation No 40/94 applies to the present case if the right under Article 8 of the CPI on which Mr Fiorucci relies in fact exists.

##### **2. Has Article 52(2)(a) of Regulation No 40/94 been infringed through an incorrect assessment of Article 8 of the CPI?**

##### **a) Arguments of the parties**

35. The appellant and OHIM contend that Article 8 of the CPI was interpreted incorrectly by the General Court and that this necessarily results in an infringement of Article 52(2)(a) of Regulation No 40/94.

36. According to the appellant, by reason of the reference made in Article 52(2) of Regulation No 40/94, Article 8(3) of the CPI became an 'integral part of the legal order of the European Union'. However, so it argues, Article 8(3) of the CPI does not confer on Mr Fiorucci as the bearer of that name the right to prohibit the use of a mark but simply the first right to register the name as a mark. Marks containing the element FIORUCCI, including in addition to the Italian mark FIORUCCI the New Zealand mark ELIO FIORUCCI, were previously registered by Mr Fiorucci. Later he sold those marks through Fiorucci SpA to the appellant. By reason of the possibility of confusion with marks already protected, Mr Fiorucci can no longer register – where this is contrary to the wishes of the proprietor of the mark – any further marks containing the element FIORUCCI. (27)

37. The appellant contends further that Article 8(3) of the CPI applies only to names which first became well-known in a non-commercial field. That results both from Italian legal literature and previous rulings on Article 8(3) of the CPI concerning only ‘non-commercial signs’. For the appellant, it is incomprehensible that the General Court did not consider that case-law proffered also at first instance.

38. OHIM essentially complains that the General Court did not examine the repercussions of the sale of all the marks containing the element FIORUCCI for the interpretation of Article 8(3) of the CPI. Those marks were registered with the consent of Mr Fiorucci. Accordingly, so it argues, he exhausted his rights under Article 8(3) of the CPI. Article 52(2)(a) of Regulation No 40/94 refers to Article 8(3) of the CPI. Thus, incorrect assessment of the Italian provision may constitute an infringement of Article 52(2)(a) of Regulation No 40/94.

39. Mr Fiorucci resists that argument which he contends is in part inadmissible, as it was not advanced at first instance, and in part unfounded.

#### **b) Questions to be resolved**

40. As Article 8 of the CPI does not constitute a provision of European Union law (‘EU law’), but a provision of Italian law, I will examine first how it should be taken into consideration when applying Article 52(2) of Regulation No 40/94.

41. As a second step, I will then consider whether and, if so, to what extent the complaint of a legally incorrect interpretation of Article 8 of the CPI may be advanced before the Courts of the European Union (‘EU Courts’).

#### **i) Normative structure of Article 52(2)(a) of Regulation No 40/94 in conjunction with national law: no assimilation of national law through EU law**

##### **– Grammatical and schematic interpretation of the provision**

42. If one examines the wording of Article 52(2) of Regulation No 40/94, it is apparent that for the derivation of the right to a name defeating the use of a mark this provision establishes a distinction, that is, rights based either on ‘Community legislation or national law’. (28) It follows from this twin-track approach established by the legislature that in applying Article 52(2) of Regulation No 40/94 it may be necessary as a preliminary point to examine national law when the relevance of a right to a name vis-à-vis a subsequent mark is at issue.

43. However, that fact does not endow national law with the character of EU law. In particular, the case-law which holds that international law may be an integral part of EU law is not relevant here. (29) Instead, the very wording of the provision militates against the incorporation of national law through EU law and suggests a separation from one another of the two issues. Thus, also in the framework of examining the criterion of a ‘right to a name’ Article 8 of the CPI retains its character as a provision of national law.

##### **– Special status accorded to national law having regard to the implementing regulation**

44. If one looks at the implementing regulation, this confirms that national law to which reference is made in Article 52(2) of Regulation No 40/94 is not absorbed by EU law but must be viewed in an independent legislative context distinct from EU law.

45. Under Rule 37, the applicant must furnish ‘particulars showing that [he] is the proprietor of an earlier right as referred to in Article 52(2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right’. (30)

46. Thus, the applicant has the obligation to present the facts and the burden of proof to establish before OHIM that the right in question on which it relies enables the use of a subsequent mark to be prohibited. (31)

47. Initially, that allocation of the obligation to present the facts and of the burden of proof appears strange as it places the national legal position more on a par with the submissions on the facts. (32) However, on closer inspection, that appears consistent and appropriate to the function of national law in the cases where reference is made thereto in the framework of European Union legislation.

48. In EU law procedures, national law and EU law do not constitute the same kind of law and in their application are characterised by important practical differences. These are rendered clear also in judicial practice.

#### **ii) Special status accorded to national law in the judicial practice of the EU Courts**

##### **– General preliminary observation**

49. The EU Courts are given the task of ensuring that ‘in the interpretation and application of the Treaties the law is observed’ (33) (Article 19 TEU). In principle, their tasks do not include the interpretation of national law. That is a matter for the courts of the Member States. However, in applying European Union legislation, as in the present case, questions on the substance and interpretation of national law may arise.

50. In that regard, there are no specific instruments available to EU Courts by which they may establish the national legal position in relation to a particular set of facts. EU law does not provide for a procedure, in the sense of a counterpart to the preliminary ruling procedure, whereby a reference may be made to national supreme courts or other national bodies to obtain a binding ruling on a specific issue of national law.

51. Likewise, nor does EU procedural law provide in such a case that the proceedings must necessarily be stayed and the parties ordered to bring the matter before the national courts and to obtain by way of an action for declaration a ruling on the legal position. As a rule, for obvious practical reasons, the EU Courts and a fortiori the other bodies responsible for applying EU law (34) are likely to find it disproportionately more difficult to establish correctly the national law applicable to a particular set of facts than to assess the case from the perspective of EU law.

52. Although according to the second paragraph of Article 24 of its Statute (35) the Court may generally ‘require the Member States ... to supply all information which the Court considers necessary for the proceed-

ings', first, that provision is of no assistance where the Court is faced with the national law of a non-member country and, second, information on the substance, say, of national tax legislation is not equivalent to a binding judicial ruling on the legal position which applies to a particular set of facts.

– **National law in the context of Article 52(2) of Regulation No 40/94**

53. However, at least in the case of Article 52(2) of Regulation No 40/94 at issue here, the EU Courts are spared that problem. According to the implementing regulation, the applicant itself must furnish proof of the right on which it seeks to rely. Thus, assessment of the evidence adduced by that party – and not more (36) – is the task facing OHIM and, if the matter goes further, the EU Courts to which any disputes are referred.

54. Admittedly, there is no specific provision in relation to judicial proceedings which corresponds to Rule 37 of the implementing regulation. However, there is no reason to depart from the principle established by that rule in the context of judicial proceedings. If the subject of the dispute before the Board of Appeal and the General Court is identical, (37) it is logically consistent that this should apply also to the allocation and extent as between the parties of the obligation to present the facts and concerning the burden of proof.

55. Thus, from the perspective of those applying EU law, the national law to be examined as a preliminary issue exits the legal sphere and becomes approximated to the factual sphere amenable to the adduction of evidence. (38)

56. In locating the national law to be examined as a preliminary issue of fact where facts must be presented and are subject to the requirements of the burden of proof, (39) EU law finds itself, first, to be in harmony with the classic principles of private international law. (40) Second, that approach which in the field of European Union trade mark law appears – implicitly on an individual case basis – to be laid down in substantive law by the implementing regulation corresponds also to the conventional practice of international courts and arbitration tribunals. (41) The maxim *iura novit curia* applies, if at all, to the relevant issues of international law but not national law, (42) the substance of which must be demonstrated where necessary by the production of evidence and which must be assessed in the light of the argument advanced by the parties without any obligation on the court to engage in a more thorough examination of the matter.

– **Interim conclusion**

57. Although the mere reference to national law in Regulation No 40/94 does not transform that law into EU law, an incorrect assessment of national law, where this is relevant as a preliminary issue for the purposes of the criteria established by Article 52(2)(a) of Regulation No 40/94, may none the less result in a finding incorrectly establishing or denying the existence of a criterion, such as a right to a name defeating the use of a mark.

58. However, the question of whether a complaint to that effect may be examined by the General Court or on

appeal before the Court of Justice will be assessed below.

**iii) The complaint alleging an infringement of Article 8(3) of the CPI before the EU Courts**

59. The written submissions of the appellant and Mr Fiorucci consider, in part, on a detailed basis, the different approaches to the interpretation of the provision concerned advanced in the Italian literature which they each wish to adopt in support of their own position. However, in that regard, no mention was made of the question whether on appeal the Court of Justice is at all authorised to review the assessment of national law made at first instance by the General Court. At the hearing, the appellant contended that on appeal national law – to the extent that EU legislation refers to it – should be amenable to comprehensive review. On the other hand, in the view of OHIM, simply a review limited to manifest errors, and, in particular, on the basis of the evidence submitted to the General Court, appears warranted. Mr Fiorucci considers the appellate court to be strictly limited to a review of EU law.

60. An initial analysis of trade mark law and procedural law provisions indicates that the EU Courts must not necessarily apply the same yardstick when considering whether the application of national law may be examined for errors of law. In first instance proceedings before the General Court and in appeal proceedings before the Court of Justice different principles apply. The reason for that difference is the fact that national law, divested of its normative character before the EU Courts, is assimilated, so to speak, to the submissions of the parties on the facts. Thus, in accordance with that treatment, on appeal, it is – in the same way as submissions on the facts – amenable only to limited review.

– **Examination of national law by the General Court in the light of Article 63 of Regulation No 40/94 (now Article 65 of Regulation No 207/2009)**

61. Under Article 63(2) of Regulation No 40/94, actions before the Court of Justice against decisions of the Boards of Appeal 'may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power'.

62. The expression 'Court of Justice' in that provision refers to the Court of Justice as an institution and not as a court. (43) Accordingly, Article 63(2) of Regulation No 40/94 must be read as meaning that an action before the General Court may be brought on grounds, *inter alia*, of 'infringement of the Treaty, of this Regulation or any rule of law relating to their application'. (44)

63. The first issue which must be examined is what is meant by '[a] rule of law relating to [the] application [of Regulation No 40/94]'.

64. On a literal interpretation, the general term 'rule of law' includes not only provisions of EU law but also those of national law. In fact, Regulation No 40/94 includes numerous references to national law, in particular in circumstances in which, as in the present case, earlier rights conflict with the Community trade mark. (45)



65. Moreover, rules of law ‘relating to their application’ do not mean simply the provisions of the implementing regulation. If one were to adopt a strict interpretation encompassing simply the implementing regulation, the references in Regulation No 40/94 to national law would be excluded and not amenable to review by the General Court. That would be problematic having regard to the principle of effective legal protection.

66. Other language versions (46) confirm an interpretation of Regulation No 40/94 which is favourable to legal protection. It is noticeable that, for example, the French version of Article 63(2) of Regulation No 40/94 refers to ‘violation du traité, du présent règlement ou de toute règle de droit relative à leur application’. (47) The possessive pronoun ‘leur’, a plural pronoun, indicates more clearly than in the German version that the application of both the Treaty and Regulation No 40/94 is intended. Simply for that reason, to limit the term ‘rule of law’ to provisions of the implementing regulation, which relates only to Regulation No 40/94 but not the Treaty itself, would not make any sense. (48) Thus, the term ‘rule of law’ includes all provisions which must be observed in the interpretation and application of Regulation No 40/94.

67. Therefore, as an interim conclusion it may be stated that an incorrect interpretation of national law – to the extent that its application is called for in the application of Regulation No 40/94 – may be challenged at any rate before the General Court. (49)

68. In the light of that conclusion, the fact that in the judgment under appeal, (50) taking account of the evidence submitted to the Board of Appeal, a thorough examination of Article 8(3) of the CPI was undertaken (51) in principle cannot be challenged on the basis of Article 63 of Regulation No 40/94.

69. However, that does not shed any light on the decisive question for the present appeal, namely, whether the assessment of national law which in accordance with Article 63(2) of Regulation No 40/94 the General Court undertook and which it was entitled to undertake is amenable to review by the Court of Justice.

#### **iv) No examination of national law in appeal proceedings having regard to Article 58 of the Statute of the Court of Justice**

70. Under Article 58 of the Statute of the Court of Justice, an appeal may be brought only on points of law. It lies only on the grounds of lack of competence of the General Court, a breach of procedure before it which adversely affects the interests of the appellant as well as the infringement of Union law by the General Court.

##### **– Grammatical interpretation**

71. If one takes Article 58 of the Statute of the Court of Justice simply on its wording, the Court of Justice is precluded from examining a ground of appeal alleging an infringement of national law. Specifically, such a ground of appeal does not challenge an ‘infringement of Union law’ by the General Court but alleged errors in the application of national law.

72. The fact that Article 52(2) of Regulation No 40/94 may require recourse to be had to national law for the purpose of determining the relevance of earlier rights to

a name vis-à-vis subsequent marks does not transform any national law applied in that connection into EU law which may be challenged by way of an appeal. (52)

73. Moreover, not only the structure and wording of the substantive provision but also a general consideration of the procedural provisions governing actions and appeals supports this outcome.

##### **– Schematic interpretation**

74. An initial comparison of Article 58 of the Statute of the Court of Justice and Article 63(2) of Regulation No 40/94 reveals that the latter provision expressly permits an action to be brought on the basis of an infringement of any rule of law relating to the application of Regulation No 40/94 whereas in the context of appeals the Statute expressly refers to the narrow concept of Union law. The legislature could easily have applied the subtle distinction made in Article 63(2) of Regulation No 40/94 also to Article 58 of the Statute and have included within the purview of the appellate jurisdiction not only Union law but also, using a parallel formulation, other ‘rules of law relating to its application’.

75. However – in contrast, moreover, to the general provision made in Article 263(2) TFEU for actions brought at first instance – that has not happened. If one compares Article 263(2) TFEU, first, with Article 63(2) of Regulation No 40/94 and, second, with Article 58 of the Statute it is clear that in appellate proceedings, in contrast to whatever may be the case at first instance, an examination of rules of law other than EU law is in principle precluded.

76. Nor does the second subparagraph of Article 256(1) TFEU justify any different conclusion. Admittedly, it provides in general for ‘a right of appeal ... on points of law only’ which, at first glance, appears to allow for the inclusion of points of law in relation also to national law. However, the appeal must be ‘within the limits laid down by the Statute’ which results, in turn, in the exclusion on appeal of complaints alleging the infringement of national law.

77. Thus, the schematic view of the provisions governing actions and appeals suggests in principle also that the examination of rules of national law is excluded on appeal. That is consistent, too, as from the perspective of those applying EU law, the national rule is included within the issues of fact, assessment of which is not the task of the appellate jurisdiction, at least in so far as there is no allegation that the General Court distorted the clear meaning of the first instance pleadings or the evidence. (53)

78. Thus supposed errors of law in the application of Article 52(2) of Regulation No 40/94 in relation to the scope of protection of ‘another earlier right’ may be examined comprehensively also on appeal where that earlier right derives from EU law but only in proceedings brought at first instance where national law governs the protection of that earlier right.

##### **– Interim conclusion**

79. If one follows this strict approach, the ground of appeal based on an infringement of Article 8(3) of the CPI must be rejected as inadmissible without any examination of its merits. As regards the scope of the ex-

amination, EU procedural law – at any rate in the context of the Community trade mark regulation relevant here – provides for a clearly balanced, two-tier system of judicial remedies. Under that system, in accordance with Article 63(2) of Regulation No 40/94, a first instance plea on a matter of national law is admissible but a ground of appeal raising that issue is, in principle, inadmissible.

– **No distortion**

80. The fact that in the application of Article 52(2) of Regulation No 40/94 the assessment of national law is approximated to an issue of fact allows, however, for a narrowly-defined possibility of review on appeal. In principle, the General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. (54) However, there is an issue of law which may be raised in the framework of an appeal where it is alleged that it clearly follows from the first instance pleadings that the first instance findings are, in fact, incorrect (55) or that the General Court distorted the clear sense of the evidence submitted. The latter was held to be the case where the assessment of the existing evidence appeared to be clearly incorrect, (56) and applies most certainly if such distortion is obvious from the documents on the court file, without there being any need to carry out a new assessment of the facts and the evidence. (57)

81. Such allegation of distortion cannot reasonably be maintained in relation to the judgment under appeal. On the contrary, the General Court engaged in a detailed analysis of the wording of the Italian provision at issue and assessed in a logically consistent manner the Italian legal literature submitted to the Board of Appeal and to that court itself. No grounds exist for a complaint that the clear sense of the parties' submissions or evidence was distorted.

82. In relation to the national legal position, the General Court was not required to engage in further investigations of its own. On the contrary, as the subject-matter of the proceedings before the General Court is defined by the subject-matter of the appeal to the Board of Appeal, (58) the General Court was required to confine itself to the material on the dispute submitted to the Board of Appeal in relation also to the national legal position. That follows, first, from the classification of national law as an issue of fact and, second, from the fact that a review of the legality of the decision of the Board of Appeal may be undertaken only on the basis of evidence already available to the Board of Appeal. (59)

83. The General Court had to assess whether the assessment of national law made in that regard by the Board of Appeal was well-founded or, if not, whether there had been an infringement of a rule of law relating to the application of Regulation No 40/94. (60) The fact that the appellant now contends that at first instance, moreover, reference was made to various relevant judgments of Italian courts which the General Court did not assess is irrelevant. Although the General Court has the authority to review the legality of decisions of the Board of Appeal, it is precluded from considering evi-

dence first submitted in the annex to the application. (61)

**v) Distinction vis-à-vis the arbitration clause (Article 272 TFEU)**

84. A subtle and highly intricate scheme, as arises through the interplay of trade mark law and procedural law, does not apply in the case of the arbitration clause.

85. The approach taken by the arbitration clause is unusual in that the EU Courts 'have jurisdiction to give judgment pursuant to any arbitration clause in a contract concluded by or on behalf of the Union, whether that contract be governed by public or private law' (Article 272 TFEU) and where that contract ordinarily declares the law of a Member State to be the substantive law applicable.

86. In the present case there is no need to consider whether the legal position concerning the reviewability of national law on appeal is any different where, on the basis of an arbitration clause, a complaint is raised before the EU Courts alleging an infringement of national law.

3. Conclusion on the first and second grounds of appeal  
87. As neither an infringement of Article 52(2)(a) of Regulation No 40/94 nor an infringement of Article 8 of the CPI is to be criticised on appeal, the first and second grounds of appeal must be rejected.

**B – Third and fourth grounds of appeal: failure to state adequate grounds and a denial of justice and/or an infringement of Article 63(3) of Regulation No 40/94**

88. These two grounds of appeal may also be considered together as in essence they concern the division of roles between the General Court and the Board of Appeal and, in particular, the scope of the General Court's power of review.

**1. Failure to state adequate grounds**

89. In the alternative, the appellant bases its appeal on an alleged failure to state adequate grounds in that the General Court is said not to have considered the argument and evidence it submitted to the effect that Mr Fiorucci consented to the registration of the mark. According to the appellant, that supposed consent, first, may be 'presumed' as the application for a declaration of invalidity was lodged only several years after the application for and registration of the mark in question and, second, the Board of Appeal was supplied with a statement by a manager at Fiorucci SpA to whom Mr Fiorucci had declared his consent.

90. It must be borne in mind at the outset that the question whether the grounds of a judgment of the General Court are contradictory or inadequate is a point of law which is amenable, as such, to review on appeal. (62)

91. Under Article 36 of the Statute of the Court of Justice, which in accordance with the first paragraph of Article 53 of the Statute applies also to the General Court, judgments of the General Court must state the grounds on which they are based. The provision does not establish any more detailed requirements concerning that obligation to state reasons.

92. It is clear from established case-law that the obligation to state reasons in particular does not require the

General Court to provide an account which follows exhaustively and one by one all the arguments put forward by the parties to the case and that the reasoning may therefore be implicit on condition that it enables the persons concerned to know why the General Court has not upheld their arguments and provides the Court of Justice with sufficient material for it to exercise its power of review. (63)

93. In paragraphs 64 and 65 of the judgment under appeal, the General Court did not examine the merits of the appellant's arguments on the relevance of Mr Fiorucci's admission on the basis that the Board of Appeal had not rejected the application for a declaration of invalidity on that ground and by reason of the fact that it was precluded from substituting its own reasoning for that of the body concerned.

94. Accordingly, the General Court discharged its obligation to state reasons. The question of whether its assessments were well-founded is irrelevant here. Thus, no failure to state adequate reasons is apparent.

## **2. Denial of justice and/or infringement of Article 63(3) of Regulation No 40/94**

95. In the further alternative, the appellant bases its appeal on an alleged denial of justice. It contends that the General Court refused incorrectly to examine the issue of the acquisition of the mark ELIO FIORUCCI in referring in that regard to the subject-matter of the dispute before the Board of Appeal and incorrectly declined to alter the decision of the Board of Appeal in favour of the appellant. To that extent, so it argues, Article 63(3) of Regulation No 40/94 was infringed.

96. Very much in the alternative, it seeks to have that argument referred to OHIM for examination.

97. However, the judgment under appeal cannot be criticised for the fact that in relation to Article 8 of the CPI it did not examine the supposed relevance – called into question also by OHIM – of the contractual acquisition of the marks and refused to alter the decision of the Board of Appeal.

98. Admittedly, Article 63(3) of Regulation No 40/94 permits the General Court not only to revoke but, in principle, also to alter the decision of the Board of Appeal.

99. However, in the present case there was no reason to do so. Instead, given the subject-matter of the dispute, the hands of the General Court were tied in relation to any alteration of the decision. Legal protection in the field of trade marks has three levels and is characterised by the fact that in relation to issues of fact the Board of Appeal has the central role in delineating the subject-matter of the dispute. For that reason, paragraph 64 of the judgment under appeal is correct to point out that the Board of Appeal did not base its decision on the issue of the acquisition of the marks and rejected the application for a declaration of invalidity (and thus Article 8 of the CPI) on other grounds. It is not open to the EU Courts to undertake a renewed and broader examination of national law taking account of that issue since such national law must be assessed in the same way as an issue of fact and thus forms part of the subject-matter of the dispute.

100. This can no more be regarded as an infringement of Article 63(3) of Regulation No 40/94 than it can be deemed a denial of rights, as alleged by the appellant.

101. However, under Article 63(6) of Regulation No 40/94, OHIM must take the necessary measures to comply with judgments of the EU Courts. Where all or part of a decision of a Board of Appeal is annulled that may mean under Article 1(d) 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 (64) that a 're-examination by the Boards of Appeal' must be undertaken. That is understood to mean a comprehensive examination in the light of the judgment concerned which OHIM must undertake itself independently of any judicial directions. (65)

102. Therefore, in the present case, a Board of Appeal undertaking a re-examination would have to consider, first, whether Mr Fiorucci consented, in fact, to the registration of the mark. That question of fact – although irrelevant for the purposes of the complaint alleging a failure to state adequate reasons – is likely, having regard to the criticism expressed by the General Court concerning the interpretation of Article 8 of the CPI, to be germane and can no longer remain unaddressed. The same applies to the question on the extent to which the contract of sale assigned marks and signs to the appellant.

103. Although the appellant's plea – advanced very much in the alternative – seeks to obtain an order requiring OHIM specifically to undertake that examination, it cannot succeed. OHIM's obligations in connection with examinations result immediately from the provisions to be applied. In contrast, the EU Courts cannot issue OHIM with directions.

## **3. Interim conclusion**

104. Consequently, the third and fourth grounds of appeal must also be rejected.

### **C – Final outcome of the appeal**

105. Since none of the appellant's grounds of appeal can be upheld, the appeal must be dismissed in its entirety.

## **VII – Mr Fiorucci's application for an alteration to paragraphs 33 and 35 of the judgment under appeal**

106. Mr Fiorucci considers the findings made in those paragraphs mentioned to be incorrect. To that extent, he seeks a kind of 'rectification of the judgment' without stating the repercussions that he envisages this will have for the operative part.

107. This does not constitute an application which is admissible as a response as it seeks neither to have the decision of the General Court set aside at least in part nor the same form of order as that sought at first instance. (66)

108. On the same grounds, there can be no question of interpreting that application as a cross-appeal. (67)

109. Mr Fiorucci's application must therefore be dismissed as inadmissible.

## **VIII – Costs**

110. Pursuant to Article 118 in conjunction with Article 69(3) of the Rules of Procedure of the Court, where



each party succeeds on some and fails on other heads, or where the circumstances are exceptional, the Court may order that the costs be shared or that the parties bear their own costs.

111. In the present case, it must be noted that save as regards rectification of the judgment Mr Fiorucci is successful in his claims. On the other hand, the appellant is entirely unsuccessful save in its claim to have Mr Fiorucci's application for an alteration to the judgment dismissed. OHIM is entirely unsuccessful.

112. Consequently, it appears appropriate to order OHIM and the appellant to pay three quarters of the costs of Mr Fiorucci and their own costs. As a result, Mr Fiorucci remains liable for a quarter of his own costs.

#### **IX – Conclusion**

113. In the light of all of the foregoing, I propose that the Court should:

- (1) Dismiss the appeal;
- (2) Reject Mr Fiorucci's claim for an alteration to the judgment;
- (3) Order the appellant and OHIM to bear their own costs and to pay jointly three quarters of the costs of Mr Fiorucci;
- (4) Order Mr Fiorucci to bear one quarter of his own costs.

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1 – Original language: German.

2 – OJ 1994 L 11, p. 1.

3 – Case T-165/06 Fiorucci v OHIM – Edwin (ELIO FIORUCCI) [2009] ECR II-1375.

4 – Protocol (No 3) on the Statute of the Court of Justice of the European Union (OJ 2008 C 115, p. 210).

5 – Case T-191/04 MIP Metro v OHIM– Tesco Stores(METRO) [2006] ECR II-2855, paragraph 36, according to which 'the [Board] of Appeal may [not] adopt a decision that is unlawful at the time when [it] make[s] a decision based on the evidence submitted by the parties in the proceedings before [it].'

6 – Now Article 65 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1).

7 – Case T-247/01 eCopy v OHIM(ECOPY) [2002] ECR II-5301 states in paragraph 46: 'decisions of the Boards of Appeal may be annulled or altered only where they contain a substantive or procedural irregularity. Next, it is settled case-law that the legality of a Community measure falls to be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted.'

8 – Judgment under appeal, paragraph 40.

9 – Now Article 51 of Regulation No 207/2009.

10 – Now Article 53 of Regulation No 207/2009.

11 – Now Article 65 of Regulation No 207/2009.

12 – On that point see also the wording of the provision in the other official languages of OHIM, that is, French ('violation du traité, du présent règlement ou de toute règle de droit relative à leur application'), Italian ('violazione del trattato, del presente regolamento o di

qualsiasi regola di diritto relativa alla loro applicazione'), Spanish ('violación de Tratado, del presente Reglamento o de cualquier norma jurídica relativa a su aplicación') and German ('Verletzung des Vertrages, dieser Verordnung oder einer bei ihrer Durchführung anzuwendenden Rechtsnorm').

13 – OJ 1995 L 303, p. 1.

14 – Judgment under appeal, paragraphs 6 to 8.

15 – Judgment under appeal, paragraph 10.

16 – On that point see also the wording of the provision of the implementing regulation in the other official languages of OHIM, that is, French ('des éléments démontrant que le demandeur est titulaire de l'un des droits antérieurs énoncés à l'article 52 paragraphe 2 du règlement ou qu'il est habilité, en vertu de la législation nationale applicable, à faire valoir ce droit'), Italian ('indicazioni da cui risulti che il richiedente è titolare di uno dei diritti anteriori di cui all'articolo 52, paragrafo 2 del regolamento oppure che, a norma della legislazione nazionale applicabile, è legittimato a far valere tale diritto'), Spanish ('los datos que acrediten que el solicitante es el titular de un derecho anterior a que se refiere el apartado 2 del artículo 52 del Reglamento o que, en virtud de la legislación nacional vigente, está legitimado para reivindicar tal derecho') and German ('Angaben, die beweisen, dass der Antragsteller Inhaber eines in Artikel 52 Absatz 2 der Verordnung genannten älteren Rechts ist oder dass er nach einschlägigem nationalen Recht berechtigt ist, dieses Recht geltend zu machen') (emphasis added).

17 – Decreto Legislativo of 10 February 2005, No 30 (published in the Gazzetta Ufficiale No 52 of 4 March 2005 – Supplemento Ordinario No 28).

18 – See paragraph 42 of the judgment under appeal. The version of the provision reproduced there was recently amended by the Decreto Legislativo of 13 August 2010, No 131, with effect from 2 September 2010 and now renders not only registration but also use of the mark ('registrati o usati come marchio') subject to the requirement of consent. However, on the grounds mentioned in point 10 of this Opinion no account may be taken of those recent amendments in the present proceedings.

19 – This refers to certain dependents who following the death of the person concerned may give the consent required.

20 – Case C-259/04 Emanuel [2006] ECR I-3089, paragraph 53.

21 – Judgment under appeal, paragraphs 31 to 37.

22 – Judgment under appeal, paragraphs 43 to 63.

23 – Judgment under appeal, paragraph 67.

24 – Decision of the Second Board of Appeal of OHIM of 14 April 2005 (R 635/2003-2, paragraph 21).

25 – Decision of the First Board of Appeal of OHIM of 6 July 2005 (R 869/2004-1, paragraph 43).

26 – Decision of the Second Board of Appeal of OHIM of 7 August 2002 (R 607/2001-2, paragraph 43).

27 – In this connection, the appellant refers to Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715.

28 – Emphasis added.

29 – The appellant relies on the case-law – not relevant here – on the relationship between EU law and international agreements, for example, Joined Cases C-202/08 P and C-208/08 P *American Clothing Associates v OHIM* [2009] ECR I-6933 and Case C-533/08 *TNT Express Nederland* [2010] ECR I-0000.

30 – Emphasis added.

31 – To the same effect in claims for invalidity based on earlier rights as provided for in Article 52(1)(c) of Regulation No 40/94 see Joined Cases T-114/07 and T-115/07 *Last Minute Network v OHIM – Last Minute Tour(LAST MINUTE TOUR)* [2009] ECR II-1919, paragraph 47, and judgment of 12 June 2007 in Joined Cases T-53/04 to T-56/04, T-58/04 and T-59/04 *Budějovický Budvar v OHIM – Anheuser Busch(BUDWEISER)*, paragraph 74.

32 – See footnote 31. Moreover, the Decision of the Fourth Board of Appeal of OHIM of 25 October 2004 (R 790/2001-4, paragraph 17) is remarkably clear where it states that: ‘[i]t is for the applicant for a declaration of invalidity to furnish proof ... especially as to the national law referred to by the provision which, because the Office is a Community body, amounts to a factual element ...’

33 – Emphasis added.

34 – On this point, in the context of the similarly constructed opposition procedure, OHIM openly concedes that ‘[t]he Office is not in a position to determine with sufficient accuracy on [its] own motion what the law relating to Article 8(4) rights is in all the Member States. .... Thus, as regards questions of law, i.e. the rules and norms of the respective national law applicable to the specific case, the Office will generally require the opponent to provide the necessary elements for the Office to take a decision. It is only when such elements have already been previously established by the Office... that such proof will not be necessary. ...’. (see the OHIM Manual of Trade Mark Practice available online at <http://oami.europa.eu/ows/rw/pages/CTM/legalReferences/guidelines/OHIMManual.de.do> (section 5.4 under the heading ‘Non-registered rights’, last updated 16 September 2009)).

35 – On this point see Rodriguez Iglesias, G. C., ‘Le droit interne devant le juge international et communautaire’, in *Du droit international au droit de l’intégration, Liber amicorum Pierre Pescatore, Nomos, Baden-Baden 1987*, p. 583, at p. 597, in particular footnote 43.

36 – See the case-law cited in footnote 31. Also in Case T-435/05 *Danjaq v OHIM –Mission Productions (Dr. No)* [2009] ECR II-2097, paragraph 43, the judgment is based on an assessment of the ‘documentation submitted’ in evidence. In the context of the opposition procedure, in Case T-318/03 *Atomic Austria v OHIM – Fabricas Agrupadas de Muñecas de Onil(ATOMIC BLITZ)* [2005] ECR II-1319, paragraphs 33 to 38, the General Court appears to have taken a more far-reaching position. It held that although it is incumbent on OHIM to assess the ‘evidence submitted’ it must ‘of its own motion and by whatever means considered ap-

propriate [such as by requesting guidance from the parties] obtain information about the national law of the Member State concerned’. That approach cannot be reconciled with the wording of Rule 37 of the implementing regulation. Under that provision, the principle that OHIM should investigate the facts of its own motion is restricted in accordance with the allocation of the obligation to present the facts and concerning the burden of proof; otherwise it would be deprived of its substance.

37 – On this point, see Article 63(1) of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the General Court.

38 – At the outset of her article ‘La prise en considération du droit national par le juge communautaire’, *Revue critique de droit international privé 2007*, p. 539, Chanteloup, H., portrays national law in this connection artistically, describing it as divested of its normative character and clothed in ‘the robes of the facts’. On p. 559, she emphasises more succinctly: ‘Le droit national pris en considération est un fait[.]’

39 – This point is expressly made – and in its reference to the supposedly unanimous principles of private international law in the Member States goes too far – in the OHIM Manual of Trade Mark Practice (above footnote 32), according to which the law of the Member States must be treated as ‘an issue of fact, subject to proof by the party alleging such right’.

40 – On this point see the Lautour judgment of the French Cour de Cassation of 25 May 1948, once regarded as groundbreaking nowadays considered in part superseded, reproduced and annotated in Ancel, B. and Lequette, Y., *Les grands arrêts de la jurisprudence française de droit international privé*, Paris Dalloz, 5th edition 2006, p. 165, at p. 171. According to that judgment, the party seeking to assert a judicial claim has the burden of proving the foreign law on which that claim is based. According to more recent case-law of the French courts, too, that is, the judgments in *Amerford* and *Itraco*, reproduced and annotated in Ancel, B. and Lequette, Y., *op. cit.*, p. 718, at p. 723 et seq., it is primarily although not exclusively for the parties to establish the *loi étrangère*, review of which by the Cour de Cassation appears essentially to be limited to distortion of the substance of the foreign law (*dénaturation*) and manifest errors (*erreur manifeste de compréhension*). However, that approach cannot be generalised on an international basis. Under German law, for example, it is for a court of its own motion to establish and apply the foreign law – in its entirety as provided for in legislation and in practice – applicable under the German rules of private international law. Accordingly, as a matter of procedural law, foreign law is treated as an issue of law and not fact even though evidence may be taken on this point (Paragraph 293 of the *Zivilprozessordnung* (Code of Civil Procedure or ‘ZPO’)). However, it remains disputed in the legal literature whether following the recast of Paragraph 545 of the ZPO it has also become a matter amenable to an appeal on a point of law (on the status of the dispute see Schack, H., *Internationales Zivilverfahrensrecht*,

5th edition, Verlag C. H. Beck, Munich 2010, points 723 to 727).

41 – On that point see Santulli, C., *Le statut international de l'ordre juridique étatique*, Editions A. Pedone, Paris 2001, pp. 271 to 277. That work cites in footnote 561 et seq. a particularly striking judgment of the Permanent Court of International Justice of 12 July 1929 (Case concerning the payment in gold of Brazilian federal loans contracted in France, PCIJ, Series A, No 20/21, pp. 93-126, in particular p. 124). See also Rivier, R., 'La preuve devant les juridictions interétatiques à vocation universelle (CIJ et TIDM)' in Ruiz Fabri, H., and Sorel, J.-M., (eds) *La preuve devant les juridictions internationales*, Editions A. Pedone, Paris 2007, pp. 49-51.

42 – Chanteloup (footnote 38) mentions on p. 559 the judgment of the Permanent Court of International Justice of 7 June 1932 (Case concerning certain German interests in Polish Upper Silesia, PCIJ, Series A, No 7, p. 19), which clarifies that from the standpoint of international law and of the PCIJ municipal laws are merely facts which express the will and constitute the activities of States.

43 – Eisenführ, G., and Schennen, D., *Gemeinschaftsmarkenverordnung*, 3rd edition, Carl Heymanns Verlag, Cologne 2010, Article 65, point 1.

44 – Emphasis added.

45 – See for example on the opposition procedure Article 8(4) of Regulation No 40/94.

46 – See footnote 12.

47 – Emphasis added.

48 – A comparison of the other language versions mentioned in footnote 12 results in the same conclusion.

49 – Eisenführ and Schennen (cited in footnote 43), Article 65, point 16, note that the issue of review by the courts of 'the application of the underlying national provisions let alone unwritten legal principles' has not yet been discussed.

50 – Paragraphs 43 to 63 of the judgment under appeal.

51 – As regards the restriction which must be observed in this connection limiting the General Court's jurisdiction to the subject-matter of the dispute before the Board of Appeal, see point 54 of this Opinion.

52 – See my observations above in point 42 et seq.

53 – On the basic principle, see Case C-53/92 P Hilti v Commission [1994] ECR I-667, paragraph 42, and Case C-136/92 P Commission v Brazzelli Lualdian and Others [1994] ECR I-1981, paragraph 49. For detail see points 80 to 83 of this Opinion.

54 – Case C-286/04 P Eurocermex v OHIM [2005] ECR I-5797, paragraph 43.

55 – Commission v Brazzelli Lualdi, cited in footnote 53.

56 – Case C-229/05 P PKK and KNK v Council [2007] ECR I-439, paragraph 37.

57 – Case C-551/03 P General Motors v Commission [2006] ECR I-3173, paragraph 54. On this issue, see Wägenbaur, B., *EuGH VerFO, Satzung und Verfahrensordnungen EuGH/EuG*, Verlag C. H. Beck, Munich

2008, Article 58 of the Statute of the Court of Justice, points 8 to 12.

58 – See Article 135(4) of the Rules of Procedure of the General Court.

59 – Case T-399/02 Eurocermex v OHIM (shape of a beer bottle) [2004] ECR II-1391, paragraph 52, and Case C-214/05 P Rossi v OHIM [2006] ECR I-7057, paragraphs 50 to 53.

60 – Article 63(2) of Regulation No 40/94.

61 – See footnote 59.

62 – Case C-47/07 P Masdar (UK) v Commission [2008] ECR I-9761, paragraph 76.

63 – Case C-583/08 P Gogos v Commission [2010] ECR I-0000, paragraph 30.

64 – OJ 1996 L 28, p. 11.

65 – Case T-163/98 Procter & Gamble v OHIM (BABY-DRY) [1999] ECR II-2383, paragraph 53.

66 – Article 116 of the Rules of Procedure of the Court of Justice.

67 – Article 113 of the Rules of Procedure of the Court of Justice.