

Court of Justice EU, 18 October 2012, Jager & Polacek



TRADEMARK LAW - LITIGATION

Communication of OHIM to opposing party that opposition is admissible, is not simply a procedural measure but a decision which may only be revoked or annulled in accordance with Regulation

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

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Court of Justice EU, 18 October 2012

(A. Rosas, U. Löhms, T. von Danwitz, A. Arabadjiev and C.G. Fernlund (Rapporteur))

JUDGMENT OF THE COURT (Second Chamber)

18 October 2012 (*)

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

In Case C-402/11 P,

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

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

the other party to the proceedings being:

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

THE COURT (Second Chamber),

composed of A. Rosas, acting as President of the Second Chamber, U. Löhms, T. von Danwitz, A. Arabadjiev and C.G. Fernlund (Rapporteur), Judges, Advocate General: Y. Bot, Registrar: K. Malacek, Administrator, having regard to the written procedure and further to the hearing on 24 May 2012,

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

gives the following

Judgment

1 By its appeal, Jager & Polacek GmbH ('Jager & Polacek') seeks to have set aside the judgment of the General Court of the European Union of 12 May 2011 in Case T-488/09 Jager & Polacek v OHIM (REDTUBE) ('the judgment under appeal'), by which that court dismissed its action for annulment of the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 29 September 2009 (Case R-442/2009-4) ('the contested decision') concerning opposition proceedings between that company and RT Mediasolutions s.r.o. ('RT Mediasolutions').

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

Legal context

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

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

Regulation No 40/94

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

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

...

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

...

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

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

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

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

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

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

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

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

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

The Implementing Regulation

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

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

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

...

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

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

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

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

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

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

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

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

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

The facts of the dispute

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

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

...

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

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

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

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

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

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

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

evidence to substantiate its opposition and RT Mediasolutions to reply to that evidence.

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

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

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

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

...

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

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

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

19 According to the Board of Appeal, the [communication of 20 May 2008] did not constitute a decision capable of being revoked under Article [77a of

Regulation No 40/94], but a simple measure of organisation of procedure.'

The proceedings before the General Court and the judgment under appeal

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

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

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

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

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

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

20 In that regard, at paragraphs 91 to 93 of the judgment under appeal, the General Court took the view that the letter of 20 May 2008 was simply a communication addressed to the appellant concerning the date on which the contentious part of the proceedings was to commence and an invitation to submit facts, evidence and arguments and that, accordingly, such a communication was not intended to produce legal effects. It is not apparent from the form of that letter that it constitutes the adoption of a definitive position by OHIM on the admissibility of the opposition. At paragraph 102 of that judgment, the

General Court concluded that the communication of 20 May 2008 constituted not a decision but a simple measure of organisation of procedure.

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

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

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

Forms of order sought by the parties

24 The appellant claims that the Court of Justice should:

- set aside the judgment under appeal, and
- order OHIM to pay the costs.

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

The appeal

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

Arguments of the parties

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

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

29 The appellant maintains that, while it is open to OHIM to determine whether the opposition is admissible at any point in the proceedings, it can equally adopt a firm position on that question at any time, in particular in the letter by which it informs the parties of the commencement of the contentious part of the opposition proceedings. The terms used in the communication of 20 May 2008 show that one of its purposes was to give a decision on the admissibility of the opposition. Those terms were precise and unconditional. That communication did not state that OHIM might review the admissibility of the opposition

or that it had not reached a definitive view on that question.

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

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

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

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

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

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

36 With regard, next, to the part of the ground concerning the categorisation of the communication of 20 May 2008 as a decision, the General Court clearly stated, at paragraph 122 of the judgment under appeal, that it is not apparent from that communication that OHIM intended to give a definitive decision on

admissibility. The principle of effective judicial protection is not applicable in the present case since that communication did not constitute, in OHIM’s terms, an ‘executive act’, capable of infringing that right. The communication had no legal effect on the appellant’s legal situation.

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

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

Findings of the Court

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

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

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

The first part of the ground of appeal

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

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

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

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

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

47 However, that reasoning cannot be upheld.

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

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

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

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

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

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

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

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

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

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

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

59 On that point, it is apparent from the Court's case-law that, in principle, the withdrawal of an unlawful measure is permissible, even though the principles of legal certainty and the protection of legitimate expectations require that the withdrawal should occur within a reasonable time and that regard be had to how

far the person concerned might have been led to rely on the lawfulness of the measure (see, to that effect, Case C-508/03 *Commission v United Kingdom* [2006] ECR I-3969, paragraph 68 and the case-law cited).

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

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

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

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

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

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

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

67 Those powers on the part of the Board of Appeal also include the power to review the admissibility of the opposition in order to enable the defendant in the

opposition proceedings, where appropriate, to challenge the finding of admissibility in the appeal which is available to it under Article 57(2) of Regulation No 40/94.

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

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

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

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

The action at first instance

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

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

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

75 However, as is apparent from paragraphs 53, 64 and 68 above, the measure by which OHIM notified the opposing party that its opposition was found to be admissible is not simply a communication emanating from that body but constitutes a decision on the admissibility of the opposition which may be revoked

only in accordance with the conditions laid down in Article 77a of Regulation No 40/94 or annulled in an appeal brought under Article 57 of that regulation.

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

77 It follows that the contested decision must be annulled.

Costs

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

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

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

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

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

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

* Language of the case: German.

OPINION OF ADVOCATE GENERAL BOT

delivered on 5 July 2012 (1)

Case C-402/11 P

Jager & Polacek GmbH

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Appeals – Community trade mark – Regulation (EC) No 40/94 – Regulation (EC) No 2868/95 – Procedure upon opposition to registration of a Community trade mark – Legal nature of the act adopted at the close of the stage of the examination of the admissibility of the opposition – Revocation procedure – Principle of effective judicial protection – Principle of legal certainty)

1. Is the act whereby the Office for Harmonisation in the Internal Market (Trade Marks and Designs)

(OHIM) deems an opposition to registration of a Community trade mark admissible a mere 'measure of organisation of [the opposition] procedure' or a 'decision' within the meaning of European Union law?

2. That, essentially, is the question raised by the present appeal by *Jager & Polacek GmbH* against the judgment of the General Court of the European Union of 12 May 2011 in *Jager & Polacek v OHIM*. (2) The answer to that question determines the remedies available to the person concerned against the act at issue and also the circumstances in which that act may be revoked by OHIM.

I – Legal framework

A – The procedure upon opposition to the registration of a Community trade mark

3. Under Article 8(4) of Regulation (EC) No 40/94 on the Community trade mark, (3) OHIM may refuse to register a Community trade mark upon opposition by the proprietor of an earlier non-registered trade mark. That opposition must be submitted in accordance with Article 42 of that regulation. It must be expressed in writing and must specify the grounds on which it is made, within three months following the publication of the Community trade mark application, and is deemed to have entered made only after the opposition fee has been paid.

4. The European Union ('EU') legislature laid down the rules governing the opposition procedure in Rules 15 to 22 of Regulation (EC) No 2868/95. (4) In particular, it defined the rules on assessment of the admissibility of the opposition in Rule 17 of the implementing regulation, which is worded as follows:

'1. If the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. ...

2. If the notice of opposition has not been filed within the opposition period, or if the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark ... on which the opposition is based in accordance with Rule 15(2)(a) and (b), or does not contain grounds for opposition in accordance with Rule 15(2)(c), and if those deficiencies have not been remedied before the expiry of the opposition period, [OHIM] shall reject the opposition as inadmissible.

3. Where the opposing party does not submit a translation as required under Rule 16(1), the opposition shall be rejected as inadmissible. ...

4. If the notice of opposition does not comply with the other provisions of Rule 15, [OHIM] shall inform the opposing party accordingly and shall invite him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, [OHIM] shall reject the opposition as inadmissible.

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

5. Under Rule 17 of the implementing regulation, the opposition must satisfy the absolute admissibility criteria referred to in Rule 15(2)(a) to (c) of the implementing regulation. (5) The notice of opposition must thus contain the file number of the application against which the opposition is entered and the name of the applicant for the Community trade mark, a clear identification of the earlier mark on which the opposition is based and a statement to the effect that the requirements under Article 8(4) of Regulation No 40/94 are fulfilled.

6. The opposition must also satisfy the relative admissibility criteria referred to in Article 15(2)(d) to (h) of the implementing regulation. The notice of opposition must, in particular, contain the filing date and, where available, the registration date and the priority date of the earlier mark; a representation of the earlier mark; the goods and services on which the opposition is based; and the name and address of the opposing party or, where appropriate, his representative.

7. Rule 18(1) of the implementing regulation provides as follows:

'When the opposition is found admissible pursuant to Rule 17, [OHIM] shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. ...'

8. Rule 19 of that regulation then specifies the nature of the facts and evidence which the opposing party is invited to submit or supplement in support of his opposition. In particular, under paragraph 2 of that article, the opposing party is required to file proof of the existence, validity and scope of protection of his earlier mark.

9. Last, the EU legislature laid down the procedural rules relating to the substantive examination of the opposition in the context of Rule 20 of the implementing regulation.

B – Rules governing the revocation of a decision adopted by OHIM

10. Article 77a of Regulation No 40/94 sets out the conditions governing the revocation of a decision adopted by OHIM. It provides as follows:

'1 Where [OHIM] has ... taken a decision which contains an obvious procedural error attributable to [OHIM], it shall ensure that ... the decision is revoked ...'

2. ... revocation shall be [ordered], ex officio or at the request of one of the parties to the proceedings, by the department which ... took the decision. ... revocation shall be [ordered] within six months from the date on which ... the decision was taken, after consultation with the parties to the proceedings ...'

11. The procedure governing the revocation of such a decision is laid down in Rule 53a of the implementing regulation. According to that rule, OHIM is to inform the party affected by the intended revocation, who may submit observations.

II – Background to the dispute

12. The background to the dispute, the proceedings before the General Court and the judgment under appeal may be summarised as follows. (6)

13. On 25 March 2008 the appellant filed an opposition under Article 42 of Regulation No 40/94 to the registration of the word mark 'REDTUBE' applied for by RT Mediasolutions s.r.o. (7)

14. By letters of 20 May 2008 the Trade Marks Department of OHIM sent a communication to each of the two parties to the proceedings. In those letters, OHIM stated that the opposition had been deemed admissible in so far as it was based on the earlier nonregistered mark Redtube. It informed the two parties that the period for a friendly settlement would expire on 21 July 2008 and that the adversarial stage of the opposition proceedings would begin on 22 July 2008. It also specified the period within which the appellant was to substantiate its application and that within which RT Mediasolutions was to reply.

15. On 10 September 2008 RT Mediasolutions claimed that the appellant had not paid its opposition fee within the deadline and therefore requested OHIM to annul the communication of 20 May 2008 and also to find that the opposition was deemed not to have been entered.

16. On 2 October 2008 the Trade Marks Department of OHIM sent a letter, entitled 'Correction', to the appellant, informing it that the communication of 20 May 2008 had been sent in error and that it should be regarded as being devoid of purpose. Following the application to that effect lodged by RT Mediasolutions, OHIM's Opposition Division adopted on 22 January 2009 a decision according to which the opposition was deemed not to have been entered, as the opposition fee had not been paid within the requisite time limit.

17. On 20 March 2009 the appellant lodged an appeal against that decision, submitting that on 20 May 2008 OHIM had adopted a decision declaring the opposition admissible and that that decision had not been revoked in accordance with the procedural rules laid down in Article 77a of Regulation No 40/94. On 29 September 2009 the Fourth Board of Appeal of OHIM rejected the appellant's claims on the ground, in particular, that the letter of 20 May 2008 was a mere measure of organisation of procedure and not a decision.

III – Forms of order sought by the parties before the General Court

18. By application lodged at the Registry of the General Court on 4 December 2009, the appellant brought an action for annulment of the decision of the Fourth Board of Appeal of OHIM of 29 September 2009.

19. In support of its action, the appellant raised three pleas in law. I shall refer only to the second plea, since it alone forms the subject-matter of the present appeal.

20. The second plea in law alleged infringement of Article 77a(1) and (2) of Regulation No 40/94. In support of that plea, the appellant claimed that OHIM's communication of 20 May 2008 was a decision. Since, in application of Rule 17(5) of the implementing regulation, it is decisions that declare that the opposition is deemed not to have been filed or that reject the opposition on the ground that it is

inadmissible, then under the legal principle of *actus contrarius* or parallelism of forms the act whereby OHIM deems an opposition admissible must also be qualified as a ‘decision’.

21. Consequently, in the appellant’s submission, that decision could be revoked only in accordance with the procedure laid down in Article 77a of Regulation No 40/94, read with Rule 53a of the implementing regulation.

22. The General Court considered that the letter of 20 May 2008 was not a decision but a mere measure of organisation of procedure. It held that that letter was merely a communication sent to the appellant concerning the date on which the adversarial stage of the opposition proceedings would begin and inviting it to submit the facts, evidence and observations on which its opposition was based. Furthermore, the General Court considered that the letter had no legal effect vis-à-vis the appellant. Last, it held that the letter did not constitute a final position adopted by OHIM on the admissibility of the opposition.

23. The General Court then rejected the arguments which the appellant based on the principle of *actus contrarius* and of parallelism of forms. The Court also considered that as the letter of 20 May 2008 was not a decision the appellant could not rely on the principle of protection of the legitimate expectations which the letter had caused it to have.

24. Last, the General Court held that the case did not concern an international registration designating the EU and that there was no need to rule on the legal nature of OHIM’s notification of oppositions deemed admissible to the World Intellectual Property Organisation (WIPO).

25. After examining the other two pleas, the General Court, by the judgment under appeal, dismissed the appellant’s action.

IV – Forms of order sought by the parties before the Court of Justice

26. By its appeal, the appellant requests the Court to set aside the judgment under appeal and to order OHIM to pay the costs.

27. OHIM contends that the Court should dismiss the appeal and order the appellant to pay the costs.

V – The appeal

28. By its single plea in law, the appellant maintains that the General Court infringed Article 77a(1) and (2) of Regulation No 40/94, which lays down a specific procedure for revocation of an unlawful decision.

29. The plea is subdivided into three parts. First, the appellant maintains that the General Court erred in law in ruling that the letter of 20 May 2008 is a mere measure of organisation of procedure, and thus breached the principles of effective judicial protection and legal certainty. Second, it contends that the General Court did not correctly interpret the concept of communication in that a communication can in itself contain a decision. Third, the appellant claims that the judgment under appeal is vitiated by a failure to state reasons.

A – First part of the plea, alleging incorrect qualification of the act at issue and breach of the principles of effective judicial protection and legal certainty

30. The first part of the plea may be subdivided into two complaints. First, the appellant maintains that the letter of 20 May 2008 whereby OHIM deemed its opposition admissible contains a decision and that it therefore ought to have been revoked in accordance with the procedure laid down in Article 77a of Regulation No 40/94. Second, the appellant takes issue with the General Court for having failed to observe the appellant’s right to effective judicial protection and the principle of legal certainty.

31. OHIM disputes those arguments.

1. First complaint, alleging error of law with respect to the legal nature of the act at issue

32. In view of the way in which it was conducted and the errors of assessment made, the procedure at issue is clearly unsatisfactory. I understand, moreover, that the fact that the act at issue did not take the form of a ‘decision’ deprives the appellant a priori of the procedural guarantees laid down in Article 57 of Regulation No 40/94, which provides for the possibility to bring an action for annulment, and in Article 77a of that regulation, which determines the rules on the revocation of acts that constitute decisions.

33. None the less, I share the General Court’s view that that act is not a decision, in particular because it does not produce binding legal effects for the appellant.

34. In order to reach that conclusion, it is necessary, first, to refer to the Court’s case-law on the nature of acts that are open to challenge and, second, to examine the substance of the act at issue and also the procedural framework of which it forms part.

(a) The Court’s case-law on the nature of acts that are open to challenge in the context of an action for annulment

35. It follows from settled case-law, as the General Court observed at paragraph 90 of the judgment under appeal, that only an act capable of producing binding legal effects constitutes a decision capable in itself of forming the subject-matter of an action for annulment within the meaning of Article 263 TFEU. In other words, according to the Court, the interests of an applicant for annulment must be affected and a distinct change must be brought about in his legal position. (8)

36. It is also common ground that, in order to determine whether an act produces such effects, it is necessary to look at its substance and not at its formal presentation. (9) It is thus irrelevant that the act is not described as a decision by the person who takes it.

37. That case-law enables the scope of an action for annulment to be extended to acts which cannot formally be classified as ‘decisions’ but which, in substance, produce binding legal effects. It also serves to ensure that the institutions cannot avoid review by the EU Courts by simply disregarding formal requirements such as the title of the act, the statement of reasons on which it is based or a reference to the provisions which constitute its legal basis.

38. The existence of binding effects assumes particular importance when it is necessary to assess whether an act adopted in an administrative procedure consisting of several stages, such as the procedure applicable to examination of an opposition before OHIM, is open to challenge. In that context, OHIM adopts numerous acts whereby it not only decides on measures of organisation of procedure but also carries out a final assessment of the merits of the application, yet not all those acts have legal effects vis-à-vis the parties to the proceedings.

39. The Court therefore places those acts in different categories.

40. The first category consists of acts whereby the institution concerned definitively determines its position at the end of the procedure. Those acts are open to challenge in so far as they produce binding legal effects and are not followed by any other act capable of giving rise to an action for annulment. That is the case of the decision whereby OHIM deems an opposition by an undertaking well founded and therefore rejects the registration of a Community trade mark.

41. The second category consists of intermediate acts whose purpose is to pave the way for the final decision.

42. On the one hand, such acts include measures which, although adopted in the course of the preparatory procedure, mark the culmination of a distinct stage of the main procedure and produce legal effects. (10)

43. Numerous examples may be found in the context of the procedures for the implementation of Articles 101 TFEU and 102 TFEU. Those procedures are arranged in several successive stages, such as the preliminary investigation stage, the inter partes inquiry stage, then the hearing stage. Thus, in *Hoechst v Commission* (11) and *Orkem v Commission*, (12) the Court accepted that the decisions whereby the Commission requests information from the undertakings or conducts on-the-spot investigations are acts open to challenge.

44. In the same way, the Court has held that the decision whereby the Commission initiates the formal investigation procedure following its preliminary analysis is an act open to challenge. (13) The Court takes the view that such a decision entails legal effects vis-à-vis the Member State and undertakings concerned, since the Commission can order suspension of the measure. According to the Court, those effects are independent of the final decision and are not capable of being rectified in an action against the final decision, thus depriving the applicants of sufficient judicial protection. (14)

45. On the other hand, the second category includes measures of a 'purely' (15) or 'simply' (16) preparatory character. Such measures constitute only one of the stages that enable the institution to adopt its final decision. They do not produce any legal effects and are not, in accordance with the case-law, acts open to challenge. From that standpoint, the Court takes the view that any defects in such measures may be relied upon in an action directed against the final decision, for which they represent a preparatory step. (17) That is

true, in competition law, of the act whereby the Commission communicates its objections against the undertakings.

46. Reference to that case-law reveals the imperatives which guide the Court's action in this field.

47. As we have just seen, the Court seeks to ensure effective judicial protection of an individual's rights under EU law. In *Athinaiki Techniki v Commission*, (18) the Court noted that, as the European Union is a community based on the rule of law, the procedural rules governing actions must be interpreted in such a way as to ensure that those rules can contribute to the attainment of such an objective. (19) It is for that reason that preparatory acts capable of producing legal effects and constituting the culmination of a procedure ancillary to the main procedure must, according to the Court, be acts against which an action for annulment may be brought.

48. None the less, the Court also seeks to avoid an increase in the number of actions against preparatory measures, which could paralyse the activity of the institutions.

49. That case-law defines the context within which the act at issue must be classified. Is that act, as the General Court asserts in the judgment under appeal, a mere measure of organisation of the opposition proceedings, which is thus not amenable to an action, or is it, as the appellant maintains, a decision?

50. In order to answer that question, it is necessary to examine the substance of the letter of 20 May 2008 and the procedural framework of which it forms part.

(b) The substance of the act at issue and the procedural framework of which it forms part

51. As is apparent from the facts set out at paragraph 9 of the judgment under appeal and from the findings of the General Court at paragraphs 91, 92 and 95 of that judgment, first, the letter of 20 May 2008 informs the appellant that its opposition 'has been deemed inadmissible in so far as it was based on the earlier non-registered trade mark Redtube' and that, if the opposition was based on other earlier rights, examination of those other rights has not yet taken place. Second, it informs the appellant, together with RT Mediasolutions, of the duration of the 'friendly settlement' period, of the time-limit for initiating the adversarial stage of the procedure and, last, of the periods within which the appellant could substantiate its opposition and RT Mediasolutions could respond.

52. It is clear that the second part of the letter constitutes a simple communication to the parties, not having the nature of a decision, in so far as OHIM informs them, in accordance with Rule 18(1) of the implementing regulation, of the time-limits applicable to the opposition procedure.

53. None the less, the letter cannot be interpreted as merely informing the parties of the initiation of the opposition procedure and the relevant time-limits. It is necessary to take account of the first part of the letter of 20 May 2008, in which OHIM informs the appellant that its opposition 'has been deemed admissible' in that

it is based on the earlier nonregistered trade mark Redtube.

54. In the appellant's view, that in itself constitutes a decision in so far as, in substance, OHIM adopts a definitive assessment of the admissibility of the opposition, capable of giving rise to binding legal effects. It is true that the use of the work 'deem' indicates that OHIM did in fact rule on the admissibility of the claim.

55. To my mind, however, that is not sufficient for the act at issue to be recognised as being in the nature of a decision.

56. The opposition procedure consists of two stages that must be distinguished. There is, first, the stage of examination of the admissibility of the opposition referred to in Rule 17 of the implementing regulation and, second, the stage of the examination properly so-called, established by Article 43 of Regulation No 40/94 and governed by Rules 18 to 20 of the implementing regulation.

57. The stage of examination of the admissibility of the opposition is of a preliminary nature. It must enable OHIM to assess the admissibility of the opposition in the light of the conditions expressly referred to in Rules 15 and 16 of the implementing regulation. OHIM must therefore ensure that the absolute conditions laid down in Rules 15(2)(a) to (c) and 16 (1) of the implementing regulation are satisfied, namely, first, that the opposition act does indeed identify the Community trade mark challenged, the earlier mark and the grounds on which the opposition is based; and, second, that the opposition is translated. OHIM must also ensure that the relative conditions laid down in Rule 15(2)(d) to (h) of the implementing regulation are satisfied, that is to say, the notice of opposition must contain a representation of the earlier trade mark and identify the goods and services concerned and also the opposing party or his representative.

58. If those conditions are not satisfied, OHIM must then reject the opposition as inadmissible by adopting a decision, which therefore puts an end to the opposition proceedings. Only in those circumstances does the EU legislature require that OHIM adopt a decision, which may form the subject-matter of an action in accordance with Article 57 of Regulation No 40/94.

59. On the other hand, where all the conditions are satisfied, OHIM acknowledges that the opposition is admissible, by an act which the EU legislature has not in fact defined.

60. In those circumstances, and in accordance with the first sentence of Rule 18(1) of the implementing regulation, that act opens what may properly be called the examination procedure of the opposition. (20) That procedure must enable OHIM to have full information concerning all the evidence submitted in support of the opposition and to adjudicate on the related substantive issues. Thus, it is only at that stage of the procedure that the opposing party is required to submit the facts, the evidence and the observations in support of his opposition, in accordance with Rule 19 of the implementing regulation, and it is on that basis that

OHIM will proceed to examine the merits of the opposition by assessing whether the registration of the trade mark applied for might harm the rights acquired by the opposing party. Only at the close of that examination will OHIM adopt a definitive decision, whereby it may reject the opposition in whole or in part, or deem it well founded, thus rejecting, in whole or in part, the application for registration of the Community trade mark. In accordance with Article 57 of Regulation No 40/94, that decision may form the subject-matter of an action for annulment.

61. It must be emphasised that the act whereby OHIM deems the opposition admissible is therefore not an act adopting OHIM's final decision in the opposition proceedings, but a preparatory procedural act which, in that it initiates the procedure of the examination of the merits of the opposition, takes place at the beginning of the preparation, in stages, of the final decision.

62. Nor, to my mind, does that act entail any binding legal effect. It enables the 'friendly settlement' stage to be initiated between the parties and, in the absence of a friendly settlement, initiates the discussion of the substantive issues connected with the opposition.

So far as the opposing party is concerned, the initiation of the opposition proceedings properly so-called places only one obligation on him – if he wishes his opposition to succeed –, namely to produce all the evidence and to present all the facts and observations in support of his opposition.

63. Consequently, I am unable to conclude that the act at issue affects the appellant's interests or alters its legal situation. That legal situation is not comparable with the situation of a Member State which, because the Commission has initiated the formal examination procedure in respect of State aid which is in the course of being implemented, is required to suspend the application of the aid, or the situation of an individual who, because the file which he has submitted to the relevant authority in order to establish his over-indebtedness has been declared admissible, finds that the enforcement proceedings against his assets are automatically suspended. In the present case, the effects of the act at issue do not go beyond the actual effects of a procedural act and do not affect, beyond its procedural situation, the legal situation of the appellant, (21) and, more broadly, of the parties to the procedure.

64. In that regard, it must be observed that the appellant has no interest in bringing an action against the act whereby OHIM deems his opposition admissible.

65. In the light of those factors, I am of the view that the act whereby OHIM deemed the appellant's opposition admissible is a preparatory measure, having no binding legal effects vis-à-vis the appellant.

66. Consequently, I consider that the General Court did not err in law in holding, at paragraph 102 of the judgment under appeal, that the letter of 20 May 2008 is not a decision, (22) and I propose that the Court should reject this first complaint as unfounded.

2. Second complaint, alleging breach of the principles of effective judicial protection and legal certainty

67. By its second complaint, the appellant takes issue with the General Court for having breached its right to effective judicial protection by denying that the act at issue in any way constituted a decision. The appellant also maintains that the General Court breached the principle of legal certainty in so far as the appellant could legitimately claim, first, that OHIM definitively ruled on the admissibility of its application and would initiate the opposition proceedings and, second, that it would comply with the requirements laid down in Article 77a of Regulation No 40/94.

(a) Breach of the principle of effective judicial protection

68. The right to effective judicial protection is a general principle of EU law which, it will be recalled, is also enshrined in Articles 6 and 13 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (23) and also in the first paragraph of Article 47 of the Charter of Fundamental Rights of the European Union. (24) That principle requires that any individual whose rights have been violated can have an effective remedy before a judicial authority.

69. In the present case I do not think that the General Court committed a breach of that principle when it took the view that the act at issue was not a decision. First, it will be recalled that the act does not create any right in favour of the appellant and therefore does not affect its legal situation. Nor, as I have said, does the appellant have any interest in bringing a legal action seeking annulment of the act at issue, since the object of the act is to acknowledge the admissibility of the opposition filed by the appellant itself. Second, it is common ground that the appellant has not been deprived of the opportunity to rely on its rights and to denounce any irregularities in the present procedure, since it brought an action for annulment of the decision of 22 January 2009 whereby OHIM deemed the appellant's opposition incomplete.

70. Consequently, this complaint must in my view be rejected.

(b) Breach of the principle of legal certainty

71. It is apparent from the content of the letter of 2 October 2008, entitled 'Correction', that OHIM revoked the act at issue, stating that it had been sent in error and that it should be regarded as being devoid of purpose. It is clear – and OHIM, moreover, acknowledged at the hearing – that that act in reality contained an error of assessment, which vitiated the examination of the admissibility of the application at issue, and wrongly entailed the initiation of the opposition proceedings. The way in which the act was revoked, like the period within which OHIM reacted, is to mind very much open to criticism and clearly raises questions relating to compliance with the principles of legal certainty and the protection of legitimate expectations.

72. None the less, it is settled that OHIM is entitled to revoke an act which it considers to be defective. (25) Its power to do so is based on the principle of legality, which prohibits the continuation of any illegality and

permits the authorities, by elimination of the defective act, to restore the legal order which was wrongly disrupted. It also makes it possible to avoid the development of contentious proceedings and clearly contributes to ensuring a smooth administration of the procedure.

73. It has consistently been held that the revocation of a vitiated act must be subject to very strict conditions since such revocation involves reconciling the principle of legality with the principle of legal certainty and, in that context, respecting the legitimate expectation of the beneficiary of the act, who may have been led to rely on the lawfulness of the act. (26) Indeed, the principle of legal certainty, which is a general principle of EU law, (27) is intended to ensure the foreseeability of situations and legal relationships governed by EU law (28) and requires that the EU institutions respect the intangibility of the acts which they have adopted. Consequently, where a vitiated act is revoked, the Court requires that the institution concerned observe the relevant rules of competence and procedure, act within a reasonable time and take account of the extent to which the person concerned may have been led to rely on the lawfulness of the act.

74. In the context of Regulation No 40/94, the EU legislature thus made provision, in Article 77a, for a special procedure that would enable OHIM to revoke a decision containing an obvious procedural error attributable to OHIM. In accordance with paragraph 2 of that article, OHIM must thus order revocation of such a decision within six months from the date on which the decision was taken, after consultation with the parties to the proceedings. According to that procedure, the revocation of the unlawful act must take place within a time-limit, thus ensuring legal certainty, and each of the parties has the right to be consulted.

75. None the less, the guarantees afforded to the person concerned in that context are recognised only in so far as the act in question creates rights and affects his legal and material situation.

76. However, I have stated that the act at issue, in that it constitutes a procedural act, preparatory to the final decision, is not capable of producing legal effects vis-à-vis the appellant and, as such, is not a decision. Consequently, the appellant cannot in my view rely on the principle of legal certainty with respect to the revocation of the act at issue.

77. In the light of those factors, I consider that the appellant's second complaint must also be rejected.

78. Consequently, I invite the Court to find that the first part of the single plea in law raised by the appellant is unfounded.

B – Second part of the plea, alleging incorrect interpretation of the concept of communication

79. By the second part of its single plea, the appellant takes issue with the General Court for having, at paragraph 114 of the judgment under appeal, based its reasoning on the fact that Rule 17(5) of the implementing regulation mentions a 'decision' where the notice of opposition is deemed not to have been entered and that Rule 18(1) of that regulation uses the

word ‘communication’. In the appellant’s submission, it follows from Rule 62(1) of the implementing regulation that a communication may also contain a decision. (29)

80. OHIM challenges that argument.

81. Like OHIM, I consider this argument to be unfounded.

82. First, the appellant cannot take issue with the General Court for having referred to the actual wording of the applicable legislation in order to substantiate its assessment of the legal nature of the act at issue.

83. Second, the appellant fails to take account of the reasoning preceding paragraph 114 of the judgment under appeal and, in particular, that set out at paragraphs 88 to 102 of that judgment, where the General Court set out the reasons why the act at issue was not capable of constituting a decision. In that regard, the General Court gave full consideration to the fact that a communication, such as that at issue, could, as such, contain a decision. Indeed, at paragraph 94 of the judgment under appeal, the General Court observed that ‘it is not possible to examine only the form of the letter of 20 May 2008’ and that, in order to establish whether that letter constitutes a decision, it is necessary to look at the substance of the act rather than at its form, in accordance with the case-law of this Court.

84. In light of those factors, I therefore propose that the Court should reject this second part of the plea as unfounded.

C – Third part of the plea, alleging breach of the obligation to state reasons

85. By the third part of its single plea, the appellant claims, in substance, that the General Court committed a breach of its obligation to state reasons by failing to respond sufficiently to the argument which the appellant based on the actual legal effects of the international registration of a trade mark designating the European Union. At first instance the appellant maintained that, in the event of such registration, OHIM is required to inform the WIPO of the admissibility of an opposition, which entails actual legal effects in so far as mention is made in the international trade marks registry of the provisional refusal of protection. However, at paragraph 132 of the judgment under appeal the General Court merely responded as follows:

‘... it is sufficient to state that the present case does not concern an international registration designating the EU, but an application for a Community trade mark. There is thus no need to rule on the legal nature of such notification by OHIM to the WIPO in the context of applications for international registrations designating the European Union.’

86. The appellant takes issue with the General Court for not having taken account of the fact that the act whereby OHIM informs the WIPO of the admissibility of an opposition constitutes a decision. In the appellant’s submission, the principles of effective judicial protection and legal certainty thus required that the act at issue, in that it constitutes a communication

addressed to the applicant for the trade mark in the same context, also be qualified as a ‘decision’.

87. OHIM disputes that argument, maintaining, in particular, that the Community and international registration procedures are not comparable.

88. In order to assess the merits of that argument, it is appropriate to recall the scope of the General Court’s obligation to state reasons.

89. The obligation to state reasons is laid down in Article 36 of the Statute of the Court of Justice, applicable to the General Court under the first paragraph of Article 53 of the Statute, and in Article 81 of the Rules of Procedure of the General Court.

90. It is settled case-law that a judgment must disclose in a clear and unequivocal fashion the reasoning followed by the General Court, in such a way as to enable the persons concerned to ascertain the reasons for the decision adopted and the Court of Justice to exercise its power of review. (30) In the case of an action under Article 263 TFEU, the requirement to state reasons means that the General Court must examine the pleas in law relied on by an applicant in seeking annulment and state the grounds on which it rejects a plea or annuls the act at issue.

91. However, in *Connolly v Commission* the Court of Justice placed limits on that obligation to respond to the pleas relied on. (31) It considered that the grounds of a judgment must be assessed in light of the circumstances of the case (32) and that the General Court is ‘not obliged to respond in detail to every single argument advanced by the appellant, particularly if the argument was not sufficiently clear and precise and was not adequately supported by evidence’. (33)

92. In the light of those factors, I consider that the General Court responded to the requisite legal standard to the arguments put forward by the appellant. It explained the reason why there was no need, in its view, to adjudicate on the legal nature of the act whereby OHIM informs the WIPO of the admissibility of an opposition in the context of an application for international registration designating the European Union. Admittedly, that explanation is succinct, but it is none the less sufficient in so far as the nature of the act at issue clearly cannot be determined by reference to that of an act adopted in the context of a separate procedure that produces effects specific to that procedure, but must be assessed in the light of the substance and the legal effects specific to the act at issue.

93. I would also observe that that explanation enabled the appellant to challenge the findings of the General Court and also enables the Court of Justice to exercise its power of review.

94. In that context, I am of the view that the reasoning set out by the General Court at paragraph 132 of the judgment under appeal is not insufficient.

95. I therefore propose that the Court should reject the third part of the single plea as unfounded.

96. In the light of all the preceding factors, I propose that the Court declare the single plea raised by the appellant, alleging infringement of Article 77a(1) and

(2) of Regulation No 40/94, unfounded and, accordingly, dismiss the appeal.

VI – Conclusion

97. In the light of the foregoing considerations, I propose that the Court should:

- (1) Dismiss the appeal;
- (2) Order Jager & Polacek GmbH to pay the costs.

1 – Original language: French.

2 – Case T-488/09, not yet published in the ECR; ‘the judgment under appeal’.

3 – Commission Regulation of 20 December 1993 (OJ 1994 L 11, p. 1), as amended by Council Regulation (EC) No 1891/2006 of 18 December 2006 (OJ L 386, p. 14; ‘Regulation No 40/94’). Regulation No 40/94 was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. None the less, in view of the time when the facts took place, the present dispute is governed by Regulation No 40/94.

4 – Commission Regulation 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’).

5 – See Opposition Guidelines, Part 1: Procedural matters, available on OHIM’s website, in particular A.V, points 1 and 2.

6 – For a full account of the background to the dispute, reference is made to paragraphs 1 to 20 of the judgment under appeal.

7 – Hereinafter ‘RT Mediasolutions’.

8 – Case 133/79 Sucrimex and Westzucker v Commission [1980] ECR 1299, paragraph 15, and Case 60/81 IBM v Commission [1981] ECR 2639, paragraph 9. See also Case C-322/09 P, not yet published in the ECR, paragraph 45 and the case-law cited.

9 – Case C-147/96 Netherlands v Commission [2000] ECR I-4723, paragraph 27 and the caselaw cited.

10 – IBM v Commission (paragraph 11)

11 – Joined Cases 46/87 and 227/88 [1989] ECR 2859.

12 – Case 374/87 [1977] ECR 3283.

13 – Case C-400/99 Italy v Commission [2001] ECR I-7303.

14 – Ibid. (paragraphs 59, 60, 62 and 63).

15 – IBM v Commission (paragraph 12).

16 – Italy v Commission (paragraph 63).

17 – IBM v Commission (paragraph 12).

18 – Case C-521/06 P [2008] ECR I-5829.

19 – Paragraph 45 and the case-law cited.

20 – It should also be noted that, in accordance with Article 43(4) of Regulation No 40/94, OHIM may, at this stage, propose that the parties make a friendly settlement and, in that regard, set a deadline before which the examination stage properly so-called will not be opened. If OHIM considers that the friendly settlement is ineffective or if the parties have not arrived at such a settlement, the stage of examination of the merits of the operations is opened.

21 – See, in that regard, the reasoning of the General Court at paragraphs 128 and 129 of the judgment under appeal.

22 – On the other hand, I have some reservations where the General Court it qualifies the act at issue as a mere ‘measure of organisation of procedure’. However, that point was not discussed and if that qualification were incorrect, that would have no consequence on the outcome of the dispute.

23 – The Convention was signed in Rome on 4 November 1950.

24 – See, in particular, Case C-432/05 Unibet [2007] ECR I-2271, paragraph 37 and the caselaw cited.

25 – Case C-508/03 Commission v United Kingdom [2006] ECR I-3969, paragraph 68 and the case-law cited.

26 – Case C-90/95 P de Compte v Parliament [1997] ECR I-1999, paragraph 35 and the case-law cited, and Case T-251/00 Lagardère and Canal+ v Commission [2002] ECR II-4825, paragraph 140.

27 – Case 13/61 Geus [1962] ECR 45.

28 – See, to that effect, Case 325/85 Ireland v Commission [1987] ECR 5041, paragraph 18, and Case C-107/97 Rombi and Arkopharma [2000] ECR I-3367, paragraph 66 and the case-law cited).

29 – That provision is worded as follows:

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

30 – Case C-280/08 P Deutsche Telekom v Commission, not yet published in the ECR, paragraph 136. See also Case C-259/96 P Council v de Nil and Impens [1998] ECR I-2915, paragraphs 32 to 34, and Case C-449/98 P IECC v Commission [2001] ECR I-3875, paragraph 70, and orders of the President of the Court in Case C-149/95 P(R) Commission v Atlantic Container Line and Others [1995] ECR I-2165, paragraph 58; Case C-268/96 P(R) SCK and FNK v Commission [1996] ECR I-4971, paragraph 52; and Case C-159/98 P(R) Netherlands Antilles v Council [1998] ECR I-4147, paragraph 70.

31 – Case C-274/99 P [2001] ECR I-1611.

32 – Paragraph 120.

33 – Paragraph 121. See also Case C-197/99 P Belgium v Commission [2003] ECR I-8461, paragraph 81.