

Court of Justice EU, 3 October 2013, Rintisch v OHIM – Proti Snack



TRADEMARK LAW - LITIGATION

Evidence submitted to OHIM after expiry of period specified; OHIM's discretion

- As the Court has held, it results from the wording of that provision that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of Regulation No 40/94 and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late.
- The General Court found, in paragraph 36 of the judgment under appeal, that it followed from that provision that the Board of Appeal was bound to apply Rule 20(1) of the Implementing Regulation and, therefore, to find that the submission of evidence after the expiry of the period specified for that purpose by OHIM, in order to establish the existence, validity and scope of protection of the earlier mark, entails the rejection of the opposition, and the Board of Appeal has no discretion in that regard.

Appeal must state precisely the contested elements and legal arguments, failing which the plea is inadmissible

- According to consistent case-law, it follows from Article 256 TFEU, the first paragraph of Article 58 of the Statute of the Court, and Article 112(1)(c) of the Rules of Procedure of the Court, in the version in force at the date when the appeal was brought (now Article 168(1) (d) of the Rules of Procedure of the Court), that an appeal must state precisely the contested elements of the judgment which the appellant seeks to have set aside and also the legal arguments specifically advanced in support of the appeal, failing which the appeal or plea concerned is inadmissible.

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Court of Justice EU, 3 October 2013

(L. Bay Larsen (Rapporteur), J. Malenovský, U. Løhmus, M. Safjan and A. Prechal)

JUDGMENT OF THE COURT (Fourth Chamber)

3 October 2013 (*)

In Case C-120/12 P,

Appeal under Article 56 of the Statute of the Court of Justice of the European Union, brought on 28 February 2012,

Bernhard Rintisch, residing in Bottrop (Germany), represented by A. Dreyer, Rechtsanwalt, appellant, the other parties 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, Bariatix Europe Inc. SAS, established in Guilhaingrandes (France), intervener at first instance,

The Court (Fourth Chamber), composed of L. Bay Larsen (Rapporteur), President of the Chamber, J. Malenovský, U. Løhmus, M. Safjan and A. Prechal, Judges, Advocate General: E. Sharpston, Registrar: A. Calot Escobar, having regard to the written procedure, after hearing the Opinion of the Advocate General at the sitting on 16 May 2013,

gives the following

Judgment

1 By his appeal, Mr Rintisch seeks to have set aside the judgment of the General Court of the European Union of 16 December 2011 in Case T-62/09 Rintisch v OHIM – Bariatix Europe (PROTI SNACK) ('the judgment under appeal'), by which that court dismissed his action for the 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 15 December 2008 (Case R 740/2008-4) ('the contested decision'), relating to opposition proceedings between the appellant and Bariatix Europe Inc. SAS.

Legal context

2 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. However, having regard to the material time, the present dispute continues to be governed by Regulation No 40/94.

3 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 2005 L 172, p. 4) ('the Implementing Regulation').

Regulation No 40/94

4 Article 74(2) of Regulation No 40/94 states that '[t]he Office may disregard facts or evidence which are not submitted in due time by the parties concerned'.

The Implementing Regulation

5 Rule 19 of the Implementing Regulation provides:

'1. The Office shall give the opposing party the opportunity to present the facts, evidence and

arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time-limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence in accordance with Rule 18(1).

2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:[...]

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time-limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered; [...]

3. The information and evidence referred to in paragraphs 1 and 2 shall be in the language of the proceedings or accompanied by a translation. The translation shall be submitted within the time-limit specified for submitting the original document.

4. The Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time-limit set by the Office.'

6 Rule 20 of the Implementing Regulation, entitled 'Examination of the opposition', provides in paragraph 1:

'If until expiry of the period referred to in Rule 19(1) the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well [as] his entitlement to file the opposition, the opposition shall be rejected as unfounded.'

7 Rule 50 of the Implementing Regulation, entitled 'Examination of appeals', provides in paragraph 1:

'Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.[...] Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time-limits set in or specified by the Opposition Division in accordance with [Regulation No 40/94] and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) of the Regulation.'

Regulation No 1041/2005

8 Recital 7 in the preamble to Regulation No 1041/2005 states:

'The provisions concerning the opposition procedure should be reframed completely [so] as to specify the admissibility requirements, to specify clearly the legal consequences of deficiencies and to bring the provisions in the chronological order of the proceedings.'

Background to the dispute

9 The background to the dispute was set out by the General Court in paragraphs 1 to 16 of the judgment under appeal in the following terms:

'1 On 17 March 2006, *Bariatatrix Europe Inc. SAS* filed an application for registration of a Community trade mark with [OHIM] pursuant to [...] Regulation [...] No 40/94 [...]

2 The mark for which registration was sought is the word sign *PROTI SNACK*.

3 The goods in respect of which registration was sought are in, *inter alia*, Classes 5, 29 and 32 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* [...] [...]

5 On 9 March 2007, [...] *Rintisch* [...] filed a notice of opposition under Article 42 of Regulation No 40/94 [...] against registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

6 The opposition was based, *inter alia*, on the following earlier rights:

– German word mark *PROTIPLUS*, filed on 4 December 1995 and registered on 20 May 1996, under number 39549559, in respect of goods in Classes 29 and 32;

– German word mark *PROTI*, filed on 22 January 1997 and registered on 3 March 1997, under number 39702429, in respect of goods in Classes 29 and 32;

– German figurative mark [...] filed on 24 February 1996 and registered on 5 March 1997, under number 39608644, in respect of goods in Classes 29 and 32 [...]

8 In order to prove the existence and the validity of the earlier marks referred to in paragraph 6 above, [Mr *Rintisch*] annexed to the notice of opposition (i) registration certificates issued by the *Deutsches Patent- und Markenamt* (German Patent and Trade Mark Office), dated March 1996, October 1996 and March 1997 respectively, and (ii) extracts from the *Deutsches Patent- und Markenamt* online register, dated 8 January 2007, which, for each of the earlier marks, contained the words "Marke eingetragen" ("registered mark") under the heading "Letzter Verfahrensstand" (latest procedural stage), and, for the earlier marks Nos 39549559 and 39608644, dates in 2006 under the heading "Verlängerungsdatum" (renewal date). A translation into the language of the proceedings was provided only for the registration certificate for each of the earlier marks.

9 On 26 April 2007, OHIM communicated to [Mr *Rintisch*] the date of the commencement of the adversarial stage of the opposition proceedings [...] In that communication, OHIM advised [Mr *Rintisch*] that

a renewal certificate had to be provided for marks whose registration was more than 10 years old. Similarly, OHIM stated that the existence and the validity of the earlier marks relied on in support of the opposition had to be proved by official documents translated into the language of the proceedings. In that respect, OHIM set a time-limit of 27 August 2007 for the submission of evidence. Lastly, OHIM advised [Mr Rintisch] that, if the evidence for the existence and the validity of the earlier marks was not filed within the required time-limit, the opposition would be rejected without any examination as to its merits, in accordance with Rule 20(1) of [the Implementing Regulation].

10 On 25 September 2007, [Mr Rintisch] submitted to OHIM, for each of the earlier marks, an extract from the online register and a declaration from the Deutsches Patentund Markenamt, together with a translation of that declaration into the language of the proceedings. The declaration stated that the earlier marks had been renewed, before the date on which the notice of opposition was filed, until 2015, 2016 and 2017 respectively.

11 On 31 March 2008, the Opposition Division rejected the opposition on the ground that [Mr Rintisch] had failed to prove, within the time-limit set, the existence and the validity of the earlier marks relied on in support of the opposition. First of all, the Opposition Division found that, although it could be considered, on the basis of the 3 certificates annexed to the notice of opposition of 9 March 2007, that the earlier marks had been registered in 1995, 1996 and 1997 respectively, that was not sufficient to establish that they were valid as at 27 August 2007 [...]. In addition, the Opposition Division found that, in accordance with Rule 19(4) of [the Implementing Regulation], the online extracts, dated 8 January 2007, could not be taken into account for the purposes of proving that the earlier marks had been renewed, since they had not been translated into the language of the proceedings. Lastly, as regards the documents submitted on 25 September 2007, the Opposition Division refused to take them into account, on the basis of Rule 20(1) of [the Implementing Regulation], because they had been submitted late.

12 On 8 May 2008, [Mr Rintisch] filed a notice of appeal with OHIM against the Opposition Division's [decision], pursuant to Articles 57 to 62 of Regulation No 40/94 [...]. In the appeal, [Mr Rintisch] requested that the Board of Appeal refuse to register the mark applied for on the basis that there was a likelihood of confusion. To that end, he included as an annex to the written pleading setting out the grounds of the appeal the documents filed with the Opposition Division on 25 September 2007.

13 By [the contested decision], the Fourth Board of Appeal of OHIM dismissed the appeal without assessing the merits of the opposition. It found that the Opposition Division had been correct to conclude that the [appellant] had not duly substantiated, within the time-limits laid down, the existence and the validity of the earlier marks relied on in support of the opposition.

14 In particular, the Board of Appeal considered, first, that the registration certificates annexed to the notice of opposition of 9 March 2007 were not sufficient to prove that the earlier marks were still in force at the date on which the notice of opposition was filed. Second, it found that the fact that the online extracts from the register, dated 8 January 2007, had not been translated was sufficient justification in itself for refusing to take them into account.

15 The Board of Appeal also found that the documents submitted on 25 September 2007 could not be taken into account, on the ground that they had been filed after the expiry of the time-limit set by OHIM, that is, after 27 August 2007.

16 Lastly, the Board of Appeal stated that neither the Opposition Division nor the Board of Appeal itself had discretion under Article 74(2) of Regulation No 40/94 [...] to take into account documents that had not been filed before expiry of the time-limit set by OHIM, having regard to Rule 20(1) of [the Implementing Regulation] which provides expressly that an action must be dismissed where documentary evidence is submitted late. The Board of Appeal further stated that, in any event, even if it were to be held that it enjoyed a discretion to accept documents filed late with the Opposition Division, the Board would have exercised such a discretion against [Mr Rintisch] [...].

The procedure before the General Court and the judgment under appeal

10 By application lodged at the General Court Registry on 13 February 2009, Mr Rintisch brought an action seeking the annulment of the contested decision.

11 In support of that action, he relied on three pleas in law, only the second of which is at issue in this appeal. That plea alleged infringement by the Board of Appeal of Article 74(2) of Regulation No 40/94 and misuse of powers.

12 The General Court noted, first, in paragraphs 30 and 31 of the judgment under appeal – referring to paragraph 42 of the judgment in [Case C-29/05 P OHIM v Kaul \[2007\] ECR I-2213](#) – that it is clear from Article 74(2) of Regulation No 40/94 that, as a general rule and unless otherwise provided, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of that regulation and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late. The General Court then rejected the first part of the plea thus put forward by Mr Rintisch, finding essentially as follows, in paragraphs 32 to 41 of the judgment under appeal:

'32 [...] [T]he possibility for parties to proceedings before OHIM to submit facts and evidence after the expiry of the periods specified for that purpose is conditional upon there being no provision to the contrary [...]

33 In the present case, the Board of Appeal found [...] that there was an express provision to the contrary, according to which, as held in the case-law, the rejection of the opposition was mandatory, and not

merely an option subject to OHIM's discretion. The Board of Appeal considered that Rule 20(1) of [the Implementing Regulation], applicable to proceedings before it pursuant to Rule 50(1) of that regulation, prevented the discretion under Article 74(2) of Regulation No 40/94 from being exercised.

[...]

36 It is clear from reading [Rule 20(1) and the first and third subparagraphs of Rule 50(1) of the Implementing Regulation] together that, in the absence of any provision to the contrary, the Board of Appeal is bound to apply Rule 20(1) of [the Implementing Regulation] in the proceedings before it and, therefore, to find that the submission of evidence after the expiry of the period specified for that purpose by OHIM, in order to establish the existence, validity and scope of protection of the earlier mark, results in the rejection of the opposition without the Board of Appeal having a discretion in that regard [...]

37 [Mr Rintisch] submits that the end of the third subparagraph of Rule 50(1) of [the Implementing Regulation], and, in particular, the reference therein to Article 74(2) of Regulation No 40/94, is precisely the provision to the contrary which would, in all events, preclude Rule 20(1) of that regulation from being applied to proceedings before the Board of Appeal. However, that argument cannot be upheld.

38 It must be noted at the outset that, since the notice of opposition was filed on 9 March 2007, the version of [the Implementing Regulation] applicable to the present case is that in force after the amendment by [...] Regulation [...] No 1041/2005 [...] In particular, according to recital 7 of that regulation, one of the aims of that amendment was to reframe completely the provisions concerning the opposition procedure in order to specify clearly, *inter alia*, the legal consequences of procedural deficiencies.

39 In addition to the risk of applying circular reasoning to the provisions in question, accepting the interpretation put forward by [Mr Rintisch] would result in the scope of Rule 20(1) of [the Implementing Regulation], as amended, being limited significantly.

40 If the evidence to establish the existence, validity and scope of an earlier mark – which, in accordance with the new wording of Rule 20(1) of [the Implementing Regulation], applicable to the present case, cannot be taken into account by the Opposition Division when it is filed late – could nevertheless be taken into consideration by the Board of Appeal by virtue of its discretionary power

Article 74(2) of Regulation No 40/94, the legal consequence laid down expressly in Regulation No 1041/2005 for that type of deficiency, namely the rejection of the opposition, might, in certain cases, have no practical effect.

41 It must therefore be held that the Board of Appeal did not err by finding that, in the circumstances of the present case, there was a provision which prevented evidence submitted late to OHIM by [Mr Rintisch] from being taken into account and that therefore, the Board

of Appeal did not have any discretion under Article 74(2) of Regulation No 40/94.'

13 The General Court then rejected the second part of the second plea in law, on the following ground:

'47 [...] [A]s regards the alleged misuse of powers by the Board of Appeal, the Court finds that the application does not satisfy the minimum requirements for the admissibility of a complaint laid down in Article 21 of the Statute of the Court of Justice of the European Union and Article 44(1)(c) of the Rules of Procedure of the General Court [...] In the present case, the [appellant]'s complaint, as submitted in the application, does not include any argument to demonstrate how the Board of Appeal misused its powers. The present complaint must therefore be declared inadmissible.'

14 Since it also rejected the other pleas in law relied on by Mr Rintisch in support of his action, the General Court dismissed the action.

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

15 By his appeal, Mr Rintisch asks the Court of Justice to set aside the judgment under appeal and order OHIM to pay the costs.

16 OHIM contends that the Court should dismiss the appeal and order Mr Rintisch to pay the costs.

The appeal

17 In support of his appeal, the appellant relies on two grounds of appeal, alleging infringement of Article 74(2) of Regulation No 40/94 and misuse of power by the Board of Appeal, respectively.

The first ground of appeal, alleging infringement of Article 74(2) of Regulation No 40/94 Arguments of the parties

18 Mr Rintisch submits that the General Court misinterpreted Article 74(2) of Regulation No 40/94 and Rule 50(1) of the Implementing Regulation.

19 He thus argues that the General Court disregarded the third subparagraph of Rule 50(1) of the Implementing Regulation, although the latter is a special provision for the examination of appeals which expressly provides for the application of Article 74(2) of Regulation No 40/94 and therefore confers on the Board of Appeal a discretion to decide whether additional or supplementary facts and evidence should be taken into account. In addition, the General Court erred in failing to distinguish between new facts and the late submission of additional or supplementary facts and evidence within the meaning of the third subparagraph of Rule 50(1) of the Implementing Regulation.

20 OHIM disputes the interpretation of the relevant provisions put forward by the appellant. It contends that the General Court correctly pointed out that Rule 20(1) of the Implementing Regulation must be regarded as a provision to the contrary, as referred to in the judgment in [OHIM v Kaul](#), inasmuch as it is a mandatory provision linked to an absolute time-limit.

Findings of the Court

21 Article 74(2) of Regulation No 40/94 provides that OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

22 As the Court has held, it results from the wording of that provision that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of Regulation No 40/94 and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late ([OHIM v Kaul, paragraph 42](#), and Case C-621/11 P *New Yorker SHK Jeans v OHIM* [2013] ECR I-0000, paragraph 22).

23 In stating that the latter 'may', in such a case, decide to disregard evidence, Article 74(2) grants OHIM broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account ([OHIM v Kaul, paragraph 43](#), and *New Yorker SHK Jeans v OHIM*, paragraph 23).

24 Since the first ground of appeal put forward by the appellant relates only to the discretion which he claims OHIM's Board of Appeal enjoys, it is appropriate, in order to determine whether there is a provision to the contrary liable to preclude such discretion, to refer to the rules governing the appeal proceedings.

25 In that regard, the first subparagraph of Rule 50(1) of the Implementing Regulation lays down that, unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought are to be applicable to appeal proceedings *mutatis mutandis*.

26 The General Court found, in paragraph 36 of the judgment under appeal, that it followed from that provision that the Board of Appeal was bound to apply Rule 20(1) of the Implementing Regulation and, therefore, to find that the submission of evidence after the expiry of the period specified for that purpose by OHIM, in order to establish the existence, validity and scope of protection of the earlier mark, entails the rejection of the opposition, and the Board of Appeal has no discretion in that regard.

27 In so doing, the General Court adopted an incorrect interpretation of Rule 50(1) of the Implementing Regulation, which misconstrues the scope of the third subparagraph of that provision.

28 Although the first subparagraph of Rule 50(1) lays down the principle that the provisions relating to proceedings before the department which has made the decision against which the appeal is brought are to be applicable to appeal proceedings *mutatis mutandis*, the third subparagraph of Rule 50(1) constitutes a special rule derogating from that principle. That special rule is specific to the appeal proceedings brought against the Opposition Division's decision and specifies the rules, before the Board of Appeal, governing the facts and evidence submitted after the expiry of the time-limits set or specified at first instance.

29 The third subparagraph of Rule 50(1) of the Implementing Regulation must therefore be applied, at this particular stage of the appeal proceedings against

the Opposition Division's decision, in place of the provisions relating to the proceedings before that division, which include Rule 20(1) of the Implementing Regulation.

30 It must be emphasised here that that special rule was introduced in the Implementing Regulation when it was amended by Regulation No 1041/2005, which, according to recital 7 thereof, seeks to specify clearly the legal consequences of procedural deficiencies in the opposition proceedings. That statement confirms that the consequences, before the Board of Appeal, of the delay in the submission of evidence before the Opposition Division must be determined on the basis of that rule.

31 Under the third subparagraph of Rule 50(1) of the Implementing Regulation, where the appeal is directed against a decision of an Opposition Division, the Board of Appeal must limit its examination of the appeal to facts and evidence presented within the time-limits set in or specified by the Opposition Division, unless the Board considers that additional or supplementary facts and evidence must be taken into account pursuant to Article 74(2) of Regulation No 40/94.

32 The Implementing Regulation therefore expressly provides that the Board of Appeal enjoys, when examining an appeal directed against a decision of the Opposition Division, the discretion deriving from the third subparagraph of Rule 50(1) of the Implementing Regulation and from Article 74(2) of Regulation No 40/94 to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time-limits set or specified by the Opposition Division.

33 Consequently, in finding, in paragraph 41 of the judgment under appeal, that Rule 20(1) of the Implementing Regulation constituted a provision to the contrary which prevented evidence submitted late to OHIM by the appellant from being taken into account by the Board of Appeal, with the result that the Board of Appeal did not have any discretion under Article 74(2) of Regulation No 40/94 for the purposes of taking into account that evidence, the General Court committed an error of law which vitiates its judgment.

34 However, it should be pointed out that where the grounds of a judgment of the General Court disclose an infringement of EU law but the operative part of the judgment is shown to be well founded for other legal reasons, the appeal must be dismissed (Case C-210/98 P *Salzgitter v Commission* [2000] ECR I-5843, paragraph 58, and Case C-352/09 P *ThyssenKrupp Nirosta v Commission* [2011] ECR I-2359, paragraph 136).

35 It follows from the considerations in paragraph 33 of this judgment that the Board of Appeal erred in law in finding, in paragraphs 35 to 37 of the contested decision, that it followed from Rule 20(1) of the Implementing Regulation that it did not have any discretion to decide whether or not it was necessary to take into account evidence which was submitted late of the existence, validity and scope of protection of the earlier mark.

36 None the less, it must be pointed out that the Board of Appeal stated, in paragraph 39 of the contested decision, that, if it were held that it enjoyed a discretion to decide whether or not it is necessary to take into account documents submitted late, it would exercise that discretion against the opponent. Then, in paragraphs 40 to 43 of that decision, it set out the reasons for that conclusion.

37 Those reasons – given as alternative grounds by the Board of Appeal for refusing to take into account the evidence submitted late by Mr Rintisch – are capable of remedying the defect vitiating the contested decision only if they permit the inference that the Board of

Appeal actually exercised its discretion under Article 74(2) of Regulation No 40/94, for the purposes of deciding, in a reasoned manner and having regard to all the relevant circumstances, whether it was necessary to take into account the evidence submitted to it late, in order to give its decision (see, to that effect, Case C-610/11 P *Centrotherm Systemtechnik v OHIM* and *centrotherm Clean Solutions* [2013] ECR I-0000, paragraph 110).

38 In that regard, the Court has held, *inter alia*, that where OHIM is called upon to give judgment in the context of opposition proceedings, taking into account facts or evidence produced late is particularly likely to be justified where OHIM considers, first, that the material which has been produced late is, on the face of it, likely to be genuinely relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account ([OHIM v Kaul, paragraph 44](#), and *Centrotherm Systemtechnik v OHIM* and *centrotherm Clean Solutions*, paragraph 113).

39 In this case, since Mr Rintisch based his opposition, *inter alia*, on three registered German marks, the evidence of the existence, validity and scope of protection of those marks which he had to submit during the opposition proceedings is set out precisely and exhaustively in Rule 19(2)(a)(ii) of the Implementing Regulation. Mr Rintisch was therefore deemed to be aware, even before filing his opposition, of the precise documents which he had to produce in support of it. Consequently, the Board of Appeal must, in those circumstances, exercise its discretion restrictively and may allow the late submission of such evidence only if the surrounding circumstances are likely to justify the appellant's delay in the submission of proof required of him.

40 In stating the reasons for its decision, the Board of Appeal emphasised in particular that Mr Rintisch was in possession of the proof of renewal of the marks at issue as from 2 December 2005 and that he did not put forward any reasons why he withheld that document until September 2007.

41 It is therefore apparent from the contested decision that the circumstances surrounding the late submission of the evidence of the existence, validity and scope of protection of the marks at issue are not capable of

justifying the appellant's delay in the submission of proof required of him.

42 The fact that Mr Rintisch produced, within the time-limit set by the Opposition Division, extracts from the *Deutsches Patent- und Markenamt* online register referring to the renewal of the marks at issue, in a language other than that of the language of the proceedings, cannot call in question that analysis, since it is clear from Rule 19(4) of the Implementing Regulation that OHIM must not take into account documents that have not been submitted, or that have not been translated into the language of the proceedings, within that time-limit.

43 It follows that the Board of Appeal was justified in refusing to take into account the evidence submitted by Mr Rintisch after the expiry of the periods specified for that purpose by the Opposition Division, and there was no need for it to rule on the possible relevance of that evidence or to determine whether the stage of the proceedings at which that late submission takes place precludes such evidence from being taken into account.

44 Contrary to Mr Rintisch's claims, the Board of Appeal is not required, when exercising its discretion under Article 74(2) of Regulation No 40/94, to examine the three criteria referred to in paragraph 38 above when one of those criteria alone is sufficient to establish that it must not take into account the evidence submitted late at issue (see, to that effect, order of 4 March 2010 in Case C-193/09 P *Kaul v OHIM*, paragraph 38).

45 In those circumstances, the error in law identified in paragraph 33 above, which vitiates the judgment under appeal, has no effect on the examination of the appeal, since the General Court's rejection, in paragraph 46 of that judgment, of the first part of the second plea in law, alleging infringement of Article 74(2) of Regulation No 40/94, is well founded on legal grounds other than those given by the General Court, and cannot therefore lead to the setting aside of that judgment.

The second ground of appeal, alleging misuse of power by the Board of Appeal **Arguments of the parties**

46 Mr Rintisch submits that the General Court underestimated the fact that the Board of Appeal had misused its powers.

47 OHIM states that no arguments supporting the second ground of appeal can be found in the appeal.

Findings of the Court

48 As regards the second ground of appeal, it must be noted, first, that the appellant confines himself to general assertions and in no way identifies the paragraphs of the judgment under appeal which he criticises and, second, that he does not state the legal arguments relied on in support of that ground of appeal.

49 According to consistent case-law, it follows from Article 256 TFEU, the first paragraph of Article 58 of the Statute of the Court, and Article 112(1)(c) of the Rules of Procedure of the Court, in the version in force at the date when the appeal was brought (now Article 168(1) (d) of the Rules of Procedure of the Court), that an appeal must state precisely the contested elements of

the judgment which the appellant seeks to have set aside and also the legal arguments specifically advanced in support of the appeal, failing which the appeal or plea concerned is inadmissible (Joined Cases C-189/02 P, C-202/02 P, C-205/02 P to C-208/02 P and C-213/02 P Dansk Rørindustri and Others v Commission [2005] ECR I-5425, paragraph 426, and Case C-487/06 P British Aggregates v Commission [2008] ECR I-10515, paragraph 121).

50 Since the second ground of appeal put forward by Mr Rintisch in support of his appeal does not meet those requirements, it must therefore be rejected as being inadmissible.

51 As none of the grounds relied on by the appellant in support of his appeal can be upheld, the appeal must be dismissed.

Costs

52 In accordance with Article 184(2) of the Rules of Procedure of the Court, where the appeal is unfounded, the Court is to make a decision as to costs. Under Article 138(1) of those rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

53 Since OHIM has applied for costs and the appellant has been unsuccessful, the latter must be ordered to pay the costs.

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

1. Dismisses the appeal;
2. Orders Mr Bernhard Rintisch to pay the costs.

* Language of the case: English.

OPINION OF ADVOCATE GENERAL

Sharpston

delivered on 16 May 2013 (1)

1. The appeals in these three cases are brought against three judgments of the General Court which were delivered on the same day, drafted in similar terms and based on the same interpretation of Article 74(2) of Regulation No 40/94 (2) and Rules 20(1) and 50(1) of Regulation No 2868/95 ('the Implementing Regulation'). (3) The appeals are based on the same two grounds.

2. In each case, the same trade mark holder, Mr Rintisch, opposed the registration of three different marks as Community trade marks on the basis that there was a likelihood of confusion with certain marks of which he claims to be the proprietor. He relied in support of his opposition on, inter alia, earlier German marks. In order to oppose the registrations, he also needed to show the existence and validity of those earlier marks. However, Mr Rintisch did not submit to the Opposition Division of the Office for Harmonisation in the Internal Market ('OHIM' or 'the Office'), within the time-limits set by it, all necessary evidence to that effect together with translations of the relevant documents into the language of the proceedings, which was English in each case. The

Opposition Division therefore rejected the oppositions. On appeal, Mr Rintisch then filed further documents and translations of the documentary evidence. In each case, OHIM's Board of Appeal refused to take them into account on the ground that it had no discretion to do so. The General Court dismissed the actions brought against the decisions of the Board of Appeal.

3. In these appeals, the Court is asked to consider whether the General Court erred in holding that the Board of Appeal has no discretion to take into account evidence of the existence and validity of earlier marks as well as translations of the documentary evidence filed after the expiry of the time-limit set by the Opposition Division.

EU trade mark law

4. Article 42 of Regulation No 40/94, entitled 'Opposition', provides:

'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: [(4)] [...]

3. Opposition must be expressed in writing and must specify the grounds on which it is made. [...] Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.'

5. Article 74, on 'Examination of the facts by the Office of its own motion', states:

'1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.'

6. The Implementing Regulation lays down rules necessary for the implementation of the Regulation. (5) Its rules 'should ensure the smooth and efficient operating of trade mark proceedings before the Office'. (6)

7. Rule 18 describes the commencement of proceedings regarding an admissible opposition:

(7) '(1) When the opposition is found admissible pursuant to Rule 17, the Office 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. According to Rule 19,

'(1) The Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time-limit specified by it [...]

(2) Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the

opposing party shall provide the following evidence:
(a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting: [...]

(ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time-limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered; [...]

(3) The information and evidence referred to in paragraphs 1 and 2 shall be in the language of the proceedings or accompanied by a translation. The translation shall be submitted within the time-limit specified for submitting the original document.

(4) The Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time-limit set by the Office.'

9. Rule 20, entitled 'Examination of the opposition', states:

'(1) If until expiry of the period referred to in Rule 19(1) [(8)] the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well [as] his entitlement to file the opposition, the opposition shall be rejected as unfounded.

(2) If the opposition is not rejected pursuant to paragraph 1, the Office shall communicate the submission of the opposing party to the applicant and shall invite him to file his observations within a period specified by the Office.

(3) If the applicant submits no observations, the Office shall base its ruling on the opposition on the evidence before it.

(4) The observations submitted by the applicant shall be communicated to the opposing party who shall be invited by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.

(5) Rule 18(2) and (3) shall apply *mutatis mutandis* after the date on which the opposition proceedings are deemed to commence.

(6) In appropriate cases, the Office may invite the parties to limit their observations to particular issues, in which case it shall allow the party to raise the other issues at a later stage of the proceedings. In no case shall the Office be required to inform the parties which facts or evidence could be or have not been submitted. [...]

10. The first and third subparagraphs of Rule 50(1), entitled 'Examination of appeals', state:

'Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*. [...] Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence

presented within the time-limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) of the Regulation.' The proceedings before OHIM Case C- 120/12 P 11. *Bariatric Europe Inc. SAS ('Bariatric')* applied on 17 March 2006 to register the word mark 'PROTI SNACK' as a Community trade mark in respect of goods in Classes 5, 29 and 32 of the Nice Agreement. (9)

12. On 9 March 2007, Mr Rintisch opposed the registration of that mark on the basis of the ground set forth in Article 8(1)(b) of Regulation No 40/94 (the likelihood of confusion on the part of the public in the territory in which an earlier mark is protected). The earlier marks on which his opposition was based included the German word marks 'PROTIPLUS' and 'PROTI' and the German figurative mark 'PROTIPOWER'.

13. With the notice of opposition, Mr Rintisch filed documents in order to prove the existence and validity of each of those earlier marks. In particular, he submitted to the Opposition Division: (i) registration certificates issued by the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office or 'DPMA') (10) and (ii) extracts from the DPMA online register. English translations of the original registration certificates, but not of the extracts from the online register, were also filed.

14. On 26 April 2007, the Opposition Division communicated to Mr Rintisch the date for the adversarial part of the opposition proceedings to commence. It stated that a renewal certificate had to be provided for marks whose registration was more than 10 years old and that the existence and validity of the earlier marks had to be proved by official documents translated into the language of the proceedings. If that evidence was not filed by 27 August 2007, the opposition would be rejected, in accordance with Rule 20(1) of the Implementing Regulation, without any examination as to its merits.

15. Almost one month after expiry of that time-limit, on 25 September 2007, Mr Rintisch submitted to OHIM with respect to each earlier mark: (i) an extract from the DPMA online register and (ii) a declaration from the DPMA confirming that the marks had been renewed before the date on which the notice of opposition was filed. He also filed an English translation of that declaration.

16. On 31 March 2008, the Opposition Division rejected the opposition because Mr Rintisch had not shown, within the time-limit set, the existence and validity of the earlier marks on which the opposition was based. First, the original registration certificates filed with the notice of opposition were insufficient to establish the continuing validity of the earlier marks as at 27 August 2007, which was the time-limit set by OHIM. Under German law, the protection of German trade marks ends upon the expiry of a period of 10 years from the date of application. Second, in

accordance with Rule 19(4) of the Implementing Regulation, the DPMA online extracts could not be taken into account as proof of the renewal dates of the earlier marks because they had not been translated into the language of the proceedings. Third, the Opposition Division refused, on the basis of Rule 20(1) of the Implementing Regulation, to take into account the documents filed on 25 September 2007 because they were filed late.

17. On 8 May 2008, Mr Rintisch appealed against that decision. He asked that the Board of Appeal refuse registration of 'PROTI SNACK' on the basis of the existence of a likelihood of confusion. He argued that the non-translated extracts from the DPMA were self-explanatory and sufficient to prove at least that the earlier marks 'PROTIPLUS' and 'PROTI POWER' had been renewed. He resubmitted the documents that he had filed with the Opposition Division on 25 September 2007, together with their translations, and asked the Board of Appeal to take them into account.

18. On 15 December 2008, the Board of Appeal dismissed the appeal. It held that the Opposition Division had rightly decided, applying Rules 19(2), (3) and (4) and 20(1) of the Implementing Regulation, that Mr Rintisch had not duly substantiated the existence and validity of the earlier marks. It agreed with the Opposition Division's reasons for deciding not to take into account the registration certificates (failure to show renewal of the marks) and the extracts from the DPMA online register (lack of translation) filed on 9 March 2007 and the documents filed on 25 September 2007 (late submission). It further found that neither the Board of Appeal nor the Opposition Division had discretion under Article 74(2) of Regulation No 40/94 to take into account documents filed after the expiry of the time-limit set by OHIM. The Board of Appeal added that, even if it had had such a discretion, it would not have exercised it in favour of Mr Rintisch. The applicant had neither acted improperly, nor played a part in Mr Rintisch's submission of evidence after the expiry of the time-limit set.

19. On 13 February 2009, Mr Rintisch appealed against that decision before the General Court.

Cases C- 121/12 P and C- 122/12 P

20. Valfleuri Pâtes Alimentaires SA ('Valfleuri') applied on 6 January 2006 for registration of the word marks 'PROTIVITAL' and 'PROTIACTIVE' as Community trade marks in respect of goods, inter alia, in Classes 5, 29 and 30 of the Nice Agreement.

21. On 24 October 2006, Mr Rintisch opposed both registrations on the grounds set out in Article 8(1)(b) of Regulation No 40/94. His opposition was directed against goods in respect of which the applications were made. In support, Mr Rintisch relied on, inter alia, earlier German marks including the word marks 'PROTI' and 'PROTIPLUS' and the figurative mark 'PROTI POWER'.

22. On 16 January 2007, in order to prove the existence and validity of those earlier marks, Mr Rintisch filed in the context of both opposition proceedings: (i) DPMA registration certifications and (ii) extracts from the

DPMA online register. He submitted an English translation only of the registration certificates for each of the marks.

23. On 23 January 2007, the Opposition Division communicated to Mr Rintisch the date for the adversarial part of the opposition proceedings involving the registration of the mark 'PROVITAL' to commence. On 13 March 2007, it made an equivalent communication in the proceedings involving the mark 'PROTIACTIVE'. The Opposition Division stated expressly that Mr Rintisch needed to prove the existence and validity of the earlier marks by filing official documents translated into the language of the proceedings. It advised him to submit renewal certificates for those marks whose registration was more than 10 years old. The time-limit for submitting evidence was 4 June 2007 in the 'PROVITAL' proceedings and 26 May 2007 in the 'PROTIACTIVE' proceedings. The Opposition Division warned Mr Rintisch that, if the relevant evidence was not filed by then, it would reject the oppositions without an examination of the merits.

24. On 19 September 2007 in the 'PROVITAL' proceedings and on 24 September 2007 in the 'PROTIACTIVE' proceedings, the Opposition Division rejected the opposition on the ground that Mr Rintisch had failed to substantiate within the time-limits the existence and validity of the earlier trade mark rights. The registration certificates showed the original registration of the earlier marks but did not show that they were still valid as at the date on which the time-limit set by the Opposition Division would expire. Taken on their own, indeed, those documents showed that the validity of the marks had expired. The Opposition Division further found that, under Rule 19(4) of the Implementing Regulation, it could not take into account the extracts from the DPMA online register as proof of the renewal dates of the earlier marks because no English translations had been submitted.

25. On 23 October 2007, Mr Rintisch appealed against both decisions and requested that the Board of Appeal refuse to register the marks applied for on the basis of the existence of a likelihood of confusion. With his appeal, he filed extracts from the DPMA online register and a declaration from the DPMA, together with an English translation, stating that the earlier marks had been renewed before the date on which the notice of opposition was filed.

26. On, respectively, 21 January and 3 February 2009, the Board of Appeal dismissed the appeal in both proceedings. It held that the Opposition Division had rightly rejected the opposition because Mr Rintisch had failed to substantiate within the time-limit set the existence and validity of the earlier trademarks. The registration certificates filed on 16 January 2007 were insufficient by themselves to show that the earlier marks were enforceable on the date on which the notice of opposition was filed. Furthermore, the Opposition Division was right not to take into account the extracts from the DPMA online register because

they had not been translated into English. Finally, neither the Opposition Division nor the Board of Appeal itself had a discretion to take into account documents filed after the time-limit set by OHIM. Rule 20(1) of the Implementing Regulation expressly states that, in such circumstances, an action must be dismissed. Even if it had enjoyed such a discretion, the Board of Appeal would not have exercised it in favour of Mr Rintisch: the other party had not acted improperly, nor had it played any part in the late submission of evidence.

Summary of the judgments of the General Court Case T- 62/09 (11) (the subject of the appeal in Case C- 120/12 P)

27. The action against the Board of Appeal's decision of 15 December 2009 was based on three pleas: (i) infringement by the Opposition Division of Article 8(1)(b) of Regulation No 40/94, (ii) infringement by the Board of Appeal of Article 74(2) of Regulation No 40/94 and misuse of powers and (iii) infringement by the Board of Appeal of Article 8(1)(b) of Regulation No 40/94.

28. On 16 December 2011, the General Court dismissed the action.

29. The General Court rejected, at paragraph 24 of its judgment, the first plea as being inadmissible because it was not directed against a decision of the Board of Appeal.

30. The General Court rejected the second plea as being unfounded. At paragraphs 27 and 28 of its judgment, it first summarised the terms of Rule 19(1) to (3) of the Implementing Regulation and the dates on which Mr Rintisch filed evidence.

31. Next, at paragraphs 29 to 32, the General Court focused on the terms of Article 74(2) of Regulation No 40/94 and the case-law according to which (i) as a general rule, the submission of facts and evidence by the parties remains possible after the expiry of the timelimits to which such submission is subject under the provisions of Regulation No 40/94; (ii) a party has no unconditional right to have facts and evidence submitted out of time taken into consideration by OHIM and (iii) the possibility for parties to proceedings before OHIM to submit facts and evidence after the expiry of the periods specified for that purpose is conditional upon there being no provision to the contrary.

32. After setting out the terms of Rule 20(1) and the first and third subparagraphs of Rule 50(1) of the Implementing Regulation, the General Court then went on to consider whether the latter is a 'provision to the contrary' that precludes Rule 20(1) from being applied to proceedings before the Board of Appeal:

'38 It must be noted at the outset that, since the notice of opposition was filed on 9 March 2007, the version of [the Implementing Regulation] applicable to the present case is that in force after the amendment by Commission Regulation (EC) No 1041/2005 [...] In particular, according to recital 7 of that regulation, one of the aims of that amendment was to reframe completely the provisions concerning the opposition

procedure in order to specify clearly, inter alia, the legal consequences of procedural deficiencies.

39 In addition to the risk of applying circular reasoning to the provisions in question, accepting the interpretation put forward by the applicant would result in the scope of Rule 20(1) of [the Implementing Regulation], as amended, being limited significantly.

40 If the evidence to establish the existence, validity and scope of an earlier mark – which, in accordance with the new wording of Rule 20(1) of [the Implementing Regulation], applicable to the present case, cannot be taken into account by the Opposition Division when it is filed late – could nevertheless be taken into consideration by the Board of Appeal by virtue of its discretionary power under Article 74(2) of Regulation No 40/94, the legal consequence laid down expressly in Regulation No 1041/2005 for that type of deficiency, namely the rejection of the opposition, might, in certain cases, have no practical effect.

41 It must therefore be held that the Board of Appeal did not err by finding that, in the circumstances of the present case, there was a provision which prevented evidence submitted late to OHIM by the applicant from being taken into account and that, therefore, the Board of Appeal did not have any discretion under Article 74(2) of Regulation No 40/94.'

33. The General Court then turned to Mr Rintisch's argument regarding the Board of Appeal's statement that, in any event, it would have exercised its discretion against him:

'43 In that regard, even though the Board of Appeal found that the circumstances of the present case prevented the discretion under Article 74(2) of Regulation No 40/94 from being exercised in favour of the applicant in any event, it is clear from paragraph 39 of the contested decision that that finding was made purely in the alternative and in the light of the fact that CORPO livre [(12)] [...], on which the Board of Appeal's reasoning was based, was the subject of an appeal to the Court of Justice.

44 It should be pointed out that in its order in K & L Ruppert Stiftung v OHIM [(13)] [...] the Court of Justice did not call in question the General Court's approach in CORPO livre [...] In addition, since, in accordance with the conclusion drawn in paragraph 41 above, the Board of Appeal did not have the discretion provided for in Article 74(2) of Regulation No 40/94, there is no need to examine the applicant's arguments seeking a declaration that the contested decision was mistaken in that regard in the light of the conditions laid down by OHIM v Kaul (14) [...] [...]

46 It follows that the Board of Appeal did not infringe Article 74(2) of Regulation No 40/94, in not taking into account, in the contested decision, the documents submitted late to the Opposition Division by the applicant which were intended to prove the existence and validity of the earlier marks.'

34. At paragraph 47 of the judgment, the General Court declared inadmissible the complaint as regards the alleged misuse of powers by the Board of Appeal

because the application did not satisfy the minimum requirements for the admissibility of a complaint, in particular the requirement of arguments in support of the complaint, laid down in Article 21 of the Statute of the Court of Justice of the European Union and Article 44(1)(c) of the Rules of Procedure of the General Court, provisions which apply to intellectual property matters pursuant to Articles 130(1) and 132(1) of those rules.

35. At paragraph 62 of its judgment, the General Court also rejected the third plea as being unfounded because, having concluded that the existence and validity of the earlier marks had not been duly substantiated by the opposing party, it was not entitled to examine the merits of the opposition or to analyse, in particular, the existence of a likelihood of confusion between the marks at issue.

Cases T- 109/09 (15) and T- 152/09 (16) (the subject of the appeal in, respectively, Cases C- 121/12 P and C- 122/12 P)

36. Mr Rintisch's actions against the decisions of the Board of Appeal of 21 January 2009 and 3 February 2009 were based on the same three pleas in law that he advanced in Case T-62/09.

37. On 16 December 2011, the General Court dismissed the actions.

38. In both Case T-109/09 and Case T-152/09, the General Court rejected the three pleas on the basis of reasoning that, in essence, is the same as that which led to the rejection of identical pleas in Case T-62/09 (now under appeal in Case C-120/12 P).

Summary of the appeals and the remedies sought in the appeals

39. In each appeal, Mr Rintisch asks the Court to set aside the judgment of the General Court and to order OHIM to pay the costs.

40. The appeals are based on two grounds: (i) infringement of Article 74(2) of Regulation No 40/94 inasmuch as the General Court wrongly found that the Board of Appeal has no discretion when deciding that an opposing party has not substantiated earlier marks and (ii) misuse of powers.

Summary of the parties' arguments in the three appeals

Infringement of Article 74(2) of Regulation No 40/94

41. Mr Rintisch argues that the General Court erred in interpreting Article 74(2) of Regulation No 40/94 and Rule 50(1) of the Implementing Regulation. The General Court was wrong to conclude that the Board of Appeal has no discretion to decide that documents submitted after expiry of the time-limit set by the Opposition Division may be taken into account for its decision. The General Court also erred in failing to find that the Board of Appeal had erroneously exercised the discretionary powers conferred under Article 74(2).

Whether the Board of Appeal has discretion

42. Mr Rintisch relies on the decision in *Henkel v OHIM – LHS (UK) (Kleencare)*, where the General Court held that *'[i]t follows from the principle of continuity of functions that, within the scope of Article 74(1) in fine [...], the Board of Appeal is required to*

base its decision on all the matters of fact and of law which the party concerned introduced either in the proceedings before the department which heard the application at first instance or, subject only to Article 74(2), in the appeal'. (17) The Board of Appeal therefore had to take into account documents filed with the Opposition Division after the expiry of the time-limit, such as translations of documents showing the renewal of the trademarks.

43. Whilst Mr Rintisch accepts that the Court of Justice said in *OHIM v Kaul* (18) that the discretion in Article 74(2) was conditional upon there not being a provision to the contrary, he argues that that provision itself does not contain such a condition. Nor is there any other rule excluding the exercise by the Board of Appeal of that discretion. He thus also appears to contest the validity of the principle set out in *OHIM v Kaul*.

44. Mr Rintisch claims that, whilst it is true that Rule 20(1) applies to opposition proceedings, the General Court failed to take into account that Rule 50(1) prevails over Rule 20(1) in so far as it gives discretionary powers to the Board of Appeal. The General Court disregarded the fact that the third subparagraph of Rule 50(1), which is a special provision for examining appeals, expressly provides for the application of Article 74(2). In that regard, the General Court failed to distinguish between entirely new facts and the late production of 'additional or supplementary' facts and evidence. The General Court should also have held that, under Article 74(2), the Board of Appeal ought to have taken into account the translation filed after expiry of the time-limit.

45. OHIM argues that the question raised by the first ground of appeal can be resolved on the basis of two considerations. First, Rule 20(1) must be read against its historical background. In its older version, that rule did not state what consequence resulted from noncompliance with the time-limits under Rule 19(1). Rule 20(1), as amended by Regulation No 1041/2005, now expressly provides that an opposition must be rejected as unfounded if the opposing party has not proven the existence, validity and scope of protection of his earlier mark before the expiry of the period referred to in Rule 19(1). Second, Rule 19(3) clearly states that evidence in support of opposition proceedings must be submitted in the language of the proceedings or be accompanied by a translation into that language. That principle is based on the need to observe the rule of *audi alteram partem* and to ensure equality of arms between parties in inter partes proceedings. Evidence taken from registration certificates can thus be taken into account only if it complies with the requirements in Rule 19(3). The General Court was therefore right to hold that Rule 20(1) of the Implementing Regulation excludes any discretion to decide whether or not to take into account evidence and translations filed after the expiry of the time-limit.

46. OHIM goes on to address the possible parallelism between Rule 20 and Rule 22(2). With regard to the latter and the consequences of filing evidence after the

expiry of the time limit set by OHIM under that rule, the General Court had previously distinguished initial evidence from additional evidence. In OHIM's view, that case-law concerns the submission of evidence at a later stage in the opposition proceedings. In relation to proof of genuine use, OHIM accepts that there may be different interpretations concerning the quality of the evidence submitted and thus a need for flexibility. In the context of demonstrating the existence and validity of earlier rights, however, there will never be any doubt about the sufficiency of the documents submitted. As a result, the distinction is not relevant in this context.

47. Unlike *Bariatric* in Case C-120/12 P, *Valfleuri* has intervened in Cases C-121/12 P and C-122/12 P. It takes the view that, in the circumstances leading to the present appeals, OHIM has no discretion. Its argument is based on the wording of Rules 19 and 20 of the Implementing Regulation and the fact that both provisions preclude OHIM from granting the opposing party further time in which to prove the existence, validity and scope of protection of the earlier mark. It further contests Mr Rintisch's reliance on case-law that did not involve the application of Rules 19 and 20 of the Implementing Regulation as amended by Regulation No 1041/2005. *Valfleuri* notes that, in the present cases, Mr Rintisch was in possession of the required documentary evidence before the expiry of the time-limit set by OHIM; yet he has not put forward any reason for withholding the documents until October 2007.

Exercise of the Board of Appeal's discretion

48. Mr Rintisch submits that the General Court should have found that the Board of Appeal erred in stating that, if it had discretion under Article 74(2) of Regulation No 40/94, it would have exercised that discretion against him. Here, the General Court should have examined his arguments on the Board of Appeal's failure to consider whether taking into account evidence filed after the expiry of the time-limit was justified because, on the one hand, the material was on the face of it likely to be relevant to the outcome of the opposition proceedings and, on the other hand, the state of the proceedings at which that late submission took place and the circumstances surrounding it did not preclude it.

49. OHIM submits that this plea is relevant only if the Court finds that the Board of Appeal does have a discretion. In any event, the Board of Appeal had explained how it would exercise that discretion in the circumstances of the case.

Misuse of powers

50. Mr Rintisch appears to submit, as a second ground of appeal, misuse of powers by the General Court. However, no specific arguments in support of that ground have been put forward.

51. OHIM is uncertain whether this ground remains in the appeal. In any event, for lack of argument, it must be dismissed as inadmissible.

Assessment

Discretion of the Board of Appeal and exercise of that discretion

52. The first ground of appeal can be divided in two parts. The first part concerns whether the Board of Appeal has discretion to take into account evidence of the existence and validity of earlier marks and translations of that evidence filed after the expiry of the time-limit set by the Opposition Division. The second part concerns the exercise of that discretion, should it exist.

Whether the Board of Appeal has discretion

53. In my Opinion in Case C-621/11 P *New Yorker SHK Jeans v OHIM*, also delivered today, I explained that the starting point of the analysis on the scope of OHIM's discretion in taking evidence in all types of proceeding must be that OHIM, including the Opposition Division and the Board of Appeal, normally does have discretion to take into account evidence submitted outside the time-limit set.

54. The appeal in *New Yorker SHK Jeans v OHIM* concerned whether the Opposition Division has a discretion to decide whether or not to take account of a second batch of evidence filed after the expiry of the time-limit set by OHIM in order to prove genuine use in opposition proceedings.

55. The present appeal concerns (i) evidence of the existence and validity of the marks on which the opposing party relies and (ii) translations of that evidence. That is the evidence that must be filed to get over the initial threshold in opposition proceedings. If there is no extant, valid earlier mark, there can be no question of opposing an application to register a new mark.

56. On the basis of the general rule in Article 74(2) of Regulation No 40/94, it appears evident to me, as it was to the General Court, (19) that the starting point here is also that the Board of Appeal has a discretion.

57. Does Regulation No 40/94 or the Implementing Regulation contain an exception that applies in the context of the three appeals at issue?

58. I shall consider that question first in relation to the submission of evidence; and address translations separately.

59. Apart from Article 74(2), Regulation No 40/94 contains no express rule concerning the discretion of the Board of Appeal to decide whether or not to take into account evidence of the existence and validity of marks filed after the expiry of the time-limit set by the Opposition Division. (20)

60. However, Article 42(1) of Regulation No 40/94 makes it clear that only proprietors of (earlier) marks can file a notice of opposition to registration of a trade mark. The opposing party must therefore provide information concerning the mark on which it relies and its rights to it. Material evidence of those facts, that is to say, the existence and validity of the mark, can be filed later to the Opposition Division. (21)

61. Whilst the material evidence does not have to be filed with the notice of opposition, the information concerning the existence and validity of the mark relates to the admissibility of the opposition. It must therefore be considered by the Opposition Division before it addresses the merits. The need for procedural

efficiency, sound administration and legal certainty lead me to conclude that, when read in that context, Article 74(2) of Regulation No 40/94 must be understood as excluding the possibility that the Board of Appeal may consider evidence which, without having been submitted at any earlier stage of the opposition proceedings as a whole, is submitted to it in support of an element pertaining to the admissibility of an opposition, such as (specifically) evidence of the existence and validity of the (earlier) marks.

62. The third subparagraph of Rule 50(1) of the Implementing Regulation confirms that position.

63. The first part of the third subparagraph of Rule 50(1) sets out the general rule applicable to appeals against decisions of the Opposition Division. I read that rule, and in particular the words ‘shall limit’, to mean that the Board of Appeal can consider only facts and evidence that were presented within the time-limit ‘set in or specified by the Opposition Division in accordance with the Regulation and these Rules’. Whilst the text does not distinguish between evidence of the existence and validity of earlier marks and other evidence, different rules in Regulation No 40/94 and the Implementing Regulation govern the submission of those two types of evidence. Rules 19 and 20 of the Implementing Regulation govern the submission of evidence of the existence and validity of earlier marks and translations of any documents submitted.

64. Contrary to the argument advanced by Mr Rintisch, the first part of the third subparagraph of Rule 50(1) does not therefore ‘prevail over’ Rule 20(1). Rather, it makes a ‘renvoi’ to that provision and excludes, with regard to facts and evidence other than ‘additional or supplementary facts and evidence’, the possibility of the Board of Appeal examining facts and evidence presented outside the time-limits set or specified by the Opposition Division in accordance with Regulation No 40/94 and the Implementing Regulation. The Board of Appeal has, just like the Opposition Division, (22) no discretion to decide whether or not to take such evidence into account.

65. The second part qualifies the rule set out in the first part of the sentence: that rule applies ‘*unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2)*’ which sets out the general rule of discretion.

66. Whether the Board of Appeal has that discretion thus depends on whether the evidence of the existence and validity of earlier marks can be characterised as ‘additional or supplementary’. (23) Whilst I do not consider it necessary, for the purposes of these appeals, to provide an exhaustive definition of those words, it is plain that, in order for evidence to be so characterised, other evidence must have been submitted at an earlier stage of the proceedings.

67. In circumstances where the Implementing Regulation defines (i) the indispensable formal requirements for evidence to be admissible to prove a fact and (ii) the time-limit for submitting that evidence, I do not consider that the opposing party can submit

inadequate evidence within the time-limit set and then later, possibly only on appeal, submit evidence that is actually indispensable under the guise of ‘additional or supplementary’ evidence.

68. Whatever the basis for the opposition, the opposing party must always file proof of the existence, validity and scope of protection of the earlier marks on which it relies. Rule 19(2) of the Implementing Regulation states: ‘*the opposing party shall provide the following evidence*’. Under paragraph 2(a)(ii), it then defines the documentary evidence required in circumstances where the opposition is based on a trade mark which is not a Community trade mark, namely the relevant registration certificate and, if appropriate, the latest renewal certificate.

69. Since its amendment by Regulation No 1041/2005, Rule 20(1) is clear on the consequence if the opposing party fails to submit the relevant registration (and, where necessary, renewal) certificate before the expiry of the time-limit set by the Opposition Division: ‘*the opposition shall be rejected as unfounded*’

70. Although it is true that that phrase is similar to the phrase ‘*the Office shall reject the opposition*’ in Rule 22(2) of the Implementing Regulation, I nevertheless consider that the phrases should be interpreted differently.

71. I concluded in my Opinion in Case C-621/11 P *New Yorker SHK Jeans v OHIM* that, under the second sentence of Rule 22(2) of the Implementing Regulation, the Opposition Division must reject the opposition if no evidence of genuine use of the mark has been submitted at the time of the expiry of the time-limit set by OHIM. (24) I also stated that the exception to the general rule in Article 74(2) of Regulation No 40/94 no longer applies if the opposing party, who is asked to show genuine use of its mark, has, in good faith, submitted credible initial evidence showing that use. (25) Whilst Rule 22(3) describes what needs to be proven and Rule 22(4) lists how this can be done, there is no exhaustive list of indispensable documentary evidence that must be submitted to satisfy the burden of showing genuine use. Depending on the circumstances, such as the type of mark and the market in which it is used, the quality and quantity of evidence can vary and the sufficiency of the initial evidence submitted may legitimately be called into question by the applicant during the inter partes procedure.

72. I do not interpret Rule 20(1) in the same way. In Rule 19(2)(a)(ii), the legislature has essentially defined an evidentiary threshold: for registered marks which are not Community trade marks, the opposing party is required to submit a copy of the relevant registration certificate and, if appropriate, of the latest renewal certificate showing that the term of protection of the trade mark extends beyond the time-limit set by the Opposition Division and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered.

73. Either the opposing party files the relevant registration (and, if appropriate, renewal) certificate or it does not. I therefore agree with OHIM that there is no

scope for questioning the sufficiency of the evidence or for debating whether it is additional or supplementary to evidence previously submitted. Indispensable documentary evidence cannot be additional or supplementary to other documentary evidence. (The latter can, however, be additional or supplementary to the former.)

74. Unlike Mr Rintisch, I see no basis for distinguishing between documents filed with the Opposition Division after the expiry of the time-limit and those filed with the Board of Appeal after that date. On my reading of Rules 19(2)(a)(ii) and 20(1) of the Implementing Regulation, the Opposition Division has no discretion to take into account registration certificates or renewal certificates submitted after the time-limit set. In accordance with the principle of continuity of functions and unless a provision to the contrary exists, there is no basis for allowing the Board of Appeal to take account of late indispensable evidence which the Opposition Division cannot take into account. Continuity implies consistency in the application of the same rules. (26)

75. In my opinion, the same conclusion applies to the late submission of translations of the relevant registration (and, if appropriate, renewal) certificates.

76. Rule 19(3) of the Implementing Regulation makes it clear that documents described in Rule 19(2) are to be submitted either in the language of the proceedings or accompanied by a translation. The same rule provides that the translation must be '*submitted within the time-limit specified for submitting the original document*'. Under Rule 19(4), OHIM '*shall not take into account*' documents that are not submitted or translated within the time-limit set. Against the background of these unambiguous terms, it seems to me that the Opposition Division cannot have a discretion to decide whether or not to take account of translations of the documents described in Rule 19(2)(a)(ii) which are submitted late. Nor can the Board of Appeal.

77. Based on these considerations, I consider that the General Court was right to hold that the Board of Appeal did not err in finding that it had no discretion to take into account evidence of the existence and validity of the earlier marks filed after the expiry of the time-limit set by the Opposition Division.

Exercise of the discretion of the Board of Appeal

78. If the Board of Appeal has no discretion to take account of (i) evidence that is neither additional nor supplementary and (ii) translations filed after expiry of the time-limit set by the Opposition Division, there exists no scope to consider how it might or should exercise such a discretion.

79. I therefore agree with OHIM that this ground of appeal is relevant only if this Court finds that the General Court erred in its interpretation of Article 74(2) of Regulation No 40/94 and concludes that, in relation to the evidence and translations at issue in the three appeals, the Board of Appeal has a discretion to decide whether or not to take account of those documents. Given the conclusion I have reached in relation to the

first part of this ground, I shall not consider the second part further.

Misuse of powers

80. I agree with OHIM that, in the absence of any reasoned argument to support the second ground of appeal, it must be rejected as inadmissible.

Costs

81. Under Article 138(1) of the Rules of Procedure, which applies to appeals on the basis of Article 184(1) of the same rules, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Article 184(4) states that the Court may decide that an intervener at first instance who takes part in the proceedings is to bear his own costs.

82. In each case, OHIM has applied for costs, and Valfleuri has applied for costs in Cases C-121/12 P and C-122/12 P. In my assessment, Mr Rintisch should be unsuccessful in all cases.

Conclusion

83. For these reasons, I propose that the Court should:

- dismiss the appeals in their entirety;
- order Mr Rintisch to pay the costs incurred by OHIM and those of the intervening party in Cases C-121/12 P and C-122/12 P.

1 – Original language: English.

2 – Whilst Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) ('Regulation No 40/94') as amended has been 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) ('Regulation No 207/2009'), the regulation in force at the time when Mr Rintisch filed his notices of opposition and when other relevant subsequent events occurred in the three cases was Regulation No 40/94. In any event, materially Regulation No 207/2009 does not more than codify Regulation No 40/94 and its amendments. The provisions of Regulation No 40/94 at issue in these proceedings remained unaffected.

3 – Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) as amended by, inter alia, Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4).

4 – Article 8 sets out the relative grounds for refusal of registration.

5 – See the fifth recital in the preamble to the Implementing Regulation.

6 – See the sixth recital in the preamble to the Implementing Regulation.

7 – Rule 17 sets out the grounds for declaring an opposition inadmissible. These include: nonpayment of the opposition fee, late filing of the notice of opposition, lack of statement of the grounds of opposition, failure to clearly identify the earlier mark or the earlier right on which the opposition is based, failure to submit a translation as required under Rule 16(1), failure to comply with the provisions of Rule 15.

8 – I take the opening words to mean: ‘If, before the expiry of the period referred to in Rule 19 (1),’

9 – Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended.

10 – Those registration certificates were dated March 1996, October 1996 and March 1997.

11 – [2011] ECR II-0000.

12 – Case T-86/05 K & L Ruppert Stiftung v OHIM – Lopes de Almeida Cunha and Others (CORPO livre) [2007] ECR II-4923.

13 – Order of 5 March 2009 in Case C-90/08 P.

14 – Case C-29/05 P [2007] ECR I-2213.

15 – [2011] ECR II-0000.

16 – [2011] ECR II-0000.

17 – Case T-308/01 [2003] ECR II-3253, paragraph 32.

18 – Cited in footnote 14 above, paragraph 42.

19 – See paragraph 30 of the judgment under appeal in Case T-62/09; paragraph 31 of the judgments under appeal in Cases T-109/09 and T-152/09.

20 – See Rule 15 of the Implementing Regulation.

21 – See Rule 19 of the Implementing Regulation.

22 – See point 74 below.

23 – The different language versions of the third subparagraph of Rule 50(1) do not fully correspond. For example, the French text refers to ‘faits et preuves nouveaux ou supplémentaires’ and the Dutch text states ‘aanvullende feiten en bewijsstukken’.

24 – See point 57 of my Opinion in *New Yorker SHK Jeans v OHIM*, cited in point 53 above.

25 – *Ibid.*, point 65; Article 74(2) of Regulation No 40/94 is the equivalent of Article 76(2) of Regulation No 207/2009, in issue in that case.

26 – See paragraph 111 of my Opinion in *OHIM v Kaul*, cited in footnote 14 above.