

Case T-342/02

Metro-Goldwyn-Mayer Lion Corp.

v

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

(Community trade mark — Opposition proceedings — Extent of the obligation to examine — Conversion into a national trade-mark application — Article 58 of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 16 September 2004 II - 3194

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Persons entitled to appeal and to be parties to the proceedings — Persons whose claims not upheld by a decision — Opposition proceedings based on several earlier national trade marks — Decision upholding the opposition without taking account of all the earlier trade marks — Decision allowing the opponent's claims — Possibility for the applicant to convert his Community trade mark application into a national trade mark application in the relevant Member States — Not relevant*

(Council Regulation No 40/94, Arts 58 and 108)

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Suspension of the proceedings where the opposition is based on an application for registration — Power of assessment of the Office*
(Commission Regulation No 2868/95, Art. 1, Rule 20(6))

1. A decision of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) which upholds, in respect of all the goods and services concerned, a Community trade mark based on several earlier national trade marks upholds the claims of a party to the proceedings which led to a decision, within the meaning of Article 58 of Regulation No 40/94 on the Community trade mark, even though the opposition was not upheld on the basis of all the trade marks put forward as grounds for opposition, since the applicant for the Community trade mark is still able therefore to convert his application, in accordance with Article 108 of Regulation No 40/94, into an application for a national trade mark in the Member States in respect of which the applicant's earlier marks were not taken as the basis for refusal.

trade marks which might give rise to a likelihood of confusion with their earlier marks or rights, and not to settle pre-emptively potential conflicts at national level.

Furthermore, the fact that the Opposition Division does not take account of a number of other earlier national trade marks does not have any negative legal consequences for the opponent in so far as that conversion of a Community trade mark application into a national trade mark application is merely optional for an applicant for a Community trade mark. It does not confer on applicants the right to have their applications accepted and nothing prevents an applicant whose Community trade mark application has been refused following opposition proceedings from filing similar applications with national authorities without having recourse to the conversion procedure.

The aim of opposition proceedings is to give undertakings an opportunity to challenge, by means of one procedural system, applications for Community

(see paras 35, 41, 42, 45)

2. It follows from Rule 20(6) of Regulation No 2868/95 implementing Council Regulation No 40/94 on the Community trade mark, which provides that the Office for Harmonisation in the Internal Market (Trade Marks and Designs) 'may suspend any opposition proceeding where the opposition is based on an application for registration ... until a final decision is taken in that proceed-

ing', and that the suspension referred to remains optional for the Office, which avails itself of it only when it considers it appropriate.

(see para. 46)