

ORDER OF THE COURT OF FIRST INSTANCE (Second Chamber)
5 March 2004 *

In Case T-94/02,

Hugo Boss AG, established in Metzingen (Germany), represented by E. Baud,
lawyer,

applicant,

v

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

defendant,

* Language of the case: English.

defendant,

the intervener before the Court being:

Delta Holding SA, formerly **Delta Protypos Biomichania Galaktos SA**, established in Athens (Greece), represented by **P. Kanellopoulos**, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 12 December 2001 (Case R 53/2001-4), relating to opposition proceedings between **Hugo Boss AG** and **Delta Protypos Biomichania Galaktos SA**,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Second Chamber),

composed of: **J. Pirrung**, President, **A.W.H. Meij** and **N.J. Forwood**, Judges,

Registrar: **H. Jung**,

makes the following

Order

Facts, procedure and arguments of the parties

- 1 On 12 August 1996, Delta Holding SA, formerly Delta Protypos Biomichania Galaktos SA (hereinafter ‘Delta Holding’), lodged, pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (hereinafter ‘the Office’).
- 2 On 29 May 1998, the applicant filed, pursuant to Article 42 of Regulation No 40/94, a notice of opposition to registration of the mark applied for. When the opposition was rejected, the applicant filed notice of appeal at the Office, pursuant to Article 59 of Regulation No 40/94, against the decision of the Opposition Division.
- 3 The appeal was rejected by decision of the Fourth Board of Appeal of the Office of 12 December 2001.
- 4 By application registered at the Court Registry on 27 March 2002, the applicant brought an action against the decision of the Board of Appeal.

- 5 On 26 August 2002, Delta Holding lodged a response.
- 6 On 12 August 2002, Delta Biomichania Pagatou SA, also called Delta Ice Cream SA (hereinafter 'Delta Ice Cream'), applied, under Article 115 of the Rules of Procedure of the Court of First Instance, to intervene in this case in support of the form of order sought by Delta Holding.
- 7 Delta Ice Cream has explained that it is a subsidiary of Delta Holding and that, in the course of a restructuring in 2002, the application for a Community trade mark was transferred to it by Delta Holding. That was confirmed by an agreement of 29 April 2002, of which the Office was notified on 5 June 2002. That transfer was registered at the Office on 25 July 2002, in accordance with Articles 17 and 24 of Regulation No 40/94.
- 8 In its observations on the application to intervene, the Office has requested the Court to declare that Delta Ice Cream may participate in the proceedings before the Court as an intervener pursuant to Article 134 of the Rules of Procedure. The Office has pointed out the disadvantages which would result from allowing the new owner of the rights connected to the application for the mark to intervene pursuant to Article 40 of the Statute of the Court of Justice and Articles 115 and 116 of the Rules of Procedure.
- 9 Invited to clarify the purpose of its application to intervene, Delta Ice Cream stated that it wished to participate in the proceedings before the Court as an intervener pursuant to Article 134 of the Rules of Procedure, in place of Delta Holding. In the alternative, it applied to be allowed to intervene in support of the form of order sought by Delta Holding, in accordance with Articles 115 and 116 of the Rules of Procedure. It sought, in addition, should its substitution for Delta Holding in these proceedings be allowed, that all the observations and evidence lodged by Delta Holding should be regarded as having been lodged by Delta Ice Cream.

- 10 The other parties to the proceedings were invited to submit their observations on the application thus clarified.
- 11 Delta Holding stated that it had no objection to being replaced, for the purposes of these proceedings, by Delta Ice Cream. The Office recorded its agreement to Delta Ice Cream's application to replace Delta Holding. The applicant lodged no observations.

Law

- 12 The action under Article 63 of Regulation No 40/94 is open, according to Article 63(4) thereof, to any party to proceedings before the Board of Appeal adversely affected by its decision.
- 13 Under Article 134(1) and (2) of the Rules of Procedure, the parties to the proceedings before the Board of Appeal other than the applicant may participate, as interveners, in the proceedings before the Court of First Instance and have, for that purpose, the same procedural rights as the main parties.
- 14 In addition, anyone establishing an interest in the result of any proceedings may be allowed to intervene therein by order pursuant to Article 40 of the Statute and Articles 115 and 116 of the Rules of Procedure.

- 15 Neither the Statute of the Court of Justice nor the Rules of Procedure of the Court of First Instance contain any provisions expressly governing the situation in which a party to the proceedings before the Board of Appeal transfers the intellectual property right affected by the proceedings after the decision of the Board of Appeal. In particular, there is no provision for the possibility, for the new owner of the right, to replace the transferor for the purposes of the proceedings before the Court of First of Instance.
- 16 Admittedly, the possibility of intervening pursuant to Article 40 of the Statute and Articles 115 and 116 of the Rules of Procedure is, in any event, open to the new owner of the right. That possibility is not however sufficient, in all respects, to take account of the particular situation of the parties to an action in the field of intellectual property.
- 17 As is recognised in the second paragraph of Article 53 of the Statute, litigation in the field of intellectual property presents specific features which require derogation from certain provisions governing proceedings before the Court of First Instance. As the Office correctly points out, the specific provisions of Title IV of the Rules of Procedure concerning proceedings relating to intellectual property rights have been adopted in order to take account of those specific features. One such feature is the fact that such litigation involves, so far as opposition proceedings are concerned, disputes between private persons. To that end, specific rules on the procedural rights of interveners, in particular, were adopted. Thus, Article 134(2) of the Rules of Procedure confers, on the parties to the proceedings before the Board of Appeal other than the applicant, the same procedural rights as on the main parties. That provision thus derogates from the fourth paragraph of Article 40 of the Statute, according to which the claims in the application to intervene must be limited to supporting the form of order sought by one of the main parties. However, interveners pursuant to Article 134 of the Rules of Procedure may not only support the form of order sought by a main party, but also apply for a form of order and put forward pleas in law independent of those of the main parties.

- 18 If the person claiming under a party before the Board of Appeal could participate in the action only by means of intervention pursuant to Article 40 of the Statute and Articles 115 and 116 of the Rules of Procedure, the protection of his rights could be jeopardised by the fact that his position in the proceedings before the Court of First Instance is not on a footing equal to that of the main parties, despite the fact that the former owner of the right may no longer have an interest, following the transfer, in ensuring such protection effectively.
- 19 Where it is a question, as in this case, of the transfer of the rights connected to an application for a Community trade mark, the application of Article 40 of the Statute and Articles 115 and 116 of the Rules of Procedure to the person claiming under the party before the Board of Appeal would also create disparity between the status of that claimant before the Office, where he is regarded as the new owner of the Community trade mark application and, as such, a party in every respect to the opposition proceedings, and his status before the Court of First Instance. Finally, the application of those provisions would create a discrepancy between the situation of the new intellectual property right owner on the substance and his situation in the proceedings before the Community judicature.
- 20 Consequently, it must be accepted that the person claiming under the party before the Board of Appeal may replace that party for the purposes of the proceedings before the Court of First Instance.
- 21 Contrary to the Office's suggestion, it cannot however be accepted that such replacement takes place automatically as soon as the transfer of the right in question has been registered at the Office.
- 22 Admittedly, it has been recognised in the case-law that an action brought by a party can be pursued by that party's universal successor, in particular in the case of an individual's death or the cessation of a legal person's existence whenever all

their rights and obligations are transferred to a new owner (see, to that effect, Case 92/82 *Gutmann v Commission* [1983] ECR 3127, paragraph 2; Case 294/83 *Les Verts v Parliament* [1986] ECR 1339, paragraphs 13 to 18, and Case C-361/01 P *Kik v OHIM* [2003] ECR I-8283, paragraph 19). In such situations, the party claiming under the original party automatically replaces the latter.

23 That solution cannot however be transposed to the case of an individual transfer of an intellectual property right.

24 First, the transfer of an intellectual property right, whether individually or in the context of the transfer of an undertaking, does not, by itself, affect the existence or the capacity to bring proceedings of the former owner of the right. In that situation, and in the absence of provisions expressly so providing, that former owner cannot be deprived of his status as a party to the proceedings before the Court of First Instance, unless he has had an opportunity of taking a position on the point and raised no objection.

25 Secondly, the replacement of one party for another in the course of the proceedings before the Court of First Instance may prejudice the legitimate interests of the other parties to the proceedings. Therefore, such replacement cannot occur without their being heard.

26 Thirdly, actions brought before the Court of First Instance concern not only intellectual property rights at Community level, such as Community trade marks or the rights connected to applications for registration of such marks, but may also concern intellectual property rights recognised on the basis of the law of the Member States. The position of the transferee cannot differ according to whether

the right which has been transferred to him lies at Community level or at national level. The conditions for the validity of the transfer of an intellectual property right guaranteed by the national law of a Member State, and for being able to rely on it as against third parties, are governed by that law. The Court of First Instance cannot always easily ascertain whether those conditions are fulfilled. To allow automatic replacement in such circumstances would create uncertainty as regards the parties to the proceedings before the Court of First Instance, capable of producing untoward effects.

- 27 As a result, replacement may be allowed only by order of the Court. Taking account of the fact that, essentially, it involves a decision to join a new party to the action, the procedural provisions of Articles 115 and 116 of the Rules of Procedure must apply by analogy.
- 28 Thus, the application of the person claiming under the former owner to replace him must be lodged within the time-limit laid down in Article 115(1) of the Rules of Procedure and, *mutatis mutandis*, meet the formal requirements arising under Article 115(2).
- 29 By analogy with Article 116(1) of the Rules of Procedure, the application for replacement must be served on the parties and they must be given an opportunity to submit their written or oral observations thereon. Since the former owner of the right ceases to be a party to the proceedings before the Court in the event of replacement, the latter may not take place if he objects to it. In that case, the person claiming under the party may be given leave to intervene under Article 40 of the Statute. That possibility is also open to him where it appears that the replacement is not appropriate, either because it would prejudice the legitimate interests of the other parties in a manner unjustified by the legitimate interests of the former owner and the person claiming under him, or for other reasons.

30 By analogy with the third subparagraph of Article 116(1) of the Rules of Procedure, the order on the application for replacement is made either by the President of the Chamber to which the case is assigned, or, if the President refers the decision to the Chamber, by that Chamber.

31 The person claiming under a party must accept the proceedings as they are at the time of replacement. In particular, he is bound by the procedural steps already taken by the former owner. If appropriate, leave to lodge a rejoinder may be granted to him in accordance with Article 135(2) of the Rules of Procedure, but replacement alone is not sufficient, by itself, to justify such leave. In any event, the person claiming under the former owner of the right who has been allowed to replace him in accordance with the principles set out above may defend his position at the hearing.

32 In this case, Delta Holding, the former owner of the rights connected to the Community trade mark application, has stated that it has no objection to the replacement, and the Office has stated its agreement thereto. The applicant has raised no objection. In those circumstances, it is appropriate to allow Delta Ice Cream to replace Delta Holding as an intervener under Article 134 of the Rules of Procedure.

Costs

33 Since this application to intervene is a procedural step, the costs are reserved.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby orders:

1. Delta Biomichania Pagatou SA is admitted as intervener under Article 134 of the Rules of Procedure of the Court of First Instance in place of Delta Holding SA, formerly Delta Protypos Biomichania Galaktos SA.
2. The costs are reserved.

Luxembourg, 5 March 2004.

H. Jung

Registrar

J. Pirrung

President