



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

27 June 2012*

(Community trade mark — Opposition proceedings — Application for Community figurative mark my baby — Earlier national and international word marks MYBABY and earlier national figurative mark mybaby — Relative ground for refusal — Failure to produce evidence in the language of the opposition proceedings — Legitimate expectation — Rules 19(3), 20(1) and 98(1) of Regulation (EC) No 2868/95)

In Case T-523/10,

Interkobo sp. z o.o., established in Łódź (Poland), represented by R. Skubisz and K. Ziemski, lawyers,
applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

XXXLutz Marken GmbH, established in Wels (Austria), represented by H. Pannen, lawyer,

ACTION brought against the decision of the Fourth Chamber of OHIM of 8 September 2010 (Case R 88/2009-4) relating to opposition proceedings between Interkobo sp. z o.o. and XXXLutz Marken GmbH,

THE GENERAL COURT (Third Chamber),

composed of O. Czúcz, President, I. Labucka and D. Gratsias (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the General Court on 8 November 2010,

having regard to the response of OHIM lodged at the Registry on 24 March 2011,

having regard to the response of the intervener lodged at the Registry on 17 March 2011,

having regard to the written question from the General Court to the applicant and the latter's response to that question lodged at the Registry on 22 December 2011,

* Language of the case: German.

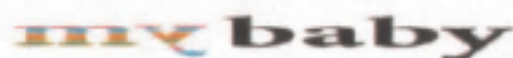
having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur and pursuant to Article 135a of the Rules of Procedure of the Court, to give a ruling without an oral procedure,

gives the following

Judgment

Background to the dispute

- 1 On 10 February 2006, the intervener, XXXLutz Marken GmbH, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).
- 2 That application was drawn up in German, the second language, indicated pursuant to Article 115(3) of Regulation No 40/94 (now Article 119(3) of Regulation No 207/2009), being English.
- 3 The trade mark in respect of which registration was sought is the figurative sign reproduced below:



- 4 The goods in respect of which registration was sought are in Classes 12, 20, 24 and 28 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, and correspond, for each of those classes, to the following description:
 - Class 12: 'Vehicles; apparatus for locomotion by land, air or water';
 - Class 20: 'Furniture, mirrors, picture frames; goods, so far as included in class 20, of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics';
 - Class 24: 'Textiles and textile goods, included in class 24; bed and table covers';
 - Class 28: 'Games and playthings; gymnastic and sporting articles (included in class 28); decorations for Christmas trees'.
- 5 The application for the Community trade mark was published in *Community Trade Marks Bulletin* No 35/2006 of 28 August 2006.
- 6 On 28 November 2006, the applicant, Interkobo sp. z o.o., gave notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) to the registration of the mark applied for in respect of the following goods: 'Games and playthings; gymnastic and sporting articles', which are in Class 28.

- 7 The opposition, drawn up in German, was based on the earlier international word mark MYBABY, on the earlier Polish word mark MYBABY and finally, on the earlier Polish figurative mark depicted below:



- 8 Those marks designated goods in Class 28, corresponding to the following description: ‘Games, playthings and sporting articles’.
- 9 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).
- 10 Since the language chosen for the notice of opposition corresponded to the language of the trade mark application, that language, namely German, became the language of the proceedings before OHIM, in accordance with Article 115(6) of Regulation No 40/94 (now Article 119(6) of Regulation No 207/2009).
- 11 On 19 November 2008, the Opposition Division upheld the opposition in view of the likelihood of confusion, in its opinion, between the mark applied for and the earlier Polish word mark.
- 12 On 13 January 2009, the intervener filed a notice of appeal at OHIM against the decision of the Opposition Division, pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009).
- 13 By decision of 8 September 2010 in Case R 88/2009–4 (‘the contested decision’), the Fourth Board of Appeal of OHIM upheld the appeal, annulled the decision of the Opposition Division and rejected the opposition.
- 14 The Board of Appeal took the view that the applicant had not demonstrated the scope of the protection of the earlier Polish word mark and had failed to prove the existence, the validity or the scope of the protection of the other earlier marks referred to at paragraph 7 above, namely the international word mark and the Polish figurative mark. In those circumstances, the opposition must, in its opinion, be rejected, pursuant to Rule 20(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation (EC) No 40/94 (OJ 1995 L 303, p. 1), as amended.

Forms of order sought by the parties

- 15 The applicant claims that the General Court should:
- annul the contested decision;
 - order OHIM and the intervener to pay the costs incurred during the administrative proceedings before the Opposition Division and before the Board of Appeal;
 - order OHIM and the intervener to pay the costs incurred during these proceedings before the General Court.
- 16 OHIM contends that the General Court should:
- dismiss the action;

— order the applicant to pay the costs.

17 The intervener claims that the General Court should:

- dismiss the action;
- order OHIM to pay the costs.

Law

18 In support of its application, the applicant puts forward two pleas in law, alleging, respectively, infringement of Rule 20(1) of Regulation No 2868/95, read in conjunction with Rule 19(2) and (3) of the same regulation, and breach of the principle of protection of legitimate expectations.

The first plea in law: infringement of Rule 20(1) of Regulation No 2868/95, read in conjunction with Rule 19(2) and (3) of the same regulation

Preliminary observations

19 In the context of its first plea in law, the applicant invokes the provisions of both Regulation No 2868/95 and the OHIM guidelines. Accordingly, it is important to define, at the outset, their scope.

– As regards proof of the existence, the validity and the scope of the protection of an earlier mark or of an earlier right at the stage of the opposition proceedings

20 Under Rule 20(1) of Regulation No 2868/95, which forms part of Title II entitled ‘Procedure for opposition and proof of use’:

‘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 his entitlement to file the opposition, the opposition shall be rejected as unfounded.’

21 Under Rule 19 of the same regulation:

‘1. [OHIM] 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...’

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... 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:
 - (i) if the trade mark is not yet registered, a copy of the relevant filing certificate or an equivalent document emanating from the administration with which the trade mark application was filed; or
 - (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. [OHIM] 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 [OHIM].'
- 22 Under Rule 98(1) of that regulation, which forms part of Title XI entitled 'General provisions':
- 'When a translation of a document is to be filed, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. [OHIM] may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text...'
- 23 It follows from those provisions that when the information and evidence referred to in Rule 19(1) and (2) of Regulation No 2868/95 are in a language other than that of the proceedings, the opposing party must file, at the stage of the opposition, within the period prescribed for the production of that information and evidence, a translation of those documents, which must meet specific requirements regarding both its form and content.
 - 24 Firstly, Rule 19(3) of Regulation No 2868/95 stipulates that the information and evidence not in the language of the proceedings must be 'accompanied' by a translation. As regards Rule 98(1) of that regulation, it provides that the translation must 'identify' the document to which it refers and reproduce, inter alia, the 'structure' of that document. Combined, those two rules state, in particular, that the translation of any of the information or evidence referred to in Rule 19(1) and (2) of Regulation No 2868/95 must be submitted not in the form of mere annotations in the original document but of one or several separate written documents. In the event that that formal requirement is not met, the above-mentioned information and evidence submitted by the opposing party cannot be taken into account in the opposition proceedings.
 - 25 The purpose of that formal requirement is, firstly, to enable the other party to the opposition proceedings, as well as the OHIM bodies, to easily differentiate the original document from its translation, and secondly, to ensure that the latter is sufficiently clear. In other words, the objective is, in particular, to enable the debate between the parties to the opposition proceedings to take place on a sound basis, in accordance with the principle of *audi alteram partem* and to ensure equality of arms (see, to that effect, Case T-232/00 *Chef Revival USA v OHMI - Massagué Marín (Chef)* [2002] ECR II-2749, paragraph 42, and Case T-107/02 *GE Betz v OHMI - Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 72).
 - 26 Secondly, it is apparent from Rule 98(1) of Regulation No 2868/95, interpreted in the light of the considerations set out in the previous paragraph of the present judgment, that the translation, presented as set out above, in the form of a separate written document, must faithfully reproduce the contents of the original document. In case of doubt as to the faithfulness of the translation, the OHIM bodies are entitled to require from the interested party the production of a certificate attesting that the translation corresponds to the original text.
- As regards proof of the existence, the validity and the scope of the protection of an earlier mark or of an earlier right before the Board of Appeal
- 27 Rule 50(1) of Regulation No 2868/95, which forms part of Title X entitled 'Appeals', provides that, '[u]nless 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. It follows, in particular, from that provision that the rules set out in the above paragraphs, and especially that referred to at paragraph 24 above, apply *mutatis mutandis* before the Board of Appeal.

– As regards the OHIM guidelines

- 28 In order to indicate its practice ‘with regard to the Regulation on the Community trade mark’, OHIM adopted guidelines intended both for its own personnel and for professionals with an interest in its work, which deal with opposition proceedings in particular.
- 29 Such guidelines are merely a set of consolidated rules setting out the line of conduct which OHIM proposes to adopt (see Case T-410/07 *Jurado Hermanos v OHMI (JURADO)* [2009] ECR II-1345, paragraph 20, and the judgment of 7 July 2010 in Case T-124/09 *Valigeria Roncato v OHMI — Roncato (CARLO RONCATO)*, not published in the ECR, paragraph 27). Thus, their provisions cannot, as such, either be deemed to be of a higher order than the provisions of Regulations No 207/2009 and 2868/95 or indeed influence the interpretation of those regulations by the Courts of the European Union. On the contrary, they are designed to be read in accordance with the provisions of Regulation No 207/2009 and Regulation No 2868/95.
- 30 The applicant’s arguments dealing with the evidence of the existence, the validity and the scope of the protection, first, of the earlier Polish marks and, secondly, of the earlier international mark, referred to at paragraph 7 above, should be examined in the light of these preliminary observations.

As regards the earlier Polish word mark

- 31 It is apparent from the file relating to the proceedings before OHIM, lodged with the General Court in accordance with Article 133(3) of the Rules of Procedure of the General Court, that, in order to prove the existence, the validity and the scope of the protection of the earlier Polish mark, the applicant submitted two documents to the OHIM bodies, one of which was accompanied by a translation in a separate written document.
- 32 The first of the documents was presented by the applicant as the copy of an extract from the databases of the *Urząd Patentowy Rzeczypospolitej Polskiej* (Polish Patent Office). It is a one-page document which includes, as a header, the coat of arms of the Republic of Poland and, immediately to the right of that coat of arms, the words ‘Polish Patent Office’. Under that header, the following title may be read: ‘Industrial property information retrieval’, which is located above a table. That table sets out various information relating to the mark concerned. Firstly, two columns entitled ‘Kind of right, number and date’ and ‘Kind of right and number’, respectively, contain figures. Then, in a column entitled ‘Kind of trade mark’, the word ‘slowny’ (verbal) is stated in Polish and is translated into German, in bold text, by the word ‘wörtlich’. That is followed by two columns entitled, respectively, ‘Persons’ and ‘Publications’. Finally, a column entitled ‘Nice classes’ contains the following Polish words: ‘(510) gry, zabawki, artykuły sportowe’ (games, playthings, sporting articles), translated into German, in bold text, by the words ‘Spielen, Spielzeugen, Sportartikeln’.
- 33 The second document submitted by the applicant is the copy of a certificate of registration. That three-page document, drawn up in Polish, is accompanied by a German translation. On the first page, the Republic of Poland’s coat of arms are set out as a header and under which the terms ‘*Urząd Patentowy Rzeczypospolitej Polskiej*’ and ‘*Świadectwa ochronne*’ (protection certificates) may be read. In the body of the document, it is certified that the mark in question, held by the applicant, has been protected since 15 February 2002. On the second page, the wording of the word mark concerned, namely ‘MYBABY’, is specified. Finally, on the third page, various supplementary information is given, namely the date of submission (*Data zgłoszenia*), the number of the application (*Numer zgłoszenia*), the priority (*Pierwszeństwo*), the date of publication of the decision concerning the grant of the right of protection

(Data wydania decyzji o udzieleniu prawa ochronnego), the number of the protection (numer prawa ochronnego), the reference to the Official Gazette in which the mark was published and the applicant's name. The last line of the third page includes the words 'gry, zabawki, artykuły sportowe' (games, playthings, sporting articles), preceded by partially illegible entries. All the entries on that page had been translated into German, in a separate document, with the exception of the last line.

- 34 It is apparent from paragraphs 12 and 15 of the contested decision that the Board of Appeal took the view that neither of the two documents produced showed the scope of the protection of the earlier mark.
- 35 Firstly, '[the] extract from the databases with the statement of goods in German "games, playthings, sporting articles"... [does not constitute] either a document of the [Urząd Patentowy Rzeczypospolitej Polskiej] comparable [to a] certificate of registration or the German translation of such a document. In fact, the Board [does not] have knowledge of any case in which extracts, in English, from the databases of the [Urząd Patentowy Rzeczypospolitej Polskiej] are] partially in German. Furthermore, while the German words are [according to the Board of Appeal] comprehensible, they include grammatical errors. There are therefore doubts as to whether it is an original document issued by the [Urząd Patentowy Rzeczypospolitej Polskiej] or whether the German insertions were made by a third party. The [applicant] itself, in the attached letter, simply informed [OHIM] of the fact that the goods on which the opposition was based, namely 'Spielen, Spielzeugen, Sportartikeln', follow from the attached extract. According to the Board, that correlation in the spelling mistakes in the statement of the goods also [suggests] an insertion a posteriori of the statements in German in the extract from the databases. Those insertions [cannot] be regarded as the translation of the extract from the databases [carried out] in accordance with Rule 19(3) of [Regulation No 2868/95], ... the necessary separation between the original document and the translation [is] lacking'.
- 36 Secondly, according to the Board of Appeal, the certificate of registration contains 'the list of the goods and services registered, but obviously that list [has not been] translated into the language of the proceedings'. 'The German translation...attached [does not refer] to any goods or services. It therefore [lacks] the statement of goods and services on which the opposition is based, [when] that statement [is] necessary in order to justify the opposition' (paragraph 3 of the contested decision).
- 37 By the present action, the applicant disputes the Board of Appeal's conclusion. It alleges that the Board of Appeal infringes the combined provisions of Rule 20(1) and Rule 19(2) and (3) of Regulation No 2868/95.
- 38 In order to assess whether this plea is well-founded, it is necessary, firstly, to note and interpret the legal and factual considerations on which the Board of Appeal based its finding.
- 39 As regards the document described at paragraph 32 above, presented by the applicant as a copy of the extract from the databases of the *Urząd Patentowy Rzeczypospolitej Polskiej*, it is apparent from the contested decision, and in particular from paragraph 14 thereof, as reproduced in paragraph 35 above, that, according to the Board of Appeal, that document contains entries in German, but that was not the practice of the *Urząd Patentowy Rzeczypospolitej Polskiej*. The Board of Appeal pointed out that those entries contained grammatical errors, the German words 'Spiele', 'Spielzeuge' and 'Sportartikel' ended, wrongly, in the letter 'n'. On the basis of those findings, it concluded as follows: either those entries were an integral part of the original document, in which case it could not be regarded as authentic, or they are a translation inserted a posteriori into the original document, in which case that translation did not meet the requirements imposed by Rule 19(3) of Regulation No 2868/95. That is why the Board of Appeal took the view that, in any event, the document in question should not be taken into account.
- 40 As regards the copy of the certificate of registration, described at paragraph 33 above, it is apparent from paragraph 13 of the contested decision, as reproduced in paragraph 36 above, that the Board of Appeal took the view that that copy of the certificate did not establish the scope of the protection of the earlier mark relied on. Its translation did not include, according to the Board of Appeal, a statement regarding the goods and services covered by that mark.

- 41 Ultimately, the Board of Appeal held that none of the evidence submitted to it established the scope of the protection of the earlier mark.
- 42 Contrary to the applicant's claim, that latter conclusion is not vitiated by any infringement of Rule 20(1) of Regulation No 2868/95, read in conjunction with Rule 19(2) and (3) of the same regulation.
- 43 It is apparent from OHIM's file that the document presented by the applicant as an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej and described at paragraph 32 above contains only two entries in the language of the proceedings before OHIM, namely German. They are, firstly, the word 'wörtlich' and, secondly, the words 'Spielen, Spielzeugen, Sportartikeln' (sic). The applicant itself admits at paragraphs 30 to 32 of the application that those entries had been 'inserted' and are not an integral part of the original document, but are a translation of it. However, such a translation was not presented in a separate written document. Therefore, it does not, in any event, meet the procedural requirements set out at paragraph 24 above. Accordingly, the Board of Appeal, which had circumscribed powers in that regard, was required to refuse to take that document into account.
- 44 Moreover, it is not disputed that, unlike the document referred to in the previous paragraph, the copy of the certificate of registration described in paragraph 33 above and drawn up in Polish had been translated into the language of the proceedings before OHIM in a separate written document. However, it is apparent from the file relating to the proceedings before OHIM that that translation does not specify the goods or the services covered by the earlier Polish word mark. The effect of Rule 19(4) of Regulation No 2868/95, read in conjunction with Rule 50 of the same regulation, is that when a document drawn up in a language other than the language of the proceedings is produced before OHIM, the parts of that document which have not been translated into the language of the proceedings cannot be taken into account (see, to that effect, the judgments in *BIOMATE*, paragraph 74, and in Case T-407/05 *SAEME v OHMI - Racke (REVIAN's)* [2007] ECR II-4385, paragraph 40). Thus, in the light of the translation submitted to it, the Board of Appeal was justified in forming the view that the above-mentioned copy of the certificate of registration did not establish the scope of the protection of the mark relied upon by the applicant.
- 45 It follows from the two previous paragraphs that the Board of Appeal was required to hold that one of the documents that had been presented to it could not be taken into account and that the other did not enable the Board of Appeal to assess the scope of the protection afforded by the earlier mark. In those circumstances, the Board of Appeal correctly found that the applicant had not established the scope of that protection.
- 46 Furthermore, that conclusion cannot be affected by any of the arguments put forward by the applicant.
- 47 Firstly, the applicant claims that, under Rule 19(2) and (3)(a)(ii) of Regulation No 2868/95, an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej can constitute evidence of the existence, the validity and the scope of the protection of the earlier rights. It adds that the translation into the language of the proceedings of the databases of the Urząd Patentowy Rzeczypospolitej Polskiej was complete. It takes the view that it was not required to translate all the elements of the original document necessary for the determination of the existence, the validity and the scope of the protection of its earlier mark into the language of the proceedings and, in particular, was not required to translate the headers of the extract of the databases of the Urząd Patentowy Rzeczypospolitej Polskiej 'bearing INID codes'.
- 48 However, such arguments spring from a misinterpretation of the contested decision.
- 49 At no stage of its reasoning did the Board of Appeal dispute that an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej was, in itself, capable of establishing the existence, the validity and the scope of the protection of a Polish mark.

- 50 Moreover, although ultimately, the Board of Appeal, decided not to take into account the document presented by the applicant as an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej and described at paragraph 32 above, it is not, as the applicant claims, due to the alleged incompleteness of its translation into the language of the proceedings, but, inter alia, on the ground that it had not been translated in a separate written document.
- 51 Secondly, the applicant argues that the authenticity of the extract from the databases that it submitted to the Board of Appeal cannot be questioned, just because that information in German had been included therein. On the contrary, it is possible to translate a document by just adding annotations in the language of the proceedings. In any event, according to the applicant, the method of translation applied in a particular case does not constitute a 'lack of separation between the document and the translation'. The information in German was inserted beside the information in the original language and not instead of that information. Moreover, the information in German is distinct from the other information on account of the typeface used. Finally, it is not usual for English extracts from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej to be partially written in German. Therefore, the German translation could easily be distinguished from the text of the original document.
- 52 That argument is unfounded.
- 53 While it is true that the Board of Appeal pointed out that there was a doubt as to whether the document presented by the applicant as an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej and described at paragraph 32 above was authentic. However, as noted at paragraph 39 above, the Board of Appeal did not refuse to take that document into account on that ground alone. It also noted that that document had not been translated in a separate written document. As is apparent from paragraph 43 above, such a ground is enough, in itself, to justify the decision not to take that document into account.
- 54 Thirdly, the applicant submits that it fulfilled its obligation to establish the existence, the validity and the scope of the protection of the earlier mark 'by the mere fact that it provided, within the time limit, an extract from the databases of the [Urząd Patentowy Rzeczypospolitej Polskiej] with the indication on this document that there is a German translation'.
- 55 This argument is unfounded. It is apparent from paragraph 43 above that, in order to establish the existence, the validity and the scope of the protection afforded to the earlier Polish word mark, it was not enough to produce the document described in paragraph 32 above by the time limit laid down by Rule 19(1) of Regulation No 2868/95.
- 56 Fourthly, the applicant claims that the provisions of Regulation No 2868/95 cannot be interpreted as meaning that the conditions relating to the existence, the validity and the scope of the protection of the earlier rights must be demonstrated by the production of a single document. In addition, the applicant states that the Board of Appeal should have 'taken into account all of' the information contained in the two documents that it had submitted, namely the extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej and the copy of the certificate of registration. Those documents are complementary. The applicant claims that the copy of the certificate of registration establishes the existence and the validity of the mark, while the scope of the protection is established by the extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej.
- 57 That argument is based on a misinterpretation of the contested decision. It is apparent from that decision that the Board of Appeal never claimed that the existence, the validity and the scope of the protection of an earlier right must be 'established by the production of a single document'. As stated in paragraphs 39 and 40 above, it merely stated that the first of the two documents produced by the applicant could not be taken into account and that the translation of the other document did not contain any information as to the scope of the protection of the earlier mark relied on by the applicant, so that such information had to be regarded as missing. In doing so, it did not infringe Rule 20(1) of Regulation No 2868/95, read in conjunction with Rule 19(2) and (3) of that regulation, as stated in paragraphs 42 and 45 above.

As regards the earlier Polish figurative mark

- 58 It is apparent from the file relating to the proceedings before OHIM that, in order to prove the existence, the validity and the scope of the protection of the rights attached to the application for registration of the earlier Polish figurative mark, the applicant produced a single document before the OHIM bodies. It is a document presented as a copy of an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej. This one-page document includes, as a header, the coat of arms of the Republic of Poland and, immediately to the right of that coat of arms, the words ‘Polish Patent Office’. Under that header, the following title may be read: ‘Industrial property information retrieval’, which is located above a table. That table sets out various information relating to the mark concerned. Firstly, two columns entitled ‘Kind of right, number and date’ and ‘Kind of right and number’, respectively, contain figures. Then, in a column entitled ‘Kind of trade mark’, the term ‘slowno-graficzny’ (figurative) is stated and is translated into German, in bold text, by the word ‘wörtlich-grafisch’. That is followed by three columns entitled, respectively, ‘Persons’ and ‘Classifications’ and ‘Publications’. Finally, a column entitled ‘Nice classes’ contains the following Polish words: ‘(510) gry, zabawki, artykuły sportowe’ (games, playthings, sporting articles), translated in German, in bold text, as ‘Spielen, Spielzeugen, Sportartikeln’.
- 59 The Board of Appeal took the view that that document was not enough to establish the existence, the validity and the scope of the protection of the earlier mark. According to the Board of Appeal, what ‘has been stated ... [regarding the earlier Polish word mark] applies by analogy to that extract from the databases. It is neither an original document nor a translation of such a document ...’ (paragraph 17 of the contested decision).
- 60 The applicant claims that that finding is unfounded. It states that it submitted, within the period prescribed by OHIM, an extract in English from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej, accompanied by a German translation integrated into that document and refers, furthermore, to its observations on the earlier Polish word mark.
- 61 However, such claims cannot be accepted.
- 62 It is apparent from the file relating to the proceedings before OHIM that the document presented by the applicant as an extract from the databases of the Urząd Patentowy Rzeczypospolitej Polskiej and described at paragraph 58 above includes only two entries in the language of the proceedings before OHIM. They are, firstly, the term ‘wörtlich-grafisch’ and, secondly, the words ‘Spielen, Spielzeugen, Sportartikeln’. However, it follows implicitly but necessarily from paragraph 38 of the application, read in conjunction with paragraphs 30 to 32 of the application, that the applicant admitted that those entries had been inserted in the document and thus constituted a translation of that document. However, such a translation was not submitted in a separate written document. Therefore, it does not, in any event, meet the procedural requirements set out at paragraph 24 above. Consequently, the Board of Appeal, which was exercising circumscribed powers, was required to refuse to take that document into account. It could not therefore deduce that either the existence or the validity or the scope of the protection of the rights attached to the Polish figurative mark were proven.
- 63 It must be noted that such a finding cannot be affected by any of the arguments put forward by the applicant regarding the earlier Polish word mark (see paragraphs 47 to 55 above).

As regards the earlier international mark

- 64 It is apparent from the file relating to the proceedings before OHIM that, in order to establish the existence, the validity and the scope of the protection of the earlier international mark, the applicant submitted a single document before the OHIM bodies. It is a document described by the applicant as a copy of an extract from the databases of the World Intellectual Property Organization (WIPO). That

document is presented as a list of printed entries on a sheet of paper without a header. This includes, inter alia, after the number 541, the entry 'Reproduction of the mark where the mark is represented in standard characters' and, after the number 511, the following entries: 'Games and playthings, sporting articles. Jeux et jouets, articles de sport. Spielen und Spielzeugen, Sportartikeln'.

- 65 The Board of Appeal took the view, at paragraph 19 of the contested decision, that that document cannot be regarded as emanating from WIPO. That document included annotations in German, which is not in line with WIPO practice.
- 66 Furthermore, the Board of Appeal stated, at paragraph 20 of that decision, that 'the insertion of German words [did not] fulfil the translation requirement, because the necessary separation between the original document and the translation [was] lacking'.
- 67 In those circumstances, it concluded that the document which was submitted to it could not be taken into account since it did not constitute evidence in accordance with Rule 19(2)(a) of Regulation No 2868/95 and did not meet the requirements laid down in terms of translation by Rule 19(3) of the same regulation.
- 68 The Board of Appeal's finding must be upheld.
- 69 It is apparent from the file relating to the proceedings before OHIM that the document described at paragraph 64 above, presented by the applicant as a copy of an extract from the WIPO databases, contains only one entry in the language of the proceedings before OHIM: 'Spielen und Spielzeugen, Sportartikeln'. It is apparent from paragraphs 42 to 44 of the application that the applicant admits that that document had been 'supplemented' by 'information in German', which constitutes a 'translation' of that document. However, such a translation was not submitted in a separate written document. Therefore, it does not meet, in any event, the procedural requirements referred to at paragraph 24 above.
- 70 Accordingly, the Board of Appeal, which was exercising circumscribed powers, was required to refuse to take into account that document. In that context, it could only therefore conclude that neither the existence nor the validity nor the scope of the protection of the earlier international mark were proven.
- 71 It must be pointed out that such a finding is not undermined by any of the four arguments put forward by the applicant.
- 72 By its first argument, the applicant states that it had provided, within the period prescribed by OHIM, an extract from the official database of WIPO and, more particularly, the database known as the 'Madrid express database', accompanied by a German translation integrated into that document. According to the applicant, that document, in the light of its form, should have been identified as originating from WIPO. The extracts from the Madrid express database are drawn up in accordance with a single formula, familiar to the Board of Appeal, with which the extract from the database complied.
- 73 By its second argument, the applicant claims that it was not possible to dispute the authenticity of the document that it had produced just because it contained information in German. According to the applicant, it is apparent from Rule 19(3) of Regulation No 2868/95 that it is possible to translate a document by merely inserting annotations therein.
- 74 By its third argument, the applicant claims that Regulation No 2868/95 does not define the form that that extract must take. It submits that a particular form cannot therefore be a requirement.
- 75 However, those three arguments are unfounded.

- 76 It is true that the Board of Appeal took the view that the document described at paragraph 64 above was not authentic. However, as was pointed out at paragraph 66 above, it did not refuse to take that document into account on that ground alone. It also noted that that document had not been translated in a separate written document. Yet, as is apparent from paragraph 70 above, such a ground, which none of the three abovementioned arguments call into question, was enough, in itself, to justify the decision not to take that document into account.
- 77 By its fourth argument, the applicant claims that, under the OHIM guidelines (page 32 of Part C.1 of the guidelines, in English), an extract from that database can constitute proof of the existence, the validity and the scope of the protection of the earlier rights.
- 78 It is important, however, to note that such an argument is based on a misinterpretation of the contested decision.
- 79 At no stage of its reasoning did the Board of Appeal dispute that an authentic extract from the databases of WIPO was, in itself, capable of establishing the existence, the validity and the scope of the protection of the international mark.
- 80 It follows that the first plea must be rejected.
- 81 Moreover, that finding cannot be undermined by the invocation, in support of that plea, of the OHIM guidelines, which are intended to be read in accordance with the provisions of Regulations No 207/2009 and 2868/95, as was pointed out in paragraph 29 above.

The second plea in law: infringement of the principle of protection of legitimate expectations

- 82 The applicant claims that the contested decision infringes the principle of protection of legitimate expectations. It submits that, until the adoption of that decision, it could have legitimately presumed, in the light of the indications given by OHIM, in particular, in its guidelines, that the documents that it had produced before OHIM were sufficient to establish the existence, the validity and the scope of the protection of its earlier marks.
- 83 Before examining the four arguments submitted in support of that plea, it must be noted that, under settled case-law, the right to rely on the principle of the protection of legitimate expectations extends to any individual in a situation where the Community authorities, in particular by giving him precise assurances, have caused him to entertain expectations which are justified (see judgments in Joined Cases C-182/03 and C-217/03 *Belgium and Forum 187 v Commission* [2006] ECR I-5479, paragraph 147, the judgment of 25 October 2007 in Case C-167/06 P *Komninou and Others v Commission*, not published in the ECR, paragraph 63, *BIOMATE*, paragraph 80, and the case-law cited). In that respect, firstly, whatever their form, precise, unconditional and consistent information constitute such assurances (*Komninou and others v Commission*, paragraph 63, and Case C-537/08 P *Kahla Thüringen Porzellan v Commission* [2010] ECR I-12917, paragraph 63) and, secondly, assurances which do not take account of the applicable provisions of European Union law cannot give rise to justified expectations (see, to that effect, Case 162/84, *Vlachou v Court of Auditors* [1986] ECR 481, paragraph 6; Case T-205/01 *Ronsse v Commission* [2002] ECR-SC I-A-211 and II-1065, paragraph 54; Case T-329/03 *Ricci v Commission* [2005] ECR-SC I-A-69 and II-315, paragraph 79, and Case T-304/06 *Reber v OHIM - Chocoladefabriken Lindt & Sprüngli (Mozart)* [2008] ECR II-1927, paragraph 64).

The first argument

- 84 By its first argument, the applicant claims that, in accordance with the provisions of Regulation No 2868/95, all of the evidence that it submitted to OHIM must be taken into consideration.

- 85 First, that regulation enables the applicant to prove, in particular, the registration or the renewal of the earlier marks with the assistance of the extracts of the databases of the Urząd Patentowy Rzeczypospolitej Polskiej or of WIPO. Secondly, in the context of opposition proceedings, the opposing party could ‘submit additional documents concerning the existence, the validity and the scope [of the protection] of the earlier rights in support of its opposition (subject to the time limit prescribed)’. Thirdly, the translation into the language of the proceedings of the documents submitted to the OHIM bodies does not have to adopt a strictly defined form. Fourthly, in the context of opposition proceedings, the opposing party could submit ‘complementary translations concerning the same earlier right (subject to the time limit prescribed)’. Fifthly, it is not necessary to ‘explain in the language of the proceedings all the elements of the documents concerning the earlier marks’.
- 86 However, that argument must be rejected. It is irrelevant for the purpose of demonstrating that the contested decision infringes the principle of protection of legitimate expectations and only constitutes, in essence, a reformulation of the first plea in the application.
- 87 It is apparent from paragraphs 45, 62 and 70 above that, in accordance with the provisions of Regulation No 2868/95, the Board of Appeal was required to declare that three of the documents presented to it could not be taken into account and that a fourth document did not enable the Board of Appeal to assess the scope of the protection conferred by one of the marks relied on by the applicant.

The second argument

- 88 In the context of its second argument, the applicant refers, by means of hypertext links, to two separate documents. The first corresponds to the ‘final version’ of the OHIM guidelines in English dated ‘November 2007’. The second document referred to by the applicant is the consolidated version, in English, of the OHIM guidelines, referred to as the ‘Manual of Trade Mark Practice’. That document includes not only the text of the OHIM guidelines corresponding to the ‘final version’ of ‘November 2007’, but also the subsequent amendments of the OHIM guidelines.
- 89 The applicant claims that, if it had followed its own guidelines, OHIM should have taken into account the evidence that it had produced at the stage of the opposition proceedings.
- 90 Firstly, those guidelines state, according to the applicant, that extracts from the official databanks of a ‘national office’ can be used as evidence of earlier rights relied on in support of an opposition (pages 32 and 35 of Part C.1 of the guidelines; pages 37 and 38 of the ‘Manual of Trade Mark Practice’ referred to at paragraph 88 above).
- 91 Secondly, it claims that they authorise any party to proceedings before OHIM to produce other documents relating to the earlier rights, supplementing the documents already produced. (page 38 of the ‘Manual of Trade Mark Practice’ referred to at paragraph 88 above). This means that the conditions relating to the existence, the validity and the scope of the protection of the earlier rights need not necessarily be demonstrated by the production of a single document.
- 92 Thirdly, it claims that they do not require a translation into the language of the opposition proceedings of every element of the documents constituting evidence of the earlier rights (of the earlier marks). In particular, they do not require the presentation of a translation or an ‘explanation’ of the ‘INID codes’ and the ‘national codes’ (page 34 of Part C.1 of the guidelines; page 41 of the ‘Manual of Trade Mark Practice’ referred to at paragraph 88 above).
- 93 Fourthly, it claims that they state that it is not necessary to provide a version in the language of the proceedings of the data relating to the earlier rights in a stand-alone document (that is to say a document separate from the translation itself) (page 37 of Part C.1 of the guidelines; page 44 of the ‘Manual of Trade Mark Practice’ referred to at paragraph 88 above).

94 However, this argument is bound to fail.

95 It is true that, notwithstanding the fact that they cannot, as such, take precedence over the provisions of Regulations No 207/2009 and 2868/95 (see paragraph 29 above), the OHIM guidelines may in fact be effectively relied on before the Courts of the European Union in support of a plea alleging the infringement of a general principle of law such as the principle of protection of legitimate expectations, provided, especially, that they provide precise, unconditional and consistent information to a person and that they take into account the provisions of Regulations No 207/2009 and 2868/95.

96 However, the ‘final version’ of the OHIM guidelines referred to at paragraph 88 above, is the result of Decision No EX-07-6 of the President of OHIM of 29 November 2007 adopting the guidelines relating to proceedings before OHIM, which was published in the online ‘OHIM Official Journal’ of December 2007. It is apparent from the file relating to the proceedings before OHIM, and in particular from the applicant’s letter of 20 July 2007, that the documents by which the applicant intends to prove the existence, the validity and the scope of protection conferred by its earlier rights had been produced before the Opposition Division prior to 29 November 2007. Moreover, the applicant does not explain how, prior to 29 November 2007, the provisions of the ‘final version’ of the OHIM guidelines, to which it refers, would have been applicable. In those circumstances, those provisions cannot be regarded as having given rise in the applicant to any expectations whatsoever as regards the admissibility of the above-mentioned documents.

97 In any event, it is necessary, firstly, to point out that the applicant’s argument is based, in part, on an erroneous interpretation of the contested decision. Indeed, contrary to the applicant’s claim (see paragraph 90 above), the Board of Appeal never claimed that the extracts from the databases of a national authority could not be submitted in support of an opposition. Similarly, contrary to what the applicant implies (see paragraph 91 above), at no stage in its reasoning did the Board of Appeal state that the proof of the existence, the validity and the scope of the protection of a right or a mark must be adduced by the production of a single document.

98 Secondly, it is apparent from page 31 of the English version of Part C.1 of the OHIM guidelines, as relied on by the applicant, that Part C.II of that part, entitled ‘Proof of existence and validity of earlier rights’ provides:

‘The evidence [of the existence, the validity and the scope of the protection of the earlier marks relied on by the opposing party] must be in the language of the proceedings or accompanied by a translation.’

99 It is apparent from pages 36 and 37 of the English version of Part C.1 of the OHIM, as relied on by the applicant, that paragraph C.II.2 of that part, entitled ‘Translations of evidence of trade mark registrations’, provides:

‘...[T]he evidence submitted by the opponent ... as well as any other previously submitted document or certificate, must be either in the language of the proceedings, or be accompanied by a translation...

Rule 98 (1) CTMIR requires that the translation reproduce the structure and contents of the original document. In principle, the whole document must be translated, in the correct order.

In particular, it is not acceptable that the translation is limited to parts that the opponent considers “essential”, nor that it is limited to those parts which the applicant is “not expected to understand”...

The translation has to be on a stand-alone basis and cannot be taken piecemeal from other documents...

However, the Office accepts that no translation of the information headers in the certificates (such as, ‘filing date’ ‘colour claim’, etc) is needed, provided that they are also identified using standard INID codes or national codes.

The opponent is not obliged to submit a translation of the explanation of the INID or of the national codes in the language of proceedings.

Irrelevant administrative indications, or parts with no bearing on the case, may be omitted from the translation...

[OHIM] accepts simple translations, drawn up by anybody. ... [OHIM] even accepts hand-written inscriptions on the copies of the original certificates giving the meaning of the various entries in the language of the proceedings, provided of course that they are complete and legible...'

100 By claiming, as noted in paragraph 92 above, that the OHIM guidelines do not require a translation into the language of the opposition proceedings of every element of the documents constituting evidence of the earlier rights (of the earlier marks), the applicant misreads the provisions referred to in the previous paragraphs. Indeed, those provisions require, in principle, the opposing party to translate all the evidence submitted in a language other than the language of the proceedings and only provides for a derogation so far as concerns 'irrelevant administrative indications', 'parts with no bearing on the case' and 'the explanation of the INID or of the national codes'. Furthermore, the argument alleging that those guidelines do not require a translation or an 'explanation' of the 'INID codes' and the 'national codes' is irrelevant to the present dispute, since such a requirement was not stated by the Board of Appeal.

101 Thirdly, as was pointed out in paragraph 99 above, paragraph C.II.2 of Part C.1 of the OHIM guidelines, in the version relied on by the applicant, provides, ultimately, that OHIM 'accepts simple translations, drawn up by anybody' and 'even ... hand-written inscriptions on the copies of the original certificates giving the meaning of the various entries in the language of the proceedings, provided of course that they are complete and legible'.

102 As is apparent from paragraph 93 above, those provisions state, according to the applicant, that OHIM will take into account translations which are not in the form of a 'stand-alone' document, that is, separate from the original document. Thus, by refusing to take into account three of the documents that it had produced at the stage of the opposition proceedings on the ground that they were not accompanied by a translation submitted in a written document separate from the original, the Board of Appeal disregarded the OHIM guidelines and, thus, according to the applicant, infringed the principle of the protection of legitimate expectations.

103 However, it should be noted that, even if they had been applicable prior to 29 November 2007, the date of the adoption of the decision of the President of OHIM referred to at paragraph 96 above, the statements in point C.II.2 of Part C.1 of the OHIM guidelines, cited at paragraph 101 above, are not capable of giving rise to legitimate expectations within the meaning of the case-law cited at paragraph 83 above.

104 It is true that, taken in isolation, they could lend themselves to the interpretation suggested by the applicant (see paragraph 102 above). However, they are also liable to be given another interpretation, consistent with the letter and the objectives of Regulation No 2868/95. According to that interpretation, when an original document drawn up in a language other than the language of the proceedings is submitted, OHIM accepts that it can be annotated in order to facilitate the reading and the review of its translation, which is presented in a separate document. Such an interpretation is furthermore the only interpretation compatible with the other indications provided by the OHIM guidelines. They suggest that the translation of evidence must be set out in a separate written document. Thus, as noted in paragraphs 98 and 99 above, it is stated, at paragraphs C.II and C.II.2 of Part C.1 of the guidelines, that the information and evidence referred to in Rule 19(1) and (2) of Regulation No 2868/95 must be submitted in the language of the proceedings or be 'accompanied' by a translation. In addition, it is required, at paragraph C.II.2, which further incorporates the actual terms of Rule 98(1) of Regulation No 2868/95, that 'the translation reproduces the structure and contents of the original document'. Finally, it is added, in that same paragraph, that '[t]he translation has to be on a stand-alone basis and cannot be taken piecemeal from other documents'.

105 Moreover, the indications provided by paragraph C.II.2 of Part C.1 of the OHIM guidelines, as interpreted by the applicant, are not consistent with the information supplied, in the present case, by OHIM to the applicant. It is apparent from the file relating to the proceedings before OHIM that, by letter of 19 March 2007, sent to the applicant in the context of the opposition proceeding, OHIM stated, without ambiguity, that any translation of a document not drawn up in the language of the proceedings must be submitted 'in the form of a separate written document' and must reproduce the structure and content of the original document. It is also apparent from the file relating to the proceedings before OHIM that, in a fax dated 20 July 2007, the applicant referred to a 'request' of OHIM of 19 March 2007. Since it is not apparent from the file relating to the proceedings before OHIM that a letter other than that previously referred to had been sent to the applicant by OHIM on 19 March 2007, such a reference shows that the applicant actually received that letter. In that context, as a prudent and circumspect trader, the applicant should have envisaged that it was possible that its interpretation of the OHIM guidelines was incorrect and that a measure contrary to its interests would be taken by the OHIM bodies.

106 Accordingly, the applicant cannot validly claim that the Board of Appeal infringed the principle of the protection of legitimate expectations by refusing to take into account the extracts from the databases that it had submitted on the ground that their translation was not submitted in a separate written document.

The third argument

107 By a third argument, the applicant claims that it could legitimately consider, in the light of the Opposition Division's decision, that it had duly demonstrated the existence, the validity and the scope of the protection of the earlier Polish word mark. It thus argues, implicitly but necessarily, that the Opposition Division's decision gave rise, in the applicant, to legitimate expectations within the meaning of the case-law cited at paragraph 83 above.

108 However, such an argument must fail.

109 It follows from Article 63(1) of Regulation No 207/2009 that, following the examination as to the merits of the appeal, the Board of Appeal is to decide on it and that, in doing so, it may 'exercise any power within the competence of the department which was responsible for the contested decision', that is to say, in the present case, give a decision itself on the opposition by either rejecting it or declaring it to be founded, thereby either upholding or reversing the contested decision. In other words, through the effect of the appeal brought before it, the Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (Case C-29/05 P *OHIM v Kaul* [2007] ECR I-2213, paragraph 56 and 57).

110 It follows that a decision of the Opposition Division, such as that referred to at paragraph 11 above, cannot be likened to conduct of the EU administration that is liable to give rise to legitimate expectations in the opposing party.

The fourth argument

111 By its fourth argument, the applicant submits that the Board of Appeal had not established, prior to the adoption of the contested decision, the inadequate nature of the evidence submitted by the applicant. It claims that, in that context, it could not, in the absence of doubt as to the regularity of the Opposition Division's decision, have 'contemplated producing ... new documents concerning its earlier rights'.

112 However, that argument must be rejected.

- 113 Firstly, for the reasons stated at paragraph 109 above, the fact that the Board of Appeal did not state to the applicant that it intended to reverse certain assessments made by the Opposition Division is not, in itself, such as to infringe the principle of the protection of legitimate expectations.
- 114 Secondly, the applicant cannot, in any event, claim that it had no reason to submit new evidence before the Board of Appeal. It is apparent from the file relating to the proceedings before OHIM that, before the Board of Appeal, the intervener had inter alia claimed that the protection of each of the marks relied on was not 'sufficiently proven'.
- 115 It follows from all the foregoing that, the second plea in law must be rejected and that, consequently, the action must be dismissed as unfounded.

Costs

- 116 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Interkobo sp. z o.o. to pay the costs.**

Czúcz

Labucka

Gratsias

Delivered in open court in Luxembourg on 27 June 2012.

[Signatures]