



## Reports of Cases

OPINION OF ADVOCATE GENERAL  
BOT  
delivered on 28 November 2013<sup>1</sup>

### Case C-530/12 P Office for Harmonisation in the Internal Market

(Trade Marks and Designs) (OHIM)

v

National Lottery Commission

(Appeals — Community trade mark — Regulation (EC) No 207/2009 — Article 53(2)(c) — Community trade mark — Application for a declaration of invalidity based on an earlier copyright under national law — Knowledge and interpretation of national law — Role of the EU judiciary)

1. By its appeal, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') seeks to have set aside the judgment of the General Court of the European Union of 13 September 2012 in *National Lottery Commission v OHIM – Mediatek Italia and De Gregorio (Representation of a hand)*,<sup>2</sup> by which that court upheld the action brought by the National Lottery Commission<sup>3</sup> for annulment of the decision of the First Board of Appeal of OHIM of 9 June 2010<sup>4</sup> relating to invalidity proceedings between Mediatek Italia Srl and Mr De Gregorio,<sup>5</sup> on the one hand, and the NLC, on the other.
2. This case offers the Court the opportunity to clarify the status of national law within the EU legal system and to lay down guidelines governing the review which the EU judiciary may conduct into the content and interpretation of that law in the context of disputes relating to Community trade marks.
3. The first ground of appeal raises, in particular, the question whether the General Court, when an action against a decision of a Board of Appeal of OHIM is brought before it, may of its own motion examine the content of the positive national law relied upon by the party seeking the annulment of a Community trade mark on the basis of an earlier right protected by that national law.
4. In that regard, I shall submit in this Opinion that the exercise of the full review of legality which falls to the General Court presupposes that that court is able to provide a solution to the dispute which is consistent with the positive national law and, to that end, that it may examine, if necessary of its own motion, the content, the conditions of application and the scope of the rules of national law relied upon by the parties in support of their claims.
5. I shall, however, make the point that, where the EU judiciary examines such national rules of its own motion, it must observe the principle that the parties should be heard.

1 — Original language: French.

2 — Case T-404/10, 'the judgment under appeal'.

3 — The 'NLC'.

4 — Case R 1028/2009-1, 'the contested decision'.

5 — Together, 'Mediatek Italia'.

6. Since the General Court failed to observe that principle, I shall propose that the Court of Justice uphold the appeal and set aside the judgment under appeal.

7. Finally, since the state of the proceedings does not appear to me to permit judgment to be given, I shall ask the Court of Justice to refer the case back to the General Court.

## I – Legal framework

### A – Regulation (EC) No 207/2009

8. Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark<sup>6</sup> was repealed and codified by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark,<sup>7</sup> which entered into force on 13 April 2009.

9. Under Article 53(2)(c) of Regulation No 207/2009:

‘A Community trade mark shall also be declared invalid on application to [OHIM] or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Community legislation or national law governing its protection, and in particular:

...

(c) a copyright’.

10. Article 76(1) of that regulation provides:

‘In proceedings before it [OHIM] 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.’

### B – Regulation (EC) No 2868/95

11. Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94,<sup>8</sup> as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005,<sup>9</sup> lays down, inter alia, the rules applicable to the conduct before OHIM of proceedings for the revocation or invalidation of a Community trade mark.

12. Rule 37(b)(iii) of the Implementing Regulation provides:

‘An application to [OHIM] for revocation or for a declaration of invalidity ... shall contain:

...

(b) as regards the grounds on which the application is based,

6 – OJ 1994 L 11, p. 1.

7 – OJ 2009 L 78, p. 1.

8 – OJ 1995 L 303, p. 1.

9 – OJ 2005 L 172, p. 4, ‘the Implementing Regulation’.

...

- (iii) in the case of an application pursuant to Article [53(2) of Regulation No 207/2009], particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article [53(2) of that regulation] or that he is entitled under the national law applicable to lay claim to that right.'

## II – Background to the case and the contested decision

13. On 2 October 2007, the NLC obtained the registration of the following Community figurative mark at OHIM:<sup>10</sup>



14. On 20 November 2007, Mediatek Italia filed an application with OHIM, on the basis of Article 52(2)(c) of Regulation No 40/94, now Article 53(2)(c) of Regulation No 207/2009,<sup>11</sup> for a declaration that the contested trade mark was invalid by virtue of the existence of an earlier copyright, owned by Mr De Gregorio in the following figurative sign:<sup>12</sup>



15. By decision of 16 July 2009, the Cancellation Division of OHIM granted that application on the ground, in essence, that Mediatek Italia had demonstrated that a copyright protected by Italian legislation existed which was virtually identical to the contested trade mark, and that that copyright pre-dated the contested trade mark.

10 — The 'contested trade mark'.

11 — Although the proceedings were brought under Regulation No 40/94, in this Opinion reference will be made exclusively to Regulation No 207/2009, which did not amend the wording of the relevant provisions.

12 — The 'mano portafortuna'.

16. The NLC filed an appeal against that decision.
17. By the contested decision, the First Board of Appeal of OHIM dismissed that appeal.
18. The Board of Appeal found, firstly, that Mediatek Italia provided evidence of the creation of the work and the ownership of the copyright by producing a photocopy of an agreement under private signature dated 16 September 1986,<sup>13</sup> under which a third party purporting to be the author of the ‘mano portafortuna’ stated that it had assigned to one of the applicants for a declaration of invalidity his rights to reproduce and use that work reproduced, along with other drawings, as annexes to that agreement.
19. Secondly, it took the view that the anomalies referred to by the NLC, namely the mention of a maximum duration of the copyright protection of 70 years, even though such a duration has existed only since 1996, the date of the post office stamp which is a Sunday, a day on which post offices are closed, and the difference in terms of quality and design between the drawing of the ‘mano portafortuna’ and the other drawings appended to the 1986 Agreement, were not such as to give rise to doubts as to the authenticity of the 1986 Agreement.
20. Thirdly, it made clear that, if the document under private signature constituted conclusive evidence of the provenance of the statements of the parties to the 1986 Agreement, pending proceedings challenging it as a forgery under Article 2702 of the Italian Civil Code, it was competent to assess the content of that agreement freely.

### **III – The action before the General Court and the judgment under appeal**

21. By application lodged at the Registry of the General Court on 8 September 2010, the NLC brought an action for annulment of the contested decision.
22. In support of its action, the NLC relied on three pleas in law, alleging: (i) infringement of Article 53(2)(c) of Regulation No 207/2009; (ii) illegality of the Board of Appeal’s refusal to open an oral procedure or to adopt any measures for the collection of evidence; and (iii) incorrect assessment by the Board of Appeal of its powers to determine whether the 1986 Agreement was authentic.
23. By the judgment under appeal, the General Court upheld the action and ordered OHIM to pay the costs.
24. The General Court, which examined the first and third pleas in law together, set out first of all, in paragraphs 17 to 21 of the judgment under appeal, the procedural arrangements applicable to an application for a declaration that a Community trade mark is invalid on the basis of the existence of an earlier copyright protected under national law.
25. In paragraphs 18 and 19 of the judgment under appeal, it cited paragraphs 50 to 52 of *Edwin v OHIM*,<sup>14</sup> before recalling, in paragraph 20 of the judgment under appeal, its own case-law, based on the concept of ‘well-known facts’, under which OHIM ‘must – of its own motion and by whatever means considered appropriate – obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted’.

<sup>13</sup> – The ‘1986 Agreement’.

<sup>14</sup> – Case C-263/09 P [2011] ECR I-5853.

26. In the light of those principles, the General Court held, in paragraphs 23 and 24 of the judgment under appeal, that although ‘the Board of Appeal was right to rely on the rules of Italian law in determining the probative value of the 1986 Agreement’, the General Court did, however, have to ‘determine whether the Board of Appeal [had] construed the relevant Italian law correctly in finding that, pursuant to Articles 2702 and 2703 of the Italian Civil Code, the 1986 Agreement constituted conclusive evidence of the provenance of the statements of the parties to that agreement, pending the introduction of proceedings challenging it as a forgery’.

27. Having recalled the content of Articles 2702 to 2704 of the Italian Civil Code, the General Court expressed its view as follows:

‘29 However, it is clear from Articles 2702 to 2704 of the Italian Civil Code that, in the circumstances of the present case, such an assertion will be correct only if the signatures of the parties to the agreement can be regarded as lawfully recognised, in that they have been authenticated in accordance with Article 2703 of the Italian Civil Code, or if one of the exceptions provided for under Article 2704 of that code applies.

...

31 ... as regards the application of Article 2704 of the Italian Civil Code, it should be noted that this makes it possible to enforce against third parties a document under private signature, in respect of which the signature has not been authenticated, as from the day following its registration or the occurrence of an event which establishes in a[n] equally certain manner that the document under private signature had been drawn up beforehand.

32 Pursuant to the case-law of the Corte suprema di cassazione (Italian Supreme Court of Cassation), the affixing of a post office stamp to a document under private signature constitutes a fact establishing the exact date of that document for the purposes of Article 2704 of the Civil Code, since the stamp appears in the body of the document (judgment No 13912 of 14 June 2007 [15]). It is also apparent from that case-law that proof may be adduced that the date of a post office stamp is not genuine, without it being necessary for proceedings to be brought for a declaration of forgery’.

28. Having again pointed out, in paragraph 33 of the judgment under appeal, that, ‘although no mention is made in the contested decision of Article 2704 of the Italian Civil Code, reference is made to the presence of a post office stamp dated 21 September 1986’, the General Court acknowledged, in paragraph 34 of that judgment, that ‘the presence of the post office stamp is a factor which enables it to be established that the 1986 Agreement has a definite date as from 21 September 1986’, before however adding, in paragraph 35 of the judgment, that, ‘pursuant to the case-law [of the Corte suprema di cassazione], it was open to the [NLC], without having to bring proceedings for a declaration of forgery, to adduce proof that, in actual fact, the 1986 Agreement had been drawn up on a date other than that shown on the post office stamp’.

29. The General Court therefore inferred from this in paragraph 36 of the judgment under appeal:

‘Accordingly, by finding ... that the 1986 Agreement “[was] a document under private signature and therefore [constituted] full proof of the provenance of the statements made by the signatories, pending a declaration of forgery in accordance with Article 2702 of the Civil Code”, when it was not necessary to bring proceedings for a declaration of forgery in the circumstances, the Board of Appeal based its approach on a misinterpretation of the national law applicable pursuant to Article 53(2) of Regulation No 207/2009 and therefore failed to assess accurately the precise scope of its own powers.’

15 — The judgment of 14 June 2007.

30. Next, having stated, in paragraph 39 of the judgment under appeal, that the findings relating to the anomalies concerning the 1986 Agreement could have been affected by the misinterpretation of Italian law, since arguably ‘the Board of Appeal would have attributed more weight to those factors if it had believed that it was legitimate for the [NLC] to challenge before it the reliability of the date indicated on the post office stamp and that, accordingly, the 1986 Agreement did not necessarily constitute proof of the provenance of the statements made therein’, the General Court held, in paragraph 40 of the judgment under appeal, that the misinterpretation of the national law governing the protection of the earlier right relied upon by Mediatek Italia might have had an effect on the content of the contested decision.

31. The General Court therefore concluded, in paragraph 41 of the judgment under appeal, that the contested decision had to be annulled, without it being necessary to examine the second plea.

#### **IV – The procedure before the Court and the forms of order sought by the parties**

32. OHIM claims that the Court should set aside the judgment under appeal and order the NLC to pay the costs incurred by it, whereas the NLC contends that the appeal should be dismissed.

33. In support of its appeal, OHIM raises three pleas in law: by the first, it alleges infringement of Article 76(1) of Regulation No 207/2009, as interpreted by the Court in conjunction with Article 53(2) of that regulation, and of Rule 37 of the Implementing Regulation; by the second, it alleges a breach of OHIM’s right to be heard; and, by the third, it alleges manifest inconsistency and distortion of the facts.

##### *A – The first plea in law, alleging infringement of Article 76(1) of Regulation No 207/2009 and of Rule 37 of the Implementing Regulation*

34. By the first plea in law, which is divided into two limbs, OHIM submits that the General Court could not rely on either Article 2704 of the Italian Civil Code (first limb) or the judgment of 14 June 2007 (second limb), since those two factors had not been invoked by the parties and did not, therefore, fall within the subject-matter of the dispute brought before the Board of Appeal.

##### **1. Arguments of the parties**

35. Taking the view that it is not clear from the line of reasoning followed by the General Court whether that court regards national law as a question of law or as a well-known fact, OHIM submits in the alternative that:

- in the event that the General Court took the view that the application of the national law is a question of law, it infringed the principle, expressed in Rule 37(b)(iii) of the Implementing Regulation, that it is for the party which relies on the national law to furnish OHIM with particulars establishing the content of the legislation and how it applies to the case in question, as well as the solution provided in *Edwin v OHIM* from which it is clear that the national law is a question of fact which the parties must invoke and prove;
- in the event that the General Court took the view that the application of the national law is a question of fact, it unduly regarded the national legislation as a ‘well-known fact’ which, on that basis, could be examined and relied upon by OHIM on its own initiative, and that, in addition, the General Court substituted its own analysis for that of the Board of Appeal and assessed matters upon which that board had not expressed a view.



36. In response, the NLC argues that Rule 37 of the Implementing Regulation and *Edwin v OHIM* are concerned exclusively with the burden of proof incumbent upon the applicant and make no reference either to the defendant or to OHIM.

37. In addition, it submits that it is for OHIM to apply the national law correctly and to obtain information about the national law of its own motion where that is necessary for the purposes of assessing the applicability of a ground for invalidity.

38. The NLC adds that the Board of Appeal did not simply conduct a factual analysis, but gave a legal decision. An interpretation of Article 76(1) of Regulation No 207/2009 which restricts the examination carried out by the Board of Appeal simply to the relative grounds raised by the applicant would be contrary to the application of the fundamental principles of law which OHIM must take into account, as is made clear in recital 13 in the preamble to that regulation and in Article 83 thereof.

39. Finally, the NLC points out that the error made by the Board of Appeal stemmed from a misinterpretation of Articles 2702 and 2703 of the Italian Civil Code, to which its attention had been directed, and that the issue of the probative value of the 1986 Agreement had been raised before the Board of Appeal and the General Court. Accordingly, even assuming that the General Court did wrongly introduce a discussion on Article 2704 of the Italian Civil Code and the related case-law, that error would not have affected the outcome of the analysis which it carried out, such that the appeal should be dismissed.<sup>16</sup>

## 2. My analysis

### a) Preliminary observations

40. The first plea in law, by which OHIM complains that the General Court altered the subject-matter of the dispute in order to rely on provisions and case-law not invoked by the parties, alleges exclusively infringement of Article 76(1) of Regulation No 207/2009 and Rule 37 of the Implementing Regulation.

41. Although a new plea in law, since it was raised for the first time before the Court, that plea in law is in my view admissible since, given that the plea in law has its basis in the grounds of the judgment under appeal, it could not, by definition, have been raised beforehand.

42. Nevertheless, consideration may be given to whether it is effective.

43. The two provisions on which the complaint is based are concerned exclusively with the course of the proceedings before OHIM. The first sets out the role of OHIM as regards the examination of the facts which it is required to carry out, whereas the second lists the particulars which an application for revocation or for a declaration of invalidity made to OHIM must contain.

44. Neither of those two provisions therefore relates to judicial proceedings or applies to the General Court.

45. OHIM does not, however, allege infringement of Article 21 of the Statute of the Court of Justice of the European Union or of Articles 44(1), 48(2) or 135(4) of the Rules of Procedure of the General Court.

<sup>16</sup> — The NLC refers to Case C-94/02 P *Biret et Cie v Council* [2003] ECR I-10565, paragraph 63.

46. Since the provisions alleged to have been infringed are not directly applicable to the judicial proceedings before the General Court where it rules on actions brought against decisions of the Boards of Appeal and do not, by themselves, lay down the obligation upon that court to take into account only the elements of national law adduced before OHIM by the applicant for a declaration of invalidity, the plea in law – which alleges that the General Court infringed those provisions – could be regarded as ineffective.

47. However, the principles which stem from those provisions must logically likewise apply to the judicial proceedings before the General Court, since the subject of the dispute before the Board of Appeal and the General Court is identical.<sup>17</sup>

48. It is therefore necessary to give further consideration to the substance of the plea in law.

b) The status of national law in the context of disputes relating to Community trade marks and the role of the EU judicature and the OHIM bodies

i) Reminder of the case-law of the General Court

49. The solution adopted in the judgment under appeal as regards the status of national law and the role of OHIM is in line with the case-law of the General Court.

50. As a general rule, the General Court regards national law as an element of fact which it is for the opponent or cancellation applicant to prove. It does, however, temper that principle significantly by requiring OHIM to obtain, of its own motion, information about the national law where that law is a well-known fact. Thus, it has been held in a number of judgments that OHIM must of its own motion obtain information, by whatever means appear to it to be necessary for that purpose, about the national law of the Member State concerned, if such information is necessary to assess the applicability of a ground for refusal of registration or a ground for invalidity and, in particular, to assess the correctness of the facts pleaded, and the probative value of the documents submitted by the parties.<sup>18</sup> According to the General Court, restricting the factual basis of the examination by OHIM does not preclude it from taking into consideration, in addition to the facts which have been expressly put forward by the parties to the opposition proceedings or the invalidity proceedings, facts which are well known, that is, facts which are likely to be known by anyone or which may be learnt from generally accessible sources.<sup>19</sup>

51. There is a limit to that exception itself, since the General Court has clearly restricted the obligation to obtain of its own motion information about national law to cases ‘where OHIM already has information relating to [that law], either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced’.<sup>20</sup>

52. In the view of the General Court, ‘for the institutions of the European Union, determining and interpreting rules of national law, in so far as so doing is essential to their activity, is a matter of establishing the facts, not applying the law. Indeed, the only law which is applied is EU law’.<sup>21</sup>

17 — See, to that effect, point 54 of the Opinion of Advocate General Kokott in *Edwin v OHIM*.

18 — Case T-318/03 *Atomic Austria v OHIM - Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* [2005] ECR II-1319, paragraph 35; Joined Cases T-225/06, T-255/06, T-257/06 and T-309/06 *Budějovický Budvar v OHIM - Anheuser-Busch (BUD)* [2008] ECR II-3555, paragraph 96; Case T-303/08 *Tresplains Investments v OHIM - Hoo Hing (Golden Elephant Brand)* [2010] ECR II-5659, paragraph 67; and Case T-571/11 *El Corte Inglés v OHIM - Chez Gerard (CLUB GOURMET)* [2013] ECR, paragraph 39.

19 — *Atomic Austria v OHIM - Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, paragraph 35; *Budějovický Budvar v OHIM - Anheuser-Busch (BUD)*, paragraph 96; and *Tresplains Investments v OHIM - Hoo Hing (Golden Elephant Brand)*, paragraph 67.

20 — *El Corte Inglés v OHIM - Chez Gerard (CLUB GOURMET)*, paragraph 41.

21 — *Ibid.*, paragraph 35.



53. In addition, the General Court has stated that it is for the party relying on an earlier right ‘to establish, before OHIM, not only that this right arises under the national law, but also the scope of that law’.<sup>22</sup>

54. Nevertheless, the case-law of the General Court is not wholly unequivocal, since in certain judgments national law appears to be understood not in terms of the assessment or interpretation of the facts, but rather the interpretation of a rule of law.

55. Thus, in order to determine the content of the national law, the General Court examines – as in the case of any rule of law – not only the wording of the applicable legislation but also its interpretation in case-law and the views expressed in academic writings.<sup>23</sup> In *Olive Line International v OHIM – Knopf (O-live)*,<sup>24</sup> the General Court, ‘in view of the great similarity existing between the two rules’,<sup>25</sup> namely an article of the Spanish Law on Trade Marks and an article of Regulation No 40/94, held that that the former had to be interpreted ‘in the light of Community case-law’.<sup>26</sup>

56. Despite such typical examples of the difficulty of regarding national law merely as a matter of fact, I will nevertheless accept that, in principle, the General Court requires OHIM to obtain of its own motion information about the national law where that law represents a well-known fact and, in addition, considers itself obliged ‘to determine whether the Board of Appeal construed the relevant [national] law correctly’.<sup>27</sup>

57. It remains to be determined whether either of those two obligations is justified and whether a necessary and logical connection exists between the two, such that the obligation to interpret the relevant national law correctly would include that of obtaining information ex officio about that law.

58. In order to be able to answer those questions, it is necessary to review the applicable legislation and reassess the scope of *Edwin v OHIM*.

## ii) The legislation

59. In support of its first plea in law, OHIM infers from the applicable legislation that national law has the status of mere fact, meaning that the burden of proof is borne by the party who relies upon it and, as a corollary, the General Court is prohibited from taking into account, on its own initiative, provisions of national law not invoked by the parties.

60. That premiss is based on a reading of the legislation which is debatable.

61. In addition to the fact that it cannot be inferred from Rule 37 of the Implementing Regulation that national law has the status of mere fact which the parties have to prove, Article 53(2) of Regulation No 207/2009 undeniably affords national law a certain degree of ‘legal status’ within the EU legal system.

22 — Case T-579/10 *macros consult v OHIM – MIP Metro (makro)* [2013] ECR, paragraph 62. Although this judgment concerned an application for a declaration of invalidity of a Community trade mark submitted by the proprietor of an earlier right as referred to in Article 8(4) of Regulation No 207/2009, the solution which it provides appears to me to apply, by analogy, where a national right is relied upon on the basis of Article 53(2) of that regulation (see, for a parallel line of reasoning, paragraph 60 of the judgment).

23 — See, inter alia, Case T-165/06 *Fiorucci v OHIM - Edwin (ELIO FIORUCCI)* [2009] ECR II-1375, paragraphs 42 to 61, and Case T-466/08 *Lancôme v OHIM - Focus Magazin Verlag (ACNO FOCUS)* [2011] ECR I-1831, paragraphs 33 to 39.

24 — Case T-485/07.

25 — Paragraph 57. Emphasis added.

26 — Ibid.

27 — Paragraph 24 of the judgment under appeal.

– The procedural position of national law under Rule 37 of the Implementing Regulation

62. There are justifiable grounds to doubt whether it may be inferred from Rule 37(b)(iii) of the Implementing Regulation that national law has the status of a fact about which OHIM is not required to obtain information of its own motion.

63. That solution is not supported by a literal interpretation of that provision.

64. Rule 37(b)(iii) of the Implementing Regulation, which imposes on the proprietor of the earlier right, who is bringing an action for a declaration of the invalidity of a later Community trade mark, the burden of making claims and adducing the evidence which establishes its earlier right under the applicable national legislation, does not specify all the legal rules applicable to the national law, since it seeks to apply the procedural handling of questions of fact to that law only in relation to the determination of the role of the applicant for a declaration of invalidity. The obligation on the part of the latter to produce evidence would by no means be rendered meaningless if the EU judicature were granted the freedom to obtain information beyond that evidence with a view to being able to apply the solution which appeared to them to be consistent with the solution provided for in national law. Failure to comply with that obligation would, in any event, continue to result in the application being deemed inadmissible, in accordance with Rule 39(3) of the Implementing Regulation.

65. Furthermore, as a more general point, it should be observed that, although there is undeniably a link between the burden of proof vis-à-vis the national law and the power of the EU judicature to examine the content of that law of its own motion, imposing on the party who relies upon it the burden of adducing evidence of the national law does not necessarily preclude all powers on the part of the courts to determine the content, meaning and scope of that law.

66. Moreover, a systematic interpretation of Rule 37(b)(iii) of the Implementing Regulation demonstrates that the EU legislature did not intend to enshrine a purely adversarial perception of invalidity or opposition proceedings, which would make the courts mere arbiters and would leave the reins fully in the hands of the parties. On the contrary, the investigative powers afforded both to OHIM and to the General Court are an expression of a more balanced view of the respective roles of the various parties in all proceedings, including *inter partes* proceedings. Accordingly, Article 78(1) of Regulation No 207/2009 and Rule 57(1) of the Implementing Regulation lay down a non-exhaustive list of the means of taking evidence which may be decided upon by OHIM.<sup>28</sup> The power thus afforded to the competent OHIM bodies to order certain means of giving or obtaining evidence shows that the taking of evidence in disputes relating to Community trade marks is not dominated by a principle of neutrality or passivity. As the General Court has recognised, OHIM may, in particular, invite the parties to provide it with guidance on the content of national law.<sup>29</sup>

67. In the final analysis, the assertion that Rule 37 of the Implementing Regulation gives expression to the principle that the national law is a mere question of fact appears to me to call for, beyond its initial scope, a provision which simply requires the applicant to make claims and produce evidence of the national law whose protection it claims, without excluding all power of initiative on the part of OHIM.

28 — Those means include hearing the parties, requests for information, the production of documents and items of evidence, hearing witnesses, opinions by experts, statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up and carrying out an inspection.

29 — *Atomic Austria v OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*, paragraph 36.

– Taking into account the national law under Article 53(2) of Regulation No 207/2009

68. There is a large variety of provisions of EU law which refer to national law and attach different functions to it. In addition to the diversity of those situations, there is also a multitude of legal procedures by which the EU judicature may be called upon to take account of national law.

69. Attempts to compile a list of the various functions of national law within the EU legal system<sup>30</sup> demonstrate the difficulty in assigning to a clearly identified legal category the references made in Regulation No 207/2009 in the case of opposition to the registration of a Community trade mark or an application for a declaration of invalidity. For some, it is simply a question of ‘taking the national law into consideration’,<sup>31</sup> whereas for others, who equate the situation of the EU judicature ruling on disputes relating to Community trade marks with that in which they give a ruling under an arbitration clause, those references authorise the General Court to ‘apply and interpret’ the domestic law of a Member State ‘directly’.<sup>32</sup>

70. It is established in any event that, although it does not confer upon national law the character of EU law, Article 53(2) of Regulation No 207/2009 does require the institutions of the European Union, in the event of an application to have a Community trade mark declared invalid on the basis of an earlier right protected by a rule of national law, to determine and interpret that rule of law.

71. In a situation such as that at issue here, it is for OHIM to examine whether, in the context of the invalidity proceedings, the conditions for the application of the ground for invalidity relied upon are satisfied. If that ground stems from the existence of an earlier right protected by national law, it is my view that the institutions of the European Union cannot confine themselves to reviewing the value and the scope of the evidence adduced. It may also prove necessary to interpret that law and to apply it; the present case offers a crystal clear example of this fact. Presented with a challenge to the probative value of the 1986 Agreement, a photocopy of which was produced by Mediatek Italia, OHIM, the Board of Appeal and the General Court were faced with the need to interpret the rules of evidence relied upon and to apply them. Determining that the earlier right relied upon is established and proven under the applicable national legislation is a preliminary question which must be resolved before being able to apply the rule of EU law which renders the Community trade mark invalid. Accordingly, even though the adage *juria novit curia* does not extend to national law, of which the EU judicature is not deemed to be aware, and although the content of that law is regarded – for procedural purposes – as a fact which the parties bear the burden of claiming and proving, the fact remains that, from the perspective of the person who bears the responsibility of applying it, and for the purposes of the intellectual reasoning which leads to the resolution of the dispute, that law has the same standing as any rule of law, irrespective of its origin.

72. It is for those reasons that I take the view that Article 53(2) of Regulation No 207/2009 affords the national law some degree of legal status in the EU legal system, which prohibits it from being regarded exclusively as a mere question of fact.

30 — See, inter alia, Rodríguez Iglesias, G.C., ‘Le droit interne devant le juge international et communautaire’, *Du droit international au droit de l’intégration – Liber amicorum Pierre Pescatore*, Nomos Verlagsgesellschaft, Baden-Baden, 1987, p. 583; Chanteloup, H., ‘La prise en considération du droit national par le juge communautaire: contribution à la comparaison des méthodes et solutions du droit communautaire et du droit international privé’, *Revue critique de droit international privé*, 2007, p. 539; points 38 to 48 of the Opinion of Advocate General Jääskinen in Joined Cases C-106/09 P and C-107/09 P *Commission and Spain v Government of Gibraltar and United Kingdom* [2011] ECR I-11113, and points 66 to 76 of the Opinion of Advocate General Mengozzi in Case C-401/09 P *Evropaïki Dynamiki v ECB* [2011] ECR I-4911.

31 — See, to that effect, Chanteloup, H., op. cit., who states that the ‘mechanism of taking [the national law] into consideration ultimately results in ... a rule being transformed into a mere point of law which, in turn, will be transformed into a point of fact capable of being interpreted by the rule to be applied’ (paragraph 14). That transformation of national law into a point of fact is even more salient in EU law than in international private law on account of the principle of the autonomous interpretation of the former, in accordance with which the EU judicature ‘most often refuse[s] to hide behind domestic classifications’ (ibid.).

32 — See point 42 of the Opinion of Advocate General Jääskinen in *Commission and Spain v Government of Gibraltar and United Kingdom*.

73. That finding is supported by the guidance which may be drawn from *Edwin v OHIM*.

iii) The scope of *Edwin v OHIM*

74. *Edwin v OHIM* contains significant findings on the allocation of the various roles between the applicant, the competent OHIM bodies, the General Court and the Court of Justice.

75. Firstly, the Court of Justice infers from Rule 37 of the Implementing Regulation that the party applying to have a Community trade mark declared invalid on the basis of an earlier right protected by a rule of national law is required to provide OHIM with the particulars which establish the content of that rule.

76. Secondly, the Court assigns to the competent OHIM bodies the responsibility to ‘assess the authority and scope of the particulars submitted by the applicant in order to establish the content of that rule’.<sup>33</sup>

77. Thirdly, the Court holds that the General Court has jurisdiction to conduct a ‘full review of the legality of OHIM’s assessment of the particulars submitted by an applicant in order to establish the content of the national law whose protection he claims’.<sup>34</sup>

78. Fourthly, the Court of Justice establishes the scope of its own review by breaking it down into three stages relating, respectively, to the wording, the content and the scope of the positive law. The ‘wording of the national provisions at issue or of the national case-law relating to them, or of the academic writings concerning them’<sup>35</sup> is reviewed to establish whether it has been distorted, whereas the content of those particulars and the scope of each of them individually in relation to the others are reviewed to establish whether manifest errors exist.

79. My interpretation of that judgment differs quite markedly from that given to it by OHIM. Contrary to the claim made by the latter that it follows from the judgment that national law is a question of fact, I do not take the view that the Court tipped the scales in favour of it being a question of fact rather than a question of law.

80. First of all, it must be observed that the Court of Justice was careful not to express a view on the nature of the ‘particulars’ which must be produced by the applicant in order to establish the content of the national law. Not only did it not classify them as ‘matters of fact’, but, in requiring the General Court to ‘assess the authority and scope of the particulars submitted by the applicant’, it also used a new expression, which differs from that normally used to refer to the review carried out on points of fact, in order to clarify the scope of the review which the competent OHIM bodies must conduct of the evidence adduced.

81. Next, the Court of Justice based the ‘full review of legality’ that the General Court is required to conduct on the wording of Article 63(2) of Regulation No 40/94, now Article 65(2) of Regulation No 207/2009, which permits an action to be brought against decisions of the OHIM Boards of Appeal ‘on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of *any rule of law relating to their application* or misuse of

33 — Paragraph 51.

34 — Paragraph 52.

35 — Paragraph 53.

power'.<sup>36</sup> The Court expressly referred to the Opinion of Advocate General Kokott, who had taken the view that the expression 'any rule of law relating to [the] application [of Regulation No 207/2009]' was sufficiently broad to cover not only EU law, but also the national law applicable in the context of the application of that regulation.<sup>37</sup>

82. The Court could have justified that review on the basis of the power of the General Court to penalise errors made in the assessment of the facts. It has, indeed, repeatedly held that, when conducting its review of the legality of the decisions of the OHIM Boards of Appeal, the General Court may examine whether those boards made a correct legal classification of the facts of the dispute or whether the 'assessment of the facts submitted to them was flawed'.<sup>38</sup>

83. If the Court had regarded national law as a mere fact, it would therefore, quite logically, have been moved to justify the review carried out by the General Court by the latter's power to penalise errors committed in the assessment of the facts.

84. Finally, it may be stated that the Court extended its review in the context of an appeal beyond the distortion of the evidence presented to the General Court, by acknowledging the existence of a review of manifest errors of assessment.<sup>39</sup> Although it is not easy to determine the possible extent of a judicial examination of legality in the context of that review, the view may be taken that the review of the distortion of facts and that of manifest errors of assessment will probably differ from one another not only by their intensity but also in terms of their subject-matter, with the former focussing on the actual content of the national law and the latter potentially covering the interpretation and analysis of that law.

85. Finally, two main points of guidance may be deduced from the letter and the spirit of the applicable legislation and from the interpretation given to that legislation by the Court: the first relates to the status of the national law, the second to the role of the EU judicature.

86. Firstly, national law – even though it must be invoked and proven by the applicant for a declaration of invalidity – cannot be regarded as being a mere fact. The reference to national law made in Regulation No 207/2009 affords a legal status to that law, which in some way becomes part of EU law by having been exposed to the full review of legality conducted by the General Court.

87. Secondly, the role of the competent OHIM bodies and of the EU judicature when faced with the application of national law is not governed by a principle of neutrality which would confine them to a purely passive role by denying them any power of determination over the content of the alleged law.

88. The question whether the General Court must determine of its own motion the applicable national law should be assessed in the light of these two points of guidance.

#### iv) Determination ex officio of the applicable national law

89. I am of the view that the exercise of the full review of legality which falls to the General Court presupposes that that court is able to provide a solution to the dispute which is consistent with the positive national law and, to that end, that it may examine, if necessary of its own motion, the content, the conditions of application and the scope of the rules of national law relied upon by the parties in support of their claims.

36 – Emphasis added.

37 – See points 61 to 67 of the Opinion.

38 – See Joined Cases C-101/11 P and C-102/11 P *Neuman and Others v José Manuel Baena Grupo*, paragraph 39 and the case-law cited.

39 – See Coutron, L., 'De l'irruption du droit national dans le cadre du pouvoir', *Revue trimestrielle de droit européen*, 2012, p. 170, who comments that the 'repeated mention of a review of manifest errors rather encourages [the national law] to be regarded ... as a point of law at the appeal stage'.



90. Three lines of argument argue in favour of that solution.

91. The first is based on the practical effect of Regulation No 207/2009. It appears to me that the objective of protecting Community trade marks pursued by that regulation would be called into question if a trade mark could be declared to be invalid on the basis of an earlier right protected by national legislation without either the competent OHIM bodies or the General Court being able to examine the solution required under the positive national law to the matter brought before them. There can be no doubt that an incorrect assessment of that law could result in the existence of an earlier right being unduly recognised and an application for a declaration of invalidity upheld.

92. The second line of argument concerns the requirements of the principle of effective judicial protection. The power to determine *ex officio* whether the conditions for the application of the rule of national law relied upon are met also appears to me to follow from the requirement that any decision by the competent OHIM bodies which has the effect of depriving the proprietor of a Community trade mark of his right may be subject to a judicial review intended to guarantee the effective protection of that right. The judicial review would, however, be rendered meaningless if the EU judicature were simply to make do with the documents produced by the applicant, at the risk of incorrectly applying or misconstruing the applicable rules.

93. The third line of argument is based on the role performed by the competent OHIM bodies in disputes relating to Community trade marks. Far from being confined to an exclusively administrative role, those bodies perform a quasi-judicial function equivalent to that of national courts deciding on a counterclaim in infringement proceedings. Furthermore, Article 100(2) of Regulation No 207/2009 confers on their decisions the force of *res judicata*. Accordingly, it therefore seems illogical that the scope of the review carried out on the application and interpretation of the national law differs significantly depending on whether the application for a declaration of invalidity is made as a primary claim before OHIM or as a counterclaim before the national court.

94. It must be pointed out that the power to obtain information *ex officio* about the relevant national law is by no means intended to compensate for any shortcoming on the part of the applicant in discharging the burden of proof borne by it as regards the content of the national law. It is rather a question of enabling the EU judicature to establish the relevance of the national law which has been invoked. Prohibiting the competent OHIM bodies from conducting genuine checks would ultimately be tantamount to turning them into mere boards for the registration of the national law produced by the applicant.

95. I am therefore of the view that the General Court was right to examine, by obtaining information of its own motion about the content of the relevant Italian law, whether the Board of Appeal had interpreted that law correctly.

96. However, I do not believe that the justification for that duty of examination lies in the concept of a ‘well-known fact’.

97. First, national law cannot be deemed to be a question of fact.

98. Second, and in particular, the application of the concept of a ‘well-known fact’ to national law gives rise to considerable legal uncertainty and yields arbitrary results. In this connection, I seriously doubt that the complex principles of evidence governing documents under private signature in Italian law are accessible to all and may genuinely be regarded as ‘well-known facts’.

99. As I have stated above, I base the duty of examination *ex officio* on the need to protect the practical effect of Regulation No 207/2009 and on the requirements of effective judicial protection.

100. It must further be stated that that duty must remain restricted. As the General Court has held,<sup>40</sup> it is intended to apply only where OHIM already has information relating to national law. Furthermore, it does not allow the subject-matter of the dispute to be altered by the introduction of new facts, but simply enables the content, the conditions of application and the scope of the rules of national law relied upon to be examined.

101. That clarification is capable of responding, at least in part, to the objection of a practical nature raised by OHIM, regarding the impossibility of having knowledge of the applicable law in practice. There is no question of the competent OHIM bodies taking the place of the parties in connection with the taking of evidence. Their duty to obtain information is more limited in scope, since it seeks merely to determine the accuracy of the information provided by the applicant regarding the content of the national law and the scope of the protection afforded by it.

102. What is more, while recognising the difficulties which OHIM may face in connection with examining the content of the national law, it appears to me that the development of means of obtaining information puts that body of the European Union, which – it should be remembered – has investigative resources at its disposal, in a position to examine the substance of what may have been submitted by the applicant as regards the protection afforded by the national law.

103. In the light of all of those points, I am of the opinion that the first plea in law raised by OHIM should be rejected.

#### B – *The second plea in law, alleging infringement of OHIM's right to be heard*

##### 1. The arguments of the parties

104. In OHIM's view, according to a principle of EU law, a person whose interests are appreciably affected by a decision taken by a public authority must be given the opportunity to make his point of view known.<sup>41</sup>

105. It submits that, in the present case, it did not have the opportunity to make known its point of view regarding the judgment of 14 June 2007, which was not invoked by the parties during the administrative procedure, and, therefore, did not form part of the subject-matter of the dispute before the Board of Appeal, and that, had it had that opportunity, the line of reasoning followed and conclusion reached by the General Court would have been different.

106. OHIM concludes from this that the General Court infringed its right to be heard.

107. The NLC responds that the point of law to which the case-law of the Corte suprema di cassazione was relevant was raised prior to the hearing since, pursuant to Article 64 of its Rules of Procedure, by letter of 7 February 2012 the General Court asked OHIM to respond to questions relating to the scope of Article 2704 of the Italian Civil Code. It contends that OHIM did therefore have the opportunity of being heard on this issue, both in writing and at the hearing, and that it cannot be submitted that, in the absence of a prior notification concerning all relevant or potentially relevant case-law, a judgment which refers to that case-law infringes the rights of the defence.

40 — *El Corte Inglés v OHIM – Chez Gerard (CLUB GOURMET)*, paragraph 41.

41 — OHIM refers to Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 21, and Case T-320/03 *Citicorp v OHIM (LIVE RICHLI)* [2005] ECR II-3411, paragraph 22.

108. The NLC adds that, even assuming that the General Court did err in law by failing to give OHIM the opportunity to submit observations on that case-law, that error did not in any event have any effect on the outcome of the ruling.

## 2. My analysis

109. Although, as I have stated, the General Court must – subject to certain restrictions – obtain of its own motion information about the content of national law, it appears to me to be of fundamental importance to take this opportunity to restate the scope which the Court has always afforded to the principle that the parties should be heard, which is the basic requirement for any fair trial.

110. The right to a fair trial is a fundamental principle of EU law, enshrined in Article 47 of the Charter of Fundamental Rights of the European Union and in Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms,<sup>42</sup> which afford ‘the same protection’.<sup>43</sup>

111. In order to satisfy the requirements of that law, the EU judiciary must ensure that the principle that the parties should be heard is respected in proceedings before them and that they themselves respect that principle,<sup>44</sup> which applies to any procedure which may result in a decision by an institution of the European Union perceptibly affecting a person’s interests.<sup>45</sup>

112. The principle that the parties should be heard does not merely confer on each party to proceedings the right to be apprised of and discuss the documents produced and observations made to the EU judiciary by the other party. It also implies a right for the parties to be apprised of and discuss matters raised by those courts of their own motion, on which they intend basing their decision.<sup>46</sup>

113. Case-law has clearly recognised the existence of that right not only where the EU judiciary bases its decision on facts and documents which the parties have not had an opportunity to examine,<sup>47</sup> but also where it bases its decision on a plea in law raised of its own motion.<sup>48</sup>

114. Indeed, the scope of the right to be heard extends to all matters which will determine the outcome of the proceedings<sup>49</sup> and which form the basis of the decision-making act, whether they are matters of fact or of law, and only the final position which the authority intends to adopt and the act of giving judgment itself fall outside its scope.

115. It is therefore necessary to examine whether or not, in the present case, the parties had the opportunity in the course of the proceedings to submit their observations on the matters raised by the General Court of its own motion.

42 — Convention signed in Rome on 4 November 1950.

43 — Case C-439/11 P *Ziegler v Commission* [2013] ECR, paragraph 126 and the case-law cited.

44 — Case C-89/08 P *Commission v Ireland and Others* [2009] ECR I-11245, paragraphs 51 and 54, and Case C-197/09 RX-II Review *M v EMEA* [2009] ECR I-12033, paragraph 42.

45 — *Commission v Ireland and Others*, paragraph 50, and Review *M v EMEA*, paragraph 41.

46 — *Commission v Ireland and Others*, paragraphs 52 and 55 and the case-law cited.

47 — *Ibid.*, paragraph 52 and the case-law cited.

48 — *Ibid.*, paragraph 55. See also Review *M v EMEA*, paragraph 41, and Case C-472/11 *Banif Plus Bank* [2013] ECR, paragraph 30. The case which gave rise to the latter judgment concerned a finding made by a national court of its own motion that a term was unfair. Nevertheless, it seems to me that the solution in that judgment, based on the general requirements of the right to a fair trial, may be applied to the EU judiciary where those courts intend to settle a dispute by taking as a basis a plea in law raised of their own motion.

49 — *Commission v Ireland and Others*, paragraph 56, and Review *M v EMEA*, paragraph 41.

116. In this regard, as is clear from the letters sent on 7 February 2012 by the General Court and the questions annexed thereto, although they were able to put forward their point of view on the provisions of Article 2704 of the Italian Civil Code, the parties were not, however, put in a position to submit their observations on the judgment of 14 June 2007.

117. It is quite clear from a reading of paragraphs 32, 35, 36, 39 and 40 of the judgment under appeal that the content of the judgment of 14 June 2007 was crucial to the General Court's line of reasoning and that the solution would have been different if the General Court had not taken account of that judgment. It is because it found that the Board of Appeal failed to take into account that case-law, in accordance with which proof may be adduced that the date of the post office stamp is not genuine without it being necessary for proceedings to be brought for a declaration of forgery, that the General Court took the view that the Board of Appeal could have attributed more weight to the anomalies alleged by the NLC and that it was therefore necessary to annul the contested decision.

118. It follows from the foregoing that the General Court infringed the principle that the parties should be heard, which stems from the requirements connected with the right to a fair trial.

119. I am therefore of the view that the second ground of appeal must be upheld.

120. In those circumstances, I do not consider it to be necessary to examine the third plea in law, alleging manifest inconsistency and distortion of the facts.

#### **V – Referral of the case back to the General Court**

121. The first paragraph of Article 61 of the Statute of the Court of Justice provides that, if the appeal is well founded, the Court of Justice is to quash the decision of the General Court. In such cases, the Court of Justice may itself give final judgment in the matter, where the state of the proceedings so permits, or refer the case back to the General Court for judgment.

122. In the present case, I am of the view that the state of the proceedings does not permit final judgment to be given in the matter, since the parties must be allowed to express their views on the points of national law raised by the General Court of its own motion.

123. Those considerations lead me to propose that the present case be referred back to the General Court for judgment on the substance of the case.

#### **VI – Conclusion**

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

- (1) set aside the judgment of the General Court of the European Union of 13 September 2012 in Case T-404/10 *National Lottery Commission v OHIM – Mediatek Italia and De Gregorio (Representation of a hand)*;
- (2) refer the case back to the General Court of the European Union for a ruling on the merits of the action;
- (3) order that the costs be reserved.