Reports of Cases

ORDER OF THE GENERAL COURT (Fifth Chamber)

21 July 2020*

(Procedure — Taxation of costs — Inadmissibility)

In Case T-334/18 DEP,

Bodegas Altún, SL, established in Baños de Ebro (Spain), represented by I. Temiño Ceniceros and J. Oria Sousa-Montes, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by S. Palmero Cabezas and H. O'Neill, acting as Agents,

defendant,

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

Codorníu, SA, established in Esplugues de Llobregat (Spain), represented by M. Ceballos Rodríguez and E. Stoyanov Edissonov, lawyers,

APPLICATION for taxation of the costs to be reimbursed by the intervener to the applicant following the judgment of 27 June 2019, *Bodegas Altún* v *EUIPO — Codorníu (ANA DE ALTUN)* (T-334/18, not published, EU:T:2019:451),

THE GENERAL COURT (Fifth Chamber),

composed of D. Spielmann (Rapporteur), President, U. Öberg and R. Mastroianni, Judges,

Registrar: E. Coulon,

makes the following

* Language of the case: Spanish.

Order

Facts, procedure and forms of order sought

1 On 31 May 2013, the applicant, Bodegas Altún, SL, filed an application for the registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)). On 1 October 2013, the intervener, Codorníu, SA, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001) to the registration of the mark applied for. On 28 November 2014, the Opposition Division held that there was a likelihood of confusion between the mark applied for and the earlier mark. On 22 January 2015, the applicant filed a notice of appeal at EUIPO pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001) against the Opposition Division's decision. By decision of 9 December 2015, the Second Board of Appeal of EUIPO annulled the decision of the Opposition Division.

2 The intervener brought an action for annulment against the decision of the Second Board of Appeal of EUIPO of 9 December 2015 before the Court. By judgment of 18 September 2017, *Codorníu* v *EUIPO Bodegas Altún (ANA DE ALTUN)* (T-86/16, not published, EU:T:2017:627), the Court upheld that action, annulled the decision of the Board of Appeal, and ordered EUIPO and the applicant each to bear their own costs and to pay half of the costs incurred by the intervener.

3 Following the judgment of 18 September 2017, *ANA DE ALTUN* (T-86/16, not published, EU:T:2017:627), the opposition was referred back to the First Board of Appeal of EUIPO, which, by decision of 14 March 2018, held that for reasons of procedural economy it was necessary to examine the opposition in the light of Article 8(5) of Regulation 2017/1001, and dismissed the applicant's application.

4 By application lodged at the Registry of the General Court on 31 May 2018, the applicant brought an action for annulment of the decision of the First Board of Appeal of EUIPO of 14 March 2018.

5 By judgment of 27 June 2019, *Bodegas Altún* v *EUIPO Codorníu (ANA DE ALTUN)* (T-334/18, not published, EU:T:2019:451), the Court annulled the decision of the First Board of Appeal of EUIPO of 14 March 2018, ordering EUIPO and the intervener each to bear their own costs, and to pay half of those incurred by the applicant.

6 The applicant states that it has attempted to recover the costs related to the case which gave rise to the judgment of 27 June 2019, *ANA DE ALTUN* (T-334/18, not published, EU:T:2019:451) from the intervener amicably, without being able to reach an agreement.

7 By application lodged at the Registry of the General Court on 20 December 2019, the applicant brought a request for taxation of costs pursuant to Article 170(1) of the Rules of Procedure of the General Court, seeking a declaration that the application is admissible and asking the Court to determine the amount of recoverable costs to be paid by the unsuccessful parties in the case that gave rise to the judgment of 27 June 2019, *ANA DE ALTUN* (T-334/18, not published, EU:T:2019:451).

8 EUIPO submitted its observations on the applicant's application for taxation of costs on 18 February 2020. It denies having been contacted by the applicant with regard to the reimbursement of the costs and, as to the substance, asks the General Court to fix the total amount of recoverable costs it must pay on an equal basis with the intervener at EUR 6 000.

9 The intervener presented its observations on 20 February 2020. It challenges the admissibility of the applicant's application for taxation of costs on the ground that there is no dispute as to costs within the meaning of Article 170 of the Rules of Procedure. It submits that, in any event, the litigation between the parties is still ongoing and that the partial taxation of costs is not appropriate. It contends that the Court should dismiss the application for taxation of costs and order the applicant to pay the costs incurred in the present proceedings. In the alternative, it contends that the Court should also calculate the costs it incurred in the case that gave rise to the judgment of 18 September 2017, *ANA DE ALTUN* (T-86/16, not published, EU:T:2017:627).

10 On 6 March 2020, the applicant submitted its observations on EUIPO and the intervener's observations, which the Court decided not to place on the file.

Law

11 Under Article 170 of the Rules of Procedure, if there is a dispute concerning the costs to be recovered, the party concerned may apply to the Court to determine the dispute, after giving the party concerned by the application an opportunity to submit his or her observations.

12 It follows from that provision that it is necessary to examine the existence of a dispute regarding the costs to be recovered prior to the lodging of the application for taxation of costs (order of 24 January 2017, *Natorski and Pokrywa* v *EUIPO — PIS Opakowania (Part of a door)*, T-251/14 DEP, not published, EU:T:2017:39, paragraph 13).

13 First, as EUIPO submits, there is no evidence from the file that the applicant contacted it for the purpose of the recovery of costs and, therefore, there is a dispute by EUIPO concerning the costs to be recovered.

14 It suffices to hold that, in the absence of a dispute between the applicant and EUIPO as to the amount of those recoverable costs or their reimbursement, the applicant's application is inadmissible with regard to EUIPO.

15 Second, the applicant submits that it tried unsuccessfully to obtain reimbursement of the relevant costs from the intervener's representative amicably.

16 The intervener disputes the admissibility of the application for taxation of costs, since the applicant has not claimed their reimbursement from it.

17 The Court finds that the application for taxation of costs, apart from the fact that it does not contain any calculation of the amount claimed or any evidence of the costs at issue, merely refers to an annex in that regard, and there is no mention of any claim for reimbursement of costs being sent to the intervener.

18 It is true that the evidence in the file clearly shows that an amicable and comprehensive solution to the dispute as regards the marks at issue, including the costs, was envisaged between the applicant and the intervener.

19 However, as stated in paragraph 12 above, it is important to determine whether, at the date on which the application was lodged, there was a dispute about costs to be recovered and, in particular, their amount or the payment of those costs (see, to that effect, order of 9 November 2017, *Nestlé Unternehmungen Deutschland* v *Lotte*, C-586/15 P-DEP, not published, EU:C:2017:855, paragraphs 9 and 10 and the case-law cited).

20 Although none of the provisions of the Rules of Procedure require a party to submit documentary evidence in support of its claims at the initial contact stage preceding the submission of an application for taxation of costs (see, to that effect, order of 20 June 2013, *Marcuccio* v *Commission*, T-16/09 P-DEP, not published, EU:T:2013:330, paragraph 7), the fact remains that the party obliged to pay must have been able to express its views on the costs claimed by the applicant, before the application for taxation of costs has been lodged.

21 In the present case, although a comprehensive amicable agreement with regard to the mark at issue was envisaged between the applicant and the intervener, it does not appear from the evidence in the case file that the issue of costs was submitted to the intervener, separately from the rest of the agreement, so that the intervener was in a position to submit its views with full knowledge of the issues independently of the discussions on the merits of the dispute.

22 In those circumstances, the fact that a comprehensive amicable agreement between the applicant and the intervener was not reached is not sufficient in itself to support the conclusion that there is a dispute as to the amount of costs to be recovered or the payment thereof, within the meaning of Article 170(1) of the Rules of Procedure.

23 Therefore, it must be held that the present application is also inadmissible, in so far as it concerns the intervener.

24 It follows that, in the absence of a dispute as to the costs to be recovered prior to the present application for taxation of costs, the application must be dismissed as inadmissible.

Costs

25 Under Article 134(1) 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.

26 Since the applicant has been unsuccessful, it must, having regard to the forms of order sought by the Commission and the intervener, be ordered to pay the costs incurred by those parties.

27 Since EUIPO has not applied for costs relating to the present proceedings, it must be ordered to bear its own costs.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby orders:

1. **The application for taxation of costs is dismissed as inadmissible.**

2. **Bodegas Altún, SL is to bear its own costs relating to the present proceedings and to pay those incurred by Codorníu, SA.**

3. **The European Union Intellectual Property Office (EUIPO) is to bear its own costs relating to the present proceedings.**

Luxembourg, 21 July 2020.

E. Coulon
Registrar

D. Spielmann
President