

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

8 July 2004 *

In Case T-334/01,

MFE Marienfelde GmbH, established in Hamburg (Germany), represented by
S. Rojahn and S. Freytag, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM), represented by E. Joly and G. Schneider, acting as Agents,

defendant,

the other party to the proceedings before the OHIM Board of Appeal, intervening
before the Court of First Instance, being

Vétoquinol AG, formerly Chassot AG, established in Bern (Switzerland), represented
by A. Kockläuner, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 26
September 2001 (Case R 578/2000-4), relating to opposition proceedings between
MFE Marienfelde GmbH and Vétoquinol AG,

* Language of the case: German.

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

composed of: N.J. Forwood, President, J. Pirrung and A.W.H. Meij, Judges,
Registrar: D. Christensen, Administrator,

having regard to the application and the reply, lodged at the Court Registry,
respectively, on 24 December 2001 and 29 July 2002,

having regard to the defence and the rejoinder of OHIM, lodged at the Court
Registry, respectively, on 24 April and 30 October 2002,

having regard to the defence and to the rejoinder of the intervener, lodged at the
Court Registry, respectively, on 22 April and 29 October 2002,

following the hearing on 11 November 2003,

gives the following

Judgment

Background

- 1 On 30 December 1996, the intervener, acting under its previous name of Chassot AG, filed with the Office for Harmonisation in the Internal Market (Trade Marks

and Designs) (OHIM) an application for registration of a Community trade mark under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The mark in respect of which registration was sought was the word mark HIPOVITON.

3 The goods in respect of which registration of the trade mark was sought are in Class 31 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, under the description: 'foodstuffs for animals'.

4 On 11 May 1998, the trade mark application was published in the *Community Trade Marks Bulletin*.

5 On 11 August 1998, the applicant filed a notice of opposition under Article 42(1) of Regulation No 40/94 against registration of the trade mark in respect of all the products referred to in the trade-mark application. The opposition was based on the existence of a trade mark registered in Germany on 17 May 1972, with a priority date of 16 May 1969. That trade mark ('the earlier trade mark'), consisting of the word mark HIPPOVIT, was registered in respect of products in Class 31 of the Nice Agreement under the description: 'foodstuffs for animals'.

6 In support of its opposition, the applicant has relied on the relative ground for refusal set out in Article 8(1)(b) of Regulation No 40/94.

- 7 By letter of 15 March 1999, the intervener requested that the applicant furnish proof, in accordance with Article 43(2) and (3) of Regulation No 40/94, that the earlier mark had, during the period of five years preceding the date of publication of the Community trade mark application, been put to genuine use in the Member State in which it was protected. By letter of 8 April 1999, the Opposition Division of OHIM ('the Opposition Division') requested the intervener to furnish that proof within two months.
- 8 On 4 May 1999, the applicant sent to OHIM, first, four advertising leaflets bearing the earlier trade mark; however, the letter 'O' on those leaflets was embellished with a horse's head and the front part of a horse's body. Secondly, it produced a cover page with the wording 'Marienfelder Tierfutter-Programm' ('Animal food — the Marienfelde programme'), accompanied by an order form, and a brochure entitled 'Ich liebe Pferde von A-Z' ('I love horses from A to Z'). Thirdly, it submitted a declaration headed 'Eidesstattliche Versicherung' ('declaration in lieu of an oath') of its manager, Mr Bode. The latter indicates that the sales turnover under the earlier trade mark amounted to DEM 12 500 for the period from January to June 1998 and DEM 21 100 for the period from January to December 1998.
- 9 After several exchanges of memoranda between the applicant and the intervener, OHIM sent those parties a written notice dated 24 January 2000, which was worded as follows:
- '[OHIM] informs you that no further observations may be submitted.'
- 10 By letter of 8 February 2000, the intervener stated, inter alia, that the turnover of the applicant generated by sales of products under the earlier trade mark represented the sale of 459 units and, secondly, that the applicant's annual turnover amounted to DEM 2.8 million in 1998.

- 11 By a written notice of 8 March 2000, referring to its written notice of 24 January 2000, OHIM indicated to the applicant and the intervener that the contents of the intervener's letter of 8 February 2000 would not be taken into account in its decision.
- 12 By decision of 28 March 2000 (Decision No 601/2000), the Opposition Division rejected the opposition pursuant to Article 43(2) and (3) of Regulation No 40/94 on the ground that the intervener had not proved that the earlier marks had been put to genuine use within the meaning of that provision. In that regard, it considered that the declaration in lieu of an oath submitted by the applicant, not emanating from a neutral person or body, had to be supported by other evidence. With regard to the other evidence submitted by the applicant, the Opposition Division took the view that it did not contain any indication as to the place, the duration or the extent of the use which was made of the earlier trade mark.
- 13 On 23 May 2000, the applicant filed an appeal at OHIM under Article 59 of Regulation No 40/94 against the Opposition Division's decision.
- 14 In a schedule to the statement setting out the grounds for that appeal, dated 28 July 2000, the applicant submitted various invoices relating to participation in a number of fairs in 1998, the hiring of exhibition stands and the purchase of labels and advertising material. It also submitted 15 invoices concerning sales of products under the earlier trade mark, carried out between 6 March 1998 and 19 May 1998. In those invoices, the names of the buyers of the products were concealed. The turnover corresponding to those invoices, in so far as it had been achieved before 11 May 1998, amounted to DEM 2 753.84.
- 15 In a statement of 9 October 2000, referring to its letter of 8 February 2000, the intervener reiterated the allegations contained in that letter concerning the applicant's turnover. OHIM's letter of 24 October 2000, whereby the latter communicated that statement to the applicant, indicated that such communication was by way of information only.

- 16 By a decision of 26 September 2001, notified to the applicant on 15 October 2001 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed the appeal. In substance, it stated that the relevant period, for the purposes of examining whether the earlier trade mark had been put to genuine use, was from 12 May 1993 to 11 May 1998 and that the applicant did not claim to have used that trade mark before 1998. Regarding the applicant's declaration in lieu of an oath, the Board of Appeal considered that it was not necessary to rule on its probative value. It held that, even if the turnover achieved in 1998 through sales of products under the earlier trade mark were established, it did not follow that genuine use was made of that trade mark during the relevant period. According to the Board of Appeal, the turnover of DEM 12 500, even if it were achieved during the relevant period, firstly represented the sale of only about 450 units of the products concerned and, moreover, was minimal in relation to the total annual turnover achieved by the applicant, which amounted to DEM 2.8 million in 1998. In those circumstances, the Board of Appeal considered that it was unnecessary to examine whether, by using the earlier trade mark in a form other than that under which it had been registered, the applicant had or had not made a use of that trade mark that was sufficient to safeguard its rights.

Forms of order sought

- 17 The applicant claims that the Court should:
- annul the contested decision and the decision of the Opposition Division of 28 March 2000;
 - order OHIM to pay the costs.

18 OHIM and the intervener contend that the Court should:

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

Law

Admissibility of the application for the annulment of the decision of the Opposition Division

19 In this case, the applicant seeks annulment both of the contested decision and the decision of the Opposition Division. The application, essentially, is that the Court of First Instance should take the decision which, according to the applicant, the Board of Appeal should legally have taken when hearing the appeal before OHIM. In that respect, the second sentence of Article 62(1) of Regulation No 40/94 shows that the Board of Appeal may annul the decision of the section of OHIM which ruled at first instance. Such annulment therefore falls within the measures which may be taken by the Court of First Instance in the exercise of its power to amend decisions, as provided for in Article 63(3) of Regulation No 40/94 (see, to that effect, in relation to an application that a case be referred back to the examiner, the judgment of the Court of First Instance in Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, confirmed by an order of the Court of Justice in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461, paragraph 19). It follows that the Court of First Instance has jurisdiction to hear the application for the annulment of the decision by the Opposition Division.

Merits

- 20 In support of its application, the applicant makes five pleas in law. The first plea alleges infringement of the combined provisions of Article 43(2) and (3) and Article 15 of Regulation No 40/94. In its second plea, the applicant accuses the Board of Appeal of omitting to take account of the evidence which it produced during the appeal procedure. The third plea alleges infringement of Article 8(1)(b) of Regulation No 40/94. The fourth and fifth pleas allege infringement of, respectively, the right to be heard and the duty to state reasons.

The plea alleging infringement of the combined provisions of Article 43(2) and (3) and Article 15 of Regulation No 40/94, and the plea alleging infringement of the right to be heard

— Arguments of the parties

- 21 The applicant argues, generally, that ‘genuine use’ of a trade mark should be interpreted as covering any act which, by reason of its nature, its extent and its duration, objectively constitutes a normal use of the trade mark in the market concerned. As for the extent which such a use must have, the applicant argues that that depends on the circumstances of the case and, more precisely, the size of the undertaking concerned and the degree of diversification of its business.
- 22 In this case, the applicant argues that, had the Board of Appeal correctly applied the assessment criteria listed above, it would have had to hold that the use made of the earlier trade mark was genuine. It argues that, during the relevant period, it sold products under that trade mark over the whole of German territory. According to

the applicant, the declaration in lieu of an oath made by its manager shows that the turnover achieved by virtue of those sales, although relatively small by reason of the fact that the products concerned were newly launched, shows a normal use of the trade mark, designed to ensure an outlet for those products.

- 23 The applicant further argues that the turnover figure of DEM 2.8 million, used in the contested decision for 1998, is not correct.
- 24 In its plea alleging infringement of the right to be heard, the applicant accuses the Board of Appeal of not informing it, before adopting the contested decision, of its intention to base that decision on the fact that, during the relevant period, it had sold only about 450 units of the product under the earlier trade mark. In its reply, it states that the Board of Appeal took account of the content of the intervener's memorandum of 8 February 2000, even though the Opposition Division had indicated to it that that statement would not be taken into account.
- 25 OHIM argues that the various language versions of Articles 43(2) and 15 of Regulation No 40/94 show that genuine use requires a use that is genuine, authentic, actual or real. Thus, in OHIM's submission, such use must be capable of distinguishing the products or services designated and not merely be aimed at maintaining an existing trade mark.
- 26 In an individual case, OHIM argues, in order to assess the genuineness of the use that has been made of a trade mark, an overall assessment must be made, taking into account the market concerned, the way in which the products or services in question are normally marketed, the production and marketing capabilities of the holder of the trade mark and the market share which the latter holds.

- 27 In this case, OHIM notes, first, that, according to the evidence produced by the applicant, use of the earlier trade mark did not start until the beginning of 1998, just over four months before the publication of the trade mark application. Secondly, OHIM argues that the turnover achieved through sales of products under the earlier trade mark, during the relevant period, is derisory, which cannot be explained by the fact that marketing of the products concerned did not start until the beginning of 1998. Sales during the second half of that year were lower than those at the beginning. Thirdly, OHIM argues that the applicant's turnover of sales under the earlier trade mark was insignificant in relation to its total annual turnover.
- 28 Moreover, OHIM considers that the Board of Appeal has respected the applicant's right to be heard.
- 29 The intervener maintains that the applicant has not made genuine use of the earlier trade mark. In that respect, it argues that the turnover achieved by the applicant through sales of products under that trade mark amount to 0.75% of its overall annual turnover at the very most. At the hearing, it went on to argue that, even if the turnover achieved through the sale of products under the earlier trade mark as stated in the declaration of the applicant's manager were correct, sales of those products amount to only about 38 units per month during the relevant period.

— Findings of the Court

- 30 The ninth recital in the preamble to Regulation No 40/94 states that there is no justification for protecting earlier trade marks except where the marks are actually used. Consistently with that recital, Article 43(2) and (3) of Regulation No 40/94

provide that an applicant for a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory where it is protected during the period of five years preceding the date of publication of the Community trade mark application against which an opposition has been filed (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 34).

- 31 According to Rule 22(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), proof of use is to consist of indications concerning the place, time, extent and nature of use of the earlier trade mark.
- 32 In interpreting the concept of genuine use, account must be taken of the fact that the rationale for the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM — Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, that provision is not concerned either with assessing the commercial success of an undertaking or monitoring its economic strategy, or designed to reserve the protection of trade marks for large-scale commercial uses of them.
- 33 As stated in the judgment of the Court of Justice in Case C-40/01 *Ansul* [2003] ECR I-2439, concerning the interpretation of Article 12(1) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the content of which essentially corresponds to that of Article 43 of Regulation No 40/94, there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services, thereby excluding token use for the sole purpose of preserving the rights conferred by the mark (*Ansul*,

paragraph 43). In that respect, the condition concerning genuine use of the trade mark requires that, as protected in the relevant territory, it be used publicly and outwardly (*Ansul*, paragraph 37; *Silk Cocoon*, paragraph 39).

- ³⁴ When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).
- ³⁵ Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.
- ³⁶ In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

- 37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.
- 38 It is in the light of the above considerations that the contested decision must be examined.
- 39 As a preliminary point, it should be noted that, as the application for a Community trade mark was published on 11 May 1998, the five-year period referred to in Article 43(2) and (3) of Regulation No 40/94 extends from 11 May 1993 until 10 May 1998 ('the relevant period').
- 40 However, it is clear from Article 15(1) of that regulation that the sanctions in that provision affect only trade marks the genuine use of which has been suspended for an uninterrupted period of five years. Therefore, it is sufficient for a trade mark to have been genuinely used for part of the relevant period in order to escape those sanctions.
- 41 It is undisputed between the parties that the applicant claims to have used the earlier mark only as from January 1998. The Board of Appeal was therefore right to base the contested decision on an assessment of alleged use by the applicant during the period from the beginning of 1998 until 10 May 1998.
- 42 Although there is no express mention of the fact in the contested decision, the Board of Appeal took into consideration for the purposes of its assessment only the printed materials and the declaration in lieu of an oath submitted by the applicant during the opposition procedure and the observations submitted by the intervener in its statements of 8 February and 9 October 2000.

- 43 Concerning the declaration in lieu of an oath, the Court notes that the Board of Appeal expressly left open the question of what its probative value might be. It did, however, base its analysis on the assumption that the contents of that declaration were correct. For the purposes of this case, the Court considers it appropriate to proceed on the same premiss.
- 44 Concerning, next, the printed material submitted by the applicant, the Board of Appeal rightly held that they give no indication as to the duration or the date of use of the earlier mark. It nevertheless held that it was possible to deduce the nature and place of such use from those materials, the order form appearing amongst them being clearly intended for the German market.
- 45 In order to determine whether that use could be regarded as genuine, the Board of Appeal essentially relied on two distinct factors. It first took the view that, in the case of a medium-priced product, the turnover of DEM 12 500, even if achieved from 1 January to 11 May 1998 rather than from 1 January to 30 June 1998, and the quantity of sales achieved, estimated at about 450 units, were too small. It then held that the turnover achieved from sales of products under the earlier mark, corresponding to about 0.75% of the applicant's total annual turnover, estimated at DEM 2.8 million, was insufficient.
- 46 The factual evidence considered by the Board of Appeal shows that, through product sales under the earlier trade mark, the applicant achieved a certain turnover. Therefore, the earlier mark was the subject of acts of use which, having regard to the situation of the business sector concerned, were objectively appropriate to create or preserve an outlet for the products in respect of which it was registered.
- 47 The Court notes that this was a low turnover, achieved during a relatively short period of four and a half months, directly preceding the date of publication of the application for a Community trade mark.

- 48 It therefore needs to be examined whether doubts as to the genuineness of that use, arising from its minor extent or the fact that it was taken up just before the publication of the trade mark application, were justified on the basis of the facts and evidence adduced by the parties.
- 49 Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal. Moreover, in a small undertaking, a small percentage of annual turnover corresponds to a small amount in absolute terms.
- 50 It follows that, in this case, the ratio between the applicant's overall turnover and that achieved through sales of products under the earlier trade mark, taken in isolation, is of only minor indicative value, and cannot therefore be decisive in assessing whether use of that trade mark was genuine.
- 51 Concerning the sales volume of products under the earlier mark and the turnover generated by them, in absolute terms, OHIM explained at the hearing that the Board of Appeal took the view that medium-priced products are generally sold in greater quantities than very expensive ones. The contested decision therefore states that low turnover and sales, in absolute terms, of a medium- or low-priced product supports the conclusion that use of the trade mark in question is not genuine. Whilst that consideration is not erroneous in itself, it remains incomplete where the characteristics of the market in question are not taken into account.

- 52 In that respect, the applicant has argued, in the proceedings before the Board of Appeal, that the products sold under the earlier mark are used only in small quantities. That statement was not challenged by the intervener in those proceedings. It is, moreover, supported by the advertising leaflets produced by the applicant which contain indications as to the dosage of the products concerned. Nor was that statement referred to in the contested decision, even though it was capable of explaining the low volume of sales carried out under the earlier trade mark.
- 53 Nor did the Board of Appeal take account of the applicant's statement, contained both in the grounds of its statement of opposition and in its statement before the Board of Appeal, that it had relaunched the marketing of the products concerned, and that the commercial volume which they accounted for was accordingly modest. That statement could be relevant in assessing the genuineness of the use which was made of the earlier mark, notwithstanding the fact that the turnover allegedly achieved during the second half of 1998 was lower than that in the first half. It is possible that the initial phase of marketing a product may last more than a few months.
- 54 However, the applicant has failed to provide proof that the products marketed under the earlier mark were in the launch phase, although the intervener challenged that statement — for the first time — in its statement in reply before the Board of Appeal on 9 October 2000. However, the applicant can be blamed for that omission only if it was properly placed in a position to react to the intervener's statement of 9 October 2000. In that respect, the documents before the Court show that OHIM communicated that statement to the applicant, by letter of 24 October 2000, indicating that such communication was by way of information only. In addition, as regards the statement of the intervener of 8 February 2000 to which the latter referred in its statement of 9 October 2000, the Opposition Division of OHIM had informed the applicant, by a communication of 8 March 2000, that the contents of that statement of 8 February 2000 would not be taken into account. It follows that, since the applicant was not asked to take a position on the statement of 9 October 2000, it was deprived of the possibility of assessing the usefulness of adducing additional evidence.

- 55 That finding also applies to the statements concerning the number of products sold, in absolute terms, and to the alleged total annual turnover of the applicant appearing in the intervener's statement of 8 February 2000 (paragraph 10 above), those statements having been referred to by the intervener in its statement of 9 October 2000 and taken into account by the Board of Appeal in the contested decision.
- 56 It should be added that Rule 22(1) of Regulation No 2868/95, which provides that proof of use of the earlier mark must be supplied within the period specified to the opposing party by OHIM, failing which the opposition is rejected, cannot be interpreted as precluding additional evidence from being taken into consideration where new factors emerge, even if such evidence is adduced after the expiry of that time-limit.
- 57 Since the Commission adopted Regulation No 2868/95 in accordance with Article 140(1) of Regulation No 40/94, its provisions must be interpreted in accordance with the provisions of the latter regulation. In that respect, account should be taken in particular of Articles 43(1) and 74(2) of Regulation No 40/94. Article 43(1) of Regulation No 40/94 provides that, in the examination of the opposition, OHIM is to invite the parties, as often as necessary, to file observations, within a period set them by OHIM, on communications from the other parties or issued by itself. Article 74(2) of Regulation No 40/94, which provides that OHIM may disregard facts that the parties have not relied upon or evidence which they did not produce in time, confers a discretion upon the sections of OHIM as to whether or not to take account of evidence produced after the expiry of a time-limit.
- 58 In the light of the whole of those considerations, the Court finds that the Board of Appeal did not take all the relevant factors into account in order to assess whether the use made of the earlier mark could be classified as genuine. It relied, moreover, on an incomplete factual basis, having failed to invite the applicant to take a position

on the new facts and arguments adduced in the intervener's statement of 9 October 2000, namely the alleged total annual turnover of the applicant, the arguments concerning the quantity of products sold, and the challenge by the intervener to the applicant's allegation that the products designated by the earlier trade mark were in a launch phase.

- 59 It follows that the contested decision must be annulled, without there being any need to rule on the other pleas raised by the applicant.

The application for amendment of the contested decision

- 60 In support of this application, the applicant complains that the Board of Appeal did not annul the decision of the Opposition Division in so far as the latter held that a declaration in lieu of an oath, emanating from a manager of the holder of the earlier trade mark, could not constitute sufficient evidence.

- 61 In that respect, it should be noted that functional continuity within OHIM imposes an obligation on the Board of Appeal to carry out a new assessment of the evidence submitted by the applicant. Where such examination leads to a result different from that of the body ruling at first instance, the Board of Appeal may, under Article 62(1) of Regulation No 40/94, either rule on the opposition or refer the matter back to the Opposition Division.

- 62 It follows that, even if one were to accept the argument of the applicant as set out in paragraph 60 above, the Board of Appeal could have either ruled on the opposition itself or referred the matter back before the Opposition Division.

- 63 By annulling the decision of the Opposition Division, the Court would be carrying out an amendment to the contested decision. That possibility, provided for in Article 63(3) of Regulation No 40/94, is, in principle, restricted to situations in which the case has reached a stage permitting final judgment (Case T-323/00 *SAT.1 v OHIM (SAT.2)* [2002] ECR II-2839, under appeal, at paragraph 18). That implies that the Court of First Instance must be able to establish, on the basis of evidence submitted to it, the decision which the Board of Appeal was required to take, by virtue of the provisions applicable in the case at issue. The previous paragraph shows that, in this case, that condition is not met.
- 64 In the light of the above considerations, it would be inappropriate for the Court of First Instance to amend the contested decision.

Costs

- 65 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Under the third subparagraph of Article 87(4) of the Rules of Procedure, the Court may order an intervener to bear its own costs.
- 66 In this case, the intervener has been unsuccessful in the same way as OHIM. However, the applicant has not applied for a costs order against the intervener, and OHIM has not challenged the applicant's claim that it be exclusively ordered to pay the applicant's costs.
- 67 Therefore, OHIM must be ordered to pay the applicant's costs in addition to its own and the intervener must be ordered to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby :

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 26 September 2001 (Case R 578/2000-4);**
2. **Dismisses the remainder of the action;**
3. **Orders OHIM to bear its own costs and to pay those incurred by the applicant;**
4. **Orders the intervener to bear its own costs.**

Forwood

Pirrung

Meij

Delivered in open court in Luxembourg on 8 July 2004.

H. Jung

J. Pirrung

Registrar

President