

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

7 June 2005 *

In Case T-303/03,

Lidl Stiftung & Co. KG, established in Neckarsulm (Germany), represented by
P. Groß, lawyer,

applicant,

v

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

defendant,

* Language of the case: German.

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

REWE-Zentral AG, established in Cologne (Germany), represented initially by M. Kinkeldey, and subsequently by M. Kinkeldey and C. Schmitt, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of 30 June 2003 (Case R 408/2002-1), concerning the opposition of the proprietor of the national trade mark SOLEVITA to the registration of the Community word mark Salvita,

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

composed of M. Vilaras, President, F. Dehousse and D. Šváby, Judges,

Registrar: H. Jung,

having regard to the application lodged at the Court Registry on 4 September 2003,

having regard to the response of OHIM lodged at the Court Registry on 16 January 2004,

having regard to the response of the intervener lodged at the Court Registry on 16 January 2004,

further to the hearing on 30 November 2004,

gives the following

Judgment

Background

- ¹ On 14 August 1997, REWE-Zentral AG filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).
- ² The mark in respect of which registration was sought is the word sign Salvita.
- ³ The goods in respect of which registration was sought are within Classes 5, 29, 30 and 32 of the Nice Agreement concerning the International Classification of Goods

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and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following descriptions for each class:

- Class 5: 'medicinal infusions, chewing gum for medical purposes; food for babies; all of the above products sold only in food stores';

- Class 29: 'Meat, fish, poultry, game, shellfish, including preparations of aforesaid goods; sausage, meat, poultry and fish products, caviar; meat, fish, poultry and game salads; meat, poultry, game and fish pastes, meat extracts; fruit, vegetables and pulses (prepared); fruit and vegetable pulp; delicatessen salads made of vegetables or lettuce; potato products of all types, namely chips, croquettes, fried potatoes, prepared potatoes, potato fritters, potato dumplings, fried potato cake (rösti), potato pancakes, crisps, matchsticks; bread dumplings; semi-prepared and prepared meals, namely soups (including instant packet soups), stews, dry and liquid prepared meals, mainly of one or more of the following goods; meat, fish, vegetables, prepared fruits, cheese, pasta, rice; meat, fruit, vegetable jellies, jams; eggs, milk and milk products, namely drinking milk, sour milk, butter milk, yoghurt, fruit yoghurt, yoghurt with chocolate or cocoa additives, non-alcoholic mixed milk drinks, whey drinks, kefir, cream, quark, fruit and herb quark desserts, desserts, mainly of milk and flavourings with gelatine and/or starch being binding agents, butter, clarified butter, cheese and cheese preparations; jellies; salad dressings; edible oils and fats; savoury pastries, crisps of cereals, salted and unsalted nuts and other snackfoods, included in class 29; including all the aforesaid goods (where possible) being dietetic foodstuffs not adapted for medical use; all the aforesaid goods (where possible) also frozen or preserved, sterilised or homogenised';

- Class 30: ‘Sauces, fruit sauces, sauce thickeners, powdered sauces, ketchup, horseradish, capers; coffee, tea, cocoa, cocoa goods, chocolate, chocolate goods, cocoa-based beverage powders; chocolate-based beverages, marzipan, nougat, marzipan and nougat products; puddings, desserts, spreads mainly of sugar, cocoa, nougat, milk and/or fats; pralines, including filled pralines; sugar, confectionery, vanilla sugar, sweets, in particular caramels, peppermint and fruit sweets and wine gums, lollipops, chewing gum for non-medical use; rice, tapioca, artificial coffee; pizzas; flour and preparations made from cereals, husked wholemeal cereals, namely rice, wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also as mixtures and other preparations, in particular wheat bran, wheat germ, maize meal, maize semolina, linseed, muesli and muesli bars (mainly of cereal flakes, dried fruit and nuts), cereals, popcorn; bread, bread rolls, pastry and confectionery; pasta and wholemeal pasta, in particular noodles; ready-to-bake cakes, cake flavourings, glaze, ices, ice cream; honey, treacle; yeast, baking-powder; puddings in powdered form; salt; mustard; vinegar; spices, mixed spices, pepper corns; savoury pastries, crisps of cereals, salted and unsalted nuts and other snackfoods, included in class 30; including all the aforesaid goods (where possible) being dietetic substances not adapted for medical use, including all the aforesaid goods (where possible) frozen, preserved, sterilised or homogenised’;

- Class 32: ‘Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices, vegetable juices; syrups and other preparations for making beverages; whey beverages; instant powdered drinks’.

⁴ On 13 July 1998, the trade mark application was published in the *Community Trade Marks Bulletin* No 50/98.

- 5 On 13 October 1998, Lidl Stiftung & Co. KG filed a notice of opposition against the registration of the trade mark applied for, claiming a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. That opposition was based on the existence of the earlier German trade mark SOLEVITA, registered on 27 June 1983 to designate products falling within Class 32 for the purposes of the Nice Agreement. The opposition was brought against various products falling within Classes 29, 30 and 32 and specified in the application for the Community trade mark.
- 6 By letter of 27 October 1999, the intervener requested the applicant to provide proof of use of the mark pursuant to Article 43(2) of Regulation No 40/94.
- 7 On 18 January 2000, the Opposition Division of the Office invited the applicant to furnish that proof within two months.
- 8 On 14 February 2000, the applicant provided:
 - an affirmation, signed by the director of international purchasing and dated 27 January 2000, relating to the turnover in the Federal Republic of Germany for goods bearing the SOLEVITA trade mark from 1993 to 1999;
 - a list of the products marketed under the SOLEVITA trade mark from 1993 to 1999, headed 'Solevita bis 10-1999' (Solevita until October 1999) and bearing the words 'Stand: 23. März 1998 — 27.01.00' (updated: 23 March 1998 — 27.01.00);

— copies of specimen packages for various types of fruit juice marketed under the SOLEVITA trade mark, all undated.

9 On 28 March 2002, the Opposition Division rejected the opposition brought by the applicant. As grounds for its decision, it essentially stated that the documents provided by the applicant were inadequate to show real and genuine use of the earlier national trade mark. In particular, the Opposition Division held that the specimen packages did not bear a date, that the affirmation was of only relative evidential value, as it was from an employee of the applicant who was one of its directors, and that, in addition, that declaration constituted only an indication of the use of the mark. The Opposition Division held that the applicant had not provided either invoices or explanations from third parties to support or confirm the figures put forward by it, with the result that consideration of the evidence provided led to the conclusion that proof of real and genuine use had not been furnished. The Opposition Division also stated that the opposition fell to be rejected on the ground that the conflicting signs displayed no similarities.

10 On 10 May 2002, the applicant brought an appeal against the decision of the Opposition Division. It argued, in particular, that proof of use of the mark had been provided. Furthermore, the applicant maintained that the Opposition Division had infringed its right to be heard, as it had been unable to submit observations on the assessment of the material put forward to prove genuine use of the mark. The Opposition Division also contravened the principle that the subject-matter of a case is delimited by the parties, in that the use of the mark was not disputed by the intervener.

11 By decision of 30 June 2003 ('the contested decision'), the First Board of Appeal of the Office rejected the appeal.

- 12 As regards proof of the use of the mark, the Board of Appeal essentially held that the affirmation was a unilateral statement, drawn up by the party concerned or by one of the senior managers of its undertaking and that a statement of that kind was not sufficient to prove objective facts, unless supported by additional evidence such as invoices, which it had not been in this case. Moreover, as the copies of the specimen packages gave no indication as to the period of time during which they had been marketed, the Board of Appeal held that neither they, nor indeed the other evidence produced, could confirm the turnover figures put forward. The Board of Appeal concluded that the Opposition Division had been correct to hold that the documents produced were insufficient to prove use of the mark during the relevant period.
- 13 As regards the right to be heard for the purposes of the second sentence of Article 73 of Regulation No 40/94, the Board of Appeal held that when examining the file the Office is authorised to use all the items of information provided by a party, without first having to give it the opportunity of presenting comments on them, the party concerned being deemed to be familiar with the information in question. As regards the principle that the subject-matter of a case is delimited by the parties, the Board of Appeal held that the question of the use of the mark is subject to that principle only in so far as the applicant may withdraw his application at any time. The Opposition Division accordingly had not infringed Article 74(1) of Regulation No 40/94.

Forms of order sought

- 14 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to pay the costs.

15 The Office and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

16 In support of its application, the applicant relies on three pleas in law. By its first plea, it challenges the finding of the Board of Appeal that proof of the use of the mark had not been furnished in this case. By its second and third pleas, it alleges infringement of the right to be heard and the principle that the subject-matter of a case is delimited by the parties.

Proof of genuine use of the mark

Arguments of the parties

17 The applicant's first plea is based on five arguments.

- 18 First, noting the terms of Article 43(2) and (3) of Regulation No 40/94 and referring to several decisions of the Board of Appeal of the Office, the applicant states that ‘genuine’ use means real use of the earlier mark on the market with the intention of drawing the attention of potential customers to the goods and services offered under that sign. Article 43(3) of Regulation No 40/94 accordingly does not require extensive evidence of the use of the mark, unlike other provisions, such as Article 7 (3) of the regulation. It is sufficient to prove that the earlier mark was actually used and that it was not used on the market only as a ‘sham right’.
- 19 Second, the applicant notes that the Board of Appeal referred in its decision to the judgments in Case C-40/01 *Ansul* [2003] ECR I-2439 and Case T-174/01 *Goulbourn v OHIM — Redcats (Silk Cocoon)* [2003] ECR II-789. According to the applicant, the Board of Appeal appears to think that those two judgments addressed the issue of which documents were adequate to prove genuine use of the mark. That is not the case, as, according to the applicant, those two cases bear no relation to the subject-matter of the present case.
- 20 Third, under reference to Article 43(2) of Regulation No 40/94 and Rule 22(2) and (3) of Commission Regulation No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), the applicant contests the approach adopted by the Board of Appeal under which certain documents could suffice to establish credible use within the meaning of German law but were insufficient to prove use for the purposes of Regulation No 40/94. That observation relates in particular to the fact that the affirmation was accorded inferior evidential status to that which would customarily be given to it under German law.
- 21 Fourth, the applicant argues that the contested decision conflicts with the decision of the Third Board of Appeal of the Office of 11 July 2001 in Case R 759/2000-3

Grafenwälder/Grafenwalder. In that case, the opponent produced an affirmation, a monthly sales schedule for the period concerned, two copies of products bearing its mark and an advertising leaflet. The applicant points out that the Board of Appeal, overruling the Opposition Division, stated in particular at paragraph [22] of its decision that ‘the material submitted by the opponent in the case in question [was] sufficient to comply with these requirements, especially as [Rule 22 of Regulation No 2868/95] does not require that all evidence specified therein has to be present cumulatively’. According to the applicant, that interpretation of the law is also confirmed by the decision of the Second Board of Appeal of 8 November 2000 in Case R 756/1999-2 *DOCTORS/DOC & TORS*.

22 Fifth, the applicant maintains that the documents placed in the file, taken together, leave no doubt as to the fact that the earlier mark was the subject of very extensive genuine use for the product concerned and for the period to be taken into account in Germany, the Member State in which that mark is registered. In support of its position, the applicant refers to the decision of the First Board of Appeal of the Office of 6 April 2001 in Case R 129/2000-1 *VISIO/VISION*. It concludes from that that proof of genuine use of the mark, within the meaning of Article 43(2) of Regulation No 40/94, was furnished in the present case.

23 The Office, for its part, maintains that, even if it is not necessary under the opposition procedure for the opponent to prove that its trade mark has become distinctive in consequence of the use which has been made of it, as may be the case where Article 7(3) of Regulation No 40/94 applies, that is not of itself grounds for relieving the opponent of the burden of proof imposed on him.

24 On the contrary, Article 43(2) of Regulation No 40/94 requires the opponent to prove that the sign has been put to genuine use during the relevant period.

- 25 It is true that Rule 22(3) of Regulation No 2868/95 does not require that all evidence specified therein be present cumulatively. The evidence provided by the opponent must, however, allow clear inferences to be drawn as to the place, time, extent and nature of the use of the earlier mark for the purposes of paragraph 2 of that Rule.
- 26 In the present case, the Office acknowledges that the documents placed on the file are admissible evidence for the purposes of Article 76(1) of Regulation No 40/94 and Rule 22(2) and (3) of Regulation No 2868/95. In particular, it states that the 'affirmation' lodged by the opponent constitutes admissible evidence.
- 27 The Office none the less maintains that the evidential value of an affirmation must be assessed together with all the other documents produced, having regard to their content and the particular circumstances of the case. That examination leads to the conclusion that the affirmation, whether taken by itself or with the list of products annexed to it, is insufficient to prove genuine use of the earlier mark.
- 28 In that regard, the Office considers that the list annexed to the affirmation only repeats the figures mentioned in the affirmation, without, however, proving them. That information is thus insufficient to prove genuine use, since it is not supported, for example, by invoices, catalogues or advertising material. Furthermore, as far as the undated reproductions of packages for the products are concerned, those reproductions merely found suppositions and cannot therefore support the other evidence and statements.

- 29 The intervener also acknowledges that the affirmation constitutes an item of admissible evidence, which is expressly provided for in Article 76(1)(f) of Regulation No 40/94. However, it is a matter for the Office, and more precisely for its Boards of Appeal, to assess the evidential value of that affirmation freely and to form its own view on the matter.
- 30 In the present case, the information relating to the items sold and the period for which sales of the products were claimed appears only in the affirmation of the director of international purchases of the applicant itself. The list of the products also comes from the applicant itself and is not supported by any objective evidence. Accordingly, it does not reinforce the evidential value of the affirmation. The true position is that it is a mere written assertion made by one party and lacks any evidential value. As regards the packages, the intervener considers that they are the only objective evidence produced by the applicant. However, they do not give the slightest indication of the date of their use or of the period concerned.
- 31 The intervener also states that, even under German law, the affirmation would be insufficient to establish real and genuine use, unless it was accompanied and supported by other evidence. It refers in that regard to a decision of the First Board of Appeal of the Office cited in the application.

Findings of the Court

- 32 Article 43(2) and (3) of Regulation No 40/94 provides 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 trade mark application against which opposition has been filed.

- 33 Rule 22(2) of Regulation No 2868/95 provides that the indications and evidence for the furnishing of proof of use of a trade mark are to consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based. That rule also provides that ‘evidence in support’ of those indications must be furnished.
- 34 In that regard, Rule 22(3) of Regulation No 2868/95 states that evidence of the use of the mark is, ‘in principle’, to be confined to the submission of supporting documents and items ‘such as’ packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing as referred to in Article 76(1) (f) of Regulation No 40/94, which include statements in writing given under affirmation.
- 35 Furthermore, in order to interpret the concept of genuine use, it is necessary to take into account the fact that the *ratio legis* of 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 Community 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 (*Silk Cocoon*, cited in paragraph 19 above, paragraph 38). However, that provision is not concerned with assessing the commercial success of an undertaking or with monitoring its economic strategy, nor is it designed to reserve the protection of trade marks for large-scale commercial uses of them (Case T-334/01 *MFE Marienfelde v OHIM — Vétquinol (HYPOVITON)* [2004] ECR II-2787, paragraph 32).
- 36 As *Ansul*, cited in paragraph 19 above, shows in relation to the interpretation of Article 12(1) of First 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 legislative content of which is essentially similar to that of Article 43 of

Regulation No 40/94, there is genuine use of a trade mark where the mark is used consistently 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, but excluding token use for the sole purpose of preserving the rights conferred by the mark (paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (*Silk Cocoon*, cited in paragraph 19 above, paragraph 39; see, to that effect and by way of analogy, *Ansul*, cited in paragraph 19 above, paragraph 37).

37 The assessment of whether use of the trade mark is genuine must be based on all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly the kinds of use regarded 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 (*HIPOVITON*, cited in paragraph 35 above, paragraph 34; see, to that effect and by way of analogy, *Ansul*, cited in paragraph 19 above, paragraph 43).

38 In order to examine 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 (*HIPOVITON*, cited in paragraph 35 above, paragraph 36). Furthermore, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).

39 In the present case, the written statement of the applicant's director of international purchasing and the list, presented in tabular form, of the products marketed contained indications concerning use of the mark in relation to the place (Germany), time (1993 to 1999), extent (turnover by year and by product) and the nature of the designated products (in particular, fruit juices).

40 As regards the written statement of the applicant's director of international purchasing, it must be noted that Article 76(1)(f) of Regulation No 40/94 provides, by virtue of the reference to that provision in Rule 22 of Regulation No 2868/95, that proof of use of the mark may be established by 'statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up'. It follows that it is necessary to consider the rules of the law of the Member State concerned as to the effects of a written statement only in cases where such a statement has not been sworn or affirmed. It is not disputed in the present case that the written statement of the applicant's director of international purchasing is a statement that has been affirmed and that, as such, it was held to be admissible by the Board of Appeal. Accordingly, and without it being necessary to examine its effects under German law, that statement constitutes evidence of the kind referred to in Article 76(1)(f) of Regulation No 40/94, to which Rule 22 of Regulation No 2868/95 refers.

41 However, although the affirmation and the list, presented in tabular form, of the goods marketed by the applicant may be considered to be admissible evidence, it is necessary to undertake an overall assessment of the material in the file, taking account of all the relevant factors, in order to determine whether proof of genuine use of the mark has been furnished. It should be noted in that regard that Rule 22(3) of Regulation No 2868/95 makes various types of evidence available to the parties. Furthermore, there is nothing in either Regulation No 40/94 or Regulation No 2868/95 to support the view that the evidence of the use of the mark, seen as a whole or separately, must necessarily lead the Office to conclude that proof of genuine use has been furnished.

42 In the present case, it must be held, first, that the affirmation and the list, in tabular form, of the products marketed were drawn up by the applicant itself. It should be noted in that regard that, in order to assess the evidential value of a document, regard should be had first and foremost to the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and

reliable (see, to that effect and by way of analogy, Joined Cases T-25/95, T-26/95, T-30/95 to T-32/95, T-34/95 to T-39/95, T-42/95 to T-46/95, T-48/95, T-50/95 to T-65/95, T-68/95 to T-71/95, T-87/95, T-88/95, T-103/95 and T-104/95 *Cimenteries CBR and Others v Commission* [2000] ECR II-491, paragraph 1838; see also Opinion of Advocate General Léger in Case C-57/02 P *Acerinox v Commission* [2005] not yet published in the ECR, point 202). There is nothing in either Regulation No 40/94 or Regulation No 2868/95 to support the conclusion that the evidential value of items of evidence of the use of the mark, including affirmations, must be assessed in the light of the national law of a Member State.

43 Second, at no stage of the proceedings before the Office did the applicant provide further evidence to support, in particular, the figures included in its affirmation and in its list of the products marketed.

44 The only additional evidence placed on the file comprised copies of the specimen packages of the products concerned, which did not bear any date. Even if those copies might have the effect of corroborating the ‘nature’ (fruit juice) and possibly the ‘place’ (as the wording on them was in German) of the use of the mark, they provide no evidence to corroborate the time and the extent of that use.

45 Finally, it must be observed that the additional evidence which could have supported the information contained in the affirmation — for example, invoices, catalogues or newspaper advertisements — is not of a kind which it would have been difficult for the applicant to obtain. That evidence could have been presented to the Board of Appeal, particularly as the decision of the Opposition Division had already referred to the lack of sufficient evidence as to use of the mark.

46 In the light of the above, and having regard to all the relevant factors, it must be held that the Board of Appeal was not wrong to hold that proof of the use of the earlier national mark had not been furnished.

47 The other arguments put forward by the applicant do not invalidate that assessment.

48 With respect to the fact that the Board of Appeal referred in the contested decision to *Ansul* and *Silk Cocoon*, cited in paragraph 19 above, which we said to be irrelevant in the present case, it is sufficient to point out that, contrary to what the applicant argues, the Board of Appeal did not state that those cases dealt with the issue of which documents were sufficient to prove genuine use of the mark. As is clear from paragraph 15 of the contested decision, the Board of Appeal referred to those cases only in so far as they define the concept of ‘genuine use’ within the meaning of the Community rules. That argument is thus factually incorrect.

49 With respect to the argument that the contested decision is inconsistent with earlier decisions of the Boards of Appeal of the Office, it is sufficient to note that the lawfulness of decisions of the Boards of Appeal is to be assessed purely on the basis of Regulation No 40/94, as interpreted by the Community judicature, and not of the Boards’ practice in earlier decisions (Case T-36/01 *Glaverbel v OHIM (Design applied to a sheet of glass)* [2002] ECR II-3887, paragraph 35, and Joined Cases T-79/01 and T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 32). That argument is accordingly of no effect.

50 For all the above reasons, the first plea in law must be rejected.

Infringement of the right to be heard

Arguments of the parties

- 51 The applicant contends that, inasmuch as the Board of Appeal did not indicate that it had doubts as to the reliance to be placed on the affirmation and only afforded it limited evidential value, it should first have given the applicant the opportunity of submitting observations pursuant to the second sentence of Article 73 of Regulation No 40/94. The applicant states that, in the light of a decision of another Board of Appeal in another case (*Grafenwälder/Grafenwalder*, referred to in paragraph 21 above), it was entitled to assume that the documents produced before the Office were sufficient to provide information as to the place, time, extent and nature of the use of the mark. In particular, the applicant states that it had no reasons to believe that the Board of Appeal would accord limited evidential value to the affirmation. The applicant accordingly considers that it should have been informed by the 'court' determining the matter of a legal opinion of which it was unaware and which was to form the basis of the decision of that 'court'. In those circumstances, the present case may be distinguished from that which gave rise to the judgment of the Court of First Instance in Case T-198/00 *Hershey Foods v OHIM (Kiss device with plume)* [2002] ECR II-2567), to which the contested decision refers.
- 52 For its part, the Office considers that the right to be heard extends to all the factual and legal material which forms the basis of the decision-making act, but not to the final position which the authority intends to adopt. In those circumstances, the Office considers that there was no infringement of the right to be heard by the Opposition Division and that, in any case, that body's decision cannot be the subject of an appeal before the Court of First Instance.
- 53 If, however, the plea relied upon by the applicant is intended to refer to the decision of the Board of Appeal, the Office considers that the complaint based on failure to

observe the right to be heard is incomprehensible, in that the Board of Appeal rejected the opposition for the same reason as the Opposition Division.

- 54 The intervener, for its part, considers that the Office can reach its decision only on the basis of the facts which are within the knowledge of both the parties and on which they have had an opportunity to present their comments. The assessment of the extent to which facts adduced are sufficient to prove actual and genuine use of the mark is a question of law. It is not a question of findings of fact but rather of the legal assessment of the documents produced, which the Office does not have to communicate to the parties in advance. The intervener also states that it would contravene the Office's duty of neutrality to encourage one of the parties to provide further evidence of the use of the mark.

Findings of the Court

- 55 The first point to be noted is that, by its plea based on infringement of the principle of the right to be heard, the applicant is in fact pleading a contravention of the second sentence of Article 73 of Regulation No 40/94, which provides that the decisions of the Office may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.
- 56 It must also be pointed out that the applicant stated at the hearing that that plea is intended to cover both the procedure leading to the decision of the Opposition Division and the procedure leading to the contested decision.
- 57 As regards the procedure leading to the decision of the Opposition Division, the plea was raised for the first time at the stage of the oral procedure.

- 58 The first subparagraph of Article 48(2) of the Rules of Procedure of the Court of First Instance provides that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or fact which have come to light in the course of the procedure.
- 59 In any event, by virtue of Article 63(1) of Regulation No 40/94, actions may be brought before the Community judicature only against decisions of the Boards of Appeal. It must accordingly be held that it is only pleas directed against the decision of the Board of Appeal itself which are admissible in such an action.
- 60 In so far as it relates to the decision of the Opposition Division, the plea of infringement of the second sentence of Article 73 of Regulation No 40/94 must therefore be rejected as being inadmissible.
- 61 With respect to the contested decision, even assuming that the applicant is in fact criticising the Board of Appeal for failing to annul the decision of the Opposition Division notwithstanding an alleged procedural defect which vitiates that decision, it must be held that the contested decision was right to state, at paragraph 26, that the Office is entitled when examining the file to use all the information provided by a party without first giving him the opportunity of presenting comments on that information. In any event, the Board of Appeal would not have been obliged to annul the decision of the Opposition Division on that ground alone, in the absence of any substantive illegality. Furthermore, it must be pointed out that the applicant brought an appeal before the Board of Appeal in order, in particular, to state its position as to the relevance of the material provided in order to prove genuine use of the mark in the present case, and that it was therefore heard in that regard.

62 As regards the right to be heard before the Board of Appeal itself, it must be pointed out that the assessment of the facts forms part of the decision-making act. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position which the authority intends to adopt (see, by way of analogy, Joined Cases T-129/95, T-2/96 and T-97/96 *Neue Maxhütte Stahlwerke and Lech-Stahlwerke v Commission* [1999] ECR II-17, paragraph 231). Furthermore, as has already been pointed out, as the applicant itself produced the documents in question before the Office, it plainly had the opportunity of presenting its comments on them and on their relevance. In those circumstances, the Board of Appeal was not obliged to hear the applicant in relation to the assessment of the facts on which it chose to base its decision.

63 For those reasons, the plea of infringement of the second sentence of Article 73 of Regulation No 40/94 must be rejected.

Infringement of the principle that the subject-matter of a case is delimited by the parties

Arguments of the parties

64 According to the applicant, the principle that the subject-matter of a case is delimited by the parties, which is contained in Article 74(1) of Regulation No 40/94, means that, unless the Board of Appeal had reason to doubt the reliability of the information provided by way of affirmation as the result of an observation of the intervener or contradictory indications contained in the documents, it was not entitled to dispute the information on its own initiative and to accord the affirmation only inferior evidential value.

65 In the present case, the Board of Appeal was wrong to hold that there was no infringement of Article 74(1) of Regulation No 40/94. The Board of Appeal failed to draw any conclusions from the absence of any challenge on the intervener's part to the evidence provided as to the use of the mark. Furthermore, the Board of Appeal failed to have regard to the fact that the nature and the content of that evidence had impliedly been accepted as being conclusive, as the intervener restricted the list of its products and subsequently made no further observations on the likelihood of confusion, even in the appeal proceedings. In those circumstances, there was no reason to doubt the correctness and the veracity of the evidence produced. According to the applicant, the Opposition Division therefore had no legal basis, first, on its own initiative to consider that evidence to have been challenged, second, to doubt the reliability of the information contained in the affirmation and, third, to accord it only inferior evidential value. On those grounds alone, the contested decision is vitiated by a material procedural error.

66 With regard to the question whether proof of use was established by reason of the fact that the intervener no longer challenged that use following the lodging by the applicant of the documentary evidence relating to it, the Office states that the Court has already ruled on that point in Case T-232/00 *Chef Revival USA v OHIM — Massagué Marín (Chef)* [2002] ECR II-2749. That judgment provides that it follows from Article 74(1) of Regulation No 40/94 that it is for the parties to furnish evidence in support of their applications. It does not specify an exception to that principle where no challenge is brought.

67 As regards the question whether the absence of a response may be considered as acquiescence to the facts, the Office notes that neither Regulation No 40/94 nor Regulation No 2868/95 expressly refers to such a principle. If the applicant submits no observations, the Office may rule on the opposition on the basis of the evidence available to it. The Office also states that, even where the applicant makes no response to an opposition, it has the application before it and, together with the opposition, the necessary basis for giving a decision.

68 The Office adds that, under Article 43(2) of Regulation No 40/94, where the applicant for registration of the mark has lodged a request that use of the opponent's mark be proved, the opposition must be rejected where that proof is not provided.

69 Lastly, in the light of those points, the Office states that the applicant's argument that the restriction of the application for registration represents an implied acceptance cannot be followed. According to the Office, such a restriction can be made at any time and is not connected in any way to the opposition procedure. The applicant's position in that regard is not persuasive.

70 The intervener states, for its part, that, by virtue of Article 74(1) of Regulation No 40/94, the examination of the facts by the Office is restricted to the facts, evidence and arguments provided by the parties and the relief sought. An opposition cannot therefore be rejected solely on the ground that the opponent has not proved real and genuine use, if the applicant has not challenged the use of the mark on which the opposition is based. The intervener goes on to say that, if the use of the mark on which the opposition is based is challenged at any point in the procedure, the challenge applies to the whole of the procedure, including any proceedings on appeal. It is accordingly unnecessary to respect the challenge, as it ceases to have effect only where the applicant for registration of the mark expressly withdraws it or expressly acknowledges real and genuine use of the earlier mark, which was not the case here.

71 The intervener adds that it submitted observations as to the lack of use of the mark in the proceedings before the Board of Appeal. As to the fact that, in the opposition procedure, it argued only that there was a likelihood of confusion between the marks, that does not mean that it withdrew its plea based on lack of real and genuine use. Such a withdrawal could only have been made expressly, which was not the case here.

72 As regards the restriction of the list of products referred to in its application for registration, the intervener takes the view that that restriction does not mean that it impliedly abandoned its challenge to the use of the mark. That challenge could only be withdrawn by an express statement to the Office. The intervener adds that the restriction of the list of goods and services concerned other matters and put an end to other opposition procedures.

Findings of the Court

73 The first point to be noted here is that, by the plea of infringement of the principle that the subject-matter of a case is delimited by the parties, the applicant is in fact alleging infringement of Article 74(1) of Regulation No 40/94.

74 That provision states that ‘in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in [its] examination to the facts, evidence and arguments provided by the parties and the relief sought’. The expression ‘relief sought’ extends in the present case to the application for registration of the mark and the application for opposition brought against such registration. The expression ‘facts, evidence and arguments’ extends to the factual and legal material put forward by the parties in support of their applications.

75 In this case, the Office was thus faced with two applications for relief within the meaning of Article 74(1) of Regulation No 40/94. The first, made by the intervener, was for registration of the Salvita trade mark. The second, made by the applicant, was an opposition to that registration by reason of the existence of the earlier SOLEVITA trade mark. Those two applications were supported by the facts, evidence and arguments put forward by the parties.

- 76 It must be noted in that regard that, while the wording of Article 74(1), in its French version, does not expressly refer to the production of evidence by the parties, it nevertheless follows from it that it is also for the parties to provide the evidence in support of the relief sought. That interpretation is confirmed by an analysis of other language versions of the same provision, in particular the English version, which refers to ‘the facts, evidence and arguments provided by the parties’, the German version, which refers to ‘das Vorbringen ... der Beteiligten’, and the Italian version, which refers to ‘[ai] fatti, prove ed argomenti addotti ... dalle parti’ (*Chef*, cited in paragraph 66 above, paragraph 45).
- 77 Furthermore, Article 43(2) and (3) of Regulation No 40/94 provide that, if the applicant so requests, the proprietor of an earlier trade mark who has given notice of opposition is to furnish proof that that mark has been put to genuine use or that there are proper reasons for non-use. The presentation of such a request by the applicant therefore has the effect of shifting the burden of proof to the opponent to demonstrate genuine use (or the existence of proper reasons for non-use) if it is not to have its opposition dismissed. For that to occur, the request must be made expressly and timeously to the Office. It follows that the lack of proof of genuine use can only be penalised by rejecting the opposition where the applicant has expressly and timeously requested such proof before the Office (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraphs 38 and 39).
- 78 In the present case, the intervener requested the applicant on 27 October 1999 to furnish proof of genuine use of its mark in accordance with Article 43(2) of Regulation No 40/94. It is not in dispute that that request was made expressly and timeously. It had the effect of shifting the burden of proving genuine use of the mark to the applicant.
- 79 In those circumstances, having regard to the fact that the application for registration of the Salvita trade mark was not withdrawn by the intervener, that it was for the applicant to prove genuine use of the mark and that that proof was not furnished, it

must be concluded that the Office was right to reject the application for opposition, notwithstanding the absence of any challenge on the intervener's part to the material put forward by the applicant in support of its opposition.

80 With respect to the applicant's argument that the intervener restricted the list of products referred to in its application for registration and thus impliedly took the view that proof of genuine use of the mark had been furnished, it must be pointed out that the intervener applied to restrict only the list of products falling under Class 5 of the application for a Community trade mark. Moreover, it is common ground that the opposition brought by the applicant referred only to products falling within Classes 29, 30 and 32 of the application for a Community trade mark. It follows that the restriction of the list of products referred to in the registration could not, in the present case, have any effect on the intervener's opposition. In any event, it should be recalled that it was for the applicant to provide proof that the mark in question had been put to genuine use. In the absence of such proof, and inasmuch as the application for registration of the Community trade mark lodged by the applicant was not withdrawn, the Office was entitled to reject the applicant's opposition.

81 In the light of the above, the plea of infringement of the second sentence of Article 74(1) of Regulation No 40/94 must be rejected and, accordingly, the action must be dismissed in its entirety.

Costs

82 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful and OHIM and the intervener have applied for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs.**

Vilaras

Dehousse

Šváby

Delivered in open court in Luxembourg on 7 June 2005.

H. Jung

Registrar

M. Vilaras

President

