

Alicante, 19/04/2016
R2005/2015-1

BOULT WADE TENNANT
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT
REINO UNIDO

Subject: Appeal No. R2005/2015-1 lambretta / LAMBRETTA
Your ref.: CW/CPD/T142773EM00

Notification of a decision of the Boards of Appeal

Please find enclosed the decision of the First Board of Appeal dated 22/03/2016 concerning the appeal R2005/2015-1.

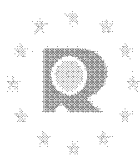
Article 65 EUTMR provides that an action may be brought before the General Court against decisions of the Boards of Appeal. The action shall be brought within two months from the date of notification of the decision of the Board of Appeal.

Please be informed that the texts governing the procedure before the General Court, in particular the Rules of Procedure and the Decision on the lodging and service of procedural documents by electronic means (e-Curia) may be consulted on the Curia website at http://curia.europa.eu/jcms/jcms/Jo2_7040/.

To the extent that you are adversely affected by the attached decision and you nonetheless decide not to challenge it, please inform us accordingly as soon as possible.

Christelle BERAT
Registry

Enc.: 1 (7 pages)



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

DECISION
of the First Board of Appeal
of 22 March 2016

In Case R 2005/2015-1

Scooters India Limited

Post Bag No 23

Sarojini Nagar

Lucknow 226 008

India

Opponent / Appellant

represented by BOULT WADE TENNANT, Verulam Gardens 70 Gray's Inn Road,
WC1X 8BT London, United Kingdom

v

Lambretta S.R.L.

Goudstraat 99

2718 RD Zoetermeer

Netherlands

IR Holder / Respondent

represented by BARDEHLE PAGENBERG - STUDIO LEGALE CASUCCI
FERRETTI STP, Viale Regina Margherita nr. 35, IT-20122 Milano, Italy

APPEAL relating to Opposition Proceedings No B 1 202 225 (International
Registration No 900 047 designating the European Union)

THE FIRST BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), Ph. von Kapff (Rapporteur) and
C. Rusconi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an international registration dated 26 September 2006 designating the European Union notified to the Office on 9 November 2006, Lambretta S.R.L. ('the IR holder') sought to protect in the European Union the word mark

lambretta

for the following list of goods:

Class 12 – Motor scooters; bicycles, mopeds, three-wheel vans;

Class 18 – Leather and imitation leather (trunks, suitcases), umbrellas, parasols, walking sticks; whips and saddlery;

Class 25 – Clothing, footwear, headgear.

- 2 On 13 November 2006, the mark applied for was republished by the Office.
- 3 On 10 August 2007, Scooters India Limited ('the opponent') filed a notice of opposition against the registration of the international registration designating the European Union for all the goods. The grounds of opposition were only those laid down in Article 8(1)(a) CTMR (double identity of the trade marks and the goods and services).
- 4 The opposition was based on the word mark

LAMBRETTA

registered as a Community trade mark under No 1 495 100 with a filing date of 7 July 2000 and a registration date of 6 August 2002, validly renewed on 20 January 2010. The opposition was based on part of the goods protected, out of which after two cancellation proceedings, namely No 2 560 C and No 4 813 C, the following goods were still valid in the present proceedings:

Class 12 – Vehicles; apparatus for locomotion by land;

Class 25 – Clothing, headgear.

- 5 At the IR holder's request, the Office suspended the opposition proceedings on 25 June 2008 because the one and only earlier right the opposition was based on, was subject to cancellation proceedings No 2 560 C, until a final decision was taken.
- 6 In those proceedings the Cancellation Division partially revoked the rights of the opponent as the proprietor of CTM No 1 495 100 by decision of 24 September

2010, as of 19 November 2007 in respect of, *inter alia*, the following goods:

Class 12 – Vehicles; apparatus for locomotion by land, air or water.

- 7 Upon the appeal of the opponent (CTM proprietor) this decision was confirmed by the First Board of Appeal with regards to the goods in Class 12 (01/12/2011, R 312/2010-1, Lambretta). At the opponent's (CTM proprietor's) appeal the General Court (30/09/2014, T-51/12, Lambretta, ECLI:EU:T:2014:844) annulled the decision of the First Board of Appeal. The judgement taken by the General Court was appealed to the Court of Justice (C-577/14 P) and is still pending.
- 8 Upon the request of the IR holder, the Opposition Division rejected opposition No B 1 202 225 as inadmissible by decision of 4 August 2015 (the 'contested decision'). It gave, in particular, the following grounds for its decision:
 - According to Article 92(2) CTMR, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the EU must be represented before the Office in accordance with Article 93(1) CTMR in all proceedings established by this Regulation, other than in filing an application for a Community trade mark.
 - The opponent does not have its domicile or principal place of business or a real and effective industrial or commercial establishment in the EU and has not appointed a representative.
 - According to Rule 17(4) CTMIR, if the notice of opposition does not comply with the provisions of Rule 15 CTMIR (other than those referred to in paragraphs 1, 2 and 3 of Rule 17 CTMIR), the Office shall inform the opponent accordingly and shall invite him/her to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before this time-limit expires, the Office shall reject the opposition as inadmissible.
 - On 25 November 2010 the opponent's representative informed the Office that it no longer represented the opponent.
 - On 10 July 2012 the Office requested the opponent to appoint a new representative and set a deadline until 22/09/2012. The opponent did not reply within the prescribed time-limit.
 - The opposition must, therefore, be rejected as inadmissible.
- 9 On 2 October 2015, the opponent filed an appeal against the contested decision, requesting that the decision be set aside in its entirety. The arguments raised in its statement of grounds submitted on 10 November 2015 may be summarized as follows:
 - The notice of opposition was compliant with Rule 15 CTMIR at the time of filing as it correctly contained the opponent's representative.

- The opponent's representative only informed the Office later that it would no longer represent the opponent.
 - The opponent appointed a new representative on 2 October 2015. Therefore there is no current ongoing failure to abide by the requirements of Article 92 CTMR.
 - Furthermore, in its decision (28/07/2015, R 3048/2014-5, RIGHTON, § 15) the Fifth Board of Appeal considered an appeal in relation to the provision of an EU representative and held that the appointment, even at the appeal stage, of a professional representative that met the territorial requirements remedied the deficiency that led the Office to adopt the contested decision.
- 10 The IR holder did not file any observations within the time-limit.

Reasons

- 11 The appeal complies with Articles 58, 59 and 60 CTMR and Rules 48 to 49 CTMR. It is, therefore, admissible.
- 12 According to Article 92(2) CTMR, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the EU must be represented before the Office in accordance with Article 93(1) CTMR in all proceedings established by this Regulation, other than in filing an application for a Community trade mark.
- 13 The opponent has its domicile in India and therefore outside the European Union. In accordance with Article 92(2) CTMR, it therefore must be represented before the Office. One of the possibilities is to appoint a professional representative in accordance with Article 93(1) CTMR.
- 14 Pursuant to Article 93(1) CTMR, professional representation of natural or legal persons before the Office may only be undertaken by:
- a) any legal practitioner qualified in one of the Member States and having his/her place of business within the EU, to the extent that he/she is entitled, within that State, to act as a representative in trade mark matters;
 - b) professional representatives whose names appear on the list maintained for this purpose by the Office. The Implementing Regulation specifies whether and under what conditions representatives before the Office must file with the Office a signed authorisation for insertion on the file.

Representatives acting before the Office must file with it a signed authorisation for insertion on the files, the details of which are set out in the Implementing Regulation.

- 15 When the opposition proceedings started in August 2007, the opponent was represented by a professional representative. However, since 25 June 2008 the

opposition proceedings were suspended. The opponent stopped being represented once the opponent's professional representative informed the Office, on 25 November 2010, that it no longer represented the opponent.

- 16 Almost two years later, on 10 July 2012, the Office requested the opponent to appoint a new representative and set a deadline until 22 September 2012. The opponent did not reply within the prescribed time-limit.
- 17 Three years later upon the request of the IR holder, the Opposition Division rejected opposition No B 1 202 225 as inadmissible by decision of 4 August 2015 because the opponent had not appointed a new representative within the prescribed time-limit set, that is on or before 22 September 2012.
- 18 When filing an appeal against the contested decision, the opponent appointed a new professional representative on 2 October 2015 and explicitly referred to that appointment in its statement of grounds of 10 November 2015.
- 19 By appointing a professional representative domiciled in the territory of the European Union, even at the appeal stage, the opponent has remedied the deficiency which led the Office to adopt the contested decision.
- 20 By appointing a professional representative, the aim of Article 92 CTMR, which consists in conducting the proceedings with a representative based in the European Union, is pursued and in particular, of having an address for notification within the European Union has been fulfilled.
- 21 It must be noted, in addition, that at the time of the contested decision, the proceedings were still suspended according to the decision of the Office of 25 June 2008 until a final decision was taken with regard to the opponent's earlier right in cancellation proceedings No 2 560 C. The reason for the suspension was still valid at the time of the contested decision as the decision in cancellation proceedings No 2 560 C had been appealed and is still, even now, pending before the Court of Justice in Case C-577/14P.
- 22 In respect of the Office's suspension decision, there was also no obvious need for the opponent to be represented before the Office until the proceedings were resumed. There was also no clear reason for the Opposition Division to resume the proceedings just to decide on the representative issue until a final decision in the cancellation proceedings was taken. This is even truer considering that the opponent was actually represented in the other parallel proceedings.
- 23 Another reason to allow the appointment of a representative before the Boards of Appeal is the effectiveness of dispute resolution. If the opposition were rejected because a representative had not been named, the opponent would have been obliged to file a request for a declaration of invalidity, if the parallel proceedings would not have led to the cancellation of the earlier trade marks. By preserving the possibility for the Opposition Division to take a decision on the substance, the Opposition Division would have contributed to ensuring that marks whose use could later successfully be challenged by means of an annulment or infringement proceedings were not registered. As the Court has already held, the reasons of

legal certainty and sound administration speak in favour of that approach (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 48 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 59).

- 24 Accepting the belated appointment of a representative is, for these reasons, in accordance with the standard practice of the Boards of Appeal. Even if the required appointment of a representative had to be made within the time-limit set by OHIM's communication of 10 July 2012, the Boards of Appeal have on many occasions agreed to remedy a lacuna of this type at the appeal stage (28/07/2015, R 3048/2014-5, RIGHTON, § 15; 05/02/2015, R 1180/2014-1, ACRIVA, § 22; 13/08/2014, R 921/2014-2, BRUNO, § 20; 11/11/2011, R 920/2011-2, LOVE, § 9; 22/03/2011, R 1629/2010-1, VINATEX, § 22; 29/02/2009, R 398/2008-4, CIRQUE ON ICE, § 11; 17/11/2009, R 430/2009-4, S-SUPERTAP, § 10; 29/04/2008, R 358/2008-2, MIRACA, § 12; 23/10/2006, R 521/2006-4, GREEN PLUS, § 30; 01/04/2008, R 83/2008-2, JAZZ BASS, § 12; 25/04/2007, R 1109/2006-1, BIZLINK, § 20; 5.03.2007, R 78/2006-4, X-Ray Tutor, § 11).
- 25 As at the time of the contested decision the proceedings before the Office were still suspended with regard to the pending cancellation proceedings concerning the earlier right, the Office did not decide on the grounds of the opposition. The decision is not a decision on the refusal of the application in the context of Article 8(1)(a) CTMR and may not, therefore, be appealed to that extent.
- 26 As a result, the contested decision must be annulled and the case is remitted to the Opposition Division for further prosecution of opposition proceedings No B 1 202 225 after a final decision is taken in cancellation proceedings in respect of the opponent's Community trade mark No 1 495 100, in line with the Opposition Division's decision to suspend the proceedings of 25 June 2008.

Costs

- 27 Even though the appeal succeeds and the contested decision is annulled and remitted to the Opposition Division, each party shall, for reasons of equity, bear its own fees and costs in accordance with Article 85(2) CTMR. While the opponent caused the present decision as it did not nominate a representative in due time before the Opposition Division, the IR holder did not file any observations during the current proceedings. The appeal fee was paid by the opponent.
- 28 For the sake of clarity and although the opponent did not raise the issue, it should be added that a refund of the appeal fee pursuant to Rule 51 CTMR does not apply as the contested decision was correct when it was taken (05/02/2015, R 1180/2014-1, ACRIVA, § 23; 29/02/2009, R 398/2008-4, CIRQUE ON ICE, § 13; 09/02/2011, R 2177/2010-2, STALLION BOOTS, § 15).

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Remits the case to the Opposition Division for further prosecution of opposition proceedings No B 1 202 225 after a final decision is taken in the cancellation proceedings in respect of the opponent's earlier Community trade mark No 1 495 100;**
- 3. Orders each party to bear its own costs as incurred in the appeal proceedings.**

Signed

Th. M. Margellos

Signed

Ph. von Kapff

Signed

C. Rusconi

Registrar:

Signed

H.Dijkema

