

ORDER OF THE COURT OF FIRST INSTANCE (Second Chamber)

3 July 2003

In Case T-10/01,

Lichtwer Pharma AG, established in Berlin, represented by H.P Kunz-Hallstein and R. Kunz-Hallstein, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (trade marks and designs) (OHIM),
represented by O. Waelbroeck and G. Schneider, acting as Agents,

defendant,

Biofarma, formerly Orsem SARL, established in Neuilly-sur-Seine (France), represented by V. Gil Vega and A. Ruiz López, lawyers,

intervener,

APPEAL against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 8 November 2000 (Case R 586/1999-2) relating to opposition proceedings between Lichtwer Pharma AG and Biofarma, THE COURT OF FIRST INSTANCE OF THE EUROPEAN COMMUNITIES (Second Chamber), makes the following

Order

1. On 26 June 1996, the applicant made an application for a Community trade mark to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (the Office), pursuant to 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 trade mark for which registration was sought is the word Sedonium.
3. The products for which registration was sought are within Classes 5 (medicines, pharmaceutical and sanitary preparations; dietetic substances adapted for medical use), 29 (dietetic substances not for medical use; food supplements) and 30 (dietetic substances not for medical use; food supplements) for the purposes of the Nice Agreement Concerning the International Classification of Goods and Services of 15 June 1957, as revised and amended.
4. The application was published in the *Community Trade Marks Bulletin* on 29 December 1997.
5. On 30 March 1998, Orsem SARL entered an opposition, under Article 42 of Regulation No 40/94, to the application for a Community trade mark for which registration is sought in respect of goods falling within Class 5, as set out in the application for registration. The earlier

mark on which the opposition is based is the word PREDONIUM registered in 1994 in several Member States in respect of goods within Class 5 for the purposes of the Nice Agreement. On 29 June 2000, Orsem merged with the intervener.

6. During the course of the opposition proceedings, the applicant restricted the list of goods contained in its application, so far as concerned goods within Class 5, to the effect that it was seeking registration of the trade mark only in respect of medicine and dietetic preparations for medical purposes, namely phytogenic soporifics and sedatives.

7. By decision of 9 July 1999, the Opposition Division refused the application for a Community trade mark under Article 43(5) of Regulation No 40/94 in respect of goods within Class 5.

8. By decision of 8 November 2000 (the contested decision), the Second Board of Appeal dismissed the appeal brought by the applicant against the decision of the Opposition Division.

9. By application lodged at the Court Registry on 22 January 2001, the applicant brought the present action.

10. On 29 March 2001, English became the language of the case, in accordance with Article 131(2) of the Rules of Procedure of the Court of First Instance.

11. By letter of 21 August 2002, the intervener informed the Court of an agreement between itself and the applicant that it would no longer object to the application for registration of the word Sedonium in respect of goods within Class 5.

12. By letter of 23 August 2002, the Office also informed the court that, by letter of 21 August 2002, it had itself been informed of the agreement between the applicant and the intervener. Furthermore, the Office points out that, since the opposition was properly withdrawn, there is no longer any need to adjudicate in the present case. So far as costs are concerned, the Office requests the Court not to order it to pay them.

13. By letter of 16 September 2002, the applicant intimated its agreement with the view that, since the opposition has been withdrawn, the present action has become devoid of purpose. Nevertheless, it states that the contested decision should be either formally annulled or declared to have no legal effect.

14. The Court finds that, in view of the withdrawal of the opposition, the present action has become devoid of purpose.

15. In that respect, it should be pointed out, first, that an opposition may be withdrawn at any time. In the first sentence of Article 44(1) of Regulation No 40/94 the legislature expressly provides for withdrawal only of Community trade mark applications. However, given that, according to the scheme of Regulation No 40/94, the applicant for a Community trade mark and the opponent are on equal footing in opposition proceedings, it must be considered that that equality also extends to the possibility of withdrawing at any procedural stage.

16. Secondly, it must be considered that, where the opposition is withdrawn in the course of proceedings before the Board of Appeal for a decision on the opposition or in the course of proceedings before the Community judicature for a decision on an appeal made to the Office against the decision on the opposition, proceedings are otiose, since they thus becomes devoid of purpose.

17. As regards the decision of the Opposition Division, the Court finds that it has not taken effect. According to the second sentence of Article 57(1) of Regulation No 40/94, appeals to the Office from decisions have suspensory effect. Accordingly, a decision such as that of the Opposition Division, against which an appeal lies, takes effect only where, within the period prescribed by the first sentence of Article 59 of Regulation No 40/94, no appeal has been lodged at the Office or such an appeal is definitively dismissed by the Board of Appeal. However, neither of those two hypotheses is the case here, given that the contested decision has not taken effect either. In that regard, it is clear from Article 62(3) of Regulation No 40/94 that decisions of Boards of Appeal take effect only after the expiry of the period referred to in Article 63(5) of Regulation No 40/94 or, where an appeal has been lodged at the Court of Justice within that period, upon the dismissal thereof. However, neither of those two hypotheses is the case here.

18. Accordingly, it suffices to declare, in accordance with Article 113 of the Rules of Procedure, that there is no longer any need to adjudicate.

Costs

19.

20. Article 87(6) of the Rules of Procedure provides that where a case does not proceed to judgment the costs are in the discretion of the Court.

21. In the circumstances of the case, it must be pointed out that the decision not to proceed to judgment is the result of an amicable settlement between the applicant and the intervener rather than of an agreement between the applicant and the defendant. Accordingly, the applicant and the intervener must be ordered to bear their own costs and to pay the costs incurred by the defendant.

On those grounds, THE COURT OF FIRST INSTANCE (Second Chamber), hereby orders:

1. There is no need to adjudicate.

2. The applicant and the intervener must be ordered to bear their own costs and to pay the costs incurred by the defendant.

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