

JUDGMENT OF THE COURT (Third Chamber)

18 July 2006 \*

In Case C-214/05 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 10 May 2005,

**Sergio Rossi SpA**, established in San Mauro Pascoli (Italy), represented by A. Ruo, avvocato,

appellant,

the other parties to the proceedings being:

**Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by O. Montalto and P. Bullock, acting as Agents,

defendant at first instance,

\* Language of the case: Italian.

**Sissi Rossi Srl**, established in Castenaso di Villanova (Italy), represented by S. Verea,  
avvocato,

intervener at first instance,

THE COURT (Third Chamber),

composed of A. Rosas, President of the Chamber, J. Malenovský (Rapporteur), J.-P. Puissechet, A. Borg Barthet and A. Ó Caoimh, Judges,

Advocate General: J. Kokott,  
Registrar: R. Grass,

having regard to the written procedure,

after hearing the Opinion of the Advocate General at the sitting on 16 March 2006,

gives the following

### **Judgment**

- <sup>1</sup> By its appeal, Sergio Rossi SpA seeks to have set aside the judgment of the Court of First Instance of the European Communities of 1 March 2005 in Case T-169/03

*Sergio Rossi v OHIM* [2005] ECR II-685 ('the judgment under appeal') by which the latter dismissed its action for annulment of the decision of the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 28 February 2003 (Case R 569/2002-1) ('the contested decision'), relating to opposition proceedings between Calzaturificio Rossi SpA, whose rights were acquired by Sergio Rossi SpA, and Sissi Rossi Srl.

## Legal context

2 Article 44(1) of the Rules of Procedure of the Court of First Instance provides:

'An application of the kind referred to in Article 21 of the Statute of the Court of Justice shall state:

...

(c) the subject-matter of the proceedings and a summary of the pleas in law on which the application is based;

(d) the form of order sought by the applicant;

(e) where appropriate, the nature of any evidence offered in support.'

3 According to the first paragraph of Article 48(2) of those Rules of Procedure:

‘No new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure.’

4 Article 8(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) provides:

‘Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.’

5 Article 73 of Regulation No 40/94 provides :

‘Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.’

6 According to Article 74 of that regulation:

‘1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.’

### **Background to the case**

7 The Court of First Instance described the background to the case as follows:

‘1 On 1 June 1998, [Sissi Rossi Srl (“Sissi Rossi”)] filed with [OHIM] an application for a Community trade mark under [Regulation No 40/94].

- 2 The mark in respect of which registration was sought is the word mark SISSI ROSSI.
  
- 3 The goods in respect of which registration was sought fall primarily within Class 18 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, and are described as follows: “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery”.
  
- ...
  
- 5 On 21 May 1999, Calzaturificio Rossi SpA filed a notice of opposition under Article 42(1) of Regulation No 40/94 to registration of the mark applied for in respect of the goods “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags”.
  
- 6 The trade marks relied on in support of the opposition are the word mark MISS ROSSI, registered in Italy on 11 November 1991 (No 553 016), and the international mark MISS ROSSI, registered on the same day with effect in France (No 577 643). The goods designated by those earlier marks are “footwear” in Class 25 of the Nice Agreement.

...

- 8 Following a merger acquisition of Calzaturificio Rossi SpA, which was recorded by a notarial act on 22 November 2000, the applicant, now called Sergio Rossi SpA, became the proprietor of the earlier marks.
  
- 9 By decision of 30 April 2002, the Opposition Division refused the application for registration in respect of all the goods covered by the opposition. It found, essentially, that the applicant had proven genuine use of the earlier marks only in relation to the goods “women’s footwear” and that those goods and the goods “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags” covered by the trade-mark application were similar. Moreover, the Opposition Division held that the marks were similar in the mind of the French consumer.
  
- 10 On 28 June 2002, [Sissi Rossi] brought an appeal against the decision of the Opposition Division before OHIM.
  
- 11 By [the contested decision], the First Board of Appeal of OHIM annulled the decision of the Opposition Division and rejected the opposition. The Board of Appeal found, essentially, that the marks in question were only vaguely similar. Moreover, having compared the distribution channels, functions and nature of the goods in question, it found that, for the most part, the differences between the goods outweighed their few common points. In particular, it examined and rejected the argument that the goods “women’s footwear” and “women’s bags” were similar because they were complementary. Therefore, there was, in its view, no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94.’

## **The proceedings before the Court of First Instance and the judgment under appeal**

- 8 By application lodged at the Registry of the Court of First Instance on 12 May 2003, Sergio Rossi SpA brought an action against the contested decision seeking principally the annulment thereof in full and in the alternative partial annulment thereof in so far as it finds that there is no likelihood of confusion between the marks with respect to ‘women’s bags’ and ‘women’s footwear’ including the word mark MISS ROSSI.
- 9 In the judgment under appeal, the Court of First Instance, first, refused to take account of certain evidence — including newspaper articles, advertisements and photographs, in particular from internet sites — produced by Sergio Rossi SpA in support of its argument that women’s footwear and women’s bags are similar goods, on the ground that those documents had not been produced during the administrative procedure before OHIM.
- 10 Concerning the application for annulment of the contested decision, the Court of First Instance held that the principal head of claim was to be dismissed and that it was necessary only to consider the claim put forward in the alternative. The Court of First Instance noted, first, that it was apparent from the application before it, in particular from the first head of claim and the oral argument put forward by the applicant, that the latter took the view that all the goods in respect of which the opposition was entered, namely ‘leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags’, on the one hand, and ‘women’s footwear’ covered by the earlier marks, on the other, were similar. It found, however, that the line of argument put forward in the application referred only to ‘women’s bags’ and ‘women’s footwear’. In the absence of any argument casting doubt on the finding of the Board of Appeal that ‘leather and imitations of leather, animal skins, hides; trunks and travelling bags’, on the one hand, and ‘women’s footwear’, on the other, were not similar, the Court of First Instance held that it was not necessary to examine the plea raised before it relating to the alleged similarity between those goods.

- 11 The Court of First Instance further held that the general reference by the applicant to all of the submissions it had put forward in the proceedings before OHIM could not make up for the lack of argument in the application. Lastly, the Court of First Instance stated that it was only at the hearing and, therefore, too late, that the applicant had claimed that all of those goods were sold through the same channels and were made of the same raw material.
- 12 Next, the Court of First Instance considered the similarities between ‘women’s bags’, covered by the application for a Community trade mark, and ‘women’s footwear’, covered by the earlier marks, and also the similarity of the signs in question, and found that there was no likelihood of confusion between the marks in question. Consequently, it dismissed the action.

### **Forms of order sought**

- 13 By its appeal, the appellant claims that the Court should:
- set aside in full the judgment under appeal;
  
  - in the alternative, set aside the judgment under appeal as regards the registration of the mark SISSI ROSSI in respect of goods such as ‘leather and imitations of leather’;
  
  - in the further alternative, once the appellant’s right to submit evidence has been upheld, set aside in full the judgment under appeal and refer the case back to the

Court of First Instance so that it may examine the evidence it held to be inadmissible or, in the alternative and pursuant to the right to present one's comments provided for in Article 73 of Regulation No 40/94, refer it back to the OHIM Board of Appeal for it to set a time-limit within which the parties may present their comments; and

— order OHIM to pay the costs.

- 14 OHIM and Sissi Rossi contend that the Court should dismiss the appeal and order the appellant to pay the costs.

### **The appeal**

- 15 In support of its claim to have the judgment under appeal set aside, the appellant relies on three grounds of appeal. The first and second grounds of appeal allege incorrect application of the Rules of Procedure of the Court of First Instance. By its third ground of appeal, which comprises two parts, the appellant alleges infringement of Article 8(1)(b) of Regulation No 40/94.

- 16 It is appropriate to begin by examining the third ground of appeal, followed by the first and second grounds of appeal.

*The third ground of appeal*

## Arguments of the parties

- 17 In the first part of the third ground of appeal, the appellant claims that the Court of First Instance made an incorrect analysis of the relevant factors for assessing the similarity of the goods concerned — and, therefore, the likelihood of confusion between the marks in question — as those factors are determined by the case-law of the Court of Justice and which include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. It refers in this connection to paragraph 23 of the judgment in Case C-39/97 *Canon* [1998] ECR I-5507.
- 18 The appellant alleges that the Court of First Instance, inter alia, ignored the fact that the end consumers of the goods are identical. Moreover, in assessing the criterion of the intended purpose of the goods, the Court of First Instance did not take due account of the aesthetic function of women's bags and women's footwear, a function which makes those goods complementary, as they must be matched in an aesthetically pleasing manner. The Court of First Instance further found that the applicant had not demonstrated, in the proceedings before OHIM, that the goods in question were usually marketed in the same sales outlets. However, the appellant was never given the opportunity during those proceedings to prove that fact.
- 19 In the second part of its third ground of appeal, the appellant claims that the Court of First Instance made an incorrect assessment of the similarity of the marks in question. It states in particular that the finding by the Court of First Instance appears to be derived from the fact that the patronymic 'Rossi' is very well known to French consumers. That statement was not supported by any objective evidence, however. According to the appellant, the finding by the Court of First Instance is incorrect because that patronymic is not widespread in France and tends to suggest an Italian family name. Moreover, even a well-known patronymic is capable of

fulfilling the function of the mark as an indication of origin and therefore of being distinctive for the goods concerned. Accordingly, the patronymic 'Rossi' should not be held to be less distinctive within France. It should be regarded as having a highly distinctive character. Lastly, the Court of First Instance could not rely on the fact that 'the applicant did not claim that the word "Rossi" was the dominant element in the mark' because at no time did the applicant maintain the contrary.

- 20 Sissi Rossi claims that the appellant is, in reality, merely challenging the assessment of the facts carried out by the Court of First Instance, without alleging any material inaccuracies in the findings made by it; this ground of appeal therefore falls outside the jurisdiction of the Court of Justice.
- 21 OHIM and, in the alternative, Sissi Rossi, also contend that the appellant's ground of appeals are unfounded.

### Findings of the Court

- 22 As to the second part of the third ground of appeal, it must be borne in mind that it is for the Court of First Instance alone to assess the value to be attached to the evidence adduced before it, and it cannot be required to give express reasons for its assessment of the value of each piece of evidence presented to it. The Court of First Instance is obliged to provide reasons which will allow the Court of Justice to exercise its judicial review; in particular they must make it possible for the Court to consider whether there has been any distortion of the evidence submitted to the Court of First Instance (see, to that effect, Case C-198/03 P *Commission v CEVA and Pfizer* [2005] ECR I-6357, paragraph 50).

- 23 Moreover, the Court of First Instance is free, in its sovereign assessment of the facts, to take account of the fact that a party has refrained from relying on certain facts.
- 24 In paragraphs 69 to 85 of the judgment under appeal, the Court of First Instance made an overall assessment of the similarity of the marks in question and the likelihood of confusion on the part of the public, taking into consideration all the relevant factors of the case. It likewise provided sufficient reasons for its findings.
- 25 As to the remainder, in criticising the Court of First Instance for having made an incorrect assessment of the relevant factors for assessing the similarity of the goods concerned and of the marks in question, the appellant is seeking, through the first and second parts of the third ground of appeal, to have the Court of Justice substitute its own assessment of the facts for that of the Court of First Instance.
- 26 It is clear, however, from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, paragraph 22, and Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975, paragraph 43).
- 27 Since the appellant has not relied upon any distortion of the facts and evidence submitted to the Court of First Instance, the first part and part of the second part of the third ground of appeal must be rejected as inadmissible.

28 Accordingly, the third ground of appeal must be rejected in its entirety.

*The first ground of appeal*

Arguments of the parties

29 The appellant claims that the Court of First Instance infringed Article 81 of its Rules of Procedure because the judgment under appeal gives no reasons for dismissing the principal head of claim.

30 The Court of First Instance could not limit the scope of the dispute to the similarity of 'women's footwear' covered by the earlier marks and 'women's bags' covered by the mark in respect of which registration is sought. First, although the arguments in support of the action before the Court of First Instance related almost exclusively to the similarity between those goods, the similarity between all of the goods covered by the mark in respect of which registration is sought and the appellant's goods was referred to several times in the application submitted to the Court of First Instance. Second, the arguments relied upon during the hearing could not be held to be inadmissible under Article 48(2) of the Rules of Procedure of the Court of First Instance as new pleas in law introduced in the course of proceedings. They were not new pleas, but rather additional arguments adduced in support of what had already been applied for in the forms of order sought in the application.

31 According to Sissi Rossi and OHIM, the Court of First Instance correctly confined its assessment to 'women's footwear' and 'women's bags' because it cannot substitute itself for the parties and, in the absence of arguments put forward by them, proceed

of its own motion with an assessment of an issue in the dispute. Moreover, although the appellant did refer at the hearing to the similarity between products other than those to which the Court of First Instance confined its assessment, it did so for the first time in those proceedings, so that the Court of First Instance rightly held that the plea was out of time.

## Findings of the Court

- 32 The title of the first ground of appeal indicates that it alleges that the judgment under appeal does not give reasons for the rejection of the principal head of claim put forward before the Court of First Instance. It is nevertheless apparent from the appeal application that the appellant is, in reality, challenging the validity of that rejection. It effectively criticises the Court of First Instance for having held that head of claim to be inadmissible on the ground that it had not put forward any argument to support it in the application itself.
- 33 It is therefore necessary to consider whether the Court of First Instance erred in law in that respect.
- 34 According to Article 44(1)(c) of the Rules of Procedure of the Court of First Instance, an application submitted to it must state the subject-matter of the proceedings and a summary of the pleas in law on which the application is based.
- 35 The Court of Justice has ruled previously on the scope of such a requirement in the context of Article 38(1)(c) of its own Rules of Procedure. It has held that the statement required must be sufficiently clear and precise to enable the defendant to

prepare its defence and the Court to exercise its power of review. It is therefore necessary for the essential matters of law and of fact on which an action is based to be indicated coherently and intelligibly in the application itself (Case C-178/00 *Italy v Commission* [2003] ECR I-303, paragraph 6, and Case C-199/03 *Ireland v Commission* [2005] ECR I-8027, paragraph 50).

36 The same applies to actions brought before the Court of First Instance, because Article 38(1)(c) of the Rules of Procedure of the Court of Justice and Article 44(1)(c) of the Rules of Procedure of the Court of First Instance have identical wording and merely reiterate a requirement laid down in Article 21 of the Statute of the Court of Justice, which is applicable to actions brought before the Court of Justice and to those brought before the Court of First Instance alike.

37 Accordingly, the Court of First Instance is obliged to reject as inadmissible a head of claim in an application brought before it if the essential matters of law and of fact on which the head of claim is based are not indicated coherently and intelligibly in the application itself. It follows that, contrary to the appellant's assertions, the failure to state such matters in the application cannot be compensated for by putting them forward at the hearing.

38 In the present case, in paragraphs 46 to 48 of the judgment under appeal the Court of First Instance rejected the principal claim on the ground that the argument put forward in the application submitted to it referred only to 'women's bags' and 'women's footwear', and that the application therefore did not present any argument casting doubt on the finding by the Board of Appeal that 'leather and imitations of leather; animal skins, hides; trunks and travelling bags' and 'women's footwear' were not similar.

39 Nor did the appellant put forward any genuine argument before this Court to demonstrate that, contrary to the finding of the Court of First Instance, the application brought before that court did refer to matters of law and of fact in support of that claim.

40 Since that claim was inadmissible, it is apparent that the appellant was, in reality, putting forward a new plea by relying on matters of law or of fact at the hearing which had the same purpose as that claim. Under Article 48(2) of the Rules of Procedure of the Court of First Instance, no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. As the appellant has not alleged that that was the case, the Court of First Instance rightly rejected that plea on the ground that those matters were submitted out of time.

41 As the Court of First Instance did not make by an error of law, the first ground of appeal must be rejected.

### *The second ground of appeal*

#### Arguments of the parties

42 The appellant submits in the main that, in finding the evidence it submitted to be inadmissible, the Court of First Instance failed to have regard to Article 44(1)(e) of its Rules of Procedure, which allows evidence to be offered.

43 It claims that the Court of First Instance relied on its own case-law on this point but referred to circumstances different from those of the present case. The judgments referred to by the Court of First Instance related to cases where the applicants had had their arguments initially rejected by OHIM — and therefore could have challenged before the OHIM Board of Appeal the counter-arguments put forward to justify that rejection — whereas, in the present case, as the Opposition Division had

ruled in favour of the appellant, the arguments of the OHIM Board of Appeal came to light for the first time only in the contested decision, so that the appellant did not have the opportunity to challenge the findings by OHIM against it at any point during the administrative procedure.

44 In the alternative, the appellant alleges infringement of Article 73 of Regulation No 40/94 on the ground that, during the proceedings before the Board of Appeal, it was not given the opportunity to give its views on whether or not there is similarity between the goods concerned.

45 Contrary to what was held by the Court of First Instance, the allegation of failure to comply with Article 73 should not have been considered to be a new plea put forward for the first time at the hearing, but was merely an elaboration of the plea in support of which certain evidence was offered at the same time as the action was brought before the Court of First Instance.

46 Under that provision, the appellant should in any case have had the opportunity to challenge the arguments put forward for the first time by OHIM. Since it was not possible to do so during the administrative procedure, the Court of First Instance, seised of an action challenging the decision of the OHIM Board of Appeal, should have chosen one of two options: to allow evidence to be put forward before it or to annul the contested decision and refer the case back to the Board of Appeal so as to give the appellant the opportunity to challenge the arguments put forward for the first time in that decision.

47 Sissi Rossi and OHIM contend that the Court of First Instance was right to hold that the disputed evidence was inadmissible, for the reasons stated in the judgment under appeal.

- 48 With respect to the alternative plea, Sissi Rossi expressed doubts as to its admissibility, on the ground that the appellant alleges infringement of Article 73 of Regulation No 40/94 by the Board of Appeal and not by the Court of First Instance.
- 49 In any event, the Court of First Instance rightly held that the plea alleging infringement of that provision was inadmissible. The appellant was, moreover, given sufficient opportunity to put forward its views during the procedure before OHIM.

### Findings of the Court

— The complaint alleging infringement of Article 44(1)(e) of the Rules of Procedure of the Court of First Instance

- 50 First of all, under Article 63 of Regulation No 40/94, a decision of an OHIM Board of Appeal may be annulled or altered only on grounds of lack of competence, infringement of an essential procedural requirement, failure to comply with the EC Treaty, with Regulation No 40/94 or with any rule of law relating to their application, or misuse of power. Accordingly, the review of that decision by the Community Courts is confined to a review of the legality of that decision, and is thus not intended to re-examine the facts which were assessed within OHIM.
- 51 Second, it follows from Article 74(1) of that regulation that, in proceedings relating to refusal of registration, such as those in this case, OHIM is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

52 Since OHIM could not take into account facts which were not put forward before it by the parties, the lawfulness of its decisions cannot be challenged on the basis of such facts. It follows that the Court of First Instance, likewise, cannot take account of evidence intended to prove those facts.

53 Contrary to what the appellant maintains, the fact that the Board of Appeal relied on evidence adduced before OHIM to draw conclusions different from those reached by the Opposition Division is irrelevant in this respect, because the appraisal of the evidence conducted by that Board could, in any event, be challenged before the Court of First Instance.

54 Moreover, as rightly held by the Court of First Instance, if the appellant was of the view that the Board of Appeal, in breach of the second sentence of Article 73 of Regulation No 40/94, had deprived it of the opportunity to put forward certain relevant evidence in a timely manner during the administrative procedure, it should have put forward such a plea in support of its application for annulment of the contested decision. However, any infringement by the Board of Appeal of the appellant's right to present its comments does not mean that the Court of First Instance is obliged to proceed with its own assessment of facts and evidence which were not put forward previously before OHIM.

— The complaint that there was an error of law by the Court of First Instance regarding the alleged infringement of Article 73 of Regulation No 40/94 by the Board of Appeal

55 As a preliminary point the Court finds that, contrary to what Sissi Rossi maintains, this complaint is admissible because the appellant alleges that the Court of First Instance made an error of law by failing to confirm the alleged infringement of Article 73 of Regulation No 40/94 by the Board of Appeal.

56 As to whether this complaint is well founded, it must be borne in mind that, according to the first paragraph of Article 48(2) of the Rules of Procedure of the Court of First Instance, no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which came to light in the course of the procedure.

57 The appellant does not deny that, in its application to the Court of First Instance, it did not allege that the Board of Appeal had infringed the second sentence of Article 73 of Regulation No 40/94, this complaint having been raised for the first time at the hearing. Likewise, it does not deny that evidence offered in support of that complaint was already in existence and was known to it at the time it lodged its application at the Registry of the Court of First Instance.

58 In those circumstances, the Court of First Instance did not make an error of law in failing to confirm the alleged infringement of the second sentence of Article 73 of Regulation No 40/94.

59 The second ground of appeal must accordingly be rejected.

## **Costs**

60 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM and Sissi Rossi have applied for costs and the appellant has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Third Chamber) hereby:

- 1. Dismisses the appeal;**
- 2. Orders Sergio Rossi SpA to pay the costs.**

[Signatures]