

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

24 November 2005 *

In Case T-135/04,

GfK AG, established in Nuremberg (Germany), represented by U. Brückmann and R. Lange, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by T. Lorenzo Eichenberg, acting as Agent,

defendant,

* Language of the case: German.

the other party to the proceedings before OHIM being

BUS — Betreuungs- und Unternehmensberatungs GmbH, established in Munich (Germany),

APPLICATION for annulment of the decision of the First Board of Appeal of OHIM of 4 February 2004 (Case R 327/2003-1), relating to opposition proceedings brought by the owner of a German figurative mark, composed of the word 'BUS' and a figure made up of three interlaced triangles, against the registration of the Community word mark Online Bus for services in Class 35,

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

composed of H. Legal, President, P. Lindh and V. Vadapalas, Judges,

Registrar: C. Kristensen, Administrator,

having regard to the application lodged at the Court Registry on 8 April 2004,

having regard to the response lodged at the Court Registry on 29 September 2004,

further to the hearing on 8 June 2005,

gives the following

Judgment

Background to the dispute

- 1 On 15 November 1999 the applicant submitted an application for a Community trade mark to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark (OJ 1994 L 11, p. 1), as amended.
- 2 The trade mark in respect of which registration was sought was the word mark Online Bus.
- 3 Registration was requested for services covered by Class 35 of the Nice Agreement on the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponding to the following description: 'drawing up statistics in the fields of economics, marketing, market research and market analysis, business consultancy, organisation consultancy, professional business consultancy, news agency services in the field of economics'.

- 4 The application was published in *Community Trade Marks Bulletin* No 57/2000 of 17 July 2000.
- 5 On 6 October 2000, BUS — Betreuungs- und Unternehmensberatungs GmbH brought opposition proceedings against the registration of the mark applied for in respect of all the services to which the trade mark application related. The company based its opposition on the likelihood of confusion with its German trade mark, registered on 12 September 1988 for, inter alia, 'business consultancy', covered by Class 35, and protecting the figurative sign reproduced below:



- 6 The applicant having requested that proof of the use of the earlier trade mark be submitted, pursuant to Article 43(2) and (3) of Regulation No 40/94, the other party to the proceedings before OHIM furnished proof of the use of the sign reproduced below:



- 7 By decision of 25 February 2003 the Opposition Division upheld the opposition.
- 8 On 29 April 2003, the applicant filed an appeal with OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94, against the Opposition Division's decision.
- 9 By decision of 4 February 2004 (Case R 327/2003-1), notified to the applicant on 13 February 2004 ('the contested decision'), the First Board of Appeal of OHIM rejected the appeal. It considered, first, that the figurative element made up of interlaced triangles and the word 'bus' were the two distinctive elements of the earlier trade mark. The use of the sign, which had been proven, had not undermined the distinctive character of the registered trade mark. Next, the Board of Appeal found that, although there was little similarity between the trade marks at issue at the visual level, they were similar aurally, which, given the high degree of similarity between the services in question, provided proof of a likelihood of confusion on the part of the relevant German public.

Forms of order sought

- 10 The applicant claims that the Court should:
- annul the contested decision;
 - reject the opposition of the other party to the proceedings before OHIM;
 - order OHIM to pay the costs.

Admissibility

14 By its second head of claim, the applicant is essentially asking the Court to order OHIM to reject the opposition against the registration of its trade mark.

15 It is appropriate to recall in that regard that, under Article 63(6) of Regulation No 40/94, OHIM is required to take the measures necessary to comply with judgments of the Community Courts. Accordingly, it is not for the Court of First Instance to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part of the Court's judgments (see the judgment of the Court of First Instance in Case T-164/03 *Ampafrance v OHIM — Johnson & Johnson (monBeBé)* [2005] ECR I-1401, paragraph 24, and the case-law cited). The applicant's second head of claim is therefore inadmissible.

Merits

16 The applicant raises two pleas in support of its action. The first alleges an infringement of Article 15(2)(a) and Article 43(2) of Regulation No 40/94. The second is based on an infringement of Article 8(1)(b) of the same regulation.

The first plea, alleging an infringement of Article 15(2)(a) and Article 43(2) of Regulation No 40/94

Arguments of the parties

- 17 The applicant claims that, as the trade mark was not used in the form in which it had been registered, the opposition should be rejected on the basis of the second sentence of Article 43(2) of Regulation No 40/94.
- 18 The relevant provision for assessing the use, in a different form from that registered, of the German trade mark relied on in this instance is Paragraph 26(3) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German law on trade marks, BGBl. 1994 I, p. 3082 and BGBl. 1995 I, p. 156, 'the Markengesetz'), transposing into German law Article 10(2) of the 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 applicant also cites a judgment of 13 April 2000 of the Bundesgerichtshof (Federal Court of Justice) (Germany) on the interpretation of the abovementioned provisions of the Markengesetz.
- 19 In this instance, the applicant submits that the distinctive elements of the sign used differ from those of the registered trade mark.
- 20 First, the sign used does not contain the words 'Betreuungsverbund für Unternehmer und Selbständige e.V.' The failure to include those words means that the public will not understand the meaning of the word 'bus', which is the acronym of the previous owner of the earlier mark.

- 21 Next, in the registered sign the word 'bus' is written in black lettering and situated under the figurative element made up of three interlaced triangles, while, in the sign used, it is in white lettering in a different font, written in black rectangles and placed to the left of the symbol in question. In that context, account should be taken of the fact that, since the earlier trade mark is a figurative mark, the typographical presentation of the word 'bus' is itself protected. Consequently, its owner does not have as much discretion to use it in a different form as, for example, in the case of a word mark.
- 22 Lastly, the colour of the figurative element made up of three interlaced triangles is different in the sign used and this sign also includes an extra figurative element, namely, a black square.
- 23 All these differences alter the distinctive character of the trade mark relied upon, so that the public would not associate it with the sign used.
- 24 OHIM points out that Regulation No 40/94 does not contain any express provisions on the use, in a different form from that registered, of a national mark cited in support of the opposition. However, Article 10(2)(a) of Directive 89/104 includes a harmonised provision, similar to Article 15(2)(a) of Regulation No 40/94. Thus, it is necessary to apply that harmonised provision, in accordance with Article 15(2)(a) of Regulation No 40/94 or the corresponding provision of Directive 89/104. Use of national legislation is precluded, as the Community trade mark regime is an autonomous system
- 25 The distinctive character of the earlier trade mark relied on in this instance is not altered at all in the form in which it is used. The removal of the element 'Betreuungsverbund für Unternehmer und Selbständige e.V.' is insignificant, because this element is not only of secondary importance at the visual level, but

also constitutes a descriptive reference. The representation of the word 'bus' and the figurative element made up of three interlaced triangles in negative form is acceptable as a current variation of the form registered, which has no effect on its distinctive character. The addition of a black square is insignificant, since it is a basic geometrical figure.

- 26 Finally, taking account of the objective of Article 15(2)(a) of Regulation No 40/94, a margin of flexibility should be available to the owner of a trade mark when using it, in order to adapt the representation of the protected sign to the norms of advertising graphics and the style of the period.

Findings of the Court

- 27 Under Article 43(2) of Regulation No 40/94:

'If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community ... In the absence of proof to this effect, the opposition shall be rejected.'

- 28 Article 43(3) of the same regulation makes that provision applicable to earlier national marks, substituting use in the Member State where the earlier national mark is protected for use in the Community.

29 Pursuant to Article 15(2)(a) of Regulation No 40/94, use of the Community trade mark includes 'use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered'.

30 In this instance, given that the trade mark invoked in support of the opposition is a national trade mark, the subject of the first plea must first be clarified: in reality the applicant alleges that the Board of Appeal infringed the combined provisions of Article 43(2) and (3) of Regulation No 40/94.

31 Next, it must be stated that, by virtue of the combined application of Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94, proof of genuine use of an earlier national or Community trade mark on which opposition proceedings against an application for a Community trade mark are based also includes proof of use of the earlier mark in a form that differs in respect of elements which do not alter the distinctive character of that trade mark in the form registered (see, to this effect, the judgment of the Court of First Instance in Case T-156/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO AIRE)* [2003] ECR II-2789, paragraph 44).

32 Consequently, the reference made by the applicant to national law is not relevant.

33 Having regard to those considerations, it is appropriate to consider whether the form used of the earlier trade mark contains differences which alter its distinctive character.

- 34 Firstly, the two forms of the earlier mark, namely, that registered and that used, include the word 'bus' and a figurative element made up of three interlaced triangles, whose distinctive character is not disputed by the parties.
- 35 As regards the different presentation of those elements in the form used, neither the typography of the word 'bus' nor the colours of the earlier trade mark, black and white, are particularly original or unusual in either of the two forms of the earlier trade mark. The variation of them is thus not such as to affect the distinctive character of that trade mark.
- 36 Secondly, so far as concerns the reference 'Betreuungsverbund für Unternehmer und Selbständige e.V.', it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see, to that effect, Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraphs 33 to 35).
- 37 In the present case, the reference in question is a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive.

38 That conclusion is not called into question by the applicant's argument that the removal of the element in question renders meaningless the word 'bus', which constitutes the acronym of the former owner of the earlier mark. The parties agree that the word 'bus' has an intrinsic distinctive character. Even assuming that the relevant public were to notice that it may also constitute an acronym, its distinctive character is not affected by the removal of the explicative element.

39 Nor is that conclusion weakened by the argument, advanced by the applicant at the hearing, that the words at issue refer to the former owner of the sign and, thus, individualise the earlier trade mark. Even if it is conceded that the words refer to the name of the trade mark's former owner, that fact would have no effect on the assessment of that element's descriptive content and of its place in the visual presentation of the sign, which, here, support the conclusion that the element lacks distinctive character.

40 Concerning, lastly, the black square in the form used, which is absent in the registered form, it is a basic geometrical figure and, for that reason, has no distinctive character. That conclusion is not influenced by its position in the form used.

41 It follows from the foregoing that the form used of the earlier trade mark used does not contain any differences such as to alter the distinctive character of that trade mark for the purpose of the combined provisions of Article 15(2)(a) and Article 43 (2) and (3) of Regulation No 40/94. The Board of Appeal was, therefore, fully entitled to hold that use of the opponent's trade mark had been proven.

42 Consequently, the first plea must be rejected.

The second plea, based on an infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

- 43 The applicant submits that the Board of Appeal was wrong in considering the earlier trade mark to be dominated by the word 'bus', common to both signs, and the signs at issue to be similar.
- 44 Firstly, the earlier trade mark contains other distinctive elements which characterise the overall impression it creates. In particular, the earlier trade mark's figurative element depicts an elaborate graphical shape, with a strong distinctive character. In some cases, only the figurative element of the earlier trade mark is used by the other party to the proceedings before OHIM. It is thus at least as important as the word 'bus'. The element 'Betreuungsverbund für Unternehmer und Selbständige e.V.' is important since it explains the meaning of the acronym 'bus'.
- 45 Secondly, the word 'bus', by itself, is not capable of characterising the earlier trade mark because of its weak distinctive character, having regard to the services concerned. A number of trade marks containing the word 'bus' are registered in class 35 and, on the internet, the word 'bus' is very often used with the term 'marketing'.
- 46 Thus, the signs at issue are not similar. At the visual level, the earlier trade mark is characterised by the figurative element, which is missing in the trade mark applied

for. At the aural level, the word mark applied for, 'Online Bus', is considerably longer and, therefore, different from the word 'bus' in the earlier trade mark. Furthermore, as the word 'online' is situated at the beginning of the word sign, it should be accorded more importance at the aural level. As regards the conceptual point of view, the word 'bus' in the earlier trade mark suggests a means of public transport, while the sign Online Bus refers to the field of computing. Thus, the concepts of the signs at issue are also different.

47 OHIM contends, citing the judgment in *MATRATZEN* (paragraphs 33 and 34), that the overall impression created by a complex trade mark may be dominated by a single element. The similarity of the signs at issue follows from the concordance of the dominant element.

48 As regards the aural comparison of the signs at issue, the Board of Appeal rightly conceded that they were highly similar, the word 'bus' being dominant in each of them.

49 The applicant's argument designed to demonstrate the weak distinctive character of the word 'bus' was submitted for the first time before the Board of Appeal and is out of time for the purpose of Article 74(2) of Regulation No 40/94.

50 Moreover, it was not substantiated in the application. The list of registered trade marks containing the word 'bus' does not constitute appropriate evidence, since the weakening of distinctive character can only be a consequence of trade marks that have been used. The internet search as to the combined use of the terms 'bus' and 'marketing' does not furnish such proof. First, only a small part of the services at

issue relate to marketing. Secondly, it does not show whether the word ‘bus’ is used on the internet as a means of distinguishing the services at issue. Lastly, the search includes the bus transport sector, with which this case is not concerned, and it is not limited to Germany, which constitutes the relevant territory.

- 51 The signs at issue are also similar at the visual and conceptual levels.
- 52 Concerning the visual comparison, the earlier trade mark is not characterised visually by its figurative element. Generally, the public refer to the words in complex trade marks. In the present case, the value that may be attached to the figurative element is at best comparable to that of the dominant verbal element ‘bus’.
- 53 Concerning the conceptual comparison, the term ‘bus’ constitutes, in both signs, a current abbreviation in Germany for Autobus or Omnibus. In this respect, by analogy with the judgments of the Court of First Instance in Cases T-186/02 *BMI Bertollo v OHIM — Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 58, and T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 36, there is a conceptual similarity between the signs at issue.

Findings of the Court

- 54 Under Article 8(1)(b) of Regulation No 40/94, the trade mark applied for shall not be registered if, because of its identity or similarity to an earlier trade mark and the

identity or similarity of the goods or services covered by the earlier trade mark and the trade mark applied for, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

- 55 According to settled case-law, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the signs and the goods or services in question and taking into account all factors relevant to the circumstances of the case, in particular, the interdependence between the similarity of the signs and the similarity of the goods or services designated (see the judgment of the Court of First Instance in Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraph 33, and the case-law cited).
- 56 In the present case, the parties dispute neither the definition of the relevant public used by the Board of Appeal nor the finding of a high degree of similarity between the services in question (paragraphs 25 and 26 of the contested decision). On the other hand, the applicant claims that the trade marks at issue are not similar and that there is no likelihood of confusion between them. The examination of the present plea must therefore be limited to those two aspects.
- 57 According to settled case-law, the global assessment of a likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, concerning the interpretation of Directive 89/104, the judgments of the Court of Justice in Cases C-251/95 *SABEL* [1997] ECR I-6191, paragraphs 22 and 23, and C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

- 58 In the case in point, it should be pointed out that one of the components of the signs at issue, namely the word 'bus', is identical.
- 59 It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).
- 60 The Board of Appeal considered (paragraph 22 of the contested decision) that the word 'bus' constituted the dominant element of the trade mark applied for and one of the dominant elements of the earlier trade mark.
- 61 The applicant contends that the word 'bus' is not very distinctive in relation to the services in question and therefore does not, by itself, characterise the signs at issue.
- 62 It relies, firstly, on the submission presented for the first time at the hearing, that the term 'bus' refers to a type of survey used when carrying out market research.
- 63 However, that submission of fact, which had not previously been raised before any of the bodies of OHIM, may not be taken into account by the Court of First Instance. It

follows from Article 74(1), in fine, of Regulation No 40/94, under which, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought, that it is not required, of its own motion, to take into consideration facts which were not put forward by the parties (judgment in Case T-296/02 *Lidl Stiftung v OHIM — REWE-Zentral (LINDENHOF)* [2005] ECR I-563, paragraph 31). It follows that no contention of illegality on the part of OHIM may be made regarding matters of fact which were not submitted to it.

64 Secondly, the applicant quotes the results of searches carried out on the internet as well as on the Cedexlex trade marks database. OHIM contends that that evidence, presented for the first time before the Board of Appeal, was submitted out of time.

65 According to the case-law, the Boards of Appeal may, subject only to Article 74(2) of Regulation No 40/94, allow the appeal on the basis of new facts relied on by the party who has brought the appeal or on the basis of new evidence adduced by that party (judgment in Case T-308/01 *Henkel v OHIM — LHS (UK) (KLEENCARE)* [2003] ECR II-3253, paragraph 26). Therefore, the evidence in question is admissible.

66 However, the searches submitted by the applicant are not sufficient to establish that the distinctive character of the term 'bus' has been weakened with regard to the services concerned.

67 As regards the list of results obtained using the Google search engine, showing that the term 'bus' is very often found on the internet next to the term 'marketing', such a

search, defined by very general criteria, is not enough to prove that there is an association between those two terms on the part of the relevant public. In fact, it contains no information as to the use of the term ‘bus’ in the relevant territory to allow the services at issue to be distinguished.

- 68 As regards the search of the Cedelex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.
- 69 The other words in the earlier trade mark, ‘Betreuungsverbund für Unternehmer und Selbständige e.V.’, have no distinctive character and are therefore insignificant in the overall impression produced by that trade mark (see paragraphs 37 to 39 above).
- 70 The word ‘online’ in the trade mark applied for cannot be regarded as the distinctive element. It is, in fact, a well-known term, associated with internet communication. To the extent that that form of communication may be used for the provision of the services in question, the term is descriptive. According to settled case-law, the public will not, generally, consider a descriptive element forming part of a complex mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM — Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II-3471, paragraph 34, and the case-law cited).

- 71 If follows from the foregoing that the Board of Appeal was able to lawfully find that the word 'bus' constituted the dominant verbal element in each of the two signs at issue.
- 72 The signs at issue should be compared in the light of those considerations.
- 73 Concerning the visual comparison, it should be noted that the Board of Appeal considered, in paragraph 20 of the contested decision, that the earlier mark was characterised by the verbal element 'bus' as well as by its figurative element made up of three interlaced triangles. That assessment is not inconsistent with the applicant's argument that the figurative element of the earlier mark is at least as distinctive as the word 'bus'.
- 74 Although there is a visual difference between the signs at issue, which must be taken into account during the global assessment of the likelihood of confusion, this difference does not affect the fact that there is a visual similarity created by the identical word 'bus', which constitutes the dominant element of the trade mark applied for and, at the visual level, one of the dominant elements of the earlier trade mark.
- 75 Concerning the aural comparison, it must be concluded, taking account of the one identical dominant word in the signs at issue ('bus'), that they possess a high degree of aural similarity.

76 Concerning the conceptual comparison, the Board of Appeal correctly took the view that a conceptual comparison of the signs at issue was not possible.

77 Although the applicant maintains that the sign Online Bus refers to the field of computing, that reference is linked to the word 'online' in the trade mark applied for. As that word has no distinctive character within the trade mark applied for, it cannot determine its underlying concept.

78 The Court cannot uphold the applicant's argument that the earlier mark refers to the concept of an autobus, and there is no need to take a view on OHIM's argument that a like reference characterises both signs. It is common ground that the services concerned have no link whatsoever with public transport. Even if it is indeed the case that the conceptual analysis of a sign is not invalidated by the fact that the meaning of that sign bears no relation to the services concerned, the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the circumstances, in view of the nature of the services in question, the relevant public will not spontaneously associate the word 'bus' with a means of public transport.

79 Finally, as regards the global assessment of the signs at issue, it is possible that the mere aural similarity between two trade marks may create a likelihood of confusion (*Lloyd Schuhfabrik Meyer*, paragraph 28, and Case T-99/01 *Mystery Drinks v OHIM — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 42).

80 In the light of all the preceding considerations and, in particular, of the high degree of similarity between the services in question and the high degree of aural similarity between the trade marks at issue, the mere visual difference between those trade marks created by the presence of the figurative element in the earlier mark is not such as to preclude a likelihood of confusion in the present case. The relevant consumer, faced by the trade marks in question, will remember only the word 'bus', which is present in both trade marks and dominates their pronunciation. Therefore, the Board of Appeal correctly concluded that there was a likelihood of confusion between the trade marks at issue.

81 As a result, the second plea cannot be upheld.

82 Accordingly, the application must be rejected in its entirety.

Costs

83 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 has applied for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

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

Legal

Lindh

Vadapalas

Delivered in open court in Luxembourg on 24 November 2005.

E. Coulon

Registrar

H. Legal

President