

Case T-215/03

Sigla SA

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)

(Community trade mark — Opposition proceedings — Application for the Community word mark VIPS — Earlier national word mark VIPS — Article 8(5) of Regulation (EC) No 40/94 — Article 74 of Regulation (EC) No 40/94 — Principle that the parties delimit the subject-matter of the proceedings — Rights of the defence)

Judgment of the Court of First Instance (Fifth Chamber), 22 March 2007 . . . II - 719

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

3. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

4. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

5. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(1)(b) and 8(5))

6. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

7. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

8. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark with a reputation*
(Council Regulation No 40/94, Art. 8(5))

9. *Community trade mark — Appeals procedure*
 (Council Regulation No 40/94, Arts 62(1) and 74)

1. Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, must be interpreted as meaning that it may be relied on in support of an opposition lodged against an application for a Community trade mark covering goods and services which are not identical and not similar to those described by the earlier mark as well as against an application for a Community trade mark covering goods which are identical or similar to those of the earlier mark. That article cannot be given an interpretation which would lead to marks with a reputation having less protection where a sign is used for identical or similar goods or services than where a sign is used for non-similar goods or services.

earlier registered mark with a reputation as against non-similar goods or services, allows, inter alia, the proprietor of the earlier mark to oppose registration of marks liable to be detrimental to the distinctive character of the earlier mark. That detriment can occur where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. That risk thus refers to the 'dilution' or 'gradual whittling away' of the earlier mark through the dispersion of its identity and its hold upon the public mind. However, the risk of dilution appears, in principle, to be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used, irrespective of the earlier mark consisting of the term at issue. In such a case, reuse of the term in question by the mark applied for is less likely to result in a dilution of the earlier mark.

(see paras 32, 33)

2. Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an

(see paras 37, 38)

3. Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, allows, *inter alia*, the proprietor of the earlier mark to oppose registration of marks liable to be detrimental to the distinctive character of the earlier mark. Such detriment is made out where the goods or services covered by the mark applied for may appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished. The risk of that detriment can, *inter alia*, occur where those goods or services have a characteristic or a quality which may have a negative influence on the image of an earlier mark with a reputation on account of its being identical or similar to the mark applied for.

unfair advantage taken of the distinctive character or the repute of the earlier mark by the use without due cause of the mark applied for encompasses instances where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, this concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation. That last type of risk must be distinguished from the likelihood of confusion covered by Article 8(1)(b) of Regulation No 40/94. In cases covered by Article 8(5) of Regulation No 40/94, the relevant section of the public makes a connection, that is to say, establishes a link, between the marks at issue without, however, confusing them. Therefore, the existence of a likelihood of confusion is not a condition for the application of that provision.

(see para. 39)

(see paras 40, 41)

4. Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, allows, *inter alia*, the proprietor of the earlier mark to oppose registration of marks liable to take unfair advantage of the distinctive character or reputation of the earlier mark. The concept of the

5. The difference between the risk of unfair advantage being taken, within the meaning of Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, and the likelihood of confu-

sion within the meaning of Article 8(1)(b) of that regulation, may be summarised as follows: there is a likelihood of confusion where the relevant consumer may be attracted by the product or service covered by the mark applied for by considering it to be a product or service with the same commercial origin as that covered by an earlier mark which is identical or similar to the mark applied for. By contrast, the risk that the use without due cause of the mark applied for would take unfair advantage of the distinctive character or the repute of the earlier trade mark continues to exist where the consumer, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears that mark, which is identical or similar to an earlier mark with a reputation.

(see para. 42)

of an earlier mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark or to take unfair advantage of that repute or distinctive character. In that connection, the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment.

In the case of an opposition based on a mark with an exceptionally high reputation, it is possible that the probability of a future, non-hypothetical risk of detriment to or unfair advantage being taken of the mark cited in opposition by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it cannot be assumed that this is always the case.

6. The purpose of Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services, is not to prevent registration of any mark which is identical or similar to a mark with a reputation. The objective of that provision is, notably, to enable the proprietor

(see paras 46, 48)

7. The existence of a link between the mark applied for and the earlier mark is an

essential condition for the application of Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides for extensive protection of an earlier registered mark with a reputation as against non-similar goods or services. The harm referred to in that provision, where it occurs, is the consequence of a certain degree of similarity between the mark applied for and the earlier mark, by virtue of which the public concerned makes a connection between them, that is, establishes a link between them. The existence of that link must be appreciated globally, taking into account all factors relevant to the circumstances of the case. In that regard, the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it.

drink prepared for consumption; self-service restaurants, canteens, bars, cafeterias' in Class 42 of that Agreement is not, in the absence of other relevant evidence, sufficient to establish prima facie proof of a non-hypothetical risk that the use of that sign will be detrimental to the distinctive character or reputation of the earlier mark or take unfair advantage of it within the meaning of Article 8(5) of Regulation No 40/94 on the Community trade mark.

(see para. 47)

8. The existence of a connection between the services covered by the word mark VIPS for which registration as a Community trade mark is sought, including 'computers and computer programs recorded on tapes and disks'; 'business consultancy; services relating to the processing of data recorded by computer'; and 'computer programming for hotel services, restaurants, cafés' in Classes 9, 35 and 42 of the Nice Agreement, and the services covered by the word mark VIPS, registered earlier in Spain for 'services in procuring food and

First, since the term 'VIPS' is the plural form, in English, of the abbreviation VIP, which is widely and frequently used both internationally and nationally to describe famous personalities, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark is limited. That same risk is also even less probable in the present case as the mark applied for covers services which are directed at a special and necessarily more limited public. The connection allegedly existing between the services covered by the two marks at issue is not relevant in that context, as dilution of the identity of a mark with a reputation does not depend

on the goods and services covered by that mark being similar to those covered by the mark applied for.

Second, the services covered by the mark applied for do not have any characteristic or quality capable of establishing the likelihood of detriment to the earlier mark by use of the mark for which registration is sought. The mere existence of a connection between the services covered by the conflicting marks is neither sufficient nor determinative. It is true that the existence of such a connection strengthens the probability that the public, faced with the mark applied for, would also think of the earlier mark. However, that factor is not, in itself, sufficient to diminish the earlier mark's power of attraction. Such an outcome can arise only if it is established that the services covered by the mark applied for have characteristics or qualities which are potentially detrimental to the reputation of the earlier mark.

Lastly, the risk of unfair advantage being taken of the distinctive character or the repute of the earlier mark would occur only if the relevant public, without confusing the origin of the services covered by the conflicting marks, were particularly attracted to applicant's software solely because it is covered by a mark which is identical to the earlier mark with a reputation. In the absence of an explanation by the applicant of the particular characteristics which it claims

its earlier mark has and of the way in which those characteristics are capable of facilitating the marketing of the services covered by the mark applied for, the characteristics normally associated with a mark with a reputation for a fast food chain cannot be considered in themselves to be such as to bring any advantage to computer programming services, even those intended for hotels or restaurants.

(see paras 61-64, 67, 71-73)

9. Through the effect of an appeal against a decision allowing an opposition brought before a Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), that board is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact.

Where the Board of Appeal considers that one of the relative grounds for refusal put forward by the opposing party in his opposition and upheld by the Opposition Division in its decision is not well founded, the new, full examination of the merits of the opposition referred to in the previous paragraph necessarily entails an examination by the

Board of Appeal, before annulling the Opposition Division's decision, of whether it may be possible to uphold the opposition on the basis of another relative ground for refusal, which was

put forward by the opposing party before the Opposition Division but was rejected or not examined by it.

(see paras 96, 97)