

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

4 May 2005 *

In Case T-22/04,

Reemark Gesellschaft für Markenkooperation mbH, established in Hamburg (Germany), represented by P. Koch Moreno, lawyer,

applicant,

v

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

defendant,

* Language of the case: English.

the other party to the proceedings before the Board of Appeal at OHIM having been

Bluenet Ltd, established in Limerick (Ireland),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 17 November 2003 (Case R 238/2002-2), concerning opposition proceedings brought by the proprietor of the trade mark West against the application for registration of the trade mark Westlife,

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

composed of J. Pirrung, President, N.J. Forwood and S. Papasavvas, Judges,
Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Court Registry on 21 January 2004,

having regard to the response lodged at the Court Registry on 18 May 2004,

further to the hearing on 18 January 2005,

gives the following

Judgment

Facts

- ¹ On 12 May 1999, BMG Music filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), 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 mark Westlife.
- ³ The goods and services in respect of which registration of the trade mark was sought fall within the following classes 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:

 - Class 9: ‘Sound storage media, image storage media and data storage media, all being pre-recorded; sound storage media, image storage media and data storage media, including such for interactive use’;

- Class 16: ‘Printed matter, newsletters, books, brochures, posters, decals, bumper stickers; musical notes and scores’;
- Class 25: ‘Clothing including T-shirts, sweatshirts, jackets, hats, and baseball caps’;
- Class 41: ‘Entertainment services provided by a musical band, including television programs, radio programs and electronic publishing; providing information relating to music, concerts, artists, and entertainment services, both via the Internet and other communications networks; organising of concerts and other performances’.

⁴ The application was published in *Community Trade Marks Bulletin* No 22/2000 of 20 March 2000.

⁵ On 20 June 2000, the applicant filed a notice of opposition against the trade mark applied for in respect of all the goods and services to which the application related. The opposition was based on the earlier German word mark No 39 743 603, West, and its earlier international word mark No 700 312, West. As regards the German trade mark, the opposition concerned the following goods and services:

- ‘photographic, cinematographic and optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound and images;

magnetic data carriers, phonograph records, automatic vending machines; data processing equipment and computers', falling within Class 9;

- 'paper, cardboard and goods made from these materials (included in this class); printed matter, bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in this class); playing cards; printer's type; printing blocks', falling within Class 16;
- 'clothing, including sportswear, footwear, headgear, scarves, cravats, stockings, braces', falling within Class 25;
- 'education and entertainment, especially organisation and realisation of festivals, festivities and music events', falling within Class 41.

⁶ On 1 February 2001, the other party to the proceedings before the Board of Appeal, Bluenet Ltd, became the successor in title to BMG Music for the purposes of the trade mark application.

⁷ By decision of 25 January 2002, the Opposition Division of OHIM, first, refused to take the earlier international trade mark into account on the ground that the opponent had failed to provide the evidence pertaining to it and, second, rejected

the trade mark application for the goods and services in Classes 9, 16, 25 and 41 on the ground that the two conflicting signs as well as the goods or services in question were identical or similar.

- 8 On 15 March 2002, the other party to the proceedings before the Board of Appeal brought an appeal against the Opposition Division's decision.
- 9 The Second Board of Appeal of OHIM, by decision of 17 November 2003 (Case R 238/2002-2, 'the contested decision'), set aside the decision of the Opposition Division and rejected the opposition.
- 10 The Board of Appeal held that the goods and services concerned were partly similar and partly identical (paragraph 16 of the contested decision). However, it found that there was a low degree of visual and aural similarity between the signs at issue and that there was only a degree of similarity between them from a conceptual point of view (paragraphs 19, 20 and 21 of the contested decision). Thus, in making its global assessment of the two marks, it concluded that the differences between the mark applied for and the earlier German mark were sufficiently significant to enable the marks to coexist in the market place. It therefore found that there existed no likelihood of confusion between them, within the meaning of Article 8(1)(b) of Regulation No 40/94, on the part of the public in the territory in which the earlier trade mark is protected (paragraph 22 of the contested decision).

Procedure and forms of order sought

- 11 The other party to the proceedings before the Board of Appeal did not lodge any written observations at the Court within the prescribed period. Having initially stated, by letter of 24 June 2004, that it intended to be present at the hearing, it

subsequently informed the Court, on 12 January 2005, that it no longer intended to do so. It must be held that that party has not participated in the proceedings before the Court of First Instance within the meaning of Article 134(1) of the Court's Rules of Procedure, particularly since it has neither proposed its own form of order nor stated that it was supporting the form of order sought by either of the other parties. It must therefore be found that it does not have the status of an intervener before the Court.

¹² The applicant claims that the Court should:

- annul the contested decision on the ground that it does not comply with Article 8(1)(b) of Regulation No 40/94;
- declare that there is a likelihood of confusion between the trade mark applied for, Westlife, and the German trade mark, West;
- order OHIM to pay the costs.

¹³ OHIM, expressly stating that it is obliged to seek the following form of order, formally requests the Court to:

- dismiss the application;
- order the applicant to pay the costs.

Law

Arguments of the parties

- ¹⁴ The applicant puts forward a single plea in law, alleging there is a likelihood of confusion between the conflicting trade marks within the meaning of Article 8(1)(b) of Regulation No 40/94. In its submission, the Board of Appeal erred in so far as it found that there was no likelihood of confusion in the circumstances of this case between the trade mark applied for, Westlife, and the trade mark West, which is registered in Germany.
- ¹⁵ OHIM concurs, in essence, with the arguments advanced by the applicant. However, in its response it formally contends that the application should be dismissed because, in its view, the case-law of the Court of First Instance obliges it to do so. It refers in that regard to the judgments in Case T-110/01 *Vedial v OHIM — France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 16 et seq., and Case T-99/01 *Mystery Drinks v OHIM — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 14 et seq.

Findings of the Court

The formulation of the form of order sought by OHIM

- ¹⁶ It must be stated at the outset that, in proceedings concerning an action brought against a decision of an OHIM Board of Appeal adjudicating in opposition

proceedings, OHIM does not have power to alter, by the position which it adopts before the Court of First Instance, the terms of the dispute, as delimited in the respective claims and contentions of the applicant for registration and of the opposing party (Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraphs 26 to 38, upholding on appeal the judgment in *HUBERT*, cited at paragraph 15 above).

- ¹⁷ However, contrary to the assertion made by the Office in its response, it does not follow from those decisions that OHIM is obliged to claim that an action brought against a decision of one of its Boards of Appeal should be dismissed. As the Court of First Instance held in its judgment in Case T-107/02 *GE Betz v OHIM — Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, while OHIM does not have the requisite capacity to bring an action against a decision of a Board of Appeal, it cannot, however, be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed (paragraph 34 of the judgment).
- ¹⁸ OHIM, although it cannot alter the terms of the dispute may, therefore, claim that the form of order sought by whichever one of the parties it may choose should be allowed and may put forward arguments in support of the pleas in law advanced by that party. However, it cannot independently seek an order for annulment or put forward pleas for annulment which have not been raised by the other parties (see, to that effect, the judgment in *HUBERT*, cited at paragraph 15 above, paragraph 24).
- ¹⁹ In this instance, OHIM stated clearly both in its response and at the hearing that it wishes to support the form of order sought, and the pleas in law advanced, by the applicant. It expressly stated that it was formally requesting that the action be

dismissed solely because it considered itself obliged to do so in view of the case-law of the Court of First Instance. Since, for the reasons set out in the foregoing paragraphs, that analysis does not reflect the law as it currently stands, it is appropriate to reformulate the form of order sought by OHIM and deem OHIM to have pleaded in essence that the applicant's claim be allowed. Following that reformulation, there is no inconsistency between the form of order sought and the arguments advanced in the response.

Substance

- 20 It must first of all be observed, that under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, a trade mark is not registered '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.'
- 21 By virtue of settled case-law, the likelihood of confusion as to the commercial origin of the goods or services must be assessed globally, according to the perception which the relevant public has of the signs and of the goods or services in question and taking into account all factors characterising the particular case, in particular the interdependence between the similarity of the signs and that of the goods or services identified (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 29 to 33, and the cases cited).

- 22 As regards the definition of the relevant public in this case, the applicant and OHIM concur that it consists, at the very least, of average German consumers. It is apparent from the terms of the contested decision that the Board of Appeal also used that definition.
- 23 Further, the finding of the Board of Appeal that the goods covered by the trade marks in question are partly identical and partly similar has not been challenged by the parties represented before the Court.
- 24 However, the applicant and OHIM challenge the finding in the contested decision that the degree of similarity between the two signs at issue was not sufficient to give rise to a likelihood of confusion. They submit that the conflicting signs are sufficiently similar to give rise to a likelihood of confusion on the part of the relevant public, regard being had to the identity or similarity of all the goods and services covered.
- 25 In the light of the foregoing, it is necessary to examine whether the mark applied for, Westlife, and the earlier mark, West, are sufficiently similar to create a likelihood of confusion on the part of the average German consumer with regard to the commercial origin of the goods and services concerned, in view of the fact that the latter are identical or similar.
- 26 It is clear from the case-law that the global assessment of the likelihood of confusion between the trade marks must, as regards the visual, aural or conceptual similarity of the signs in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

- 27 Here, the sign Westlife is composed of two words joined together, the word 'west' and the word 'life'. Thus, 'west' is one of two terms which alone form the mark applied for, Westlife, and the only term forming the earlier mark, West.
- 28 In relation to conceptual similarities, both trade marks evoke the idea of the West, since they both contain the element 'west'. As to the second component of the mark applied for, the Board of Appeal rightly stated that the word 'life' may be recognised by the relevant public as being the English for the German word 'Leben' and, accordingly, as a term with an identifiable meaning rather than a made-up name.
- 29 Thus, the 'life' component, associated with the other term comprising the mark ('west'), may be taken by the relevant public as a reference to a lifestyle.
- 30 The addition of the connotation concerning lifestyle is not sufficient to distinguish the two trade marks significantly in conceptual terms. Since both marks will be perceived as evoking western goods or services in the case of West or as pertaining to a western lifestyle in the case of Westlife, they both have similar connotations, which entails a degree of similarity from the conceptual point of view.
- 31 As regards the aural similarities, the Board of Appeal relied on the fact, stated at paragraph 28 above, that 'life' is an English word which may be recognised as such by the average German consumer. Thus, it stated that if the second component of

the mark applied for is recognised as an English word, ‘it cannot be excluded as unlikely’ that the mark as a whole, including the term ‘west’, which exists in English as well as in German, will be pronounced in an English way by the average German consumer. By contrast, the mark West will be pronounced in a German way, i.e. in the same way as the word ‘vest’ would be pronounced following the rules of English or French pronunciation.

- ³² The phrase ‘it cannot be excluded as unlikely’ is not at all emphatic, in fact so little so that it suggests, a contrario, that there is also a real possibility of the average German consumer pronouncing the ‘west’ component of the mark applied for, Westlife, in the German way, in which case there would be a real aural similarity between the two marks.
- ³³ Although it is likely that some of the consumers making up the relevant public will pronounce the ‘west’ element of the mark applied for, Westlife, in the English way, the fact none the less remains that other consumers will pronounce it in the German way. In those circumstances, there is a degree of aural similarity between the two marks, despite the presence of the ‘life’ element in the mark applied for, Westlife.
- ³⁴ Visually, there is no question that there is a degree of similarity between the marks at issue because the earlier trade mark, West, is the first component of the mark applied for, Westlife. Furthermore, since the two marks are word marks, they are both written in a non-stylised way for the purposes of any assessment of their visual similarity. Thus, the average consumer, who must normally rely on his imperfect mental image of the trade marks (see, by analogy, *Lloyd Schuhfabrik Meyer*, paragraph 26 above, paragraph 26), could confuse the marks in question from a visual perspective.

- ³⁵ It must be concluded that the conflicting signs are therefore visually similar, without, however, it being possible to say that there is a very high degree of visual similarity between them.
- ³⁶ If the two signs concerned are assessed globally, neither of the elements ‘west’ or ‘life’ emerges clearly as the dominant element of the trade mark applied for in this instance. In that regard, it would be artificial to consider ‘west’ to be dominant because it forms the first element of the mark applied for but there is no reason to consider the ‘life’ element to be dominant either. Although it is true that ‘west’ is a German word as well as an English word, whilst ‘life’ is only an English word, and thus foreign from the perspective of the relevant public, ‘west’ is not descriptive of either the goods and services in question or even their qualities.
- ³⁷ It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (*Case T-286/02 Oriental Kitchen v OHIM — Mou Dybfrost (KIAP MOU)* [2003] ECR II-4953, paragraph 39).
- ³⁸ In this instance one of the two words which alone constitute the word mark applied for is actually identical in appearance to the sole word forming the earlier word mark. Aurally, there is a degree of similarity, although the pronunciation of the word ‘west’ is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the Westlife mark mean something to the relevant public but they do not describe either the goods or services in question or their qualities and therefore do not have any particular connotation in relation to them.

- 39 Although the approach described at paragraph 37 above is not therefore directly applicable in this case, it must none the less be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.
- 40 It must therefore be held, in this case, that the fact that the Westlife trade mark consists exclusively of the earlier West trade mark, to which another word, 'life', has been added, is an indication that the two trade marks are similar.
- 41 However, the Court must reject the applicant's argument that the Westlife sign could be perceived by the relevant public as deriving from its trade mark West, since that argument is based on the fact that the applicant purports to be the proprietor not only of the West mark but also of other marks composed of the word 'west', to which a further element is added. In fact, the applicant based its opposition before the Opposition Division on only two earlier WEST word marks, one German and the other international (see, to that effect, Case T-237/01 *Alcon v OHIM — Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraphs 61 and 62, upheld on appeal by order of the Court of Justice of 5 October 2004 in Case C-192/03 P *Alcon v OHIM* [2004] ECR I-8993).
- 42 On the other hand, the existence of the earlier West trade mark may have created an association in the mind of the relevant public between that term and the products marketed by its owner, with the result that the new trade mark consisting of 'West' in combination with another word might well be perceived as a variant of the earlier mark. Therefore, the relevant public might think that the origin of the goods and services marketed under the Westlife mark is the same as that of the goods and

services marketed under the West mark, or at least that there is an economic link between the various companies or undertakings which market them (see, to that effect, Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57).

- 43 In the light of all of the foregoing and in view of the fact, which is not disputed here, that the goods and services in question are identical or similar, the Court finds that there is a likelihood of confusion between the two trade marks within the meaning of Article 8(1)(b) of Regulation No 40/94.
- 44 Consequently, the contested decision must be annulled. As to the applicant's second claim, it is sufficient to state that it is subsumed within the claim for annulment based on infringement of Article 8(1)(b) of Regulation No 40/94.

Costs

- 45 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. As OHIM has been unsuccessful, in that the Board of Appeal's decision is annulled, it must be ordered to pay the applicant's costs, in accordance with the form of order sought by the applicant, notwithstanding the reformulation, at paragraph 19 above, of the form of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 17 November 2003 (Case R 238/2002-2);**

- 2. Orders OHIM to bear its own costs and to pay those incurred by the applicant.**

Pirrung

Forwood

Papasavvas

Delivered in open court in Luxembourg on 4 May 2005.

H. Jung

Registrar

J. Pirrung

President