

Case T-168/04

L & D, SA

v

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

(Community trade mark — Opposition proceedings — Earlier figurative marks representing a fir tree including, in certain cases, verbal elements — Application for figurative mark containing the verbal element 'Aire Limpio' — Likelihood of confusion — Article 8(1)(b) and Article 73 of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 7 September 2006 II - 2703

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 registered for identical or similar goods or services*
(Council Regulation No 40/94, Art. 8(1)(b))

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 registered for identical or similar goods or services*
(Council Regulation No 40/94, Art. 8(1)(b))
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 registered for identical or similar goods or services*
(Council Regulation No 40/94, Art. 8(1)(b))
4. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Scope*
(Council Regulation No 40/94, Arts 7 and 8(1)(b))
5. *Community trade mark — Procedural provisions — Statement of reasons for decisions — Article 73 of Regulation No 40/94 — Article 1, Rule 50(2)(h) of Regulation No 2868/95*
(Art. 253 EC; Council Regulation No 40/94, Art. 73; Commission Regulation No 2868/95, Art 1, Rule 50(2)(h))
6. *Community trade mark — Procedural provisions — Decisions of the Office — Observance of the rights of the defence*
(Council Regulation No 40/94, Art. 73)

1. In the context of the examination of an opposition brought, on the basis of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, by the proprietor of an earlier mark, the particularly distinctive character of that mark can be regarded as acquired because of its prolonged use and its being well known as part of another registered trade mark, in so far as the target public perceives the mark as

indicating the origin of the goods from a specific undertaking.

(see para. 74)

2. In the context of the examination of an opposition brought on the basis of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, by the proprietor of an earlier mark, data subsequent to the date of filing of the application for a Community trade mark can be taken into account where it enables the drawing of conclusions on the situation as it was on that date. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark concerned was used during the relevant period.

within Class 5 of that Agreement, in view of, first, the similarity of the goods in question and the visual and conceptual similarity of the marks in question and, secondly, the fact that the earlier mark has a particularly distinctive character in Italy.

(see paras 100, 102)

(see para. 81)

4. The absolute grounds for refusal referred to in Article 7 of Regulation No 40/94 on the Community trade mark do not fall to be examined as part of opposition proceedings and that article is not one of the provisions in relation to which the legality of the decision allowing the opposition must be appraised.

(see para. 105)

3. There exists, for the average Italian consumer, a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, between the figurative sign which represents the silhouette of a fir tree and includes the verbal element 'aire limpio', in respect of which registration as a Community trade mark is sought for 'Perfumery, essential oils' and 'Scented air fresheners products' falling within Classes 3 and 5 of the Nice Agreement, and the figurative mark which represents a fir tree, registered earlier as a Community trade mark for goods falling

5. Under Article 73 of Regulation No 40/94 on the Community trade mark, the decisions of the Office for Harmonization in the Internal Market (Trade Marks and Designs) are to state the reasons on which they are based. Similarly, Rule 50(2)(h) of Regulation No 2868/95 implementing Regulation No 40/94 provides that the Board of Appeal's decision is to contain the reasons for the decision. The duty to

state reasons thus laid down is the same as that arising from Article 253 EC. The statement of reasons required by that provision must show in a clear and unequivocal manner the reasoning of the author of the act. That duty has two purposes: to allow interested parties to know the justification for the measure so as to enable them to protect their rights and to enable the Community judicature to exercise its power to review the legality of the decision.

(see paras 113, 114)

6. Under Article 73 of Regulation No 40/94 on the Community trade mark, decisions of the Office for Harmonization in the Internal Market (Trade Marks and Designs) may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. That provision relates both to factual and legal reasons and to evidence. However, the right to be heard extends to the factual and legal factors on which the decision-making act is based, but not to the final position which the authority intends to adopt.

(see paras 115-116)