

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

1 February 2005\*

In Case T-57/03,

**Société provençale d'achat et de gestion (SPAG) SA**, established in Marseille (France), represented by K. Manhaeve, lawyer, with an address for service in Luxembourg,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by U. Pfléghar and G. Schneider, acting as Agents,

defendant,

the other parties to the proceedings before the OHIM Board of Appeal, intervening before the Court of First Instance, being

\* Language of the case: German.

**Frank Dann** and **Andreas Backer**, residing in Frankfurt am Main (Germany),  
represented by P. Baronikians, lawyer,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 5  
December 2002 (Case R 1072/2000-2), relating to opposition proceedings  
concerning the marks HOOLIGAN and OLLY GAN,

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

composed of J. Pirrung, President, N.J. Forwood and S. Papasavvas, Judges,  
Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance  
on 20 February 2003,

having regard to the response lodged by OHIM at the Registry of the Court on  
12 September 2003,

having regard to the response lodged by the intervener at the Registry of the Court  
on 12 September 2003,

further to the hearing on 28 September 2004,

gives the following

## Judgment

### Background to the dispute

- 1 On 1 April 1996 Frank Dann and Andreas Backer ('the interveners') filed an application for a Community trade mark at 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 HOOLIGAN.
- 3 The products in respect of which registration of the trade mark was sought were in Class 25 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 correspond to the following description: 'clothing and headgear'.
- 4 The application was published in the *Community Trade Marks Bulletin* No 65/98 of 31 August 1998.

- 5 On 30 November 1998 the Société provençale d'achat et de gestion (SPAG) SA ('the applicant') filed a notice of opposition against the registration pursuant to Article 42 of Regulation No 40/94 for all the products referred to in the application, on the basis of two earlier marks of which it is the rightholder, namely:
- the international word mark OLLY GAN No 575552, with effect inter alia in Germany, Spain, Italy and Portugal, covering inter alia clothes in Class 25;
  - the French word mark OLLY GAN No 1655245, covering inter alia clothes in Class 25.
- 6 On 26 May 1999 the interveners requested the applicant to submit proof of genuine use of the earlier marks on which the opposition was based.
- 7 By decision of 15 September 2000, the Opposition Division of OHIM upheld the opposition on the grounds that, in France and in Portugal, there was a likelihood of confusion due to the identical nature of the products covered by the marks in conflict and the phonetic and, consequently, conceptual similarity between the word marks at issue.
- 8 On 9 November 2000, the interveners filed a notice of appeal against the Opposition Division's decision with OHIM.
- 9 By decision of 5 December 2002 (Case R 1072/2000-2) ('the contested decision'), the Second Board of Appeal of OHIM annulled the Opposition Division's decision.

- 10 The Board of Appeal found essentially that the average French or Portuguese consumer was aware of the usual meaning of the English word 'hooligan' and its spelling and pronounced the marks in conflict in a different manner. The Board of Appeal concluded that there was no visual, phonetic or conceptual similarity between the marks in conflict and that, accordingly, there was no likelihood of confusion between the marks in conflict.

### **Forms of order sought**

- 11 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

- 12 OHIM and the interveners contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

## **Admissibility of the matters of fact and law put forward before the Court of First Instance**

### *Arguments of the parties*

13 OHIM submits, as a preliminary point, that it is not for the Court of First Instance, as part of the examination of the legality of the contested decision, to reconsider the factual circumstances in the light of evidence adduced for the first time before it. Likewise, since the applicant did not contest before the Board of Appeal the identical nature of the products in question, the use of the marks, the relevance of only the French and Portuguese markets, and the lack of visual similarity between the marks in conflict, and since the first time it put forward argument concerning the highly distinctive character of the earlier marks in question was before the Court of First Instance, such matters may no longer be raised before the Court of First Instance without thereby changing the subject-matter of the dispute contrary to Article 135 (4) of the Rules of Procedure of the Court of First Instance.

14 The applicant submits that the argument relating to the conceptual meaning of the mark OLLY GAN had already been put forward before OHIM. It leaves in the hands of the learned Court the issue of the admissibility of fresh evidence adduced before it but asks that the same approach be adopted for fresh evidence lodged by the interveners.

### *Findings of the Court*

15 Article 63 of Regulation No 40/94 provides:

'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

3. The Court of Justice has jurisdiction to annul or to alter the contested decision.

4. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.

...'

<sup>16</sup> Article 74 of Regulation No 40/94 provides:

'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.'

- 17 It should be borne in mind that the purpose of actions before the Court of First Instance under Article 63(2) of Regulation No 40/94 is to obtain a review of the legality of decisions of the Boards of Appeal (see, to that effect, Case T-247/01 *eCopy v OHIM (ECOPY)* [2002] ECR II-5301, paragraph 46; and Case T-311/01 *Éditions Albert René v OHIM — Trucco (Starix)* [2003] ECR II-4625, paragraph 70, and the case-law cited therein). In the context of Regulation No 40/94, Article 74 thereof requires that that review must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (see, by analogy, Case T-194/01 *Unilever v OHIM (ovoid tablet)* [2003] ECR II-383, paragraph 16).
- 18 It should also be borne in mind that it follows from the principle of continuity of functions between the different bodies of OHIM that, in matters within the scope of Article 74 of Regulation No 40/94, the Board of Appeal is required to base its decision on all the matters of fact and of law contained in the decision contested before it which the party concerned introduced either in the proceedings before the department which heard the application at first instance or, subject only to Article 74(2), in the appeal. In particular, the extent of the examination which the Board of Appeal must conduct is not, in principle, determined solely by the grounds relied on by the party who has brought the appeal (see, to that effect, Case T-308/01 *Henkel v OHIM — LHS (UK) (KLEENCARE)* [2003] ECR II-3253, paragraphs 29 and 32).
- 19 As regards the factual context, it follows from Article 74(2) of Regulation No 40/94 that it is for the parties to produce before OHIM in due time the matters of fact on which they intend to rely. 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.
- 20 Accordingly, matters of fact which are relied on before the Court of First Instance without having been submitted previously before any of the bodies of OHIM must be dismissed (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 in Case C-192/03 P *Alcon v OHIM* [2004] ECR II-8993; Case T-128/01 *DaimlerChrysler v OHIM (Grille)* [2003] ECR II-701, paragraph 18; Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BLIDMEN)* [2003] ECR II-2251, paragraph 67; Case T-85/02 *Díaz v OHIM — Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 46; and Case T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13).

- 21 As regards the legal framework, the Court observes that, in proceedings relating to relative grounds for refusal, the very wording of Article 74(1) *in fine* of Regulation No 40/94 requires that the examination carried out by OHIM be restricted to the facts, evidence and arguments provided by the parties and the relief sought. Thus, the Board of Appeal, when hearing an appeal against a decision terminating opposition proceedings, may base its decision only on the relative grounds for refusal on which the party concerned has relied and the related facts and evidence it has presented (see Case T-185/02 *Ruiz-Picasso and Others v OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 28 and case-law cited therein). The criteria for applying a relative ground for refusal or any other provision relied on in support of arguments put forward by the parties are naturally part of the matters of law submitted for examination by OHIM. It should be borne in mind in this regard that a matter of law may have to be ruled on by OHIM even when it has not been raised by the parties if it is necessary to resolve that matter in order to ensure a correct application of Regulation No 40/94 having regard to the facts, evidence and arguments provided by the parties. Thus the matters of law put forward before the Board of Appeal also include any matters of law which must necessarily be examined for the purpose of assessing the facts and evidence relied on by the parties and for the purpose of allowing or dismissing the arguments, even if the parties have not put forward a view on those matters and even if OHIM has omitted to rule on that aspect. Likewise, if it is alleged that OHIM has committed an irregularity in dealing with the parties' arguments, such as, for example, breach of the *audi alteram partem* rule, that alleged irregularity also forms part of the legal framework of the case.

- 22 It follows that the matters of law relied on before the Court of First Instance which have not been raised previously before the bodies of OHIM, in so far as they relate to

a matter of law which it was not necessary to resolve in order to ensure a correct application of Regulation No 40/94 having regard to the facts, evidence and arguments provided by the parties, cannot affect the legality of a decision of the Board of Appeal relating to the application of a relative ground for refusal, since they do not form part of the legal framework of the dispute as it was brought before the Board of Appeal. They are, consequently, inadmissible. By contrast, when a rule of law must be upheld or a matter of law must be ruled upon in order to ensure a correct application of Regulation No 40/94 having regard to the facts, evidence and arguments provided by the parties, a matter of law relating to that issue may be relied upon for the first time before the Court of First Instance.

- 23 Lastly, it should be borne in mind that such rules on the admissibility of matters of fact also apply to OHIM and to interveners appearing before the Court of First Instance, pursuant to Article 134 of the Rules of Procedure (see, regarding evidence adduced by an intervener, Case T-10/03 *Koubi v OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraph 52). As regards matters of law, interveners are subject to the same rules on admissibility as applicants. The principle of equality of arms requires that applicants and interveners before the Court of First Instance have the same means at their disposal.
- 24 In the present case, the Court notes that the applicant did not submit observations before the Board of Appeal. OHIM submits that the Court of First Instance can no longer examine matters which were not put forward before the Board of Appeal relating to the identical nature of the products in question, the geographical areas for which proof of genuine use of the earlier marks was adduced, the relevance of the geographical areas retained for the analysis and the lack of visual similarity between the marks in conflict. For the reasons set out in paragraph 18 above, this argument cannot be accepted.
- 25 The Court finds that those matters were part of the factual and legal framework before the Board of Appeal. All of those matters were dealt with by the Opposition Division in its decision, in response to the arguments of the parties or of its own motion, since those issues necessarily had to be resolved in order to rule in the

opposition proceedings. Accordingly, the Board of Appeal necessarily based, or should have based, its decision on all matters of fact and of law which led to the decision contested before it. Such matters may therefore be debated as to their merits before the Court of First Instance.

- 26 However, as regards the high degree of distinctiveness of the earlier marks, both inherently and in terms of how well known they are, on which the applicant relies, it is clear that, in the light of the case-file before OHIM, the applicant never relied on that high degree of distinctiveness before OHIM, either before the Opposition Division or, a fortiori, before the Board of Appeal, since the applicant was not present before that Board.
- 27 The Court has held in that connection that the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether there is a likelihood of confusion (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 24 and operative part). In that case the Court gave the proper interpretation of Article 4(1)(b) of 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 wording of which is largely comparable to that of Article 8(1)(b) of Regulation No 40/94. Moreover, the seventh recital in the preamble to Regulation No 40/94 states that the assessment of the likelihood of confusion depends, in particular, on ‘the recognition of the trade mark on the market’.
- 28 However, Regulation No 40/94 differs from that directive in that the legislature included in it rules governing the activity of the administrative unit in charge of marks and the rights and obligations of persons intervening before that administrative unit. Thus, under Article 74(1) *in fine* of that regulation, the examination of relative grounds for refusal is restricted to the facts, evidence and arguments provided by the parties. Under Article 74(2) of the same regulation, OHIM may disregard facts which are not submitted or evidence which is not submitted in due time by the parties concerned. Since reliance on a high degree of distinctiveness constitutes a plea containing a mixture of fact and of law, a distinction must be drawn according to whether or not OHIM is able to rule on the arguments of the parties, having regard to the evidence they have submitted.

29 Turning, first, to the distinctive character resulting from the fact that the earlier marks are well known, the Court notes that that character has been relied on by the applicant solely for the purposes of the assessment of the likelihood of confusion for the purposes of Article 8(1)(b) of Regulation No 40/94.

30 Under Article 74 of Regulation No 40/94, it is for OHIM to examine any plea relating to the distinctive character of a mark owing to its reputation. However, if a party has failed either to rely on the reputation of earlier marks or to adduce evidence in support of that reputation, OHIM cannot be criticised for not having ruled on that aspect of its own motion. First, since the reputation of a mark is largely a purely conjectural matter, it is for the parties to provide sufficient precision in their argument in order to enable OHIM to rule on their argument in a comprehensive manner. Second, the assessment of reputation is based, in principle, on matters of fact which it is for the parties to present. If the party bringing the opposition proceedings intends to rely on the fact that its mark is well known, it is required to put forward facts and, if necessary, evidence to enable OHIM to determine the truth of such a claim (Case T-66/03 '*Drie Mollen sinds 1818*' v OHIM — *Nabeiro Silveira (Galáxia)* [2004] ECR II-1765, paragraph 32).

31 Accordingly, the Court finds that OHIM was not required to examine the reputation of the earlier marks in question because that reputation was not part of the opposition proceedings brought before it. The applicant's plea relating to the reputation of its earlier marks and the evidence relating thereto must therefore be dismissed as inadmissible.

32 Turning, second, to the inherent distinctive character of an earlier mark, the Court finds, conversely, that OHIM was required to examine that matter, if necessary of its own motion, once opposition proceedings had been brought. Unlike reputation, the assessment of intrinsically distinctive character does not presuppose any matter of fact which is up to the parties to establish. Moreover, that assessment does not

require the parties to provide facts, arguments or evidence tending to establish that inherent distinctive character; since OHIM alone is able to detect and assess the existence thereof having regard to the earlier mark on which the opposition is based.

- 33 It follows, in the present case, that the inherent distinctive character of the applicant's earlier marks in the assessment of the likelihood of confusion was one of the matters of law which had to be resolved in order to ensure a correct application of Regulation No 40/94 having regard to the facts, arguments and evidence put forward by the applicant before OHIM. Consequently, the applicant's argument relating thereto must be examined on its merits.
- 34 Lastly, as regards the matters of fact put forward for the first time before the Court of First Instance, OHIM has not identified annexes to the application which are relevant to an aspect other than the reputation of the earlier marks already dismissed above. However, it is apparent from the case-file that Annexes A 7 and A 8, which show that the connotation of hooligan suggested by the earlier marks OLLY GAN has already been noted, are specifically intended to demonstrate the incorrectness of the Board of Appeal's finding that the marks in question are conceptually different. Although those annexes support the analysis of the matters of fact and of law contained in the contested decision, they were not submitted to OHIM. Accordingly, those annexes are not part of the factual framework put forward before the Board of Appeal and are therefore inadmissible.
- 35 Likewise, it is proper to dismiss the new facts put forward by the interveners, namely results of a search on the internet site Google, because that evidence was not adduced during the administrative procedure before OHIM. Similarly, the interveners' statement that the mark for which registration is sought has a highly distinctive character because of its intensive use must also be dismissed, because that argument was not put forward before OHIM.

## Substance

### *Arguments of the parties*

- 36 According to the applicant, it is common ground that the products covered by the marks in conflict are identical.
- 37 It submits that the marks in conflict do carry a certain visual similarity because they both contain the letters 'ol' and end with the syllable 'gan'.
- 38 It states that the marks are phonetically identical or very similar. It contests the relevance of the pronunciations given by the French and Spanish dictionaries referred to by the Board of Appeal on the grounds, first, that the French word is 'houligan' and, second, that the academic nature of those pronunciations is inappropriate for a common, even colloquial, word. The relevant public, that is, average consumers, particularly French, Spanish and Portuguese consumers, does not comprise a sufficient proportion of Anglophones. Consequently, it cannot be taken for granted that they would know how to pronounce and spell the word 'hooligan' correctly. Moreover, those consumers who do speak English do so with a very pronounced Latin accent which blurs the differences between the pronunciation of the word marks in conflict concerning the aspirated 'h', the double 'o' or the break between the words 'Olly' and 'Gan'. The two marks in conflict are therefore pronounced in a very similar manner.
- 39 It submits that the marks in conflict are conceptually identical or very similar. Due to their phonetic similarity, the marks necessarily connote the same concept of hooligan.

- 40 It submits that, according to the case-law and legislative texts, the likelihood of confusion is all the greater if the inherent distinctive character of the earlier mark is greater as well. Moreover, the earlier marks in question have an inherently high degree of distinctiveness.
- 41 Since the average consumer only rarely has the chance to make a direct comparison between the marks in conflict, the likelihood of confusion is established (Case T-99/01 *Mystery Drinks v OHMI — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43).
- 42 OHIM contends, by way of a superabundant plea having regard to the plea of inadmissibility put forward against the argument relating to the visual similarity of the marks in conflict, that the marks are different not only in terms of the 'ol' and 'gan', but in other ways as well.
- 43 The interveners submit that there is no visual similarity between the marks in question. The mark in respect of which registration is sought is composed of a single word and contains a double 'o' as its dominant component, whereas the earlier marks are composed of two words and contain 'oll' as their dominant component.
- 44 OHIM submits that the marks in conflict are phonetically different. The English word 'hooligan' is understood throughout the Community and, in particular, in France, where it has become part of the language, principally because of its use in connection with football. A feature of the word is its English pronunciation or, at the very least, a close approximation of such pronunciation. Thus, clear aural differences exist between the marks in conflict, particularly with respect to the pronunciation of the first syllable and the break between the two words which constitute the earlier marks.

- 45 The interveners submit that there is not any phonetic similarity either. The word 'hooligan' is known and common in France, even with a slightly different spelling, and in Spain and is pronounced correctly in the English manner. Thus the terms 'hooligan' and 'Olly Gan' are composed of different vocalic combinations, namely, [u-i-ä] and [o-i-a] respectively, and contain a tonic accent in different places, namely, on the first syllable and on the second word respectively. In addition, the break between the two words which make up the earlier marks constitutes a sufficient phonetic difference.
- 46 OHIM submits that since the earlier marks do not have any meaning, there cannot be any conceptual similarity between the marks in conflict. Because the words 'hooligan' and even 'houligan' are well known and there are visual and phonetic differences between the marks in question, the relevant public cannot confuse the word 'hooligan' with the terms 'Olly Gan' (Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel* (BASS) [2003] ECR II-4335).
- 47 According to the interveners, there is no conceptual similarity between the marks in question. OLLY GAN is perceived as a given name and a male name and is understood as being the name of a designer, a common practice in the field of clothing, which tends to exclude other associations. The term 'hooligan', by contrast, is widely used in French, Italian, Portuguese and Spanish texts. There cannot, therefore, be any conceptual confusion.
- 48 OHIM submits that, since it is necessary to take account of only an average degree of distinctiveness of the earlier marks, the differences between the marks in conflict tend to exclude any likelihood of confusion (*MYSTERY*, cited in paragraph 41 above).
- 49 The interveners do not agree that the earlier marks are particularly well known.

*Findings of the Court*

- 50 Under Article 8(1)(b) of Regulation 40/94, upon opposition by the holder of the earlier mark, registration of a mark is refused where, because of its identity with or similarity to an 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.
- 51 According to 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 of marks in the mind of the relevant public of the goods or services in question and taking account of all factors relevant to the circumstances of the case, in particular the interdependence of the similarity of the marks and that of the goods or services covered (Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 29 to 33, and the case-law cited therein).
- 52 As regards the definition of relevant public in this case, all the parties agree that it is made up, at the very least, of average French and Portuguese consumers.
- 53 Next, the Court notes that the identical nature of the goods covered by the marks in question is not contested before the Court.
- 54 As to the similarity of the marks in conflict, according to the case-law, the global appreciation of the likelihood of confusion, in terms of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and

dominant components (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). It is also necessary, in determining the degree of visual, aural and conceptual similarity, to assess, where appropriate, the importance to be attached to those different components, taking account of the category of goods or services in question and the circumstances in which they are marketed (*Lloyd Schuhfabrik Meyer*, cited above, paragraph 27).

55 In the present case, as regards, first, the visual similarity of the marks in conflict, the Board of Appeal upheld the Opposition Division's finding that those signs were visually different (paragraph 20 of the contested decision). The applicant merely submits that the marks in conflict have the letters 'ol' and the final syllable 'gan' in common.

56 The Court notes that the visual similarity is limited to the common components put forward by the applicant. However, the marks in conflict contain significant visual differences. The earlier marks are made up of two words, beginning with an 'o' and containing a double 'l' and a 'y'. The mark for which registration is sought is made up of a single word, beginning with an 'h' and containing a double 'o' and an 'i'. It must therefore be held that the Board of Appeal was right in finding that the marks in conflict are visually different.

57 Next, as regards the phonetic similarity of the marks in conflict, the Board of Appeal found that their pronunciation was different in the Spanish and French dictionaries. At the hearing, OHIM argued that the Boards of Appeal had 'internal' knowledge of the pronunciation in different languages because of the various nationalities of its members. The Board of Appeal also found that, because the average French and Portuguese consumers were familiar with the meaning of the word 'hooligan' in relation to football, they were also familiar with the pronunciation. The break between the words, present in the pronunciation of the earlier marks and absent in that of the mark for which registration is sought, is a further phonetic difference (paragraphs 21 and 22 of the contested decision).

58 The Court notes that it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language. First, it is far from certain that the word will be recognised as being foreign, especially when, as in this case for French consumers, the spelling has been adapted in line with the host language. Thus, the English word 'hooligan' exists in French as 'houligan'. Second, even when the word is recognised as being foreign, it may not be pronounced in the same manner as in the original language. A correct pronunciation as in the original language presupposes not only knowledge of that pronunciation, but also the ability to pronounce the word in question correctly. Third, in the assessment of the likelihood of confusion, it will still be necessary to establish that a majority of the relevant public has that ability.

59 The dictionaries in the language of the relevant public may, as a rule, be taken into consideration in that respect, both by the first body at OHIM and by the boards of appeal, even if they have not been put to the parties, because they are, a priori, well-known facts. The dictionaries provide a pertinent indication of the correct pronunciation of the word in question in the host language, although there is no guarantee that that pronunciation is the one actually used in everyday speech. Moreover, the knowledge which the various bodies of OHIM may have as a result of the various nationalities of its officials or members may well confirm the information used in establishing the average consumer's pronunciation.

60 As regards the relevant public's phonetic familiarity with the word 'hooligan', the Board of Appeal was right to take the view that that public knew the word because of its associations with football. It was also right to find that the first syllable of the word is generally pronounced as 'ou' [English 'oo'] in French. The Board of Appeal was justified in finding that French consumers were familiar with either the English word 'hooligan' and the basic pronunciation associated with it, or the French word 'houligan' as found in the French dictionary, referred to in the contested decision. By contrast, the section of the relevant French public which is not familiar with the French word and pronounces the English word in a French manner despite its obviously foreign origin, is probably quite small. Accordingly, although the vowel

sounds 'ou' and 'o' [in French] are close, they constitute a phonetic difference between the marks in conflict. As regards the Portuguese consumers, however, the Board of Appeal's reasoning is weakened by the fact that it mistakenly relied on a Spanish dictionary, which has no relevance for the spoken language of Portuguese consumers. The Board of Appeal was right, however, to find that the fact that the earlier marks were made up of two words, whereas the mark in respect of which registration is sought is made up of only one word, constituted a further phonetic difference between the marks in conflict.

- 61 The Court notes, however, that nothing indicates that the syllables 'li' of the mark for which registration is sought and 'ly' of the earlier marks are pronounced differently by the relevant public. Likewise, regardless of how they are pronounced, the syllable 'gan', which is common to the marks in conflict, will be perceived as being identical by the relevant public. Nor does anything indicate that the letter 'h' of the mark for which registration is sought and the actual difference in tonic accent when the marks in conflict are pronounced in English allow the relevant French and Portuguese public to differentiate phonetically between the marks in conflict as pronounced by that public.
- 62 By way of conclusion, the phonetic similarities are stronger than the differences and the marks HOOLIGAN and OLLY GAN do contain phonetic similarities for the relevant public. The Board of Appeal therefore committed an error of assessment in finding that the marks in conflict are phonetically different for the average French and Portuguese consumers.
- 63 Lastly, as regards the conceptual similarity of the marks in conflict, the Board of Appeal found that since, in the Opposition Division's decision, that similarity was based solely on the phonetic similarity, the lack of phonetic similarity implied that any conceptual similarity was ruled out.

64 Since that reasoning is based on an assumption which has been held above to be incorrect, the Court accordingly holds that the contested decision is also incorrect on this point.

65 However, the Board of Appeal's finding that the marks in conflict are conceptually different is correct.

66 First, it is obvious that the mark for which registration is sought essentially derives from the concept of hooligan. Moreover, it is not disputed that that concept is known to the average French and Portuguese consumers, most notably because of its use in connection with football. Accordingly, the mark for which registration is sought will be understood and assimilated as such by the relevant public. Second, the words of the earlier marks do not at first sight have any meaning and connote primarily a first name and a surname. Such a concept is widespread in the clothing sector and will therefore be fully assimilated by the relevant public in such a manner that the earlier marks will be known as carrying that meaning. It is only indirectly, and from a strictly phonetic standpoint, that an association might arise in the mind of the relevant public between the earlier marks and the concept of hooligan. That association would, however, be based on a pre-existing confusion between the marks in conflict because of their phonetic similarity. Moreover, the visual perception of the earlier marks will immediately put a distance between the concept of hooligan and those marks. The Board of Appeal was thus right in finding that, generally, the purchase of an item of clothing involves a visual examination of the marks (paragraph 23 of the contested decision). The average consumer will thus register the earlier marks as a first name and a surname.

67 At this stage of the reasoning, it is appropriate to consider the applicant's argument that the earlier marks have an inherently high degree of distinctiveness. As discussed above, the earlier marks have been put together in a manner which will be understood by the relevant public as a first name in conjunction with a surname. This device is very common in the clothing sector. There is, moreover, nothing to

indicate that the first name and surname chosen can be considered as particularly significant in the minds of the relevant public. It thus cannot be said that the earlier marks have an inherently high degree of distinctiveness.

68 Accordingly, in the context of the overall assessment of the similarity of the marks in conflict, the Court finds that the Board of Appeal, despite the error of assessment regarding the lack of phonetic similarity, was right in finding that the visual difference between the marks and the lack of conceptual similarity led to a lack of similarity between the marks.

69 In the context of the overall assessment of the marks in conflict, the Board of Appeal was thus right in finding, in paragraph 23 of the contested decision, that the relevant public would not be likely to confuse the mark for which registration is sought with the earlier marks, particularly in the field of clothing.

70 In the light of all the foregoing, the action should be dismissed.

## **Costs**

71 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they were applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by OHIM and the interveners.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

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

Pirrung

Forwood

Papasavvas

Delivered in open court in Luxembourg on 1 February 2005.

H. Jung

Registrar

J. Pirrung

President