

Case T-57/03

Société provençale d'achat et de gestion (SPAG) SAS

v

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

(Community mark — Opposition proceedings — Application for Community word mark HOOLIGAN — Earlier word marks OLLY GAN — Matters of fact or law not raised before OHIM — Admissibility — Likelihood of confusion)

Judgment of the Court of First Instance (Second Chamber), 1 February 2005 II - 291

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Legality of the decision of a Board of Appeal ruling on opposition proceedings — Challenge by raising new matters of law — Conditions under which permissible*

(Council Regulation No 40/94, Art. 74(1))

2. *Community trade mark — Procedural provisions — Opposition proceedings — Examination restricted to the submissions of the parties — Reputation of the earlier mark — Obligation on the parties to state facts and evidence in support — Inherent distinctive character of the earlier mark — Examination of Court's own motion*
(Council Regulation No 40/94, Art. 74)
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 — Likelihood of confusion with the earlier mark — Word marks 'HOOLIGAN' and 'OLLY GAN'*
(Council Regulation No 40/94, Art. 8(1)(b))

1. Pursuant to Article 74(1) *in fine* of Regulation No 40/94 on the Community trade mark, when hearing an appeal against a decision terminating opposition proceedings, the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) may base its decision only on the relative grounds for refusal on which the party concerned has relied and the facts and evidence presented by the parties.

Since 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 the Office, the same applies to 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 the Office has omitted to rule on that aspect. Likewise, if it is alleged that the Office 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.

It follows that matters of law relied on before the Court of First Instance which have not been raised previously before the bodies of the Office, 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 applied 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.

In accordance with the equality of arms principle, interveners before the Court of First Instance are subject to such rules on admissibility in the same way as applicants.

(see paras 21-23)

2. Although, under Article 74 of Regulation No 40/94 on the Community trade mark, it is for the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to examine any plea relating to the distinctive character of a mark owing to its reputation, it is otherwise where a party has failed either to rely on the reputation of earlier marks or to adduce evidence in support of that reputation. 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 the Office 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 the Office to determine the truth of such a claim.

Concerning, on the other hand, the inherent distinctive character of an earlier mark, the Office is required to examine that matter, if necessary of its own motion, once opposition proceedings have 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 the Office alone is able to detect and assess the existence thereof having regard to the earlier mark on which the opposition is based.

(see paras 30, 32)

3. There is no risk, for average French and Portuguese consumers, of confusion between the word mark HOOLIGAN, registration of which as a Community trade mark is applied for in respect of

‘clothing and headgear’ under Class 25 of the Nice Agreement, and the work marks OLLY GAN, previously registered as an international mark with effect, *inter alia*, in Portugal and as a national trade mark in France and concerning in particular clothes falling under the same class of that agreement, since the conflicting signs, though phonetically similar, are different visually and conceptually and it cannot be said that the

earlier marks have an inherently high degree of distinctiveness, so that the relevant public is not likely to confuse the mark for which registration is sought with the earlier marks, particularly in the field of clothing.

(see paras 56, 62, 65, 67, 69)