

Case T-292/01

Phillips-Van Heusen Corp.

v

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

(Community trade mark — Regulations (EC) No 40/94 and No 2868/95 —
Opposition — Likelihood of confusion — Alteration of a decision of the Board
of Appeal — Application for registration of Community word mark BASS —
Earlier word mark PASH)

Judgment of the Court of First Instance (Second Chamber), 14 October
2003 II-4338

Summary of the Judgment

1. *Community trade mark — Appeal procedure — Appeal brought against a decision of the Opposition Division — Decision of the Board of Appeal going beyond the scope of the opposition — Unlawful*
(Council Regulation No 40/94, Arts 43(5), 62(1) and 74(1))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark registered for identical or similar goods or services — Risk of confusion with the earlier mark — Similarity between the marks at issue — Whether semantic differences capable of counteracting visual or aural similarities — Conditions (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 identical or similar earlier mark registered for identical or similar goods or services — Risk of confusion with the earlier mark — Word marks ‘BASS’ and ‘PASH’ (Council Regulation No 40/94, Art. 8(1)(b))*
4. *Community trade mark — Appeal procedure — Appeal against a decision of the Opposition Division — Suspensive effect — Contested decision taking effect following the final refusal of the Board of Appeal — Refusal incorporated into a decision of the Court of First Instance giving judgment by virtue of its power of alteration (Council Regulation No 40/94, Arts 57(1), 59 and 63(3))*

1. When deciding on an appeal against a decision of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) the Board of Appeal of the Office cannot give a ruling which goes beyond the scope of the opposition, as such an *ultra petita* decision is unlawful.

its opposition to the registration of that mark.

(see paras 23-24)

As it is apparent from reading the first sentence of Article 43(5) in conjunction with the first sentence of Article 62(1) and Article 74(1) in fine of Regulation No 40/94 on the Community trade mark, the Board of Appeal may reject the trade mark application only to the extent applied for by the opponent in

2. When assessing the likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, visual and aural similarities between the two work marks may be counteracted to a large extent by the conceptual differences which distinguish the marks. For

there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.

The fact that the word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made or applied for does not prevent the relevant public from immediately grasping the meaning of that word mark. For such a counteraction to occur, it is not necessary, however, that the other mark also has, from the point of view of the relevant public, a meaning which is clear and specific.

(see para. 54)

3. There is no likelihood of confusion by the German public between the word mark 'BASS' for which registration as a Community trade mark is applied for 'clothing' falling with Class 25 within the meaning of the Nice Agreement, and the word mark 'PASH' previously registered in Germany to designate clothing, also made of leather, belts for clothing, footwear, headgear falling within the same class, in so far as the degree of similarity between the marks is not sufficiently great for the Court to find that the public might believe that

the goods in question come from the same undertaking or, as the case may be, from undertakings which are economically linked, or given the difference between the marks that finding is not invalidated by the fact that the goods covered by the mark applied for are identical to some of the goods designated by the earlier trade mark.

(see paras 56-57)

4. In the light of the second sentence of Article 57(1) of Regulation No 40/94 on the Community trade mark, under which the appeal brought before the Office for Harmonisation in the Internal Market has suspensive effect, a decision capable of forming the subject of such an appeal, such as the Opposition Division's decision, takes effect if no appeal has been brought before the Office within the time-limit referred to in the first sentence of Article 59 of Regulation No 40/94, or if such an appeal has been dismissed by a definitive decision of the Board of Appeal. In that regard, a decision of the Court of First Instance which, by virtue of the power of alteration, dismisses the appeal brought before the Office must be deemed as a decision to that effect by the Board of Appeal.

(see para. 60)