

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)  
12 December 2002 \*

In Case T-110/01,

**Vedial SA**, established in Ludres (France), represented by T. van Innis and G. Glas, lawyers, with an address for service in Luxembourg,

applicant,

v

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

defendant,

\* Language of the case: French.

the other party to the proceedings before the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) being

France Distribution, established in Emerainville (France),

ACTION brought against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 9 March 2001 (Case R 127/2000-1),

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

composed of: M. Vilaras, President, V. Tiili and P. Mengozzi, Judges,  
Registrar: D. Christensen, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 23 May 2001,

having regard to the response lodged by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) at the Registry of the Court of First Instance on 12 September 2001,

further to the hearing on 10 July 2002,

gives the following

## Judgment

### Background to the dispute

- 1 On 1 April 1996 France Distribution filed an application under Council Regulation No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).
  
- 2 The trade mark in respect of which registration was sought is a composite word and figurative mark, reproduced below:



- 3 The goods in respect of which registration is sought are in Classes 29, 30 and 42 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 descriptions:

- Class 29: ‘Meat, charcuterie, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, egg products in general, milk and milk products; preserves, tinned or frozen fruits and vegetables, pickles’;
  
- Class 30: ‘Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces; spices; ice’;
  
- Class 42: ‘Hotel and restaurant services’.

4 That application was published in *Community Trade Marks Bulletin* No 22/97 of 6 October 1997.

5 On 6 January 1998 the applicant filed a notice of opposition under Article 42 of Regulation No 40/94 against the mark claimed in respect of some of the products covered by the mark; namely, ‘milk and milk products’ in Class 29 and ‘vinegar, sauces’ in Class 30. In filing its notice of opposition, the applicant checked boxes 93 (identity of marks and goods/services), 94 (likelihood of confusion) and 95

(unfair advantage/detriment to distinctiveness or repute) but did not check box 69 (earlier registered mark with reputation). The earlier mark is French registration No 1552214 of the word mark SAINT-HUBERT 41 for ‘butters, edible fats, cheeses and all dairy products’ in Class 29.

- 6 By decision of 1 December 1999, the Opposition Division of OHIM rejected the opposition on the ground that there was no likelihood of confusion in the mind of the public in France, where the mark is protected for the purposes of Article 8(1)(b) of Regulation No 40/94, and Article 8(5) was not applicable since the applicant had not proved the reputation of the earlier mark.
- 7 On 31 January 2000 the applicant filed an appeal with OHIM against the decision of the Opposition Division pursuant to Article 59 of Regulation No 40/94. In support of its appeal, the applicant annexed to its statement of grounds several documents intended to establish the reputation of its mark in France.
- 8 The appeal was dismissed by decision of the First Board of Appeal of OHIM of 9 March 2001, which was served on the appellant on 16 March 2001 (‘the contested decision’).
- 9 The Board of Appeal held that the decision of the Opposition Division was well founded so far as the application of Article 8(1)(b) of Regulation No 40/94 was concerned. In essence, the Board of Appeal considered that, even though there was a high degree of similarity between the goods in question and even though, for the purposes of the application of that provision, it was possible to take account of the reputation of the earlier mark demonstrated to it by the applicant, there was no likelihood of confusion in the mind of the public concerned since the

conflicting signs did not display strong similarities. On the other hand, the part of the decision of the Opposition Division ruling on the application of Article 8(5) of Regulation No 40/94 was annulled, on the ground that no application based on that provision had been made to the Opposition Division.

### Forms of order sought

10 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

11 OHIM contends that the Court should:

— make it clear that the reputation of the earlier mark should not have been recognised by the Board of Appeal;

— rule on the likelihood of confusion and annul the contested decision only if it is found that there is a likelihood of confusion;

— decide that each party should bear its own costs.

## Admissibility of the first head of OHIM's submissions

### *Arguments of the parties*

- 12 OHIM makes the preliminary point that, in *inter partes* proceedings, even though it is appearing before the Court as the defendant, it has no legal interest in defending either party to the dispute.
  
- 13 OHIM asserts that the Board of Appeal was wrong to take account, in the context of the application of Article 8(1)(b) of Regulation No 40/94, of the applicant's evidence relating to the reputation of the earlier mark in France, which was first submitted during the proceedings before the Board of Appeal.
  
- 14 According to OHIM, the Board of Appeal may not admit facts, evidence or arguments produced only during the appeal proceedings where a time-limit was set for that purpose by the Opposition Division and that time-limit was not complied with. In this case, the Board of Appeal was not entitled to accept the reputation of the earlier mark in France since the appellant failed to provide any evidence of such reputation within the period granted for that purpose by the Opposition Division. OHIM submits that the contested decision is incorrect on that point. Nevertheless, it submits that that error is not sufficient to justify the annulment of the contested decision.

15 At the hearing, the applicant stated that it considered this claim by OHIM to be inadmissible, which the Court formally noted in the minutes of the hearing.

### Findings of the Court

16 By its first head of claim, OHIM is asking the Court, in essence, to alter the contested decision by making it clear that the reputation of the earlier mark should not have been recognised by the Board of Appeal.

17 In that regard, it must be recalled, first, that Article 63(3) and (4) of Regulation No 40/94 provide that the Court ‘has jurisdiction to annul or to alter the contested decision’ and that the action is to be ‘open to any party to proceedings before the Board of Appeal adversely affected by its decision’. It therefore follows clearly from those provisions that the action is not open to OHIM, which is not a party to proceedings before its Boards of Appeal.

18 Second, it follows from Article 133(2) of the Rules of Procedure of the Court of First Instance that OHIM, as the author of the act whose legality is under review, is acting as sole defendant before the Court.

19 Third, it must be pointed out that the Boards of Appeal, notwithstanding the independent status conferred on their members under Article 131(2) of Regulation No 40/94, form an integral part of OHIM in accordance with Articles 125(e) and 130 of Regulation No 40/94 (see, to that effect, the judgment of the Court of First Instance in Case T-163/98 *Procter & Gamble v OHIM (BABY-DRY)* [1999] ECR I-2383, paragraph 37).

- 20 Fourth, so far as concerns *inter partes* proceedings, Article 134(1) and (3) of the Rules of Procedure provide that '[t]he parties to the proceedings before the Board of Appeal other than the applicant may participate, as interveners, in the proceedings before the Court of First Instance' and that an intervener may, in his response, 'seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application and put forward pleas in law not raised in the application'.
- 21 Consequently, since Article 134(3) allows an intervener to seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application and to put forward pleas not raised in the application, it must be inferred that OHIM is not entitled to seek an order annulling or altering such a decision. If the Rules of Procedure had intended to permit OHIM to do so, it would have been logical also to allow an intervener to seek an order annulling or altering the contested decision even on a point not raised by OHIM in its response.
- 22 Moreover, the possibility afforded to the intervener by Article 134(3) of the Rules of Procedure constitutes a derogation from the general system for interventions established by Articles 115 and 116 of those rules. It must, therefore, be regarded as exceptional and accordingly may not be extended to OHIM, which, in proceedings concerning Community trade marks, has the status of defendant.
- 23 Furthermore, in the specific context of *inter partes* proceedings, it must be held that to regard it as admissible for OHIM to seek an order annulling or altering a decision would be to undermine the legitimate expectation of the successful party before the Board of Appeal that OHIM will act as defendant before the Court.

- 24 Consequently, OHIM does not have *locus standi* to apply for the annulment or alteration of decisions taken by the Boards of Appeal.
- 25 OHIM's application for alteration of the contested decision requesting a declaration that the reputation of the earlier mark should not have been recognised by the Board of Appeal must therefore be held to be inadmissible.

### The application for annulment

*The sole plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94*

### Arguments of the parties

- 26 The applicant claims that in the contested decision proper regard was not had to the concept of 'likelihood of confusion' as interpreted by the Court of Justice.
- 27 First, the applicant argues that, as the Board of Appeal stated in paragraph 28 of the contested decision, the earlier mark possesses very strong distinctive character. Nevertheless, it submits that the Board of Appeal should have been more explicit in its assessment that the earlier mark is inherently very strong by pointing out that it is *ab initio* highly effective in identifying dairy and similar

products in France, and is very easily noticed, expressed, understood and memorised, which is characteristic of an inherently strong mark, especially where, as in this case, it is not disputed that the mark in question is very unusual for the goods concerned.

- 28 Second, the applicant maintains that the Board of Appeal made a number of errors of assessment in comparing the marks at issue. With regard to the visual resemblance to a figurative mark and, as regards the phonetic comparison, it submits that the Board of Appeal did not find that the similarity between the signs applies to the dominant components of the conflicting trade marks. Moreover, the applicant considers surprising the criteria used by the Board of Appeal in determining that there is no conceptual similarity between the marks in question. In that regard, it takes issue with the arguments set out by the Board of Appeal in paragraph 32 of the contested decision, relating to the fact that in France ‘Saint-Hubert’ evokes the patron saint of hunters and to the absence of any connection between the idea of a hunter and that evoked by the figurative component of the mark claimed, namely a chef.
- 29 Third, the applicant maintains that, since most of the goods covered by the two trade marks are identical, the Board of Appeal did not correctly apply the principle of interdependence between the comparison of the marks and that of the goods.
- 30 Fourth, the applicant submits that the Board of Appeal made an analytical assessment of the marks in question whilst overlooking the individual circumstances of the case and, in particular, the fact that the goods covered by the conflicting marks are staple products and that the targeted public has an overall perception of the marks without retaining a perfect image of them.

31 OHIM contends, first, that, if the earlier mark could properly be regarded as a mark with reputation, it would have to be held that there is a likelihood of confusion with the mark claimed. Nevertheless, since the reputation of the earlier mark cannot be taken into account, the case must be considered without regard being had to that factor.

32 Next, with regard to the likelihood of confusion, OHIM does not challenge the principles established by the Court of Justice in its case-law on the wide concept of likelihood of confusion, to which the applicant refers. However, it points out that the determination of a likelihood of confusion must simply involve ascertaining whether, when faced for the first time with products bearing the later mark, the consumer is likely to think immediately that those products have the same origin or, at the very least, come from an undertaking which is economically linked to the undertaking which owns the earlier mark.

33 OHIM submits that, if the Court were to find that the dominant component of the earlier mark is the Christian name ‘HUBERT’, it would be difficult to deny the existence of a likelihood of confusion between the marks in question. On the other hand, if the Court were to hold that the earlier mark is not particularly distinctive and forms a whole in which no component is dominant, the differences between the marks should be sufficient to demonstrate that there is no likelihood of confusion.

34 Finally, OHIM leaves it to the discretion of the Court to resolve that point of law brought before it.

### Findings of the Court

35 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the mark claimed is not to be 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'. Moreover, pursuant to Article 8(2)(a)(ii) of Regulation No 40/94, 'earlier trade marks' means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

- 36 According to the case-law of the Court of Justice on the interpretation of Article 4(1)(b) of 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), which contains a rule that is, in essence, identical to that in Article 8(1)(b) of Regulation No 40/94, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17).
- 37 According to that same case-law, likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Canon*, paragraph 16; *Lloyd Schuhfabrik Meyer*, paragraph 18; and Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40).
- 38 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*,

paragraph 19). The interdependence of those factors finds expression in the seventh recital in the preamble to Regulation No 40/94, according to which an interpretation should be given of the concept of similarity in relation to the likelihood of confusion, the appreciation of which in turn depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the trade mark and the sign and between the goods or services identified.

39 In addition, the perception of marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). For the purposes of that global assessment, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, paragraph 26).

40 In this case, given, first, the nature of the goods concerned by the applicant's opposition, namely 'milk and milk products' and 'vinegar, sauces', which are staple foodstuffs, and, second, the fact that the earlier mark on which the opposition was based is registered and protected in France, the targeted public in relation to which likelihood of confusion must be assessed is composed of average consumers in that Member State.

41 In the light of the foregoing considerations, it is necessary to compare both the goods concerned and the conflicting signs.

- 42 First of all, with regard to comparison of the goods, it must be pointed out that, according to the case-law of the Court of Justice, in assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves must be taken into account. Those factors include, *inter alia*, the nature of the goods or services, their end users and their method of use and whether they are in competition with each other or are complementary (*Canon*, paragraph 23).
- 43 First, the Board of Appeal found that ‘dairy products’ covered by the earlier mark were identical with ‘milk and milk products’ covered by the contested trade mark application.
- 44 It must be observed that those goods covered by the earlier mark include the goods covered by the trade mark application and, therefore, that there is clearly identity between those goods.
- 45 Second, the Board of Appeal held that there is similarity between ‘edible fats’ covered by the earlier mark and ‘vinegar, sauces’ covered by the trade mark application since fats are generally used in the manufacture of sauces, and since oils, like vinegars, are used as seasonings and are offered for sale on the same shelves (paragraph 29 of the contested decision).
- 46 It must be held that there is a link between ‘edible fats’ covered by the earlier mark and ‘vinegar, sauces’ covered by the trade mark application by reason of their nature as foodstuffs, the fact that they are intended for human consumption and, in particular, their use as everyday seasonings for foodstuffs. That proximity between the goods in question could lead the targeted public to believe that, if the goods bear an identical or similar sign, they have originated under the control of a

single undertaking which is responsible for their quality (see, to that effect, *Canon*, paragraph 28).

47 The Board of Appeal was therefore right to hold that some of the goods in question are identical and that others are similar.

48 Secondly, with regard to the comparison of the signs, it is clear from the case-law that the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). In addition, the Court of Justice has held that it is possible that mere aural similarity between two marks may create a likelihood of confusion (see, to that effect, *Lloyd Schuhfabrik Meyer*, paragraph 28). It is therefore necessary to compare the conflicting signs in this case from the visual, aural and conceptual points of view.

49 As regards visual comparison, the earlier mark ‘SAINT-HUBERT 41’ consists of a sequence of two words joined together by a hyphen and the number 41. The contested Community trade mark application consists of a composite sign comprising the name HUBERT in stylised black characters outlined in white, in which the letters are in upper case and surmounted by the bust of a chef, beaming and with his right arm raised and thumb turned up (paragraph 30 of the contested decision).

50 As a preliminary point, it must be observed that the applicant submits that a figurative mark cannot display any visual similarity whatsoever to a word mark.

- 51 That assertion cannot be accepted. It must be held that it is possible to consider and determine whether there is any visual similarity between a figurative mark and another word mark since the two types of mark have graphic form capable of creating a visual impression.
- 52 The Board of Appeal holds that the word ‘HUBERT’ does not constitute the dominant component of the mark claimed and that the opposing signs bear no resemblance to each other as regards their structure and design (paragraph 30 of the contested decision).
- 53 It must be observed that the description of the earlier mark indicates that the figure ‘41’ is placed after the words SAINT-HUBERT and, therefore, occupies a secondary position within the sign as a whole. Accordingly, the words SAINT-HUBERT must be regarded as the dominant component of the earlier mark. As regards the mark claimed, it must be observed, as the Board of Appeal did (paragraph 30 of the contested decision), that the word element ‘HUBERT’ holds an equivalent position in relation to the figurative element and, therefore, that it cannot be regarded, from a visual point of view, as subsidiary in relation to the other component of the sign.
- 54 It must also be observed that the fact that the two signs share the word ‘HUBERT’ is of little relevance in the visual comparison. In the overall visual assessment of the signs in question, the existence of other components in each sign must be taken into consideration, namely:

- in the earlier mark, the term ‘HUBERT’ is preceded by the adjective ‘SAINT’ and by a hyphen. The words form a whole which gives a visual impression distinct from the word ‘HUBERT’ alone,



- 57 With regard to conceptual analysis of the marks in question, it must be observed that the ideas suggested by the terms SAINT-HUBERT and 'HUBERT' are different. The combination of the terms 'SAINT' and 'HUBERT' with a hyphen between them creates a concept and a logical unit that is distinct from those of its components. Thus the words 'SAINT-HUBERT' form an inseparable whole which is likely to evoke in the mind of the targeted public a saint of the Catholic religion or the name of a place. The word 'HUBERT', on the other hand, corresponds to a common masculine French Christian name.
- 58 In this regard, whether the targeted public is aware of the actual significance of the words SAINT-HUBERT, as being the patron saint of hunters, is irrelevant. In order to establish conceptual similarity between the marks in question, it is sufficient to observe that the targeted public will make distinctions between the ideas evoked by each sign. Consequently, the fact that the targeted public is aware of the particular semantic connotations of the words SAINT-HUBERT does not affect the conceptual analysis of those connotations.
- 59 Accordingly, since the dominant component of the earlier mark, SAINT-HUBERT, and the Christian name 'HUBERT' in the mark claimed have distinct semantic meanings and since, moreover, the figurative component of the mark claimed, namely the representation of a chef, constitutes a distinguishing feature in relation to the idea of a saint or the name of a place, it must be held that there is no conceptual similarity between the conflicting marks.
- 60 The Board of Appeal concluded that there is no risk that the average consumer in France of the categories of goods concerned might believe that the goods offered for sale under the mark claimed come from the undertaking distributing 'butters, edible fats, cheeses and all dairy products' under the earlier mark, or that there is an economic link between the two undertakings (paragraph 33 of the contested decision).

61 It should be pointed out, in the context of the global assessment of the likelihood of confusion, that, because the average consumer retains only an imperfect image of the mark, the predominant component of the mark in question is of major importance.

62 Thus the dominant verbal component of the earlier mark, 'SAINT-HUBERT', is of primordial importance in the comparison with the mark claimed, because the average consumer looking at food products takes in and remembers the predominant word element of the sign, which enables him to make the same choice on the occasion of a subsequent purchase. When the targeted public encounters goods identified by the mark claimed, which displays visual, aural and conceptual dissimilarities to the earlier mark, it will not attribute the same commercial origin to the goods in question. Consequently, there is no risk that the targeted public might link the goods identified by each of the two marks which evoke different ideas.

63 In those circumstances, it must be held that, even though there is identity and similarity between the goods covered by the conflicting marks, the visual, aural and conceptual differences between the signs constitute sufficient grounds for holding that there is no likelihood of confusion in the mind of the targeted public.

64 The finding by the Board of Appeal that the earlier mark is widely known in France and enjoys a definite reputation in that Member State (paragraphs 28 and 33 of the contested decision) consequently has no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in this case.

- 65 According to the case-law of the Court of Justice, the likelihood of confusion presupposes that the signs as well as the goods and services covered are identical or similar, and the reputation of a mark is a factor which must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a likelihood of confusion (see, to that effect, *Canon*, paragraphs 22 and 24). However, since, in this case, the conflicting signs cannot in any way be regarded as identical or similar from the visual, aural or conceptual points of view, the fact that the earlier mark is widely known in France cannot alter the global assessment of the likelihood of confusion.
- 66 It is clear from the foregoing that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 has not been satisfied. It therefore follows that the Board of Appeal was right in finding that there is no likelihood of confusion between the mark claimed and the earlier mark.
- 67 The application must therefore be dismissed.

### Costs

- 68 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. Since the applicant has been unsuccessful, but OHIM has asked for the costs to be shared, each of the parties must be ordered to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. Dismisses the application;
2. Orders each party to bear its own costs.

Vilaras

Tiili

Mengozzi

Delivered in open court in Luxembourg on 12 December 2002.

H. Jung

Registrar

M. Vilaras

President