

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

14 July 2005\*

In Case T-126/03,

**Reckitt Benckiser (España), SL**, established in Barcelona (Spain), represented by  
M. Esteve Sanz, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)  
(OHIM)**, represented by A. von Mühlendahl, I. de Medrano Caballero and A.  
Folliard-Monguiral, acting as Agents,

defendant,

\* Language of the case: English.

the other party to the proceedings before the Board of Appeal of OHIM having been

**Aladin Gesellschaft für innovative mikrobiologische Systeme GmbH**, established in Luckenwalde (Germany),

ACTION brought against the decision of the First Board of Appeal of OHIM of 31 January 2003 (Case R 389/2002-1), relating to opposition proceedings between Reckitt Benckiser (España), SL, and Aladin Gesellschaft für innovative mikrobiologische Systeme GmbH,

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

composed of H. Legal, President, V. Tiili and V. Vadapalas, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Court Registry on 14 April 2003,

having regard to the response lodged at the Court Registry on 7 August 2003,

further to the hearing on 30 September 2004,

gives the following

## Judgment

### Facts

- 1 On 20 March 1997, Lipolyt Gesellschaft für innovative mikrobiologische Systeme mbH, whose name was subsequently changed to Aladin Gesellschaft für innovative mikrobiologische Systeme GmbH ('the other party before OHIM') submitted to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, an application for a Community trade mark.
- 2 The trade mark for which registration was sought was the word mark ALADIN.
- 3 The goods and services in respect of which registration of the mark was sought fall within Classes 1, 3, 35, 37 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 corresponded originally to the following description:
  - 'Class 1: Bacterial preparations other than for medical and veterinary use; bases [chemical preparations]; mordants (included in Class 1); acids (included in Class 1); biochemical catalysts; chemicals used in industry and science; acid proof

chemical compositions; chlorine; chlorides; detergents (included in Class 1); water softening preparations (scale removing preparations) included in Class 1; enzymes for industrial purposes; enzyme preparations for industrial purposes; ferments for chemical purposes; preparations for the separation of greases; sal ammoniac; volatile alkali [ammonia] for industrial purposes;

- Class 3: Cleaning, polishing, scouring and abrasive preparations; scouring solutions; preparations for cleaning waste pipes; colour-removing preparations; stain-removing preparations (included in Class 3); varnish-removing preparations; stain removers; oils for cleaning purposes; abrasive preparations (included in Class 3); turpentine, for degreasing; all the aforesaid goods except textile auxiliary agents and auxiliary agents for the metal-working industry;
  
- Class 35: Franchising services, namely providing of organisation and business know-how relating to sanitation and pipe cleaning;
  
- Class 37: Building construction; installation services; cleaning of pipes and waste pipes; rental of cleaning machines; disinfecting; varnishing; rat exterminating; corrosion proofing; sanding; extermination of vermin other than for agriculture;
  
- Class 42: Technical consultancy and providing of expertise; development and design of processes and apparatus and instruments for maintenance and cleaning of pipe systems; development and construction of apparatus, instruments and sensors for remote control and picture transmission technology; computer programming, except programs for diving computers.'

- 4 On 8 June 1998, the application was published in the *Community Trade Marks Bulletin* No 42/98.
  
- 5 On 8 September 1998, Reckitt & Colman SA filed an opposition under Article 42 of Regulation No 40/94 against the application for registration in respect of all the goods in Class 3, relying on the grounds in Article 8(1)(a) and (b) of that regulation. The opposition was based on the earlier national trade mark 'ALADDIN' ('the earlier mark'), registered in Spain under number 20 512 on 29 July 1912 and renewed on 16 May 1993, which designates goods in Class 3 of the Nice Agreement corresponding to the following description: 'Polish for metals'.
  
- 6 The earlier mark was subsequently assigned to the applicant.
  
- 7 Upon request of 30 April 1999 by the other party before OHIM, the applicant was asked by OHIM to furnish proof of genuine use of the earlier mark pursuant to Article 43(2) and (3) of Regulation No 40/94 and Rule 22(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1).
  
- 8 On 26 July 1999, the applicant submitted to OHIM, as proof of use of the earlier trade mark, copies of invoices dispatched to a number of customers in Spain and brochures illustrating the range of goods marketed by it.

9 On 28 February 2000 the other party before OHIM restricted the list of goods in Class 3 for which it was seeking registration of the mark, as follows:

‘Preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents’.

10 On 27 March 2000, the applicant, having been notified by the Opposition Division of the abovementioned restriction, confirmed that it was maintaining its opposition against all the goods in Class 3.

11 By decision of 27 February 2002, the Opposition Division rejected the opposition brought on the basis of Article 8(1)(a) and (b), Articles 42 and 43 of Regulation No 40/94 and Rule 22(1) of Regulation No 2868/95. First, concerning the proof of use of the earlier mark, the Opposition Division essentially found that the evidence as adduced by the applicant demonstrated use of the earlier mark for a much more specific product than polish for metals, the category for which the earlier mark had been registered. The Opposition Division thus held that, pursuant to Article 43(2) of Regulation No 40/94, the examination of the opposition would proceed solely on the basis of the specific product, namely, a product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton). Second, the Opposition Division found that, although the signs were very similar, there was no likelihood of confusion on the part of the public, since the goods differed considerably in terms of their nature, intended purpose, method of use, end users and distribution channels.

12 On 25 April 2002 the applicant filed a notice of appeal at OHIM against the Opposition Division’s decision.

- 13 By decision of 31 January 2003 ('the contested decision'), notified to the applicant on 4 February 2003, the First Board of Appeal dismissed the appeal. The Board found in essence, first, that only the proof of use of the earlier mark for the specific product had been established and, second, that, despite the fact that the marks were almost identical and despite their inherent distinctiveness, there was in Spain no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 in view of the fact that the goods were not at all alike, given, *inter alia*, the likely expertise of the consumers of the goods originating from the other party before OHIM, and the different nature and intended purpose of the goods at issue.

### **Procedure and forms of order sought**

- 14 The parties presented oral argument and replied to the Court's questions at the hearing on 30 September 2004, the other party before OHIM having failed to lodge a response.
- 15 At the hearing the Court took formal note that the heads of claim in the application were to be interpreted as seeking solely annulment of the contested decision and an order that OHIM should pay the costs.
- 16 The applicant claims that the Court should:

— annul the contested decision;

- order OHIM to pay the costs incurred both in these proceedings and in the opposition and appeal proceedings before OHIM.

17 OHIM contends that the Court should:

- dismiss the application;
- order the applicant to pay the costs.

18 At the hearing, OHIM was asked to inform the Court of the state of the insolvency proceedings to which the other party before OHIM was subject and of the effect of that situation on that party's application for a Community trade mark. OHIM complied with that request by letter lodged at the Court Registry on 25 November 2004. The oral procedure was closed by decision of 15 December 2004.

## Law

19 The applicant relies on two pleas in law, based on infringements of Article 43(2) and (3) and Article 8(1)(b) of Regulation No 40/94, respectively.



*First plea: infringement of Article 43(2) and (3) of Regulation No 40/94*

Arguments of the parties

- 20 The applicant submits that the Board of Appeal erred in finding that the earlier mark protected only the specific product in relation to which it had established genuine use of the mark in Spain, namely a product for polishing metal consisting of cotton impregnated with a metal polishing agent (magic cotton).
- 21 In its submission, proof that the mark has been put to genuine use for that specific product involves proof of use of the mark for ‘polish for metals’ in general, since the specific product belongs to that category of products. Accordingly, for the purpose of the opposition proceedings the mark should be considered registered for ‘polish for metals’ and not only for ‘polish for metals consisting of cotton impregnated with a polishing agent (magic cotton)’.
- 22 In that light, the applicant interprets Article 43(2) of Regulation No 40/94 as being intended to apply in cases in which the opposing party is unable to provide proof of use of the mark for products belonging to different product categories registered in one or more classes. It is then warranted to consider the mark registered only for the product categories in respect of which the opposing party has been able to provide proof of use.
- 23 Factors relating to the product submitted to show that the mark has been put to genuine use for a category of products, such as end use, packaging, method of application or distribution channels, are wholly irrelevant for the purposes of the

application of Article 43(2) of Regulation No 40/94. However, as has been held in the case-law of the Court of First Instance, those factors are relevant for the purpose of assessing a possible likelihood of confusion between the earlier mark and the mark for which registration is sought for products belonging to a single class.

24 In finding that, for the purposes of Article 43(2) of Regulation No 40/94, the product covered by the earlier mark is applied manually to the outer structure of metallic objects with a piece of impregnated cotton and is intended for household use whereas the product covered by the mark for which registration is sought is a cleaning preparation which is poured into blocked or infected pipes and is intended solely for operators in the trade, the contested decision thus infringed that article.

25 The applicant concludes that in holding for the purposes of the opposition that the earlier mark had to be regarded as registered solely for 'a cotton impregnated with a metal polishing agent destined for household use', the contested decision infringed Article 43(2) of Regulation No 40/94.

26 OHIM contends that the Board of Appeal did not infringe Article 43(2) and (3) of Regulation No 40/94. It relies on two arguments in support of that contention: first, in the definition of the scope of the earlier mark, regard must be had to the factual conditions of trade of the goods and services whose use has been proved in order to assess the likelihood of confusion between the earlier mark and the mark for which registration is sought on a specific market; and, second, Article 43(2) and (3) of Regulation No 40/94 is applicable regardless of whether or not the list of goods and services covered by the earlier mark contains only one item.

- 27 As to the first of those arguments, OHIM observes that Community trade-mark law requires the proprietor of a mark to make genuine use of a registered mark so that only his actual market position is protected. As evidenced by the eight recital in the preamble to 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) and the ninth recital in the preamble to Regulation No 40/94, the aim of that requirement is to reduce the number of conflicts between marks and restrict the number of trade marks which are registered but have not actually been used (Case T-174/01 *Goulbourn v OHIM — Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38).
- 28 It is thus in order to avoid ‘artificial conflicts’ that Article 43(2) of Regulation No 40/94 provides that the protection of the earlier mark is justified only in so far as the mark has really been used. That objective has been endorsed by the case-law of the Court of Justice and the Court of First Instance, which have ensured that the scope of protection afforded to a trade mark does not go beyond what is necessary to protect the proprietor’s legitimate interests.
- 29 According to OHIM, in cases of trade marks registered for and used in different commercial sectors, the exclusive protection of the earlier mark must not prevent the registration of the later mark, except where the earlier mark is well known. This is reflected in the *in concreto* approach adopted by the Court of Justice and the Court of First Instance in assessing the likelihood of confusion, which requires account to be taken, in the examination of the similarity of the goods, services and signs in question, of the degree of recognition of the earlier mark on the market (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 24; and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 23), the level of attention of the average consumer (*Lloyd Schuhfabrik Meyer*, paragraph 26), the nature of the goods and services concerned, their end users and their method of use and whether they are in competition with each other or are complementary (*Canon*, paragraph 23).

30 The applicant itself expressly acknowledges that the actual conditions of trade of the goods must be taken into account in determining whether there is a likelihood of confusion. The applicant thus contradicts itself by denying that this is so when the provisions of Article 43(2) and (3) of Regulation No 40/94 are applied.

31 Indeed, where an opposition is based on Article 8(1)(b) of Regulation No 40/94, Article 43(2) and (3) of Regulation No 40/94 is intended to determine whether in a specific case there is a likelihood of confusion between the earlier mark, as it is deemed to be registered, and the mark for which registration is sought, for the sole purpose of determining whether or not the opposition is well founded.

32 Therefore, since the case-law of the Court of Justice and the Court of First Instance requires there to be an assessment of the likelihood of a conflict between two distinctive signs on the market rather than in the register, regard must be had to all the circumstances surrounding the trade in the goods or services, which may be inferred from the proof of use of the mark: the scope of protection for the mark can be more objectively determined and is more easily discernable from the proof of use.

33 Accordingly, OHIM submits that the Board of Appeal did not infringe Article 43(2) and (3) of Regulation No 40/94 in finding that the earlier mark was deemed registered solely for a product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton), whose main feature is that it is intended primarily for household use. Conversely, to accept, as the applicant does, that the proof of use of the mark for the specific product is proof of the genuine use of the mark for the entire category covered by the registration, namely 'polish for metals', would adversely affect the assessment of the likelihood of confusion. Such an interpretation would distort the definition of the relevant market and place a disproportionate restriction on other operators' access to distinct markets. In OHIM's submission, this kind of 'artificial conflict' is precisely what Article 43(2) and (3) of Regulation No 40/94 and the case-law of the Court of Justice and the Court of First Instance seek to avoid.

34 Second, OHIM maintains that Article 43(2) and (3) of Regulation No 40/94 is applicable regardless of whether or not the list of goods or services covered by the earlier mark contains only one item. The applicant's argument that that provision applies only if the earlier mark's list of goods and services contains more than one item and that in this case the proof of use of the mark for the specific product is to be equated with proof of use of that mark for the category of products to which it belongs and for which the mark was registered is wholly irrelevant.

35 First, nothing in Regulation No 40/94 provides any support for the applicant's interpretation of the last sentence of Article 43(2). Second, such an interpretation would mean that opponents could easily circumvent the requirement for the mark to have been put to genuine use by formulating the description of the registered category of products in broad terms, thereby artificially expanding the scope of protection of the mark to encompass goods which are not marketed.

36 In addition, it follows from the practice of the OHIM Boards of Appeal when taking decisions that the use of a sub-category of goods or services does not, as a matter of principle, amount to use of a broader category, irrespective of whether the earlier mark covers only one category of goods or services.

37 Lastly, although one category may comprise a collection of goods which are homogeneous in nature, those goods may none the less be heterogeneous in terms of their intended purpose, end users and distribution channels, as in the present case. Accordingly, Article 43(2) and (3) of Regulation No 40/94 requires that, for each category of goods or services, sub-categories be established on a case-by-case basis which reflect the content of the proof of use where the earlier mark as originally designated is likely to cover goods or services which are quite disparate in their intended purposes, end users and distribution channels.

38 In the present case, OHIM contends that the use of the earlier mark has shown that 'polish for metals' is not an homogeneous group as it can cover a wide variety of goods having distinct purposes (polish for cutlery or for metallic building surfaces), different end users (average consumers of everyday products or metal industry workers), different retail outlets (ironmongers' shops, supermarkets or no outlet at all if the sale of the product is ancillary to the supply of metal-working services). The definition of the sub-category used by the Board of Appeal, namely 'products for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)', is therefore highly relevant.

### Findings of the Court

39 Article 43(2) and (3) of Regulation No 40/94 provides:

'(2) If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.'

(3) Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2) (a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

40 Rule 22 of Regulation No 2868/95 provides:

‘(2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based ...’

41 In this instance, it is common ground that the earlier mark was registered for ‘polish for metals’ in Class 3 of the Nice Agreement. It is also common ground that, at the request of the other party before OHIM, the applicant provided proof of the genuine use of the earlier mark on the basis of documents showing that it had actually been used for marketing a product for polishing metal consisting of cotton impregnated with a polishing agent (magic cotton).

42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM — Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 38, and Case T-203/02 *Sunrider v OHIM — Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38).

- 43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.
- 44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.
- 45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.
- 46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all



protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

- 47 The earlier mark was registered solely in respect of 'polish for metals'. That description restricts, with regard both to the function of the goods concerned, polishing, and to their intended purpose, for metals, the category of goods covering, under the Nice Agreement, 'cleaning, polishing, scouring and abrasive preparations'. Furthermore, it should be noted that the latter category itself falls more broadly within Class 3 of the Nice Agreement, which includes, in addition to cleaning, polishing, scouring and abrasive preparations, the following goods: 'bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.
- 48 In those circumstances, the earlier mark must be held to have been registered for a collection of goods forming a particularly precise and narrowly-defined sub-category of the category of goods to which it belongs under the Nice Agreement.
- 49 It follows that, by providing the undisputed proof of genuine use of the mark in respect of a 'product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)', which is evidently a 'polish for metals' within the meaning of the sub-category of goods to which the earlier mark relates, the applicant

has properly established that the mark had been put to genuine use for that sub-category as a whole, it not being necessary to draw any distinction in that regard by reference to the public concerned.

- 50 Consequently, in deeming, for the purposes of the examination of the opposition, the earlier mark to be registered solely for a 'product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)', the Board of Appeal incorrectly applied Article 43(2) and 3 of Regulation No 40/94.
- 51 The provisions of Article 43 of Regulation No 40/94 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so they cannot be interpreted as broadly as OHIM would have them be, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly-defined category, as has been explained above.
- 52 That finding is not called into question by any of OHIM's arguments.
- 53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.

54 Second, even on the assumption that OHIM is correct in stating that the Court of Justice and the Court of First Instance, in their assessment of the similarity of goods and services under Article 8(1)(b) of Regulation No 40/94, carry out an actual comparison of the goods or services in question, it must be stated that that is irrelevant for the purposes of the application of Article 43(2) and (3) of Regulation No 40/94, which precedes any assessment of the likelihood of confusion between the marks in question and is solely intended to determine whether, and if so to what extent, the trade mark has been put to genuine use in relation to the goods or services for which it was registered.

55 Third, as regards OHIM's argument that the practice of the Boards of Appeal in earlier cases shows that use of a sub-category does not, as a matter of principle, amount to use of a broader category, it is sufficient to observe that, even if such a practice were established, the basis for decisions of the Boards of Appeal on proof of use of an earlier trade mark is Regulation No 40/94. The legality of decisions of the Boards of Appeal must therefore be assessed purely by reference to that regulation, as interpreted by the Community Courts, not by reference to the practice of the Boards in earlier cases (*Case T-36/01 Glaverbel v OHIM (Surface of a plate of glass)* [2002] ECR II-3887, paragraph 35, upheld on appeal by order of 28 June 2004 in *Case C-445/02 P Glaverbel v OHIM* [2004] ECR I-6267).

56 Furthermore, it must be noted that OHIM's argument is irrelevant in this instance, given that the applicant is claiming not that the proof of genuine use in relation to the sub-category for which the earlier mark was registered demonstrates proof of genuine use for the whole of the category to which that sub-category belongs under the Nice Agreement, but merely that the product in respect of which genuine use of the mark has been established shows that the mark was put to genuine use in respect of the whole of the sub-category for which it was registered.

- 57 Fourth, the contention that the consequence of the applicant's interpretation would be to allow any opposing party to circumvent the requirement for the trade mark to have been put to genuine use by formulating the category of goods or services registered in general terms — although it might prove founded in certain cases — is irrelevant in this instance, given that there is a detailed description of the category in question.
- 58 Finally, OHIM observes that although one category of goods may form a collection of goods which are homogeneous in nature, they may none the less be heterogeneous in terms of their intended purpose, end users and distribution channels, as in the present case. Accordingly, Article 43(2) and (3) of Regulation No 40/94 requires that, for each category of goods or services, sub-categories be established, on a case-by-case basis, which reflect the content of the proof of use where the earlier mark as originally designated is likely to cover goods or services which are quite disparate in their intended purposes, end users and distribution channels.
- 59 As was stated at paragraph 45 above, although it is true that that interpretation is not without relevance where the category of goods or services in question is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, it must be stated that in this instance the sub-category of goods for which the earlier mark was registered is sufficiently precise and narrowly defined, with the result that the mark cannot be regarded as covering goods which are so different that it would be necessary, in accordance with OHIM's argument, to establish further subdivisions within it.
- 60 It follows from all of the foregoing that the decision of the Board of Appeal, in holding that the proof of use of the earlier trade mark had been provided only for the 'product for polishing metal consisting of cotton impregnated with a polishing agent (magic cotton)' and that the mark should thus be deemed to be registered, for the purposes of the opposition, for that product alone and not for the whole sub-

category for which the mark was registered, namely ‘polish for metals’, infringed Article 43(2) and (3) of Regulation No 40/94. Since, as a consequence, the contested decision was based on a mistaken premiss, that infringement is, on its own, such as to require the decision to be annulled.

- 61 However, given that in the contested decision the Board of Appeal expressed a view on the likelihood of confusion between the marks at issue, the Court considers it necessary also to consider the applicant’s second plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

*Second plea, infringement of Article 8(1)(b) of Regulation No 40/94*

Arguments of the parties

- 62 The applicant submits that comparison of the goods in Class 3 covered by the earlier mark and by the mark for which registration is sought, namely ‘polish for metals’ and ‘preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents’, respectively, shows that the products covered by the marks in question are similar as regards their intended purpose, the fact that they are complementary and their end users.
- 63 The earlier mark covers products intended for polishing all types of metals, including drain and waste pipes, and might be used for products intended for all types of consumers, including persons operating in the metal-working industry.

- 64 Moreover, the applicant observes that it is clear from the case-law that a low degree of similarity between the goods or services designated may be offset by a high degree of similarity between the marks and vice versa. In addition, trade marks which are highly distinctive, either inherently or because they are well known, enjoy more extensive protection than marks with a lower degree of distinctiveness; the more distinctive the earlier mark, the greater the likelihood of confusion.
- 65 Consequently, registration of a trade mark might be refused, despite a lower degree of similarity between the goods or services covered, where the earlier mark is highly distinctive.
- 66 In this instance, it is clear from the contested decision that not only is there a high degree of similarity between the two marks at issue, but that additionally the earlier mark is highly distinctive. It is an imaginary term which does not describe the type of goods covered and which has been widely used in Spain since 1912.
- 67 Finally, given the sufficiently similar nature of the goods covered by the marks at issue, there is a likelihood 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, even if only the specific product at issue were to be considered in the assessment of the likelihood of confusion.
- 68 OHIM contends that those arguments are unfounded.

- 69 It submits that the Board of Appeal rightly held in the contested decision that the goods in respect of which the earlier mark was deemed registered, namely a product for polishing metals consisting of cotton impregnated with a polishing agent, were different from the goods covered by the mark for which registration was sought, that is, preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents.
- 70 OHIM acknowledges that although in some circumstances ‘cleaning’ and ‘polishing’ may be closely related, particularly as regards household goods, that is not the case here, since there is no connection between the purposes, cleaning waste pipes and polishing household metals.
- 71 Since the goods concerned are used for different purposes, they do not respond to the same needs and are neither in competition with each other nor interchangeable.
- 72 OHIM also disagrees with the applicant’s argument that the products are complementary, on the grounds that the argument is based on the mistaken assumption that the cleaning preparations at issue are intended for metallic pipes.
- 73 Nor is it right that the goods at issue are likely to have the same end users. The specific product at issue can in fact be used only for small household utensils and is obviously inappropriate for larger metallic objects. The applicant also recognised in its letter of 23 July 1999 that its product was for household use and stated that ALADDIN was still being used by younger generations. That public, consisting of average consumers of everyday products, must be distinguished from the very

specialised group of persons operating in the metal-working industry. This view is supported by one of the applicant's advertisements, which highlights its 'home cleaning line' where the product at issue is presented alongside other household products.

- 74 Finally, OHIM submits that, in view of the public for which the product at issue is intended, it is highly unlikely that that product would use the distribution channels referred to by the Community trade-mark application, namely highly specialised plumbing distributors and wholesalers.
- 75 OHIM concludes that the goods compared are different, irrespective of whether the earlier mark is deemed to be registered only for the single product at issue.
- 76 Moreover, according to the case-law of the Court of Justice relating to Article 4(1)(b) of Directive 89/104, which is substantively applicable to the interpretation of Article 8(1)(b) of Regulation No 40/94, the likelihood of confusion presupposes that the goods or services covered are identical or similar (*Canon*, cited at paragraph 29 above, paragraph 22). For the reasons given above, that prerequisite is not met and accordingly there is no likelihood of confusion between the marks at issue, regardless of whether the earlier mark has a very high degree of inherent distinctiveness. The Board of Appeal was thus right to find that there was no likelihood of confusion.

### Findings of the Court

- 77 Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the mark applied for 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. Article 8(2)(a)(ii) of Regulation No 40/94 provides that 'earlier trade marks' means, inter alia, trade marks registered in a Member State.

- 78 According to settled case-law, 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.
- 79 According to the same line of case-law, the likelihood of confusion must be assessed globally by reference to the perception which the relevant public has of the signs and of the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 to 33, and the case-law cited).
- 80 In this instance, as has been stated in the context of the first plea and contrary to OHIM's contentions, the earlier mark must be deemed to be registered, for the purposes of the opposition, for all of the goods for which it was registered. It follows that the goods to be considered in the assessment of the likelihood of confusion between the trade marks at issue are, first, the goods designated by the earlier trade mark, namely 'polish for metals' and, second, the goods in Class 3 designated by the trade mark application, namely 'preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents'.

- 81 Although 'polish for metals' can consist equally well of everyday consumer goods as of goods intended for a professional or specialised public, it is not disputed that the goods to which the trade mark application relates must be regarded as directed solely at persons operating in the metal-working industry. Therefore, the only public likely to confuse the trade marks in question is formed of such operators. Furthermore, it should be borne in mind that the earlier mark is registered in Spain. Therefore, the relevant public by reference to which the assessment of the likelihood of confusion must be carried out is composed of persons operating in the metal-working industry who are established in Spain.

— Comparison of the goods at issue

- 82 According to settled case-law, in an assessment of the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (*Canon*, cited at paragraph 29 above, paragraph 23, and Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 31).
- 83 As regards the nature of the goods in question, it must be stated that those goods are in the same category and similarly contain chemical agents applied to metal surfaces. Furthermore, although polishing and cleaning are certainly not identical, they are at the very least similar since they are both covered by the more general activity of maintenance. The goods at issue must therefore be regarded as having a similar function.

- 84 However, it must also be observed in general terms that the description of the goods in Class 3 to which the Community trade mark application relates, namely 'preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents', covers a more restricted and specific sub-category than that designating the 'polish for metals' to which the earlier mark related.
- 85 Further, as OHIM observes, it cannot be denied that the goods have different purposes and methods of use. Whilst the goods to which the earlier mark relates are in principle intended to be rubbed on metallic objects to make them shine, and thus have a partially aesthetic purpose, the goods to which the application for registration relates are essentially intended to be poured into waste pipes to dissolve metallic deposits in order to clean and unblock waste from the metal-working industry, which shows that they have a utilitarian purpose.
- 86 In the light of the foregoing, it must at this stage be stated that the goods in question are similar in part.

— Comparison of the signs at issue

- 87 On this point it is sufficient to state that it is not in dispute that the signs at issue show a high degree of similarity, since the Board of Appeal itself accepted that visually the signs were very similar and that they were identical from a phonetic and conceptual point of view. Furthermore, given that the signs at issue are purely word marks, there is nothing to distinguish between them, apart from the very minor difference in their spelling.

## — Likelihood of confusion between the marks at issue

88 The applicant claims that the likelihood of confusion between the marks at issue is more acute on account of the fact that the earlier national mark ALADDIN is highly distinctive because it concerns an imaginary word which does not describe the type of goods covered and which has been widely used in Spain since 1912. In its submission, the Board of Appeal acknowledged in the contested decision that the earlier mark was highly distinctive.

89 In determining whether a mark is distinctive and, accordingly, in assessing whether it has a high degree of distinctiveness, it is necessary to make an overall assessment of the extent to which the mark is apt to identify the goods or services for which it is registered as originating from a particular undertaking and thus to distinguish those goods or services from those of other undertakings (see, to that effect, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 49).

90 In that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the reputation attaching to it, in particular the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Canon*, cited at paragraph 29 above, paragraph 18; *Windsurfing Chiemsee*, cited at paragraph 89 above, paragraph 51; *Lloyd Schuhfabrik Meyer*, cited at paragraph 29 above, paragraph 23; and Case T-99/01 *Mystery Drinks v OHIM — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 34).

91 In that regard, the Court states, in the first place, that the applicant merely affirms that the earlier mark has been widely used in Spain since 1912, but it does not produce any proof with regard to the various factors cited above which might establish the reputation of the mark. It follows that the earlier mark cannot be regarded as highly distinctive on that basis.

92 As regards, in the second place, the intrinsic qualities of the earlier mark, it must be stated (i) that, as the applicant has observed, the word mark ALADDIN contains no element which is descriptive of the goods for which it has been registered and (ii) that the highly evocative nature of the sign is such as to constitute an intrinsic quality of the mark. Aladdin is well known as the hero of a tale from the *Thousand and One Nights*, who found an oil lamp made of metal, which, when rubbed, conjured up a genie who could grant the wishes of the owner of the lamp. Thus, the word Aladdin evokes both one of the possible methods of use of the goods covered by the earlier mark and the allegedly miraculous nature of the goods. Consequently, it must be held that the earlier mark has a great capacity to identify the goods for which it has been registered ('polish for metals') as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings. Indeed, in the contested decision the Board of Appeal accepted the applicant's argument that the earlier mark had a high degree of distinctiveness: nor is that disputed by OHIM in these proceedings.

93 It must be borne in mind that, by virtue of the case-law, the more distinctive the earlier mark, the greater will be the likelihood of confusion (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 24), so marks with a highly distinctive character, either intrinsically or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (*Canon*, cited at paragraph 29 above, paragraph 18).

94 In addition, the global assessment of the likelihood of confusion implies that there is a degree of interdependence between the factors taken into account, in particular

the similarity between the trade marks and the similarity between the goods or services designated. Accordingly, a lesser degree of similarity between these goods or services may be offset by a higher degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the seventh recital of the preamble to Regulation No 40/94, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified (*Canon*, cited at paragraph 29 above, paragraph 17; *Lloyd Schuhfabrik Meyer*, cited at paragraph 29 above, paragraph 19; and *Fifties*, cited at paragraph 82 above, paragraph 27).

95 Therefore, for the purposes of Article 8(1)(b) of Regulation No 40/94, there may be a likelihood of confusion, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark is highly distinctive (see, to that effect, *Canon*, cited at paragraph 29 above, paragraph 19).

96 Here, it must certainly be acknowledged that the goods in question are similar in part and that the relevant public, composed of operators specialising in the area of goods covered by the Community trade mark application, is likely to evince a high degree of attentiveness when selecting those goods (see, to that effect, Case T-224/01 *Durferrit v OHIM — Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraphs 37, 40 and 52, and Case T-317/01 *M+M v OHIM — Mediametrie (M+M EUROdATA)* [2004] ECR II-1817, paragraphs 51 and 52).

97 However, it must also be observed that, in addition to the fact that they are similar in part, as stated above, the goods in question display generally a link with cleaning and metal, a connection which is further strengthened by the fact that the marks at issue are conceptually identical, which OHIM does not dispute, and may themselves

appear linked to the goods to which they relate because they evoke a character from a story who is associated with an oil lamp made of metal.

98 In those circumstances, it is possible that the relevant public will perceive the goods at issue as part of a single range of cleaning products related to metal. Even if that public, which admittedly is composed of industry operators, is aware of the differences in the way the goods are manufactured, it will not necessarily conclude that those differences prevent a single undertaking from manufacturing or marketing both types of product. Therefore the relevant public will have the impression that the goods concerned may have the same commercial origin (see, to that effect, Case T-85/02 *Díaz v OHIM — Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 33).

99 It follows that the goods in question may appear to the relevant public to be related inasmuch as they belong to a single family of goods and may thus be perceived as items in a general range of goods likely to have a common commercial origin.

100 Therefore, the Court finds that the fact that the relevant public is composed of operators specialising in the metal-working industry is not sufficient, in view of the similarity of the products in question, the high degree of similarity between the signs at issue and the high degree of distinctiveness of the earlier mark, to prevent the public thinking that the goods come from the same undertaking or, as the case may be, from economically-linked undertakings.

101 It follows that there is a likelihood of confusion between the marks at issue. The applicant's second plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94, must therefore also be accepted.

102 It follows from all of the foregoing that the application must be upheld and the contested decision must be annulled.

## Costs

103 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has been unsuccessful, it must be ordered to pay the costs, as applied for by the applicant.

104 As regards, however, the question of recoverable costs, it should be noted that, under Article 136(2) of the Rules of Procedure, '[c]osts necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal and costs incurred for the purposes of the production, prescribed by the second subparagraph of Article 131(4), of translations of pleadings or other documents into the language of the case shall be regarded as recoverable costs'. Costs incurred in the opposition proceedings are not costs incurred in the proceedings before the Board of Appeal. The applicant's claim that OHIM should be ordered to pay the costs incurred by it in the opposition proceedings must therefore be dismissed.



On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 31 January 2003;**
- 2. Orders OHIM to pay the costs.**

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Delivered in open court in Luxembourg on 14 July 2005.

H. Jung

Registrar

H. Legal

President