

# Case T-311/01

Les Éditions Albert René

v

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

(Community trade mark — Opposition proceedings — Earlier Community trade mark ASTERIX — Application for a Community figurative mark containing the word ‘starix’ — Relative grounds for refusal — Article 8(1)(b) and 8(5) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 22 October  
2003 . . . . . II-4628

### Summary of the Judgment

1. *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 — Verbal mark ‘ASTERIX’ and figurative mark consisting of the verbal element ‘starix’ and graphical elements  
(Council Regulation No 40/94, Art. 8(1)(b))*

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 — Reputation of the earlier mark — Relevance (Council Regulation No 40/94, Art. 8(1)(b))*
3. *Community trade mark — Appeal procedure — Action brought before the Community Courts — Jurisdiction of the Court of First Instance — Review of the legality of the decisions taken by the Boards of Appeal with regard to the issues of law raised before them (Council Regulation No 40/94, Art. 63)*

1. There is no risk of confusion, within the European public, between the figurative sign consisting of a red coloured oval followed by the word ‘starix’ in italics, registration of which as a Community trade mark has been applied for in respect of goods and services coming within Classes 9 and 38 of the Nice Agreement, and the verbal mark ‘ASTERIX’, which was previously registered as a Community trade mark to designate goods and services coming within, inter alia, Classes 9 and 41 of that agreement, in so far as, even though there is a more or less marked similarity, possibly even to the point of identity, between the goods and services covered by the conflicting trade marks, the visual, phonetic and conceptual differences between the marks are sufficient to rule out any such risk, with the result that one of the essential conditions for the application of Article 8(1)(b) of Regulation No 40/94 on the Community Trade Mark has not been satisfied.
2. A risk of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, presupposes that the signs as well as the goods and services designated are identical or similar, and the reputation of a mark is one 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 risk of confusion. By contrast, where the signs in dispute cannot in any way be regarded as identical or similar, the fact that the earlier mark is widely known or enjoys an extensive reputation within the European Union cannot alter the overall assessment of the risk of confusion.

(see para. 61)

- (see paras 48, 59, 62)
3. The purpose of an action brought before the Court of First Instance

against a decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) is to obtain a review of the legality of such a decision within the meaning of Article 63 of Regulation No 40/94 on the Community trade mark. While, under Article 63(3) of that regulation, the Court of First Instance 'has jurisdiction to annul or to alter the contested decision', that paragraph must be construed in the light of Article 63(2), which provides that an 'action may be brought on grounds of lack of competence, infringement of an essential procedural

requirement, infringement of the Treaty, of this regulation or of any rule of law relating to their application or misuse of power', and in the context of Articles 229 EC and 230 EC. The Court's review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal.

(see para. 70)