

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

22 October 2003 \*

In Case T-311/01,

**Les Éditions Albert René**, established in Paris (France), represented by  
J. Pagenberg, avocat,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)**  
(OHIM), represented by A. von Mühlendahl and G. Schneider, acting as Agents,

defendant,

\* Language of the case: German.

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:

Trucco sistemi di telecomunicazione SpA, established in Milan (Italy),

APPEAL against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 2 October 2001 (Case R 1030/2000-1),

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

composed of: V. Tiili, President, P. Mengozzi and M. Vilaras, Judges,

Registrar: D. Christensen, Administrator,

having regard to the written procedure and further to the hearing on 14 May 2003,

gives the following

## Judgment

### Background to the dispute

- 1 On 14 January 1999, Trucco sistemi di telecomunicazione SpA (hereinafter ‘the trade mark applicant’) filed an application with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community figurative trade mark.
- 2 The trade mark which it seeks to register is the figurative sign reproduced below:



- 3 The goods and services in respect of which registration has been sought come within Classes 9 and 38 of the Nice Agreement concerning the 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 for each of those classes:

- Class 9: ‘Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus’;
  
- Class 38: ‘Telecommunications’.

4 That application was published in *Community Trade Marks Bulletin* No 71/99 of 6 September 1999.

5 On 6 December 1999, the applicant filed an opposition under Article 42 of Regulation No 40/94 against the registration of that Community trade mark (B216020). The opposition was filed against all goods and services covered by the trade mark application. The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of Regulation No 40/94. The earlier mark in question is Community Registration No 16147, applied for on 1 April 1996 and granted on 25 November 1999, of the verbal sign ASTERIX to designate goods and services in Classes 3, 5, 9, 12, 14, 15, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 30, 32, 35, 41 and 42 of the abovementioned Nice Agreement.

- 6 The opposition was based on a portion of the goods and services covered by the earlier trade mark, that is to say,
  - Class 9: ‘Electrical and electronic photographic, cinematographic and optical teaching apparatus and instruments (except projection apparatus) so far as included in Class 9, electronic apparatus for games, with and without screens, computers, program modules and computer programs recorded on data carriers, especially video games’;
  - Class 41: ‘Film presentation, film production, film rental; publication of books and periodicals; education and entertainment; organisation and presentation of displays and exhibitions; management and exploitation of copyright; exploitation of industrial property rights, public entertainment, amusement parks, production of live orchestral and spoken-word performances’.
- 7 By decision of 26 September 2000, the Opposition Division of OHIM rejected the opposition on the basis of the differences found to exist between the two signs and which ruled out any risk of confusion in the mind of the public.
- 8 On 25 October 2000 the applicant filed an appeal with OHIM against that decision in accordance with Article 59 of Regulation No 40/94.
- 9 By decision of 3 November 2000, taken subsequent to opposition proceedings No B215543, which had been brought by a separate undertaking against the application for registration here in issue, the Opposition Division of OHIM turned down that application in part in so far as it related to ‘automatic vending

machines' in Class 9 and 'telecommunications' in Class 38. That refusal of registration in respect of a portion of the goods and services covered by the trade mark application has now become definitive.

- 10 By decision of 2 October 2001 (hereinafter 'the contested decision'), the First Board of Appeal dismissed the appeal brought by the applicant.
  
- 11 In its comparison of the goods and services designated by the trade marks in issue, the Board of Appeal concluded that there was no similarity between certain goods and services covered by the trade mark applied for and those covered by the earlier trade mark and that there was therefore no risk of confusion in regard to those goods and services; it did, however, accept that there was a similarity between the other goods and services covered by the trade mark application and certain goods and services covered by the earlier trade mark. The Board of Appeal went on to express the view, in its comparison of the signs, that these were not visually, phonetically or conceptually similar and concluded that there was no risk of confusion, even though the earlier mark ASTERIX is inherently very distinctive and is widely known as designating the famous French comic and cartoon hero.
  
- 12 The Board of Appeal further stated that 'for the sake of clarity,... the opponent's argument that its trade mark ASTERIX [was] famous [could] not be accepted because no evidence [had] been submitted in that regard' (paragraph 30 of the contested decision).

#### Procedure and forms of order sought by the parties

- 13 By application lodged with the Court Registry on 12 December 2001, the applicant brought the present action.

14 On 14 May 2002, OHIM lodged its response with the Court Registry.

15 The applicant claims that the Court should:

— annul the contested decision;

— order cancellation of the trade mark applied for;

— order OHIM to pay the costs.

16 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

## Law

17 At the hearing the applicant withdrew the second head of the form of order seeking cancellation of the trade mark applied for, and the Court noted this in the minutes of the hearing. The purpose of the action is thus confined to the application for annulment.

- 18 The applicant relies on two pleas in law alleging respectively breach of Article 8(1)(b) of Regulation No 40/94 and breach of Article 8(5) of that regulation.

*The first plea in law: breach of Article 8(1)(b) of Regulation No 40/94*

Arguments of the parties

- 19 In regard to the earlier trade mark, the applicant submits that this is a mark with a high degree of distinctiveness. It expresses the view in this connection that, as the trade mark applicant has not disputed the fact that the earlier mark ASTERIX is well known, the Board of Appeal ought to have accepted and taken account of that notoriety, even if this had not been established by the applicant. According to the latter, OHIM is obliged, pursuant to the *audi alteram partem* principle referred to in Articles 73 and 74 of Regulation No 40/94, to admit and take account of facts alleged by one party which have not been disputed by another party.
- 20 The applicant argues in this regard that the notoriety of the trade mark ASTERIX, which is the name of a famous cartoon character, has been recognised in numerous decisions of German courts and is demonstrated by documents annexed to the application, that is to say, a consumer survey, a table setting out the number of cinema-goers who watched the feature film 'Asterix & Obelix' in various Member States, a chronology of the Asterix series, press articles and affidavits. The applicant also proposes that the Court hear two persons as witnesses.

- 21 With regard to the identity and similarity of the goods and services in question, the applicant takes the view, first, that the Board of Appeal erred in not recognising the similarity between the ‘telecommunications’ services covered by the trade mark applied for and the goods ‘data processing equipment and computers’ covered by the earlier trade mark. The applicant submits that those goods and services are complementary and that this has been recognised by case-law in Germany.
- 22 Second, the applicant argues that there is an indirect similarity between the goods ‘scientific, nautical, surveying, electric, optical, weighing, measuring, signalling, checking (supervision), life-saving apparatus and instruments; cash registers, calculating machines’ coming within Class 9 and covered by the trade mark applied for and the Class 9 goods covered by the earlier trade mark, in particular ‘computers, program modules and computer programs recorded on data carriers’. The applicant submits further that the fire-extinguishing apparatus covered by the trade mark applied for comes within the containers in Class 20 covered by the earlier trade mark.
- 23 So far as similarity between the signs is concerned, the applicant takes the view that an analysis must be made on the basis of their visual, phonetic and conceptual impression and must have regard for the market conditions and consumer habits throughout the internal market.
- 24 First of all, with regard to visual comparison, the applicant accepts that there are dissimilarities between the signs by reason of the graphic form of the initial figurative element of the trade mark applied for, particularly when it is reproduced in colour, and of the different form of the letters. The Board of Appeal ought, however, to have at least taken into account, first, the fact that some of those with an interest in these proceedings consider that the first element

of the mark applied for represents the letter 'o' and, second, the fact that the mark applied for may be reproduced in colour as well as in black and white. In the latter case, the applicant submits that the mark applied for is perceived as being 'ostarix' as the initial 'o' is no longer distinguishable from the other letters.

- 25 Second, with regard to phonetic comparison, the applicant submits that the two signs in question are, in regard to their letters as a whole, distinguishable only by one single letter and are trisyllabic, with the accent falling on the first syllable in most languages. They thus have an identical sound pattern and syllabic division. Even if it were necessary to ignore the first element of the mark applied for, the phonetic similarity would remain, as all the letters of the verbal element 'starix' would then feature in full in the earlier mark.
- 26 Third, with regard to conceptual comparison, the applicant contends that the term 'asterix' signifies 'asterisk' in English and French, that is to say, a small star, which is a meaning similar to that which the Board of Appeal attributed to the verbal element 'starix' of the mark applied for, that is to say, 'star'. The applicant also points out that the two signs share the suffix 'rix', which is specifically distinctive with regard to the characters in the Asterix series.
- 27 Finally, the applicant submits that, if account is taken of the interdependence between the similarity of the goods and services and that of the signs, in conjunction with the distinctive character of the earlier mark, the differences between the signs are not so great as to prevent confusion, particularly phonetic confusion, between the marks in issue.
- 28 OHIM begins by stating, in regard to the applicant's allegations that Article 74 of Regulation No 40/94 was breached inasmuch as the Board of Appeal failed to take account of the notoriety of the earlier mark, that it follows from Article 74

that, in the case of opposition proceedings, OHIM cannot examine the facts of its own motion. That, however, does not mean that OHIM is obliged to accept as established facts matters which have been alleged by one party and which the other party to the proceedings has not challenged. OHIM points out in this regard that, in opposition proceedings, the party opposing registration is required to set out and prove all the facts necessary to establish that his opposition has a sound basis. In any event, OHIM takes the view that recognition of the notoriety of the earlier mark has no bearing on the present case as the Board of Appeal has already concluded that there is no similarity whatever between the trade marks while at the same time acknowledging the notoriety and renown of the earlier mark.

- 29 OHIM takes the view that the Board of Appeal correctly applied the principles of Community case-law concerning the risk of confusion between trade marks.
- 30 Addressing the issue of the comparison of the goods and services, OHIM points out, first, that the applicant overlooks the fact, with regard to the telecommunications services covered by the trade mark requested, that the list of goods and services in the trade mark application was limited, in particular through the removal of 'telecommunications' services following the decision of the Opposition Division in opposition proceedings No B215543.
- 31 Second, with regard to the goods 'scientific, nautical, surveying, electric, optical, weighing, measuring, signalling, checking (supervision), life-saving apparatus and instruments; cash registers, calculating machines' coming within Class 9 and covered by the trade mark applied for, OHIM submits that the Board of Appeal acted correctly in taking the view that those goods are not similar to the goods and services covered by the earlier trade mark.

- 32 Finally, concerning the goods classified as ‘containers’ in Class 20 covered by the earlier trade mark, OHIM submits that the applicant cannot rely on these as they are not the goods on which it based its opposition. OHIM accordingly takes the view that the applicant is here raising a new plea in law which is inadmissible in the light of Article 135(4) of the Court’s Rules of Procedure.
- 33 With regard to comparison of the signs, OHIM first of all submits that any assessment of the risk of confusion must take account of the situation throughout the internal market in view of the fact that the earlier mark is a Community trade mark.
- 34 With regard, first, to visual similarity, OHIM opines that the Board of Appeal was correct in its assessment that consumers would not construe the first element of the mark applied for as being a stylised capital letter but rather as being a figurative and decorative element.
- 35 With regard, second, to phonetic similarity, OHIM avers that, in all the languages of the European Union, the tonic stress of the verbal element ‘starix’ of the trade mark applied for falls on the third letter, which is included in the first syllable. In contrast, two accentuations are possible for the earlier mark ASTERIX, either on the first letter, ‘a’, or on the fourth letter, ‘e’, the latter being in the second syllable. According to OHIM, these differences are sufficient to rule out any phonetic similarity between the conflicting signs.
- 36 Third, from the conceptual point of view, OHIM submits that the signs in question are not similar. Regarding the applicant’s observations on the semantic content of the word ‘asterix’ as ‘asterisk’ in the English- and French-speaking regions of the European Union and on the semantic content of the verbal element ‘starix’ of the mark applied for as being ‘star’ in English, OHIM submits that

those findings form part of an analytical examination in which the target public does not normally engage. As for the applicant's arguments concerning the suffix '-ix', OHIM replies that this has meanings other than that of signifying characters in the cartoon series Asterix; in particular, in the area of computer software, it refers to the compatibility of such software with the Unix operating system.

- 37 OHIM thus concludes that the Board of Appeal's finding that there was no risk of confusion among the public in regard to the conflicting signs was well founded in fact and in law.

### Findings of the Court

- 38 Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for will not 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'; that provision states further that 'the likelihood of confusion includes the likelihood of association with the earlier trade mark'. Furthermore, an 'earlier trade mark' is, *inter alia*, a Community trade mark with a date of application for registration which is earlier than the date for registration of the Community trade mark (Article 8(2)(a)(i) of Regulation No 40/94).
- 39 According to the case-law of the Court of Justice on 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 that of the Court of First Instance on 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 (Cases C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and T-104/01 *Oberhauser v OHIM-Petit Libero (Fifties)* [2002] ECR II-4359, paragraph 25).

40 The 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 v Puma* [1997] ECR I-6191, paragraph 22; *Canon*, cited above, paragraph 16; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 18; Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40; and *Oberhauser*, cited above, paragraph 26).

41 This global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services concerned. 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 these factors is expressly referred to in the seventh recital in the preamble to Regulation No 40/94, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on a variety of factors which include recognition of the trade mark on the market, the association which may be made of it with the sign as used or registered, and the degree of similarity between the mark and the sign and between the goods or services identified (*Oberhauser*, paragraph 27).

42 It also follows from the case-law that, the more distinctive the earlier trade mark, the greater will be the likelihood of confusion (*SABEL*, cited above, paragraph 24, and *Canon*, paragraph 18), and such a high degree of distinctiveness must be established either in the light of the intrinsic qualities of the mark or owing to the reputation associated with it (*Canon*, paragraph 18, and Case T-99/01 *Mystery Drinks v OHIM-Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 34).

- 43 Moreover, 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 appreciation 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 appreciation, the average consumer of the goods concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. Account should also be taken of the fact that the average consumer has only rarely 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).
- 44 In the present case, the earlier mark is a Community trade mark and the territory relevant to the analysis of the risk of confusion therefore consists of the entire European Union. Furthermore, in view of the fact that the goods and services in issue are current consumer goods and services, the target public is the average European consumer, who is deemed to be reasonably well-informed and reasonably observant and circumspect.
- 45 With regard to the comparison of the goods and services in issue, the Court notes that the Board of Appeal held, in the first place (paragraph 23 of the contested decision):

‘that “scientific, nautical, surveying, electric, optical, weighing, measuring, signalling, checking (supervision), life-saving apparatus and instruments; cash registers, calculating machines, fire-extinguishing apparatus” do not have anything in common with the goods of the opponent's trade mark. For these goods no risk of confusion can exist since the goods covered by the trade marks in question are neither similar nor identical’.

- 46 Second, the Board of Appeal took the view that “photographic, cinematographic and teaching apparatus and instruments” and “apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs” as covered by the CTM application [were] at least very similar to “electrical and electronic photographic, cinematographic and optical teaching apparatus and instruments” covered by the earlier trade mark (paragraph 24 of the contested decision).
- 47 Third, the Board of Appeal opined that “mechanisms for coin-operated apparatus; data processing equipment and computers” covered by the trade mark applied for [were] at least similar to “electronic apparatus for games, with or without screens, computers, program modules and computer programs recorded on data carriers, especially video games” since they [could] all be used for the same purpose, namely playing computer games’ (paragraph 24 of the contested decision).
- 48 The Board of Appeal thus recognised that, for a large portion of the goods and services covered by the trade mark applied for, there was a more or less marked similarity, possibly even to the point of identity (as is clearly the case with regard, for example, to ‘photographic, cinematographic and optical apparatus and instruments’ coming within Class 9), with the goods and services covered by the earlier trade mark. However, and even though it also essentially recognised the significant distinctiveness of the earlier trade mark, which it considered to be ‘very distinctive *per se*’ and ‘widely known as the famous French comics and cartoon character’ (paragraph 29 of the contested decision), the Board of Appeal took the view that there was no risk of confusion ‘since the trade marks in question [were] neither visually nor phonetically nor conceptually similar’ (see paragraph 29 of the contested decision).
- 49 That being so, it is necessary to examine whether that assessment by the Board of Appeal is well founded.

50 The Court of Justice has consistently held that the global appreciation 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).

51 The Board of Appeal described as follows the trade mark applied for (paragraph 25 of the contested decision):

‘The applicant’s trade mark is a figurative trade mark consisting of a red coloured oval followed by the word [“starix”] in italics. The oval is slightly turned to the left side and contains a small point. It looks therefore like an electron orbiting the word [“starix”] or like an orbit with its satellite. The opponent’s trade mark is ASTERIX, a normal word mark’.

52 With regard to the visual comparison of the marks in dispute, the Board of Appeal ruled (paragraph 26 of the contested decision):

‘Although both marks have in common the combinations of letters [“st”] and the suffix [“rix”], they show some important visual differences, such as the different letters following [“st”], the dissimilar script and graphic representation, and

especially the different beginning of the words. In this respect, it has to be pointed out that in the applicant's trade mark the device catches the consumer's attention. Contrary to the opponent's argument, the device will not be recognised as the letter ["o"]. Therefore, the marks are considered visually dissimilar'.

53 So far as the first element of the trade mark applied for is concerned, it is unlikely that the target public could construe this as being the vowel 'o', given that the analysis of the sign must be carried out on the basis of its form as lodged with OHIM. Account has to be taken of the fact that this first element consists of a red coloured oval turned to the left side and with a small point which is indeed reminiscent of a satellite on its orbit. This element is thus clearly distinguishable from the verbal element 'starix' which follows, in which all the letters are presented in the same calligraphic style and in the same colour (black).

54 Accordingly, in the overall visual appraisal of the signs in issue, the existence of elements specific to each sign, in particular the graphical representation of the oval and the italic typography of the verbal element in the trade mark applied for, means that the overall impression of each sign is different. The Board of Appeal thus had sound reasons for concluding that the conflicting signs are not similar at the visual level.

55 In regard to the phonetic comparison, the Board of Appeal ruled as follows (paragraph 27 of the contested decision):

'the applicant's trade mark starts with the letter ["s"], while the opponent's trade mark begins with an ["a"]. Also, the second vowel in the latter (["E"]) is

pronounced differently from the... vowel ([“A”]) of the applicant’s trade mark. In all EU Member States, the marks are pronounced in a different way. Therefore, they are considered as phonetically different’.

56 It is important to stress in this regard that the verbal element of the mark applied for begins with a consonant and is composed of six letters, whereas the earlier trade mark begins with a vowel and contains one vowel more than the mark applied for. The two signs have only one syllable in common, which, moreover, is the final syllable (‘rix’). The marks in issue must therefore, on an overall appraisal, be regarded as being phonetically dissimilar.

57 So far as the conceptual comparison of the signs in dispute is concerned, the Board of Appeal set out its views as follows (paragraph 28 of the contested decision):

‘Neither the words “[asterix]” nor “[starix]” have any common meaning in any of the official languages of the European Union. The latter may remind consumers, especially when it is seen together with the device, of the English word “star”, which, since it is a basic English word, will be understood by most people within the European Union. Therefore, the trade marks in question are considered as conceptually dissimilar’.

58 The words ‘asterix’ and ‘starix’ cannot be regarded as being similar in import. In the first place, as the Board of Appeal pointed out, neither of those words has any common meaning in the languages of the European Union. Second, although the

word ‘asterix’ is close to the French word ‘astérisque’ and the English word ‘asterisk’, signifying the sign consisting of a small star generally used as a reference mark in written documents, the semantic association outlined by the applicant does not come from an overall impression but from an analysis of detail in which the average consumer does not normally engage. Third, the average consumer will more readily associate the word ‘asterix’ with the character in the cartoon series widely known throughout the European Union. This specific representation of a popular character makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar.

- 59 It follows that the Board of Appeal acted correctly in holding, in the contested decision, that the visual, phonetic and conceptual differences between, first, the figurative mark consisting of the verbal element ‘starix’ in conjunction with very specific graphical elements and, second, the ASTERIX trade mark were sufficient to rule out any risk of confusion in the perception of the target public, as such a risk would presuppose, cumulatively, that the degree of similarity of the trade marks in question and that of the goods or services designated by those marks are sufficiently high.
- 60 In those circumstances, the Board of Appeal’s assessment that the earlier trade mark is ‘very distinctive *per se*’ and ‘widely known as the famous French comics and cartoon hero’ (paragraph 29 of the contested decision) and the applicant’s allegations as to the notoriety of that trade mark have no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in the present case.
- 61 A risk of confusion 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 (see, to that effect, *Canon*, paragraphs 22 and 24). Since,

however, in the present case, the signs in dispute cannot in any way be regarded as identical or similar from the visual, phonetic or conceptual points of view, the fact that the earlier mark is widely known or enjoys an extensive reputation in the European Union cannot alter the overall assessment of the risk of confusion.

62 It follows that one of the essential conditions for the application of Article 8(1)(b) of Regulation No 40/94 has not been satisfied. The Board of Appeal was therefore correct in finding that there is no risk of confusion between the trade mark applied for and the earlier mark.

63 That being so, the plea in law alleging that Article 8(1)(b) of Regulation No 40/94

has been infringed must be rejected, without it being necessary to address the arguments raised by the applicant in the context of this plea concerning the alleged similarity between some of the designated goods and services and the alleged notoriety of the earlier trade mark. Likewise, there is no reason to accede to the request that witnesses be heard, which was submitted by the applicant with a view to establishing that notoriety.

*The second plea in law: breach of Article 8(5) of Regulation No 40/94*

Arguments of the parties

64 The applicant submits that the earlier trade mark, which is a well-known mark, is also protected against dilution for the purposes of Article 8(5) of Regulation No 40/94.

- 65 The earlier mark, so the applicant contends, is part of a family of trade marks which designate other characters in the Asterix series and which is protected in 50 countries. In that context, the applicant takes the view that, inasmuch as it incorporates the typographical, aural and conceptual elements of the most widely known of those trade marks, that is to say, the earlier mark ASTERIX, contains the final element 'ix' characteristic of that family of trade marks, and may be regarded as a combination of the words 'Asterix' and 'Obelix', the trade mark being applied for adversely affects the distinctive character of the earlier trade mark.
- 66 Referring to Article 135(4) of the Court's Rules of Procedure, OHIM submits that this plea in law is inadmissible as the applicant did not raise it before OHIM.

### Findings of the Court

- 67 Article 8(5) of Regulation No 40/94 states that '[f]urthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community... and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.'
- 68 It is common ground in this case that the applicant did not at any time request OHIM to apply that provision and that OHIM therefore did not examine it.

More specifically, although the applicant did invoke the repute of its earlier trade mark in its opposition to the trade mark application and before the Board of Appeal, this was exclusively within the context of the application of Article 8(1)(b) of that regulation, that is to say, for the purpose of substantiating the risk of confusion in the mind of the relevant public.

<sup>69</sup> It should also be pointed out, first, that, under Article 74 of Regulation No 40/94, ‘in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties’.

<sup>70</sup> Second, it must be borne in mind that the purpose of actions before the Court is to obtain a review of the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94 (Case T-237/01 *Alcon v OHIM-Dr Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 61; Case T-128/01 *DaimlerChrysler v OHIM (Grille)* [2003] ECR II-701, paragraph 18; and Case T-129/01 *José Alejandro v OHIM-Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67). While the Court, under Article 63(3) of Regulation No 40/94, ‘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] (see, to that effect, Case T-163/98 *Procter & Gamble v OHIM (BABY-DRY)* [1999] ECR II-2383, paragraphs 49 to 51, annulled in part by the Court of Justice, though without that Court giving a ruling in that regard, by the judgment in Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251). 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, in this regard, Case T-194/01 *Unilever v OHIM* [2003] ECR II-383, paragraph 16).

71 Furthermore, as OHIM has correctly pointed out, Article 135(4) of the Rules of Procedure expressly states that '[the] parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal'.

72 The applicant cannot therefore argue that the Board of Appeal breached Article 8(5) of Regulation No 40/94 or call on the Court to rule on a request for application of that provision which was not made during the administrative phase of the proceedings before OHIM.

73 The present plea must therefore be rejected as being inadmissible.

### Costs

74 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, it must be ordered to pay the costs incurred by OHIM in accordance with the form of order sought by the latter.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders the applicant to pay the costs.**

Tiili

Mengozzi

Vilaras

Delivered in open court in Luxembourg on 22 October 2003.

H. Jung

Registrar

V. Tiili

President