

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

4 May 2005 *

In Case T-359/02,

Chum Ltd, established in Toronto (Canada), represented by M.J. Gilbert, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by P. Bullock and S. Laitinen, acting as Agents,

defendant,

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

Star TV AG, established in Schlieren (Switzerland),

* Language of the case: English.

ACTION brought against the decision of the Second Board of Appeal of OHIM of 17 September 2002 (Case R 1146/2000-2), relating to opposition proceedings between Chum Ltd and Star TV AG,

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

composed of H. Legal, President, P. Mengozzi and I. Wiszniewska-Białecka, Judges,

Registrar: H. Jung,

having regard to the application lodged at the Court Registry on 3 December 2002,

having regard to the response lodged at the Court Registry on 9 April 2003,

further to the hearing on 17 November 2004,

gives the following

Judgment

Facts

- 1 On 28 July 1998 the applicant filed an application for a Community trade mark at 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.

- 2 The mark for which registration was sought was the word mark STAR TV.

- 3 The services in respect of which registration was sought fall within Classes 38 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond for each of those classes to the following description:
 - Class 38: ‘television broadcasting services, interactive electronic television broadcasting services, including via the medium of television, electronic mail, the internet and other electronic media’;

— Class 41: 'production, distribution, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks'.

- 4 The application was published in *Community Trade Marks Bulletin* No 43/99 of 31 May 1999.
- 5 On 30 August 1999, Star TV AG filed a notice of opposition to the application pursuant to Article 42 of Regulation No 40/94, alleging a likelihood of confusion under Article 8(1)(a) and (b) of the regulation. The opposition was based on the international figurative mark reproduced below:



- 6 That trade mark's registration covered Germany, Austria, the Benelux countries, France and Italy and related to services in Class 38 ('television broadcasting, i.e. broadcasting of special programmes containing information and documentaries on cinema and movies') and services in Class 41 ('production of television programmes, namely of special programmes containing information and documentaries on cinema and movies').

- 7 By decision of 28 September 2000, the Opposition Division, having found there to be a likelihood of confusion between the conflicting signs, upheld the opposition and refused to allow the applicant's application for registration.
- 8 On 28 November 2000, the applicant brought an appeal against the Opposition Division's decision.
- 9 By decision of 17 September 2002 ('the contested decision'), the Second Board of Appeal of OHIM dismissed the appeal and upheld the decision of the Opposition Division. In relation in particular to the assessment of the degree of similarity of the services, the Board of Appeal concluded, first, that the Class 38 services (television broadcasting services; interactive electronic television broadcasting services including via the medium of television, electronic mail, the internet and other electronic media) covered by the trade mark application and the production of television programmes in Class 41 included and overlapped with the opponent's services in those classes and, second, that the other services to which the application for registration related ('distribution, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks') were either complementary to the services covered by the opponent's trade mark or provided the electronic support for them. As regards the comparison of the conflicting signs, the Board of Appeal found, first, that visually the two signs were very similar, since the verbal element of the earlier mark coincided with the mark claimed; second, that phonetically the mark claimed was identical to the verbal element of the earlier mark; and, finally, that conceptually both marks suggested the same idea, that of a star.

Forms of order sought

10 The applicant claims that the Court should:

- annul the contested decision;

- order OHIM to grant its application for registration;

- order reimbursement of the costs incurred by it in the proceedings before the Board of Appeal and the Opposition Division of OHIM;

- order OHIM to pay the costs.

11 OHIM contends that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

- 12 As a preliminary point, it must be borne in mind that by virtue of settled case-law, the Court of First Instance is not entitled to issue directions to the Office (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33, and Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 18). Therefore, the applicant's claim that OHIM should be ordered to register the applicant's trade mark application must be declared inadmissible.
- 13 In support of its application for annulment, the applicant raises a single plea in law alleging infringement of Article 8(1)(b) of Regulation No 40/94.

Arguments of the parties

- 14 The applicant challenges the Board of Appeal's finding concerning, first, the high degree of similarity between or the identity of the services concerned and, second, the alleged similarity of the conflicting signs from the visual and conceptual point of view and their identity in phonetic terms.
- 15 As regards, in the first place, the similarity between the services concerned, the applicant maintains, first of all, that the range of services within Classes 38 and 41 to which the trade mark application relates is broader than the range of services in the same classes covered by the earlier mark. As far as Class 38 is concerned, the earlier mark covers only television broadcasting of special programmes containing information and documentaries on cinema and movies, whilst the services to

which the trade mark application relates encompass television broadcasting services and interactive electronic television broadcasting services including via the medium of television, electronic mail, the internet and other electronic media. The same is true of the services in Class 41, since the earlier mark covers only the production of special programmes containing information and documentaries on cinema and movies, whilst the services designated by the trade mark application include not only the production but also the distribution, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks.

16 The applicant goes on to point out that the services to which the trade mark application relates are directed at the general public, whilst those covered by the earlier mark are targeted at a more select, specialised group comprised of 'movie buffs'.

17 Finally, the services in Class 41 to which the trade mark application relates are not restricted to the production and broadcasting of television programmes but also include the distribution of those programmes to third parties. There is thus a significant difference between the applicant's and the opponent's respective areas of business so far as the services in Class 41 are concerned and the services covered by the trade mark application cannot therefore be regarded as being merely complementary to the opponent's services.

18 With respect, in the second place, to the finding that the conflicting signs are similar, the applicant points out, first of all, that the earlier trade mark is essentially a figurative mark, composed of various elements, whilst the mark applied for is purely a word mark. That essential difference precludes any comparison of the two marks from the visual point of view.

- 19 What is more, no phonetic similarity can be detected between the signs at issue. Since the earlier trade mark is figurative, it is likely to be perceived solely through its graphic representation. By contrast, it is the phonetic aspect of the mark claimed which is paramount.
- 20 Finally, the two conflicting trade marks are also conceptually different. From that perspective, the mark applied for is such as to suggest ‘movie stars, celebrities and entertainment in general and television programming related thereto’, whilst the earlier mark is more likely to suggest ‘astronomy ... and television programming related thereto’.
- 21 Furthermore, the applicant points out that the word ‘star’, which features in both the signs at issue, is commonly used in relation to services in Classes 38 and 41. It follows, in its submission, that the protection conferred on the earlier mark should not be so extensive as to secure a monopoly on that word for the proprietor of that mark.
- 22 The applicant also points out that it is already the proprietor of the Community trade mark STAR TELEVISION, registered for services in Classes 38 and 41, as well as of various international word and figurative marks containing the word ‘star’ and/or the depiction of a star. In that regard, it points out, first of all, that the opponent did not attempt to prevent registration of the trade mark STAR TELEVISION. Further, it would be clearly illogical not to allow registration of the trade mark STAR TV, when the applicant has been able to register the mark STAR TELEVISION, which is virtually identical. Finally, the trade mark applied for clearly distinguishes the applicant’s services from those of other undertakings, since it forms part of a set of trade marks of which the applicant is the proprietor and which contain the word ‘star’ and/or the representation of a star.

23 OHIM concurs with the Board of Appeal's assessment.

Findings of the Court

24 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 shall 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark'.

25 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.

26 By virtue of the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the signs and of the products or services in question and 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 identified (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 cases cited).

27 In this instance, in view of the nature of the services concerned, a description of which is set out at paragraphs 3 and 6 above, the target public by reference to which

the likelihood of confusion must be assessed consists for all the services in question, apart from the distribution of television programmes, which is covered by the trade mark application, of average consumers in the Member States in which the opponent's international mark is protected, namely Germany, Austria, the Benelux countries, France and Italy.

- 28 Although it is true that certain services offered by the applicant, falling within Class 38 and Class 41, are directed at consumers with some idea of information technology who are familiar with the use of electronic equipment, it is none the less the case that currently the supply and consumption of audiovisual products and their distribution to a wide market, composed essentially of young people, are such that those products and services cannot be regarded as restricted to a select specialised group of consumers. Contrary to the applicant's submission, although the services in Classes 38 and 41 which are protected by the earlier trade mark concern specifically the realm of cinema, they cannot be regarded as targeting a public other than the general public with a general interest in televised entertainment.
- 29 Conversely, it must be held that the services associated with the distribution of television programmes, which is referred to in the trade mark application and comes under Class 41, are directed not at the average consumer but at a public consisting of professionals working in the audiovisual and television broadcasting sectors, who are likely to be especially interested and attentive when choosing a supplier.
- 30 Under Article 8(1)(b) of Regulation No 40/94 and in the light of the foregoing considerations, it is necessary to compare, first, the services concerned and, second, the conflicting signs.

The services concerned

- 31 According to settled case-law, in assessing the similarity of the products or services concerned, all the relevant factors pertaining to the relationship between those products and services are to be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with one another or are complementary (Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 51).
- 32 Here, the opposition is based on an earlier trade mark registered for services in Classes 38 and 41 and is directed against registration of the trade mark applied for in respect of services within the same classes.
- 33 The Board of Appeal concluded that television broadcasting services, interactive electronic television broadcasting services, including via the medium of television, electronic mail, the internet and other electronic media, on the one hand, and the production of television programmes, on the other hand, covered by the trade mark application and coming within Class 38 and Class 41 respectively, included and overlapped with the services designated by the earlier mark within the same classes. As regards the other services to which the trade mark application relates and which come within Class 41 (distribution, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks), the Board of Appeal concluded that either they were complementary to the services protected by the earlier mark within the same class or they provided support for them.
- 34 A comparison of the descriptions of the Class 38 services concerned, reproduced at paragraph 3, first indent, and paragraph 6 above for each of the signs, shows (i) that the television broadcasting services covered by the earlier mark are restricted to a

specific field, namely the broadcasting of programmes about the cinema, whilst a broader form of wording is used to describe the services to which the trade mark application relates, and (ii) that the last-mentioned services expressly include ‘interactive electronic television broadcasting services’, whereas such a specification does not appear in the description of the services claimed by the opponent.

35 It must be found that, despite the differences in description, the Class 38 services to which the trade mark application relates are in part identical to the Class 38 services covered by the earlier mark and in part similar.

36 First, as has been rightly stated by both the Board of Appeal in the contested decision and OHIM in its response, the applicant and the opponent provide services of the same nature, namely television broadcasting services, notwithstanding the specialised nature of the programmes broadcast by the opponent. Therefore, the services to which the trade mark application relates also include the services protected by the earlier trade mark.

37 Second, interactive television broadcasting, which uses electronic support such as digital television or the internet, allowing consumers to use the service in a way which is more than just the passive reception of the visual component, must be regarded as a particular method of television broadcasting. In that sense, it cannot be regarded as excluded from the description of the services covered by the earlier trade mark, although it is not expressly mentioned there. Thus, the ‘interactive electronic television broadcasting services’ to which the trade mark application relates and the television broadcasting services protected by the earlier mark must be regarded, at the very least, as similar.

- 38 A similar conclusion must be drawn in respect of the ‘production of television programmes’ within Class 41 which features both in the description of the services to which the trade mark application relates and in that of the services covered by the earlier mark. In this case too, the broader form of wording used by the applicant also encompasses the television programmes produced under the earlier trade mark, which concern the specific area of cinema.
- 39 As regards, finally, the other Class 41 services offered by the applicant as part of its business of ‘production, distribution, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks’, it must not be forgotten that, according to settled case-law, the factors to be taken into account in the assessment of the similarity between the products or services include their end users and whether they are in competition with one another or are complementary (see the cases cited at paragraph 31 above). In this instance, as the Board of Appeal rightly held, the production, recording and development of television programmes, video, tapes, CDs, CD-ROMs and computer disks, covered by the trade mark application, must be regarded as similar to the production of television programmes covered by the earlier trade mark, inasmuch as either they are complementary to the latter activity, since they include the development of audiovisual or multimedia products capable of constituting a specific method of broadcasting the opponent’s products, or they provide the electronic support for such broadcasting.
- 40 In conclusion, it must be held that, despite the differences in description, the services to which the trade mark application relates are in part identical to the services covered by the earlier trade mark and in part similar.

The signs concerned

- 41 It is settled case-law that the global assessment of the likelihood of confusion, which must take into account all the relevant factors, 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 (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and *ELS*, paragraph 62). The average consumer of the type of products or services in question, whose perception of the trade marks plays a decisive role in the global appreciation of the likelihood of confusion, normally perceives a mark as a whole and does not proceed to analyse its various details (*SABEL*, cited above, paragraph 23).

42 In this case, the earlier trade mark comprises a figurative and word mark consisting of a central depiction of a five-pointed star tilting to the left, over which the words 'star TV' are written on two lines in red capital letters, rounded off by a moon surrounded by three small stars, the outlines of which appear at the top left between two of the points of the central star. The mark for which registration is sought consists of the words 'star TV'.

43 As regards, first of all, the comparison of the two marks at issue from a visual point of view, a preliminary point to note is that the Court of First Instance has already stated that there is nothing to prevent a determination as to whether there is any visual similarity between a word mark and a figurative mark, 'since the two types of mark have graphic form capable of creating a visual impression' (Case T-110/01 *Vedial v OHIM — France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 51).

44 In that connection, it is appropriate to state at the outset that the words 'star TV' constitute both the mark applied for and the verbal element of the earlier mark. In similar circumstances, the Court of First Instance held that a complex word and figurative mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by

the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).

45 In the present case, with respect to the visual comparison of the signs at issue, the Board of Appeal found that the words 'star TV' formed the dominant element of the earlier mark.

46 Such a finding is not vitiated by error. Given the overall visual impression produced by the earlier trade mark, the verbal element 'star TV' is certainly capable of holding the attention more than the other figurative aspects of the sign both on account of its size, the words 'star' and 'TV' being superposed on the central star image and extending beyond the outer edges of the star, and on account of the impact of its colours, the words being written in red on a black and white background.

47 In those circumstances, given that the mark applied for is the same as the dominant verbal element of the earlier trade mark, the Board of Appeal did not make an error of assessment in finding that there was a high degree of similarity between the two marks.

48 Similarly, the Board of Appeal was correct to find that the two marks were phonetically identical.

- 49 Contrary to what the applicant seems to be maintaining, it must be acknowledged that, like the trade mark applied for, the earlier mark, inasmuch as it is composed of a verbal element, is also capable of being reproduced phonetically. Thus, in this instance, since the phonetic expression of the earlier mark coincides with the expression of its only verbal element — the words ‘star TV’ —, which corresponds to the trade mark applied for, it must be held that from the point of view of phonetics the two conflicting signs are identical.
- 50 Finally, the Board of Appeal found that from a conceptual point of view both of the signs at issue evoked the image of a star.
- 51 In that regard, it must be stated that, although the visual impression of the earlier trade mark unequivocally and immediately evokes the idea of a star, given that one of the elements of which it is composed consists of the graphic representation of a star, the same is true of the mark applied for only if there is a reasonable presumption that the target public knows the meaning of the English word ‘star’.
- 52 Even if average consumers, who form the relevant public in relation to most of the services in question, do not necessarily know the meaning of the English word ‘star’, that word is in current usage in German, French, Italian and Dutch to describe a film star. Thus, both the trade mark for which registration is sought, which contains the word ‘star’, and the earlier mark, whose dominant verbal element reproduces the word ‘star’, are such as to evoke the idea of a ‘film star’. Furthermore, the ability of both the signs to evoke such an idea is all the greater given that in both cases the word ‘star’ is combined with the letters ‘TV’, which, as an abbreviation of the word ‘television’, are apt to emphasise the allusion to the idea of a film star or a famous actor or actress. It follows that conceptually both the conflicting marks are such as to evoke the same idea.

53 It is clear from the foregoing that visually, phonetically and conceptually the trade mark applied for and the earlier mark are very similar and, in some respects, identical.

Whether there is a likelihood of confusion

54 In the circumstances set out above, in view of the fact that the conflicting signs and the services that they designate are identical or similar, it must be concluded that there is a real likelihood that the relevant public will be unable to tell the commercial origin of those services apart.

55 Such a conclusion is equally valid for the services covered by the trade mark application which relate to the distribution of television programmes and in respect of which the target public consists, as stated at paragraph 29 above, of professionals in the audiovisual sector. It must be held that the visual, phonetic and conceptual similarities between the conflicting marks are such that even a more attentive public may be led to believe that the services in question come from the same undertaking or from economically linked undertakings. The fact that the opponent does not operate directly in the distribution sector does not undermine such a conclusion, since, as a general rule, the production and distribution of television programmes can be, and often are, carried out by the same undertakings.

56 It must therefore be concluded that the Board of Appeal did not make an error of assessment in finding that there was a likelihood of confusion between the trade mark applied for, STAR TV, and the earlier trade mark.

57 As regards the arguments which the applicant bases on its various national, international and Community registrations, whose subject-matter is trade marks containing the word 'star' or the depiction of a star, and on what it alleges to be the common use of the word 'star' to designate the services at issue in the present case, it is sufficient to note that those arguments were not advanced either before the Opposition Division or before the Board of Appeal. According to the case-law, facts which are pleaded before the Court without having previously been brought before the OHIM authorities can affect the legality of such a decision only if OHIM was required to take them into account of its own motion (Case T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13). It follows from the concluding words of Article 74(1) of Regulation No 40/94, according to which, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought, that OHIM is not required to take into account of its own motion facts which have not been put forward by the parties. Therefore, such facts cannot affect the legality of a decision of the Board of Appeal (*GAS STATION*, cited above, paragraph 13).

58 In the light of all of the foregoing, the applicant's claim for annulment must be rejected.

Costs

59 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 the applicant has been unsuccessful, it must, in accordance with the form of order sought by OHIM, be ordered to pay the costs.

60 Under Article 136(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are regarded as recoverable costs. That is not so in the case of costs incurred for the purposes of

the proceedings before the Opposition Division and the applicant's claim for reimbursement of those costs must in any event be rejected on that ground. The applicant's claim for reimbursement of the costs incurred for the purposes of the proceedings before the Board of Appeal must also be rejected, since its application for annulment has been dismissed.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

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

Legal

Mengozi

Wiszniewska-Białecka

Delivered in open court in Luxembourg on 4 May 2005.

H. Jung

Registrar

H. Legal

President

