

Case T-336/03

Les Éditions Albert René

v

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

(Community trade mark — Opposition proceedings — Earlier Community and national word mark OBELIX — Application for Community word mark MOBILIX — Article 8(1)(b) and (2) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Third Chamber), 27 October 2005 II - 4672

Summary of the Judgment

- 1. Community trade mark — Appeals procedure — Appeals before the Community judicature — Jurisdiction of the Court of First Instance — Re-evaluation of the facts in the light of evidence adduced for the first time before it — Not possible
(Rules of Procedure of the Court of First Instance, Art. 135(4); Council Regulation No 40/94, Art. 63)*

2. *Procedure — Application initiating proceedings — Subject-matter of the dispute — Delimitation — Alteration once proceedings have been started — Not allowed*
(Rules of Procedure of the Court of First Instance, Arts 44(1) and 48(2))
 3. *Community trade mark — Procedural provisions — Examination of the facts of OHIM's own motion — Opposition proceedings — Examination restricted to the submissions of the parties — Obligation on OHIM to accept points put forward by a party which have not been challenged by the other party — No obligation*
(Council Regulation No 40/94, Art. 74(1))
 4. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Word marks MOBILIX and OBELIX*
(Council Regulation No 40/94, Art. 8(1)(b))
 5. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Similarity of the marks concerned — Whether conceptual differences may neutralise visual or aural similarities — Conditions*
(Council Regulation No 40/94, Art. 8(1)(b))
 6. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Repute of the earlier mark — Effect*
(Council Regulation No 40/94, Art. 8(1)(b))
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1. The purpose of an action before the Court of First Instance is to review the legality of a decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) within the meaning of Article 63 of Regulation No 40/94 on the Community trade mark. In proceedings for annulment, the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted. It is thus not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. To admit such evidence is contrary to Article 135(4) of the Rules of Procedure of the Court of First Instance, which prohibits the parties from changing the

subject-matter of the proceedings before the Board of Appeal. Accordingly the documents produced for the first time before the Court of First Instance are inadmissible.

facts, evidence and arguments provided by the parties and the relief sought.

(see para. 16)

2. Under Article 44(1) of the Rules of Procedure of the Court of First Instance an applicant is required to state in the application the subject-matter of the proceedings and the form of order sought. Although Article 48(2) of those rules authorises, in certain circumstances, new pleas in law to be introduced in the course of proceedings, the provision cannot in any circumstances be interpreted as authorising the applicant to bring new claims before the Court and thereby to modify the subject-matter of the proceedings.

That provision restricts the examination carried out by OHIM in two ways. It relates, first, to the factual basis of decisions of OHIM, that is, the facts and evidence on which those decisions may be validly based, and, second, to the legal basis of those decisions, that is, the provisions which the jurisdiction hearing the case is obliged to apply. Thus the Board of Appeal, when hearing an appeal against a decision terminating opposition proceedings, may base its decision only on the relative grounds for refusal which the party concerned has relied on and the related facts and evidence it has presented.

(see para. 28)

3. According to Article 74(1) of Regulation No 40/94 on the Community trade mark, in proceedings relating to relative grounds for refusal of registration, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) is to be restricted in this examination to the

In that respect, whilst it is apparent from Article 74(1) of Regulation No 40/94 that, in the course of opposition proceedings, OHIM cannot examine the facts of its own motion, that does not mean however that it is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established. That provision only binds OHIM with regard to the facts, evidence and observations on which that decision is based.

(see paras 32-34)

4. For the average consumer in the European Union there is no likelihood of confusion between the word mark MOBILIX, whose registration as a Community trade mark is sought for products and services relating almost exclusively to the telecommunications sector in all its forms falling within Classes 9, 16, 35, 37, 38 and 42 of the Nice Agreement, and the word mark OBELIX, registered earlier as a Community trade mark for products and services in Classes 9, 16, 28, 35, 41 and 42.

tual differences between the signs at issue are capable of counteracting the phonetic similarities and any possible visual similarities.

Thus, even if there is a similarity between the goods and services covered by the marks, one of the indispensable conditions for the application of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark is not fulfilled.

(see paras 57, 62, 79-81, 86-87)

As regards the conceptual comparison, the words 'mobilix' and 'obelix' have no meaning in any of the official languages of the European Union. However, whilst the term 'mobilix' may readily be perceived as referring to something mobile or to mobility, the term 'obelix', even if the name has been registered as a word mark, that is to say with no visual reference to the comic strip character, will readily be associated by the average member of the public with the corpulent character from the comic strip series, widely known throughout the European Union, which tells of his adventures together with Asterix. 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. Since the sign OBELIX has a clear and specific meaning, the concep-

5. When the likelihood of confusion is being assessed for the purposes of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, conceptual differences between the signs at issue can in certain circumstances counteract the visual and aural similarities between two word marks. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.

(see para. 80)

6. A likelihood 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 likelihood of confusion. Where, however, the signs at

issue cannot be regarded as identical or similar, the fact that the earlier mark is widely known or enjoys a reputation in the European Union cannot alter the overall assessment of the likelihood of confusion.

(see para. 84)