

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

11 July 2007*

In Case T-150/04,

Mühlens GmbH & Co. KG, established in Cologne (Germany), represented by
T. Schulte-Beckhausen, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs)
(OHIM), represented initially by M. Capostagno, and subsequently by O. Montalto,
acting as Agents,

defendant,

the other party in the proceedings before the Board of Appeal of the Office for
Harmonization in the Internal Market (Trade Marks and Designs) and intervener
before the Court of First Instance being

* Language of the case: Italian.

Minoronzoni Srl, established in Ponte San Pietro (Italy), represented by G. Florida, F. Poletti and R. Florida, lawyers,

ACTION against the decision of the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) of 18 February 2004 (Case R 949/2001-1), relating to opposition proceedings between Mülhens GmbH & Co. KG and Minoronzoni Srl,

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

composed of J. Pirrung, President, A.W.H. Meij and I. Pelikánová, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 23 April 2004,

having regard to the response of the Office for Harmonization in the Internal Market (Trade Marks and Designs) lodged at the Court Registry on 29 October 2004,

having regard to the response of the intervener lodged at the Court Registry on 19 October 2004,

having regard to the measures of organisation of procedure of 14 December 2005,

further to the hearing on 6 September 2006,

gives the following

Judgment

Background to the dispute

- 1 On 2 December 1998 the intervener filed an application for a Community Trade Mark with the Office for Harmonization 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 application for the trade mark sought to register the following figurative mark:

TOSCA
BLU

3 The goods in respect of which registration was sought are in Classes 18 and 25 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 to the following description:

— Class 18: ‘Bags; handbags; travelling bags; rucksacks; wallets; purses; briefcases; document holders made of leather and imitation leather; gents’ handbags; trunks; animal skins, hides; leatherware; leather and goods made of leather; imitations of skins and leather and goods made of these materials; parasols, beach umbrellas, umbrellas, walking-sticks; harness and saddlery’;

— Class 25: ‘Clothing for men, women and children in general, including clothing of leather; shirts; blouses; skirts; suits; jackets; trousers; shorts; sports jerseys; T-shirts; pyjamas; stockings; singlets; corsets (underclothing); suspenders; underpants; brassières; underwear; hats; headscarves; neckties; waterproof clothing; overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski pants; belts; furs; scarves; gloves; dressing gowns; footwear in general, including slippers, shoes, footwear for sports, boots and sandals’.

4 On 22 July 1999, the application for the trade mark was published in the *Community Trade Marks Bulletin* No 59/99.

5 On 14 October 1999, the applicant filed a notice of opposition against the application for the Community trade mark pursuant to Article 8(1)(b) and (5) of Regulation No 40/94.

- 6 In support of the opposition, the applicant relied upon the unregistered word mark TOSCA, allegedly well known in Germany for the following products: 'perfume, eau de toilette, eau de Cologne, body lotions, toilet soaps, shower gel, etc.'

- 7 The opposition was based on all the goods covered by the earlier mark and directed against all goods covered by the trade mark applied for.

- 8 By decision of 17 September 2001, the Opposition Division held that the applicant had shown that the earlier mark was well known in Germany for 'perfumery products: eau de Cologne, perfumes'. Nevertheless, the Opposition Division rejected the opposition on the grounds that, first, the conditions referred to in Article 8(1)(b) of Regulation No 40/94 were not fulfilled due to the lack of similarity between the goods at issue and, second, since the opposition was based on an unregistered mark the protection specified in Article 8(5) of Regulation No 40/94 did not apply.

- 9 On 6 November 2001, the applicant brought an appeal against the decision of the Opposition Division.

- 10 By decision of 18 February 2004 ('the contested decision'), the Board of Appeal dismissed the appeal and ordered the applicant to pay the costs of the proceedings.

- 11 The Board of Appeal held that Article 8(1)(b) of Regulation No 40/94 required proof that the marks are identical or similar and that the goods or services covered are identical or similar. Although it was held that the marks at issue were undeniably similar, it was nevertheless held that the goods in issue were very different. The Board of Appeal also held that the reputation of a mark did not allow it to be assumed that a likelihood of confusion existed from the simple fact of a likelihood of association in the strict sense. As regards Article 8(5) of Regulation No 40/94, the Board of Appeal held that the opposition could not be upheld under this provision since it required the earlier mark to have been registered.

Forms of order sought

- 12 The applicant claims that the Court should:

- annul the contested decision;

- order OHIM to pay the costs.

- 13 OHIM contends that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

14 The intervener contends that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

15 The applicant raises two pleas in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94 and infringement of Article 8(5) of Regulation No 40/94 respectively.

The first plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

16 The applicant claims that there is likelihood of confusion between the marks at issue within the meaning of Article 8(1)(b) of Regulation No 40/94. The marks at issue have a high level of both visual and aural similarity. That similarity comes from its dominant element, the word 'tosca', which stands out particularly, since the complementary element 'blu', due to its descriptive character, does not attract the attention of the consumer. Furthermore, the earlier mark TOSCA has a strong

distinctive character on account of its reputation, which means that goods covered by the application for registration should be clearly different from those for which that well-known mark is protected.

17 The applicant claims that goods should be considered as similar when the public believes that the goods at issue come from the same undertaking or economically-linked undertakings. On the basis of the criteria expounded in Case C-39/97 *Canon* [1998] ECR I-5507, it is necessary to regard the goods at issue as complementary and they must be regarded as, at least, broadly similar. On no basis, can they be regarded as totally unlike.

18 The applicant claims that many undertakings in the fashion or fashion accessories sector grant licences of their trademarks for the production and marketing of perfumery articles. Some of those undertakings, which were originally active in the fashion sector, such as Gucci, Chanel or Rochas, are, moreover, now known as producers of perfumery only. The public is therefore accustomed to fashion sector articles and fine leather goods being sold under perfume trade marks. Moreover, there are a whole range of stylists who carry out their activities both in the perfume sector and the fashion sector and lend their names to two types of product. The relevant public, not usually being aware of the licences which are granted, attributes the goods bearing the same trade mark to the same undertaking.

19 The applicant claims, in its observations given in response to the questions of the Court, that there are many trade marks which cover various different luxury goods, such as leather bags, shoes, clothing and perfumes. In this regard, it refers to the

trade marks Yves Saint Laurent, Bulgari, Prada, Gucci, Lacoste, Cacharel, Chanel, Dior, Kenzo, Joop !, Davidoff, Armani, Hugo Boss, Bogner and Adidas.

20 In addition, the applicant refers to the judgment of the Oberlandsgericht Köln (Cologne Higher Regional Court) of 28 March 2003 (Case 6 U 113/02). In its observations in response to the questions of the Court, it also refers to other decisions of national Courts which tend to accept that physically and functionally different goods, such as perfumes and clothing, are nevertheless likely, because of the practice of granting licences, to have a certain resemblance due to their distribution under similar marks.

21 The applicant adds that the common factor between the goods in question is that they are important for the image of an individual, which is reflected by the fact that in fashion magazines, such as *Vogue*, the advertisements almost exclusively involve fashion, fashion accessories and perfumery articles. Thus, those products complement each other and are mutually connected, leading the consumer to believe that the products come from the same source.

22 In response to the questions of the Court, the applicant finally submits that, in order to assess the likelihood of confusion between an earlier mark and a more recent mark, it is not necessary to take into account the means by which the manufacturers expand their range of products over time. Neither Article 8 nor the remaining provisions of Regulation 40/94 justify assessing the likelihood of confusion by taking account of the order in which the trade mark holder creates his own range.

23 OHIM and the intervener contend that the plea in law is unfounded.

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 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. Under Article 8(2)(c), earlier trade marks are defined as trade marks which, on the date of application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words ‘well known’ are used in Article 6 bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaty Series, Vol. 828, No 11847, p. 108) (‘the Paris Convention’).
- 25 According to settled case-law, a likelihood of confusion arises when 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.
- 26 That case-law also states that the likelihood of confusion must be assessed globally, according to the perception by the relevant public of the signs and the goods or services in question, and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between similarity of the signs and similarity 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, and Case T-185/02 *Ruiz-Picasso and Others v OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraphs 49 and 50).

- 27 It is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion within the meaning of that provision presupposes that the goods or services covered are identical or similar. Therefore, even where the mark applied for is identical to a mark which is particularly distinctive, it is still necessary to adduce evidence of similarity between the goods or services covered by the two marks (Case T-296/02 *Lidl Stiftung v OHIM — REWE-Zentral (LINDENHOF)* [2005] ECR II-563, paragraph 48; see also, by analogy, *Canon*, paragraph 22).
- 28 As the contested decision rejected the existence of a likelihood of confusion on the basis of a lack of proof of similarity between the goods covered by the marks at issue, it is sufficient, in order to examine the merits of the first plea in law, to deal with the issue of similarity between the goods at issue.
- 29 In assessing the similarity of the goods in question, all the relevant factors relating to the way in which those goods are connected should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*LINDENHOF*, paragraph 49; see also, by analogy, *Canon*, paragraph 23).
- 30 In the current proceedings, it is clear from the contested decision that the goods covered by the earlier mark have the following description ‘perfumery products: eau de Cologne, perfumes’. This point was not contested. The products covered by the trade mark applied for consist of the products in Classes 18 and 25 of the Nice Agreement listed at paragraph 3 of this judgment.
- 31 Clearly perfumery products and leather goods within Class 18, as of themselves, cannot be considered similar. Perfumery products and leather goods are plainly different as regards their nature, their purpose, and their method of use. Moreover,

there nothing that enables them to be regarded as in competition with each other or functionally complementary.

32 The same conclusion must be drawn concerning a comparison between perfumery products and clothing in Class 25. Those goods, as of themselves, also differ as regards their nature, their purpose and their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary.

33 Nevertheless, the applicant claims that the goods covered by the marks at issue share a certain degree of similarity, in so far as the public is accustomed to fashion items being marketed under perfume trade marks and associate these goods with the same undertaking, by reason of trade mark licences which are granted by undertakings in the fashion sector for the marketing of perfumery articles.

34 In this regard, it is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

- 35 Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.
- 36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM — Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraphs 60 and 62).
- 37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*SISSI ROSSI*, paragraph 63).
- 38 In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so

as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

39 The applicant nevertheless claims that the goods at issue have in common their importance for a person's image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36.

40 In relation to the applicant's argument based on the decision of the Oberlandsgericht Köln of 28 March 2003 (see paragraph 20 above), it should be pointed out that this decision was annulled by judgment of the Bundesgerichtshof (German Federal Court of Justice) of 30 March 2006 (Case I ZR 96/03) and that, in any event, a decision of a national court cannot bind the OHIM authorities or the Community Courts. The Community trade mark regime is an autonomous system which applies independently of any national system (Case T-32/00 *Messe München v OHIM (Electronica)* [2000] ECR II-3829, paragraph 47).

41 It follows from the foregoing that the Board of Appeal was correct to find a lack of similarity between the goods at issue. Accordingly this plea must be rejected.

The second plea, alleging infringement of Article 8(5) of Regulation 40/94

Arguments of the parties

- 42 The applicant claims that the opposition should also be successful on the basis of Article 8(5) of Regulation No 40/94. According to the applicant, the Board of Appeal erred in law in holding that Article 8(5) could be relied upon only as regards registered trade marks.
- 43 According to the applicant, the approach adopted by the Board of Appeal goes against the wording and the purpose of Article 8(5) of Regulation No 40/94, in so far as this provision relates back to earlier marks within the meaning of paragraph 2 of that article and therefore, in particular, to the well-known marks referred to in Article 8(2)(c) of Regulation No 40/94. According to the applicant, if Article 8(5) related only to registered trade marks then only paragraphs 2(a) and 2(b) would have been mentioned in paragraph 5 of that article.
- 44 The applicant also claims that the phrase ‘for which the earlier mark is registered’ in Article 8(5) of Regulation No 40/94, is the result of a drafting error. This phrase should have stated, ‘for which the earlier mark is protected’, in order to cover also those marks which are well known within the meaning of Article 6 bis of the Paris Convention.
- 45 In support of the argument that Article 8(5) of Regulation No 40/94 may be interpreted broadly and contrary to its wording, the applicant refers to Case C-292/00 *Davidoff* [2003] ECR I-389, paragraph 24, in which the Court of Justice interpreted Article 5(2) of 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) not solely on the basis of its wording, but also in the light of the overall scheme and objectives of the system of which it is a part. The applicant maintains that if the objective of Article 8(5) of Regulation No 40/94 is, like that of Article 5(2) of Directive 89/104, the increased protection of well-known marks, it would follow that

not only registered trade marks but also earlier marks, protected due to their reputation, should be able to enjoy this increased protection.

46 In reply to the questions of the Court the applicant also submits that German legislation ensures extended protection for well-known marks within the meaning of Article 6 bis of the Paris Convention.

47 In the present case, the applicant claims that the conditions of Article 8(5) of Regulation No 40/94 are satisfied. First, the TOSCA mark enjoys a reputation within the meaning of this provision. Secondly, the trade mark applied for bears a strong resemblance to the earlier mark. Thirdly, the use of the trade mark applied for would take unfair advantage of the distinctive character and the reputation of the well-known mark TOSCA and would be detrimental to that mark. The reputation which the earlier mark enjoys in perfumery products could be transferred to the products for which the trade mark applied for seeks protection. The applicant also claims that no justification can be provided by the party seeking the Community trade mark.

48 OHIM and the intervener contend that the second plea in law is unfounded.

Findings of the Court

49 Article 8(2)(c) of Regulation No 40/94 includes within the concept of an earlier trade mark those marks which are well known within the meaning of Article 6 bis of the Paris Convention.

50 Article 6 *bis* (1) of the Paris convention provides as follows:

‘The countries of the Union [for the protection of industrial property] undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trade mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods ...’

51 It is clear from this provision that well-known marks within the meaning of Article 6 *bis* of the Paris Convention are marks which, on the basis of their reputation in the territorial area at issue and, irrespective of whether proof of registration is provided, enjoy protection against a likelihood of confusion.

52 In so far as the provisions of Article 8(1) and (5) of Regulation No 40/94 apply to earlier marks as defined in Article 8(2) the marks which are well known within the meaning of the Article 6 *bis* of the Paris Convention enjoy the system of protection put in place by those provisions. Nevertheless, for an opposition to be upheld on the basis of Article 8(1) or (5) of Regulation No 40/94, the conditions laid down by these provisions must be satisfied.

53 It should be pointed out, in this regard, that Article 8(1) and (5) of Regulation No 40/94 lay down the relative grounds for refusal for the registration of a particular Community trade mark. On the one hand, Article 8(1)(b) of Regulation No 40/94 protects the earlier mark against the risk of confusion. The protection is confined by the limits of the principle of speciality, that is, when the goods or services of the marks at issue are identical or similar. Moreover, Article 8(1) of Regulation 40/94 does not specify whether the earlier mark must have been registered.

54 On the other hand, Article 8(5) of Regulation No 40/94 protects an earlier well-known mark against marks likely either to, take unfair advantage of its reputation or of its distinctive character, or to be detrimental to that reputation or to that distinctive character. While this protection can apply when the products or services covered by the marks at issue are identical or similar, it is intended, primarily, to be applied in the case of goods and services which are not similar (see, to that effect, and by analogy Case C-408/01 *Adidas-Salomon and Adidas Benelux* [2003] ECR I-12537, paragraph 22).

55 It follows from Article 8(5) of Regulation No 40/94 which uses the expression ‘for which the earlier trade mark is registered’, that this provision only applies to earlier marks within the meaning of Article 8(2) of that regulation in so far as they have been registered (see, to that effect, and by analogy, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23; *Davidoff*, paragraph 20; and *Adidas-Salomon and Adidas Benelux*, paragraph 22).

- 56 Consequently, in contrast to Article 8(1)(b) of Regulation No 40/94 which allows, as regards identical or similar goods or services, opposition based on marks for which no proof of registration has been provided, but which are well known within the meaning of Article 6 *bis* of the Paris Convention, Article 8(5) of Regulation No 40/94 protects, in relation to goods or services which are not similar, only those well-known marks within the meaning of Article 6 *bis* of the Paris Convention for which proof of registration has been provided.
- 57 In this regard, it should be noted that the exclusion of well-known marks for which registration has not been proved, from the scope of Article 8(5) of Regulation No 40/94 is in keeping with Article 6 *bis* of the Paris Convention, which, since it is only applicable within the limits of the principle of speciality, provides no protection for different goods.
- 58 In the light of the foregoing, the applicant's argument alleging that the wording of Article 8(5) of Regulation No 40/94 resulted from a drafting error must be rejected.
- 59 Nor can the applicant further claim that an interpretation of Article 8(5) of Regulation No 40/94 having regard to its overall scheme should lead to that article also applying to unregistered well-known marks. Indeed, it is clear from the scheme of Article 8 of Regulation No 40/94 that a well-known mark within the meaning of

Article 6 *bis* of the Paris Convention, for which no proof of registration is provided, enjoys protection only against a risk of confusion in regard to identical or similar goods or services, in the same way as Article 6 *bis* of the Paris Convention provides protection in relation to goods.

60 In addition, Regulation No 40/94 is consistent, on this point, with Article 16(3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights of 15 April 1994 (Annex 1 C to the Agreement establishing the World Trade Organisation) (OJ 1994 L 336, p. 214), which extends the application of Article 6 *bis* of the Paris Convention to situations where the goods or services at issue are not similar, on the condition, however, that the earlier mark has been registered.

61 The fact that, as the applicant mentions, that German legislation provides broader protection to unregistered marks which are well known within the meaning of Article 6 *bis* of the Paris Convention does not change the finding that Article 8(5) of Regulation No 40/94 does not apply to well-known marks where they have not been registered. As has been pointed out at paragraph 40 above, the Community trade mark regime is an autonomous system which applies independently of any national system (*Electronica*, paragraph 47).

62 It follows that the Board of Appeal was right to reject the opposition brought by the applicant on the basis of Article 8(5) of Regulation No 40/94.

63 The second plea must therefore be dismissed as unfounded.

64 The present appeal, not being upheld on any of its pleas, must therefore be dismissed.

Costs

65 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, in accordance with the forms of order sought by OHIM and the intervener.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Dismisses the action;

2. Orders Mühlens GmbH & Co. KG to pay the costs.

Pirrung

Meij

Pelikánová

Delivered in open court in Luxembourg on 11 July 2007.

E. Coulon

Registrar

J. Pirrung

President