

JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

13 December 2007*

In Case T-134/06,

Xentral LLC, established in Miami, Florida (United States), represented by
A. Bertrand, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs)
(OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener
before the Court of First Instance, being

* Language of the case: French.

Pages jaunes SA, established in Sèvres (France), represented by C. Bertheux Scotte, B. Potot and B. Corne, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of 15 February 2006 (Case R 708/2005-1), in respect of opposition proceedings between Pages jaunes SA and Xentral LLC,

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

composed of M. Jaeger, President, V. Tiili and T. Tchipev, Judges,

Registrar: K. Pocheć, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 11 May 2006,

having regard to the response of OHIM lodged at the Registry on 24 November 2006,

having regard to the response of the intervener lodged at the Registry of the Court on 22 November 2006,

further to the hearing on 7 June 2007,

gives the following

Judgment

Background to the dispute

- 1 On 21 September 2000, Prodis Inc. filed an application for a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The trade mark in respect of which registration was sought is the word sign PAGESJAUNES.COM.

- 3 The goods in respect of which registration was applied for are in Class 16 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: 'Printed matter, newspapers, periodicals, directories'.

- 4 By letter of 21 February 2002 the examiner informed Prodis that the sign in question was not capable of being registered by virtue of Article 7(1)(b) of Regulation No 40/94 since it is devoid of any distinctive character. According to the examiner, the relevant public will perceive the sign as the electronic address of any one of the undertakings which market professional directories.

- 5 In the absence of any observations on his objection, the examiner refused the application for registration by decision of 4 June 2002 on the basis of Article 7(1)(b) of Regulation No 40/94.

- 6 On 3 July 2002 Prodis filed notice of appeal at OHIM in accordance with Articles 57 to 62 of Regulation No 40/94 against the refusal to register the trade mark PAGESJAUNES.COM.

- 7 By letter of 4 October 2002, following an interlocutory revision under Article 60 of Regulation No 40/94, the examiner informed Prodis that, after consideration, its application for registration had been accepted for the purposes of publication.

- 8 That application was published in *Community Trade Marks Bulletin* No 81/2002 of 14 October 2002.

- 9 On 6 January 2003, the intervener, Pages jaunes SA, gave notice of opposition under Article 42 of Regulation No 40/94 to registration of the trade mark applied for. That opposition was based, first, on the company name and trade name Pages jaunes and,

secondly, on French registration No 99800903, dated 2 April 1999, for the figurative mark LES PAGES JAUNES, covering goods and services in Classes 9, 16, 35, 38, 41 and 42, reproduced below:



- 10 The opposition was against all the goods covered by the PAGESJAUNES.COM trade mark application. It was based on all the goods and services covered by the earlier trade mark, inter alia ‘Printed matter, newspapers, periodicals, directories’ in Class 16.
- 11 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and (4) of Regulation No 40/94. The renown of the earlier trade mark, the company name and the trade name was also relied upon and was based on their intensive and long-standing use, in particular to designate directories and publications.
- 12 By decision of 28 April 2005 the Opposition Division upheld the opposition on the basis of Article 8(1)(b) of Regulation No 40/94. It found that there was a likelihood of confusion, taking into account the identical nature of the goods in question, the strong aural and conceptual similarity between the opposing marks and the renown of the earlier trade mark in France. It also held that, even though the expression

‘pages jaunes’ could be considered commonplace in a number of countries and, to a certain extent, in France, Prodis had not proven that the earlier trade mark has become commonplace ‘on account of’ the intervener.

13 On 16 June 2005 Prodis filed notice of appeal at OHIM, in accordance with Articles 57 to 62 of Regulation No 40/94, against the decision of the Opposition Division.

14 By decision of 15 February 2006 (‘the contested decision’), the First Board of Appeal of OHIM dismissed the appeal. It held that the possible earlier right of Prodis, that is the domain name ‘pagesjaunes.com’, had to be ignored, that it was not for OHIM to rule on the nullity of national trade marks, and that nothing in the documents before it substantiated the argument that, for a French consumer, the expression ‘pages jaunes’ was not distinctive or was descriptive for publications, in particular for telephone directories. According to the Board of Appeal, on the contrary, that expression had a ‘normal distinctive character’ since the colour in which it is represented is arbitrary and the expression had not become generic. The Board of Appeal held that the dominant component of the two opposing marks was made up of the same expression ‘pages jaunes’ and that the similarity between those marks was striking. In conclusion, it held that, given that the relevant goods were identical, there was a likelihood of confusion in France, on the ground that the trade mark applied for is perceived as the internet version of the paper-based directory bearing the LES PAGES JAUNES trade mark and that the goods in question are therefore considered to come from the same undertaking.

15 The application for the trade mark PAGESJAUNES.COM was transferred to the applicant, Xentral LLC. That transfer was recorded in the Register of Community trade marks on 2 May 2006.

Forms of order sought

16 The applicant claims that the Court should:

- annul the contested decision;
- validate the trade mark PAGESJAUNES.COM;
- order the Board of Appeal of OHIM to pay the costs.

17 OHIM contends that the Court should:

- dismiss as inadmissible the second head of claim;
- dismiss the remainder of the action;
- order the applicant to pay the costs.

18 The intervener contends that the Court should:

- uphold the contested decision;

- dismiss the application for registration of the trade mark PAGESJAUNES.COM in its entirety;

- order the applicant to pay the costs.

19 At the hearing the applicant withdrew its second head of claim and the Court took formal notice of that withdrawal. The applicant specified in addition that its third head of claim was to be understood as seeking an order for costs against OHIM, of which the Court also took formal notice.

20 At the hearing the intervener withdrew its second head of claim, and the Court took formal notice of that withdrawal.

The admissibility of the documents produced for the first time before the Court

21 The intervener claims that Annexes 51 to 53, 77 and 78 to the application are new documents in that they were not produced before OHIM. Therefore, those documents are inadmissible.

22 Annexes 51 to 53 and 77 to the application — Annex 52 being the same as Annex 77 — are extracts from the *Annuaire — Almanach du commerce, de l'industrie, de la magistrature et de l'administration* (Directory — Trade, Industry, Judicial

Authorities and Administration Almanac) (Didot-Bottin) of 1887, 1886 and 1891 which were not included in the administrative file before OHIM. Annex 78 contains extracts from the register of the Institut national de la propriété industrielle (INPI) (the National Institute for Industrial Property) relating to those trade marks filed in France containing the word element ‘pages jaunes’, which were also not produced before OHIM.

- 23 Those documents, produced for the first time before the Court, cannot therefore be taken into consideration. The purpose of actions before the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94, so it is not the Court’s function to review the facts in the light of documents produced for the first time before it. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value (see Case T-346/04 *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 19, and the case-law cited).

The admissibility of certain arguments put forward by the applicant

- 24 OHIM claims that the applicant’s arguments, in relation to Article 8(4) of Regulation No 40/94, are inadmissible and in any case irrelevant, as the Opposition Division upheld the opposition on the basis of Article 8(1)(b) of Regulation No 40/94 without examining the conditions for the application of Article 8(4) of that regulation. As that latter legal basis was also not examined by the Board of Appeal, the Court can review the legality of the contested decision only on the basis of Article 8(1)(b) of that regulation.
- 25 The applicant puts forward arguments relating to the application of Article 8(1)(b) and (4) of Regulation No 40/94. However, the Opposition Division and the Board of Appeal upheld the opposition on the basis of Article 8(1)(b) of that regulation, deciding that there was a likelihood of confusion between the trade mark applied for

and the earlier trade mark, which led to the refusal of the application for registration of the trade mark PAGESJAUNES.COM. Neither the Opposition Division nor the Board of Appeal carried out a comparison of the trade mark applied for with the company name or trade name of the intervener, which were relied upon by the intervener in support of its opposition based on Article 8(4) of Regulation No 40/94, since the existence of a relative ground for refusal was sufficient to uphold the opposition.

26 It must be borne in mind, in that regard, that the purpose of the action before the Court of First Instance is to obtain a review of the legality of the decision of the Board of Appeal. That 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 it (Case T-133/05 *Meric v OHIM — Arbora & Ausonia (PAM-PIM'S BABY-PROP)* [2006] ECR II-2737, paragraph 22, and Case T-364/05 *Saint-Gobain Pam v OHIM — Propamsa (PAM PUVIAL)* [2007] ECR II-757, paragraph 83).

27 Therefore, it must be examined whether the Board of Appeal correctly held that a likelihood of confusion exists between the trade mark applied for and the earlier trade mark on the basis of Article 8(1)(b) of Regulation No 40/94, without it being necessary for the Court, which cannot take the place of OHIM as regards the assessment of the relative grounds for refusal, referred to in Article 8(4) of that regulation, to take into account the company name and the trade name relied on by the intervener in support of its opposition. Therefore, only the plea alleging infringement of Article 8(1)(b) of Regulation No 40/94 must be examined.

28 Moreover, OHIM contends that the applicant's arguments intended to deny the claimed renown of the earlier mark are not relevant in the context of the present action. Since the Board of Appeal confirmed the existence of a likelihood of confusion by concerning itself with the 'normal distinctive character' of the earlier mark, it did not examine that mark's renown acquired through use, which the intervener alleged in the course of proceedings before OHIM, or base its decision on that renown.

29 Since the Opposition Division found in its decision that the intervener had proven that its mark was well-known in France, which the applicant disputed in its appeal before the Board of Appeal, the issue of renown was part of the subject-matter of the dispute before the Board of Appeal. Therefore, the arguments put forward in that regard by the applicant are admissible.

Substance

30 According to the applicant the domain name 'pagesjaunes.com', of which it is the owner, must be regarded as an earlier right enforceable against the earlier mark. In addition, the earlier mark has a weak distinctive character and is even generic. Moreover, the trade mark applied for does not constitute an unlawful imitation of the earlier mark. Finally, according to the applicant, the intervener cannot rely on any renown attaching to the earlier mark.

31 OHIM and the intervener contend that the Board of Appeal was fully entitled to find that a likelihood of confusion exists.

32 At the outset, it is necessary to examine the applicant's argument that its domain name 'pagesjaunes.com' should be regarded as an earlier right enforceable against the intervener's earlier mark.

The possible effects of an earlier right based on the domain name 'pagesjaunes.com'

- 33 The applicant claims that a domain name is a distinctive sign in the same way as a mark and gives rise to an earlier right. The domain name 'pagesjaunes.com' was registered on 9 April 1996, well before the earlier trade mark, registered on 2 April 1999, on which the intervener based its opposition.
- 34 According to the applicant, by decision of 21 August 2000, an administrative panel of the World Intellectual Property Organisation (WIPO) confirmed the applicant's rights over the domain name 'pagesjaunes.com' and refused to grant the requests of France Télécom, which was the holder, at that time, of the French figurative trade marks PAGES JAUNES, filed in 1977.
- 35 In that regard, the Board of Appeal, at point 10 of the contested decision, held that that argument had to be rejected, since 'the examination which [OHIM] must carry out under Article 8(1) of [Regulation No 40/94] is restricted to the conflict between the Community trade mark applied for and the earlier right relied upon'.
- 36 That finding must be upheld, without any need to rule on the question of whether a domain name can be regarded as an enforceable right. The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the

national authorities (Case T-269/02 *PepsiCo v OHIM — Intersnack Knabber-Gebäck (RUFFLES)* [2005] ECR II-1341, paragraph 26; see also, to that effect, Case T-288/03 *Teletech Holdings v OHIM — Teletech International (TELETECH GLOBAL VENTURES)* [2005] ECR II-1767, paragraph 29).

37 Therefore, as long as the earlier national mark is in fact protected, the existence of a national registration or another right predating that former mark is irrelevant in the context of opposition to a Community trade mark application, even if the Community trade mark applied for is the same as a national trade mark held by the applicant or another right predating the national mark on which the opposition is based (see, to that effect, Case T-185/03 *Fusco v OHIM — Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 63). Thus, even if rights over earlier domain names may be treated in the same way as an earlier national registration, in any event, it is not for the Court to rule on a conflict between an earlier national trade mark and rights over earlier domain names, as such a conflict does not come within the jurisdiction of the Court.

38 In the present case, it must be noted that the applicant has, in actual fact, on the basis inter alia of its domain name 'pagesjaunes.com', attempted to obtain before the competent national authorities a declaration of invalidity of the various PAGES JAUNES trade marks of which the intervener is the holder. However its application for invalidity was dismissed by the decisions of the Tribunal de Grande Instance, Paris (Regional Court, Paris) (France) of 14 May 2003 and of the Cour d'Appel, Paris (Court of Appeal, Paris) of 30 March 2005. Moreover, since those two decisions did not examine the validity of the earlier trade mark claimed in the present case, but that of other PAGES JAUNES trade marks of which the intervener is the holder, they do not, in any event, have any bearing in the present case, since the earlier trade mark is still valid.

39 Further, the decision of the administrative panel of WIPO dealt only with the question of a possible transfer of the domain names ‘pagesjaunes.com’ and ‘pagesjaunes.net’ to France Télécom, and not that of the likelihood of confusion between ‘pagesjaunes.com’ and LES PAGES JAUNES, so that it has no relevance for the present proceedings. Furthermore, WIPO also did not rule on the validity of the earlier trade mark.

40 Consequently the applicant cannot rely on its claimed earlier right based on the domain name ‘pagesjaunes.com’ in the present proceedings.

41 Thus, it must be examined whether the Board of Appeal correctly applied Article 8(1)(b) of Regulation No 40/94 in the present case.

The application of Article 8(1)(b) of Regulation No 40/94

42 In the words of Article 8(1)(b) of Regulation No 40/94, 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. The likelihood of confusion includes the likelihood of association with the earlier trade mark. In addition, under Article 8(2)(a)(ii) of Regulation No 40/94, earlier trade marks means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.


- 43 According to established 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.
- 44 According to the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception that the relevant public has of the signs and goods or services at issue, taking into account all factors relevant to the circumstances of the case, in particular the interdependence of the similarity between the signs and between the goods or services covered (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33, and the case-law cited).
- 45 In the present case, the mark upon which the opposition was based is a national trade mark registered in France. Therefore, the relevant territory for the analysis of the likelihood of confusion is the French territory.
- 46 Given that the goods in question are everyday consumer goods, the relevant public is the average French consumer who is deemed to be reasonably well-informed and reasonably observant and circumspect.
- 47 It is not disputed that the goods covered by the two opposing marks are identical. The two marks cover 'printed matter, newspapers, periodicals, directories' in Class 16 of the Nice Agreement. Although the opposition was also based on goods and services in other classes (Classes 9, 35, 38, 41 and 42) for which the earlier trade mark was registered, there is no need to examine them, since the contested decision was based solely on the goods covered by Class 16.

Comparison of the signs

48 According to settled case-law, the global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the opposing signs, must be based on the overall impression given by the signs, bearing in mind, *inter alia*, their distinctive and dominant components (see Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47, and case-law cited).

49 The applicant takes the view that the opposing marks are not similar, whereas OHIM and the intervener submit that they are.

50 The marks to be compared are the following:

Earlier trade mark	Trade mark applied for
	<p>PAGESJAUNES.COM</p>

51 The applicant points out that it is first necessary to assess the opposing marks overall and to consider their characteristic or distinctive components, before proceeding with the comparison. The earlier mark is characterised by a particular graphic representation highlighting the expression ‘pages jaunes’, which is descriptive, commonplace and generic.

- 52 It must be borne in mind that, according to settled case-law, a complex trade mark can be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, if 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 (*MATRATZEN*, paragraph 33; Case T-153/03 *Inex v OHIM — Wiseman (Representation of a cowhide)* [2006] ECR II-1677, paragraph 27, and *PAM PLUVIAL*, paragraph 97).
- 53 In the present case, the expression ‘pages jaunes’ constitutes the dominant element of the earlier trade mark. It stands out clearly from the whole of the earlier mark, because of the size of the characters in which it is written and its dimensions within the mark. Moreover, the graphic representation of the words ‘les pages jaunes’, written in white on a black background, is not, as OHIM correctly states, original in any way and thus must be regarded as a negligible component in the visual perception of that mark, contrary to what the applicant claims. In addition, the article ‘les’ is written in a smaller font, which minimises its visual importance. Therefore, since all the other components of that mark are negligible, the visual impression of the earlier trade mark is dominated by the word component ‘pages jaunes’.
- 54 That finding cannot be called into question by the applicant’s argument that the expression ‘pages jaunes’ has no distinctive character, because it is descriptive, commonplace and generic. The weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them (*Representation of a cowhide*, paragraph 32; see also, to that effect, Case T-115/02 *AVEX v OHIM — Ahlers (a)* [2004] ECR II-2907, paragraph 20).

- 55 Consequently, it is not necessary to rule, at this stage of the assessment, on the possible weak distinctive character of the expression 'pages jaunes', since it is obvious, having regard to the findings at paragraph 53 of this judgment, that it is that expression which is likely to make an impression on consumers and be remembered by them.
- 56 In respect of the trade mark applied for, PAGESJAUNES.COM, which is purely a word mark, it must be noted that it is made up of two parts. The component 'pagesjaunes' constitutes the dominant component on account of its length and its position. The ending '.com' is merely secondary, referring simply to an internet address.
- 57 As regards the visual comparison between the opposing signs, the applicant claims that the earlier trade mark comprises three words with a total of five syllables, while the trade mark applied for comprises only one word of six syllables. According to the applicant, the similarities arising from the word component 'pages jaunes', which is not very distinctive, must be placed in context, to focus on those aspects which differentiate the opposing marks, namely their spelling and, on the one hand, the existence of the article 'les', and on the other, the existence of the ending '.com'. There are, therefore, noticeable differences at a visual level.
- 58 That line of argument cannot be accepted. Even if the words 'pages' and 'jaunes' are side by side in the trade mark applied for, while in the earlier trade mark there seems to be a barely visible gap between the two words, the dominant components of those two marks are the same. Furthermore, the word components 'les' of the earlier trade mark, and '.com' of the trade mark applied for, do not distinguish those marks from each other, because those components are purely secondary, as is clear from paragraphs 53 and 56 above. The graphic representation of the earlier trade mark is also not such as to make the marks different at a visual level.

- 59 Therefore, it must be held that the opposing marks are similar at a visual level.
- 60 In respect of the aural comparison between the opposing signs, the applicant claims that there are also significant differences between the two marks, since the earlier trade mark is pronounced 'paj-jo-ne', while the trade mark applied for is pronounced 'paj-jo-ne-point-com'.
- 61 That reasoning cannot be accepted. It is sufficient to state that the only differences between the components 'les' and '.com', which are secondary, are not enough to rule out the aural similarities resulting from the reproduction of the words 'pages' and 'jaunes', that is to say, of the dominant component of the earlier mark, in the trade mark applied for. Further, the article is not necessarily pronounced, which the applicant itself implicitly admits, since it makes no mention of it in its claims relating to the aural comparison of the marks in question.
- 62 In respect of the conceptual comparison of the opposing signs, according to the applicant, there is no similarity, since the earlier trade mark undeniably calls to mind paper-based directories, the pages of which are yellow, while the trade mark applied for calls to mind the internet and an internet address finder.
- 63 That line of argument from the applicant must also be rejected. Both marks refer to yellow-coloured pages. The presence of the word component 'les' in the earlier trade mark in no way changes its conceptual content, given that that word merely fulfils the function of an article. The only difference relates to the ending '.com' of the

trade mark applied for. However, that ending does not alter the meaning of the expression 'pages jaunes', since it is restricted to suggesting the idea that the goods covered by the trade mark applied for can be consulted or bought over the internet.

64 Consequently, it must be concluded that the marks in question are similar, and that the Board of Appeal was fully entitled to find, at paragraph 20 of the contested decision, that the similarity between the marks was striking at both the visual and aural levels and the conceptual level.

65 It is now necessary to consider whether, overall, there is a likelihood of confusion between the opposing marks.

The likelihood of confusion

66 The Board of Appeal's position as regards whether a likelihood of confusion exists is set out at paragraph 21 of the contested decision as follows:

'If one adds to [the striking similarity between the opposing marks] the fact that they would be used for identical goods, offered to the same public, living in the same territory, the likelihood of confusion is not merely probable, but assured. French users will think that PAGESJAUNES.COM is the internet version of the paper directory [bearing the trade mark] LES PAGES JAUNES and that, obviously, the two products are offered by the same undertaking.'

- 67 The applicant claims that, taking into account its very weak distinctive character, the earlier trade mark can, by its very nature, benefit only from limited protection, consisting merely in a prohibition on the slavish reproduction of it, without ever conferring on the intervener an exclusive right over the expression ‘pages jaunes’. According to the applicant, the Board of Appeal omitted to take into account the very weak distinctive character of the earlier mark when comparing the marks in question.
- 68 It must be pointed out, in that context, that it is clear from the contested decision that the Board of Appeal held that the earlier trade mark had a ‘normal distinctive character’.
- 69 Without needing to examine the applicant’s various arguments in relation to the alleged weak distinctive character of the earlier trade mark, it is sufficient to observe that, even if it were considered that the Board of Appeal had wrongly decided that the earlier trade mark had a ‘normal distinctive character’, such an error cannot lead to the annulment of the contested decision.
- 70 The finding of a weak distinctive character for the earlier trade mark does not prevent a finding that there is a likelihood of confusion in the present case. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Case C-39/97 Canon* [1998] ECR I-5507, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see, to that effect, *Case T-112/03 L’Oréal v OHIM — Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61).

71 In addition, the approach taken by the applicant in that respect would have the effect of disregarding the factor of the similarity of the marks in favour of one based on the distinctive character of the earlier national mark, which would then be given undue importance. The result would be that where the earlier national mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question (order of 27 April 2006 in Case C-235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraph 45). Such a result would not, however, be consistent with the very nature of the global appreciation which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (judgment of 15 March 2007 in Case C-171/06 P *T.I.M.E. ART v Devinlec and OHIM*, not published in the ECR, paragraph 41).

72 Therefore, it must be held that there exists, in the present case, a likelihood of confusion, given that the goods in question are identical and given the similarity between the opposing signs. As the Board of Appeal correctly held at paragraph 21 of the contested decision, French consumers could think that the trade mark applied for, *PAGESJAUNES.COM*, is the internet version of the paper-based directory bearing the *LES PAGES JAUNES* trade mark and that, therefore, the two products are offered by the same undertaking.

73 In those circumstances, the assertion that the earlier trade mark has no renown must also be rejected. Since the Board of Appeal did not base its decision on the renown of the earlier trade mark and it correctly held there is a likelihood of confusion, the possible lack of renown would not in any way affect the legality of the contested decision.

74 It follows from all the above that the action must be dismissed.

Costs

75 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 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 (Third Chamber)

hereby:

1. Dismisses the action;

2. Orders Xentral LLC to pay the costs.

Jaeger

Tiili

Tchipev

Delivered in open court in Luxembourg on 13 December 2007.

E. Coulon

Registrar

M. Jaeger

President