

Case T-110/01

Vedial SA

v

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

(Community trade mark — Opposition proceedings — Earlier word mark
SAINT-HUBERT 41 — Application for a Community figurative mark
containing the word ‘HUBERT’ — Relative ground for refusal — Likelihood of
confusion — Article 8(1)(b) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 12 December
2002 II- 5278

Summary of the Judgment

1. *Community trade mark — Appeals procedure — Appeals before the Community
judicature — Procedural role of the Office — Defendant — Application for the
annulment or alteration of decisions taken by the Boards of Appeal — Inadmissible
(Council Regulation No 40/94, Art. 63(3) and (4))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark registered in respect of identical or similar goods or services — Similarity between the trade marks concerned — Possibility of a visual similarity between a figurative mark and a word mark*
(Council Regulation No 40/94, Art. 8(1)(b))
 3. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark registered in respect of identical or similar goods or services — Likelihood of confusion with the earlier mark — Reputation of the earlier mark — Not relevant where no similarity between the marks concerned*
(Council Regulation No 40/94, Art. 8(1)(b))
 4. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark registered in respect of identical or similar goods or services — Likelihood of confusion with the earlier mark — Composite word and figurative mark containing the word 'HUBERT' and word mark 'SAINT-HUBERT 41'*
(Council Regulation No 40/94, Art. 8(1)(b))
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1. In appeal proceedings concerning Community trade marks, directed against the decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), the Office's application for alteration of the contested decision is inadmissible. The Office does not have *locus standi* to apply for the annulment or alteration of decisions taken by the Boards of Appeal, but acts as defendant before the Court.
 2. The assertion that a figurative mark cannot display any visual similarity whatsoever to a word mark cannot be accepted in the context of the examination of a notice of opposition filed by the proprietor of the earlier mark under Article 8(1)(b) of Regulation No 40/94 on the Community trade mark. It must be held that it is possible to consider and determine whether there is any visual similarity between a figurative mark and another word mark since the two types of mark have graphic form capable of creating a visual impression.

(see paras 23-25)

(see paras 50-51)

3. Although it is true that, in the context of the examination of a notice of opposition filed by the proprietor of the earlier mark under Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the reputation of the earlier mark is a 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, such a reputation has no effect on the global assessment of the likelihood of confusion where the conflicting signs cannot in any way be regarded as identical or similar from the visual, aural or conceptual points of view.

(see paras 64-65)

4. There is no likelihood of confusion for the French public between the mark consisting of a composite sign comprising the name 'HUBERT' in stylised black characters outlined in white, in

which the letters are in upper case and surmounted by the bust of a chef, beaming and with his right arm raised and thumb turned up, for which registration as a Community trade mark has been applied in respect of certain goods in Classes 29, 30 and 42 of the Nice Agreement, and the word mark 'SAINT-HUBERT 41' registered previously in France in respect of goods in Class 29 of that agreement.

Even though there is identity and similarity between the goods covered by the conflicting marks, the visual, aural and conceptual differences between the signs constitute sufficient grounds for holding that there is no likelihood of confusion in the mind of the targeted public, so that one of the conditions for applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark has not been satisfied.

(see paras 63, 66)