

Case T-126/03

Reckitt Benckiser (España), SL

v

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

(Community trade mark — Opposition proceedings — Likelihood of confusion — Proof of use of earlier mark — Application for Community word mark ALADIN — Earlier national word mark ALADDIN — Articles 8(1)(b) and 43(2) and (3) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 14 July 2005 . . . II - 2864

Summary of the Judgment

1. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Objective of the requirement (Council Regulation No 40/94, Art. 43(2) and (3))*

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark — Partial use — Effect — Concept of 'part of goods or services' concerned by registration*
(Council Regulation No 40/94, Art. 43(2) and (3))
3. *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 ALADIN and ALADDIN*
(Council Regulation No 40/94, Art. 8(1)(b))

1. The purpose of the requirement that the earlier mark must have been put to genuine use, within the meaning of Article 43(2) and (3) of Regulation No 40/94 on the Community trade mark, is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. However, the purpose of the said Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks.

mark was actually used for the goods or services in respect of which it was registered.

(see paras 42-43)

2. The last sentence of Article 43(2) of Regulation No 40/94 on the Community trade mark should be interpreted as meaning that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and

Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier

narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. It is in that regard impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

(see paras 44-46)

3. For professionals operating in the metal-working industry who are established in Spain, there exists a risk of confusion between the word sign ALADIN, whose registration as a Community mark is sought for, 'Preparations for cleaning waste pipes for the metal-working industry, except textile auxiliary agents and auxiliary agents' falling within Class 3 of the Nice Agreement, and the word mark ALADDIN, previously registered in Spain for 'polish for metals' falling within the same class, in so far as the goods in question are similar in part, the signs at issue show a high degree of similarity and the earlier mark has a high degree of distinctiveness such that the goods in question may appear to the relevant public, composed of operators specialising in the metal-working industry, to be related inasmuch as they belong to a single family of goods and may thus be perceived as items in a general range of goods likely to have a common commercial origin.

(see paras 81, 86-87, 92, 99-101)