

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
30 June 2004*

In Case T-317/01,

M+M Gesellschaft für Unternehmensberatung und Informationssysteme mbH,
established in Frankfurt am Main (Germany), represented by M. Treis, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by S. Laitinen and U. Pflegar, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of the Office for
Harmonisation in the Internal Market (Trade Marks and Designs) being

* Language of the case: German.

Mediametrie SA, established in Paris (France), represented originally by D. Dupuis-Latour and then by S. Szilvasi, lawyers,

intervener;

action brought against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 2 October 2001 in Case R 698/2000-1 concerning opposition proceedings between Mediametrie SA and M+M Gesellschaft für Unternehmensberatung und Informationssysteme mbH,

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

composed of: J. Pirrung, President, A.W.H. Meij and N.J. Forwood, Judges,

Registrar: D. Christensen, Administrator,

having regard to the written procedure and further to the hearing of 16 December 2003,

gives the following

Judgment

Background to the dispute

- 1 On 29 November 1996 the applicant filed an application under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office').
- 2 The trade mark for which registration was sought is the sign M+M EUROdATA.
- 3 The goods and services in respect of which registration of the mark was sought fall within Classes 9, 16, 35, 41 and 42 under the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and, in respect of each of those classes, correspond to the description:

— 'computer software', falling within Class 9;

- 'publications and periodicals dealing with research in the food business', falling within Class 16;

- 'market research, market analysis and trade research, services offering advice to businesses in the sphere of marketing and distribution', falling within Class 35;

- 'seminars and other kinds of continuing training in marketing and distribution', falling within Class 41;

- 'data-bank services', falling within Class 42.

4 On 29 June 1998 the application for the trade mark was published in the *Community Trade Marks Bulletin* No 46/98.

5 On 29 September 1998 the intervener filed its opposition under Article 42(1) of Regulation No 40/94 to registration of that Community trade mark.

6 The basis of the opposition was trade mark EURODATA TV, which had been the subject of the following registrations:

- Irish registration No 201 060 of 1 July 1996;

— French registration No 92 414 002 of 7 April 1992;

— international registration No 591 515 of 25 September 1992, with effect in Benelux, Spain, Italy and Portugal.

- 7 The opposition was directed against registration of the trade mark sought in respect of the services mentioned in the application for a trade mark, described as 'market research, market analysis and trade research, services offering advice to businesses in the sphere of marketing and distribution; seminars and other kinds of continuing training in marketing and distribution'.
- 8 The opposition was based on a part only of the services covered by the French and international registrations, namely, the following: 'Gathering and supply of commercial information, more especially opinion surveys and polls in the audiovisual realm', falling within Class 35.
- 9 The opposition was also based on the following services, covered by the Irish registration: 'Gathering and supply of commercial information; commercial enquiries; advertising services; advising and assisting industrial or commercial undertakings; preparation and supply of trade statistics; marketing studies; market research and analysis', falling within Class 35.
- 10 In support of its opposition, the intervener relied on the relative grounds for refusal referred to in Article 8(1)(b) of Regulation No 40/94.

- 11 Taking the view that there was no likelihood of confusion, the Opposition Division rejected the opposition by decision of 20 April 2000 and ordered the intervener to pay the costs.
- 12 The intervener lodged an appeal against that decision under Article 59 of Regulation No 40/94 on 16 June 2000.
- 13 By decision of 2 October 2001 ('the contested decision'), the First Board of Appeal annulled the Opposition Division's decision and referred the case back to the Opposition Division to act on the application with regard to the goods and services in respect of which registration had not been refused, namely, 'computer software', which falls within Class 9, 'publications and periodicals dealing with research in the food business', which fall within Class 16, and 'data-bank services', which fall within Class 42. The Board also ordered the applicant to pay the costs incurred during the opposition and appeal proceedings.
- 14 The grounds of the contested decision can be summarised as follows.
- 15 So far as the services in question are concerned, the Board of Appeal considered that they were partly identical and partly very similar (see paragraphs 19 and 20 respectively of the contested decision).
- 16 So far as the signs in question are concerned, the Board of Appeal considered that the signs 'EUROdATA' and 'EURODATA' were identical, for the public did not pay attention to the difference between capital and small letters. Next, it considered that if it were to attribute a distinctive character to the word 'eurodata', the signs in question would then have to be regarded as similar to the point of creating

confusion, and that if it were to decide, to the contrary, that the word was essentially devoid of any distinctive character, stress would instead be placed on the signs' other features, especially the 'M+M' element, so that the signs would have to be regarded as differing (paragraph 13 of the contested decision).

- 17 On this point, the Board of Appeal decided that the word 'eurodata' was not entirely devoid of any distinctive character. In its view, it is unlikely that the consumers concerned would be able to decipher quite what that word meant. Research conducted by the applicant on the internet showed that a broad range of unconnected business activities is associated with the word 'eurodata', thus showing that the word is far from being clearly defined. What is more, the Board of Appeal thought that the word was seen as one of the characteristic features of the earlier trade mark and of the trade mark applied for and that therefore it was impossible to compare the two if that word were left out of account (paragraphs 14 and 15 of the contested decision).
- 18 Having regard to the foregoing, the Board of Appeal considered, first, the mark applied for to consist of two distinct terms, of which the word 'eurodata' predominated, and, second, the earlier mark to contain only one distinctive element, EURODATA, the abbreviation 'TV' being descriptive. The Board of Appeal deduced that the public would think that the trade marks in question emanated from the same commercial source (paragraphs 16 to 18 of the contested decision).

Procedure

- 19 By application lodged at the Registry of the Court of First Instance on 17 December 2001, the applicant brought the present action in German.

20 Since the other parties did not object within the period prescribed to German's being the language of the case before the Court of First Instance, the latter designated German as the language of this case.

21 The Office and the intervener lodged their replies at the Court Registry on 25 April 2003 and 16 May 2003 respectively.

Forms of order sought by the parties

22 The applicant claims that the Court should:

- annul the contested decision;

- order the Office to pay the applicant's costs.

23 At the hearing the applicant stated that it sought annulment of the contested decision only in so far as that decision annulled the part of the Opposition Division's decision that was favourable to the applicant.

24 The Office contends that the Court should:

- dismiss the action;

— order the applicant to pay the costs.

25 The intervener contends that the Court should:

— uphold the contested decision;

— dismiss the action in its entirety;

— order the applicant to pay the intervener's costs.

Law

The parties' arguments

26 In support of its action the applicant puts forward a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94, in that the Board of Appeal wrongly held that there was a likelihood of confusion.

27 With regard to the signs in question, the applicant maintains, first, that the earlier mark consists of descriptive elements only.

- 28 Next, as regards the visual and aural comparison of the signs at issue, the applicant claims that the element 'M+M' appears only in the mark applied for and clearly differentiates it more than the element 'eurodata'. Conceptually, the signs are different, since the element 'M+M' represents the applicant's name, whereas the element 'TV' refers to the intervener's commercial activity.
- 29 With regard to the services at issue, the applicant claims, so far as those covered by the application for the trade mark and falling within Class 35 are concerned, that it is clear from their designations that they concern nothing other than marketing and the dissemination of information. Now, it is chiefly persons active in the food business who would call on such services. In addition, it appears from the lists of services protected by the earlier trade mark that those services were offered solely in the media sphere, as shown by the intervener's name. Finally, the information gathered by those services is different.
- 30 The applicant goes on to say that, if it should be concluded that the services in question were similar, the intervener would be able to forbid the use throughout the Community of other trade marks containing the element 'eurodata' and relating to the gathering of information.
- 31 With regard to the services covered by the application for a trade mark and falling within Class 41, the applicant maintains that the fact that they fall into a class other than that within which the services protected by the earlier trade mark fall, is at the least a sign that between the services in question there is no similarity except in exceptional cases. However, this is not an exceptional case, in so far as the former services related to vocational training while the latter concern the acquisition and supply of information.

- 32 The applicant adds that the line of argument followed by the Board of Appeal would lead, when all is said and done, to recognition that a trade mark protected in respect of services offered in a particular area and falling within Class 35 is automatically protected in respect of services offered in the same area, but relating to vocational training.
- 33 The Office maintains, with regard to the signs in question, first, that the element 'eurodata' is not devoid of any distinctive character and forms, in addition, the dominant element of those signs. Furthermore, it points out that the earlier trade mark consisted of the sign 'EURODATA TV' and not of the single element 'eurodata'.
- 34 Then the Office argues that the signs in question are visually similar because each contains the element 'eurodata' and another short verbal element too. According to the Office, while the element 'M+M' is distinctive, it does not relegate the element 'eurodata' to the background.
- 35 In the Office's view, the signs at issue are aurally similar because of the full repetition of the term 'eurodata', a word which is long and easy to pronounce and which dominates the pronunciation and resonance of the signs.
- 36 So far as conceptual similarity is concerned, the Office argues that average consumers focus their attention on the 'eurodata' element and that adding the 'M +M' element has no particular effect on the overall impression given by the signs in question.
- 37 With regard to the services concerned, the Office asserts that, in relation to those falling within Class 35, their comparison must be based on their designation alone. The latter does not justify the limitations proposed by the applicant, but shows that the services are directed to the same public.

- 38 So far as the services covered by the application for a trade mark and falling within Class 41 are concerned, the Office contends that 'marketing and distribution', the subject-matter of those training services, cover a quite enormous field, including also the 'preparation and supply of trade statistics' services falling within Class 35 and protected by the earlier trade mark. In its view, it is therefore likely that the public would believe that the former services constitute an extension of the intervener's commercial activity.
- 39 The Office adds that Rule 2(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1) makes it clear that the classification of goods and services is to serve exclusively administrative purposes.
- 40 With regard to the relevant public for the purpose of assessing the likelihood of confusion, the Office argued at the hearing that it is not only undertakings that are interested in the services in question, especially so far as the training services falling within Class 41 are concerned.
- 41 The intervener argues that the word 'eurodata' is distinctive, since it is neither necessary nor descriptive in respect of the services claimed and since it is a neologism.
- 42 With regard to the distinctive character of the trade mark 'EURODATA TV', the intervener pointed out at the hearing that several national trade-mark offices have accepted its registration, as is clear from the registrations put forward in support of the opposition.

- 43 As regards the signs at issue, the intervener asserts that visually, aurally and conceptually there are resemblances in the overall impression given, because of the copying of the term 'eurodata'. In respect of the visual aspect, the intervener states that each of the signs contains the element 'eurodata' and another two-letter element. Aurally, the resemblances prevail, given the copying of the term 'eurodata'. Conceptually too the two signs are identical.
- 44 The intervener claims that the services at issue are identical or similar.
- 45 With regard to the relevant public for the purpose of assessing the likelihood of confusion, at the hearing the intervener agreed with the position taken by the Office.
- 46 Last, the intervener argued at the hearing that, while the letters in the trade mark applied for are of the same size, in 1993 the applicant sought registration as a German trade mark of the sign 'M+M EUROdATA' containing an element 'eurodata' in much smaller letters than those of the element 'M+M'. In its view, therefore, the applicant itself recognised that the 'eurodata' element was distinctive.

Findings of the Court

- 47 In accordance with 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 two 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.

- 48 According to the settled case-law of the Court of Justice and the Court of First Instance, the likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case, in particular interdependence between the similarity of the trade marks and the similarity of the goods or services (Case T-162/01 *Laboratorios RTB v OHIM (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 and 33, and the case-law cited therein). The global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (Case T-292/01 *Phillips-Van Heusen v OHIM (BASS)* [2003] ECR II-4335, paragraph 47, and the case-law cited therein).
- 49 It is in the light of those considerations that it is necessary, first, to determine the public to be taken into account in assessing the likelihood of confusion and, next, to compare both the services and the signs in question.

The relevant public

- 50 The Board of Appeal did not consider the question of what the relevant public was for the purpose of assessing the likelihood of confusion.
- 51 Here it is necessary to state that the designation of the services in question makes it clear that they are not intended for average consumers but rather for a business public (see the expressions ‘market’, ‘commercial’, ‘undertakings’, ‘marketing’ and ‘distribution’ quoted in paragraph 7 above, the expression ‘commercial’ quoted in paragraph 8 above, and the expressions ‘commercial’, ‘industrial’, ‘marketing’ and ‘market’ quoted in paragraph 9 above).

- 52 It must be pointed out that such a business public is likely, when choosing services, to be especially interested in and attentive to the signs at issue.
- 53 The applicant's argument that the relevant public is specialised and looking for specialist services cannot, however, be accepted. The commercial nature of the public in question does, admittedly, imply a degree of specialisation. Nevertheless, while the expressions repeated in paragraph 51 above show that the targeted public consists of people in business, it cannot be concluded that they are all specialists in the relevant fields covered by the services in question and that they therefore constitute a particularly restricted public.
- 54 As regards the argument put forward by both the Office and the intervener, that it is not only undertakings that are interested in the services in question, especially so far as training services are concerned, no more need be stated than that, even if that were to be conceded, the fact would nevertheless remain that, having regard to the expressions used to designate those services, quoted in paragraph 51 above, the persons concerned also include people in business.

The services at issue

- 55 In the case in point, the opposition is based on an earlier trade mark registered in respect of services falling within Class 35 and challenges registration of the mark applied for in respect of services falling within, on the one hand, Class 35, and, on the other, Class 41 (see paragraphs 7 to 9 above). Two comparisons must therefore be made, one having regard to the services covered by the application for a trade mark which fall within Class 35 and the other having regard to the services covered by that application which fall within Class 41.

— The services covered by the application for a trade mark which fall within Class 35

56 The Board of Appeal concluded that the services covered by the application for a trade mark which fell within Class 35, on the one hand, and the services protected by the earlier trade mark, on the other, were identical.

57 It must be borne in mind on this point that it is clear from the designation of the services at issue, set out in paragraphs 3, 8 and 9 above, that the services falling within Class 35 and protected by the earlier trade mark correspond to the services falling within that class and covered by the application for a trade mark. It must be concluded that the two groups of services are identical.

58 The arguments advanced by the applicant relating to the different fields in which the services in question are offered and to the different nature of the information to which they relate are not such as to alter that finding. Indeed, in paragraph 19 of the contested decision the Board of Appeal correctly considered that it had to refer to the list of services registered in respect of each sign in question. In the first place, the designation of the services covered by the application for a trade mark and falling within Class 35 does not support the conclusion that they concern the food trade exclusively. In the second place, the designation of the services protected by the earlier mark does not support the conclusion that they concern the media world exclusively. In the third place, the designations of the services in question do not support the conclusion that the nature of the information they cover is different. It must be pointed out here that the contemplated use in a particular sector on a particular market of a trade mark for which registration is sought cannot be taken into account where that registration cannot entail a restriction to that effect.

59 Furthermore, the argument that any recognition of similarity between the services in question would enable the intervener to prohibit throughout the Community the

use of other trade marks containing the element 'eurodata' and concerning the gathering of information is without relevance in assessing whether those services are similar.

— The services covered by the application for a trade mark which fall within Class 41

- 60 The Board of Appeal concluded that the services covered by the application for a trade mark which fall within Class 41, on the one hand, and the services protected by the earlier trade mark which fall within Class 35, on the other, were very similar.
- 61 It ought here to be borne in mind that, as the applicant remarks, it is clear from the designation of the services covered by the application for a trade mark which fall within Class 41 that they relate to occupational training and that they are therefore different in nature from the services protected by the earlier mark.
- 62 However, it is equally clear from the designation of those training services that they relate to the field of marketing and distribution. As has been persuasively observed, both in paragraph 20 of the contested decision and by the Office, the services entitled 'Gathering and supply of business information'; 'business enquiries'; 'advertising services', 'marketing studies' and 'market research and analysis', protected by the earlier trade mark, also fall within the ambit of marketing and distribution, in so far as 'in today's business world no marketing operation can be successful without the aid of such services'. In consequence, although the services in question were designated by similar signs, business people already familiar with the services protected by the earlier trade mark would very probably suppose that the services covered by the application for a trade mark were no more than a new line of activity for the undertaking offering the original services.

- 63 It follows that there is a close link between the services in question as regards their users and that they are complementary. It must therefore be concluded that they are similar (see, to this effect, Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).
- 64 That conclusion is not shaken by the applicant's argument that the services in question fall within different classes under the Nice Agreement. As the Office has remarked, Rule 2(4) of Regulation No 2868/95 provides that 'services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification'.
- 65 Finally, the applicant's argument that the consequence of the reasoning adopted by the Board of Appeal would, all things considered, be that a trade mark protected in respect of services falling within Class 35 would automatically be protected in respect of training services in the same field is of no relevance to determining whether the services are similar.

The signs at issue

- 66 The Board of Appeal concluded that the public would think that the signs in question came from the same commercial source.
- 67 In order to establish whether that conclusion is well founded, a visual, aural and conceptual comparison must be made of the signs concerned.

- 68 The visual and aural comparisons may appropriately be made together.
- 69 First, the parties have not challenged the Board of Appeal's finding that the 'M+M' component of the trade mark applied for is distinctive (paragraph 16 of the contested decision).
- 70 Next, the Board of Appeal considered that the component 'eurodata' predominated in the trade mark applied for and that, although the component 'M+M' is unarguably distinctive in character, it does not make it possible to divert attention from the 'eurodata' component so as to cause sufficient change to the way in which the public perceives that trade mark. According to the Board of Appeal, on the one hand the 'eurodata' component is easily pronounced and remembered and on the other that component is longer and impinges more than the 'M+M' component, which is rather terse (paragraphs 16 and 18 of the contested decision).
- 71 On this subject, it must be noted, first, that the component 'M+M', a short designation, is at the very least just as easily pronounced and remembered as the component 'eurodata'. It must be added here that the applicant has affirmed, with some relevance, that trade marks containing short combinations of letters are extremely common. Second, it is exactly because the component 'M+M' is lapidary and shorter than the component 'eurodata' that it is at least as likely as the latter to attract the public's attention, all the more so because it is the first component in the trade mark sought and a business public is concerned.
- 72 In addition, while it is not disputed that the "TV" component in the earlier trade mark is descriptive, it cannot be overlooked in the visual and aural comparison of the signs in question. Now, however short they may be, the components 'M+M' and "TV" are very different. Furthermore, the former is placed at the beginning of the

sign and the latter at the end. In that way the fact that the signs contain other verbal components means that the overall impression made by each sign is different (see, to that effect, *GIORGIO BEVERLY HILLS*, cited above, paragraph 43).

73 It must be concluded that the circumstances mentioned in the two preceding paragraphs, taken together, are sufficient for any similarities created by the presence of the component 'EURODATA' in the trade mark applied for and the component 'EURODATA' in the earlier trade mark to be dismissed.

74 It follows that neither visually nor aurally are the signs in question similar.

75 That being so, there is no need to examine the Board of Appeal's finding that the component 'eurodata' is distinctive in character. Even if it were correct, it is not such as to set aside the circumstances underlying the conclusion drawn in the paragraph above.

76 While the visual and aural comparisons of the signs in question make it possible even at this stage to deduce that, in the circumstances of this case, the signs are not similar, they must still be examined from the conceptual point of view, especially as no conceptual comparison was expressly set out in the contested decision.

77 On this subject it has to be noted, with regard to the earlier trade mark, that the Board of Appeal's finding that the component 'TV' was descriptive of the services protected by that mark had not been challenged. The Court of First Instance concurs with that view and would add that the meaning of that component must therefore be clear and precise in the mind of the relevant public.

- 78 As regards the trade mark applied for, it must be stated that, to the mind of the relevant public, the distinctive component 'M+M' has no clear or precise meaning, but refers purely and simply to the applicant's name. Therefore that component's meaning is quite different from that of the component 'TV' contained in the earlier trade mark. In consequence, there is no semantic similarity between those two components.
- 79 Furthermore, with regard to the Office's argument that consumers focus their attention on the component 'eurodata' and that the addition of the component 'M+M' does not especially impinge on the overall impression given by the signs in question, no more need be stated than that, as has been pointed out above, the relevant public is made up of business people whose attention will focus with, at the very least, as much intensity on the component 'M+M' as on the component 'eurodata' in the trade mark applied for.
- 80 It must therefore be concluded that the signs in question are not conceptually similar.
- 81 That deduction is not weakened by the intervener's argument that several national trade mark offices have agreed to register its trade mark 'EURODATA TV'. This case does not turn on whether or not the sign 'EURODATA TV' is registrable but only on the question whether there is a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, of the trade mark applied for with the earlier trade mark.
- 82 Finally, it has to be stated that the intervener's argument relating to the German trade mark supposedly applied for by the applicant in 1993 has no bearing on the trade mark applied for in the case in point.

83 It follows from all the foregoing that the Board of Appeal was wrong to consider that the public would think that the signs at issue emanated from the same commercial source.

The likelihood of confusion

84 The Board of Appeal did not clarify its conclusion concerning the likelihood of confusion of the signs in question. It contented itself with the consideration that, if it classified the word 'eurodata' as distinctive in character, as it went on to do in the contested decision, it must then be considered that the signs were so similar as to give rise to confusion, because of the high degree of similarity aurally, visually, and perhaps even conceptually in respect of identical or similar services.

85 As stated above, the services in question are partly similar and partly identical. However, even though there is identity or similarity between the services in question, 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 (see, to that effect, *GIORGIO BEVERLY HILLS*, paragraph 52). Indeed, when the services designated by the trade mark applied for, which differs visually, aurally and conceptually from the earlier trade mark, are made available to the targeted public, the latter will not attribute the same commercial origin to the services in question. In consequence, there is no likelihood of the targeted public's establishing a link between the services designated by each of the two trade marks.

86 That conclusion is borne out by the fact that, as pointed out in paragraphs 51 and 52 above, the persons for whom the services concerned are intended are all in business and likely to be especially interested in and attentive to the signs at issue.

87 It follows from the foregoing that, by having by implication considered that there was a likelihood of confusion and having, on that basis, annulled the Opposition Division's decision dismissing the opposition, the Board of Appeal misconstrued Article 8(1)(b) of Regulation No 40/94.

88 In consequence, the single plea in law alleging infringement of that provision must be upheld and the contested decision must be annulled.

89 In this regard it is to be borne in mind, however, that, as pointed out in paragraph 13 above, the Board of Appeal did not confine itself to annulment of the Opposition Division's decision, but also referred the case back to the Division for it to act on the application for a trade mark in respect of the goods and services falling within Classes 9, 16 and 42. However, the opposition in this case relates only to the services mentioned in the application for a trade mark and falling within Classes 35 and 41. Goods and services falling within Classes 9, 16 and 42 therefore formed no part of the subject-matter of the dispute before the Opposition Division or, therefore, of the subject-matter of the dispute before the Board of Appeal. Indeed, it is clear from the contested decision that all the intervener asked of the Board of Appeal was to set aside the Opposition Division's decision and to reject the application in respect of the services referred to in the notice of opposition (paragraph 8 of the contested decision), which fall within Classes 35 and 41 of the Nice Agreement.

90 In those circumstances, the decision by which the Board of Appeal referred the case back to the Opposition Division for it to act on the application for a trade mark in respect of goods and services falling within Classes 9, 16 and 42 must be treated as mere confirmation that it was necessary, so far as those goods and services were concerned, that the Office should continue the procedure for the registration of the trade mark applied for. As a result, there is no need to annul the contested decision on that point, as explained. Moreover, such confirmation does not conflict with that

part of the Opposition Division's decision that was favourable to the applicant for the purposes of the forms of order it sought, as those were clarified at the hearing (see paragraph 23 above).

- 91 It follows from all the foregoing that the contested decision must be annulled save in so far as it refers the case back to the Opposition Division for the latter to act on the application for a trade mark in respect of the goods and services covered by that application and falling within Classes 9, 16 and 42.

Costs

- 92 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 asked for in the successful party's pleadings.
- 93 In this case both the Office and the intervener have been unsuccessful, inasmuch as the contested decision must be annulled. Furthermore, the applicant has applied for an order that the Office should pay the applicant's costs.
- 94 In those circumstances, the Office must be ordered to pay the costs incurred by the applicant and the intervener to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 2 October 2001 in Case R 698/2000-1, save in so far as it referred the case back to the Opposition Division for the latter to act on the application for a trade mark in respect of the goods and services covered by that application and falling within Classes 9, 16 and 42;**
- 2. Orders the Office for Harmonisation in the Internal Market (Trade Marks and Designs) to pay the applicant's costs;**

Orders the intervener to bear its own costs.

Pirrung

Meij

Forwood

Delivered in open court in Luxembourg on 30 June 2004.

H. Jung

J. Pirrung

Registrar

President