

## **Case T-22/04**

**Reemark Gesellschaft für Markenkooperation mbH**

**v**

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

(Community trade mark — Opposition proceedings — Application for Community word mark Westlife — Earlier national trade mark West — Likelihood of confusion — Similarity of the signs)

Judgment of the Court of First Instance (Second Chamber), 4 May 2005 . . . II - 1562

### **Summary of the Judgment**

1. *Community trade mark — Appeals procedure — Actions before the Community judicature — Procedural role of the Office — Power to alter the terms of the dispute before the Court of First Instance — None — Power of the Office to uphold the claims of one of the parties and to put forward arguments in support of the pleas by that party*  
(*Rules of Procedure of the Court of First Instance, Art. 133(2)*)

2. *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 — Similarity of the marks concerned — One of the two words of the word mark applied for identical to an earlier 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 earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Word marks Westlife and West*  
(Council Regulation No 40/94, Art. 8(1)(b))

1. In proceedings concerning an action brought against a decision of a Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) adjudicating in opposition proceedings, the Office does not have power to alter, by the position which it adopts before the Court of First Instance, the terms of the dispute, as delimited in the respective claims and contentions of the applicant for registration and of the opposing party. However, the Office is not obliged to claim that an action brought against a decision of one of its Boards of Appeal should be dismissed. While OHIM does not have the requisite capacity to bring an action against a decision of a Board of Appeal, it cannot, however, be required to defend systematically every contested decision of a Board of Appeal or automatically to

claim that every action challenging such a decision should be dismissed.

The Office, although it cannot alter the terms of the dispute may, therefore, claim that the form of order sought by whichever one of the parties it may choose should be allowed and may put forward arguments in support of the pleas in law advanced by that party. However, it cannot independently seek an order for annulment or put forward pleas for annulment which have not been raised by the other parties.

(see paras 16-18)

2. Words marks are, on an initial analysis, normally to be regarded as similar within the meaning of Article 8(1)(b) of Regulation No 40/94 where one of the two words which alone constitute the word mark applied for is identical, both visually and aurally, to the single word which constitutes the earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned.

(see para. 37)

Agreement and the word mark West, registered earlier in Germany for identical or similar goods and services in the same classes, in as much as, first, the only visual difference between the two word marks at issue is that one of them contains a further element added to the first, and there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms and, secondly, the existence of the earlier West trade mark may have created an association in the mind of the relevant public between that term and the products marketed by its owner, with the result that the new trade mark consisting of 'West' in combination with another word might well be perceived as a variant of the earlier mark.

3. A likelihood of confusion exists for average German consumers between the word mark Westlife, for which registration as a Community trade mark was sought for goods and services in Classes 9, 16, 25 and 41 of the Nice

(see paras 39, 42-43)