

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

1 March 2005^{*}

In Case T-169/03,

Sergio Rossi SpA, established in San Mauro Pascoli, Forlì-Cesena (Italy),
represented by A. Ruo, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by P. Bullock and O. Montalto, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal, intervening before
the Court, being

Sissi Rossi Srl, established in Castenaso di Villanova, Bologna (Italy), represented by
S. Vereá, M. Bosshard and K. Muraro, lawyers,

^{*} Language of the case: Italian.

ACTION brought against the decision of the First Board of Appeal of OHIM of 28 February 2003 (Case R 569/2002-1) relating to the opposition proceedings between Calzaturificio Rossi SpA and Sissi Rossi Srl,

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

composed of J. Pirrung, President, A.W.H. Meij and S. Papasavvas, Judges,

Registrar: D. Christensen, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 12 May 2003,

having regard to the response lodged by OHIM at the Registry of the Court of First Instance on 12 September 2003,

having regard to the response lodged by the intervener at the Registry of the Court of First Instance on 11 September 2003,

further to the hearing on 14 September 2004,

gives the following

Judgment

Background to the dispute

- 1 On 1 June 1998, the intervener filed with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') an application for a Community trade mark under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.
- 2 The mark in respect of which registration was sought is the word mark SISSI ROSSI.
- 3 The goods in respect of which registration was sought fall primarily within Class 18 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 are described as follows: 'leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.'
- 4 The trade mark application was published in *Community Trade Marks Bulletin* No 12/1999 on 22 February 1999.

- 5 On 21 May 1999, Calzaturificio Rossi SpA filed a notice of opposition under Article 42(1) of Regulation No 40/94 to registration of the mark applied for in respect of the goods 'leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags'.
- 6 The trade marks relied on in support of the opposition are the word mark MISS ROSSI, registered in Italy on 11 November 1991 (No 553 016), and the international mark MISS ROSSI, registered on the same day with effect in France (No 577 643). The goods designated by those earlier marks are 'footwear' in Class 25 of the Nice Agreement.
- 7 At the request of the intervener, Calzaturificio Rossi SpA submitted evidence of genuine use of the earlier marks during the five years preceding publication of the application for registration of the mark in question.
- 8 Following a merger acquisition of Calzaturificio Rossi SpA, which was recorded by a notarial act on 22 November 2000, the applicant, now called Sergio Rossi SpA, became the proprietor of the earlier marks.
- 9 By decision of 30 April 2002, the Opposition Division refused the application for registration in respect of all the goods covered by the opposition. It found, essentially, that the applicant had proven genuine use of the earlier marks only in relation to the goods 'women's footwear' and that those goods and the goods 'leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags' covered by the trade-mark application were similar. Moreover, the Opposition Division held that the marks were similar in the mind of the French consumer.

- 10 On 28 June 2002, the intervener brought an appeal against the decision of the Opposition Division before OHIM.
- 11 By decision of 28 February 2003 ('the contested decision'), the First Board of Appeal of OHIM annulled the decision of the Opposition Division and rejected the opposition. The Board of Appeal found, essentially, that the marks in question were only vaguely similar. Moreover, having compared the distribution channels, functions and nature of the goods in question, it found that, for the most part, the differences between the goods outweighed their few common points. In particular, it examined and rejected the argument that the goods 'women's footwear' and 'women's bags' were similar because they were complementary. Therefore, there was, in its view, no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94.

Forms of order sought

- 12 The applicant claims that the Court should:
- declare that there is a likelihood of confusion between the marks in question and annul the contested decision;

 - in the alternative, declare that the marks in question are 'incompatible' with respect to 'women's bags' and 'women's footwear' and declare that those goods are similar;

— order OHIM to pay the costs.

13 By letter of 12 February 2004, the applicant explained that it seeks either annulment of the contested decision in its entirety or partial annulment in so far as it was found that there was no likelihood of confusion between the marks with respect to ‘women’s bags’ and ‘women’s footwear’.

14 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

The evidence submitted for the first time before the Court

15 In support of its argument that women’s footwear and women’s bags are similar goods, the applicant has produced a number of documents, including newspaper articles, advertisements and photographs, in particular from internet sites, which show women’s footwear or women’s bags. The intervener has produced extracts from websites to support its rejection of the arguments and evidence submitted by the applicant. None of those documents was produced during the administrative procedure before OHIM.

Arguments of the parties

- 16 OHIM submits that the evidence submitted by the applicant for the first time before the Court is inadmissible.
- 17 At the hearing, the applicant replied that the evidence must be admitted because the Board of Appeal had infringed its right to be heard. The Opposition Division found that the goods designated by the marks were similar. Therefore, since the Board of Appeal intended to annul the decision of the Opposition Division on the ground that the goods in question are not similar, it ought to have warned the applicant of that intention and given it an opportunity to comment on and evaluate the usefulness of submitting additional proof. According to the applicant, that infringement by the Board of Appeal of its right to be heard justifies annulment of the contested decision. The evidence submitted in the application is therefore admissible in any event.
- 18 Neither OHIM nor the applicant commented on the admissibility of the documents produced by the intervener.

Findings of the Court

- 19 First, in so far as the observations made by the applicant at the hearing are to be understood as raising a new plea of infringement of its right to be heard, which is laid down in the second sentence of Article 73 of Regulation No 40/94, that plea must be rejected as inadmissible.

- 20 Under the first subparagraph of Article 48(2) of the Court's Rules of Procedure, no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure.
- 21 The Court observes, first of all, that the applicant did not, in its application, complain of an infringement by the Board of Appeal of the second sentence of Article 73 of Regulation No 40/94.
- 22 Moreover, the fact that the Board of Appeal did not warn the applicant that it intended to annul the Opposition Division's decision on the ground that the goods designated by the marks are not similar was already given and known by the applicant when it lodged its application at the Court Registry and cannot therefore constitute a new matter of law or fact within the meaning of the first subparagraph of Article 48(2) of the Rules of Procedure.
- 23 To the extent that it is intended to support the contention that the evidence submitted by the applicant is admissible, the argument that the Board of Appeal infringed the applicant's right to be heard is irrelevant.
- 24 According to settled case-law, the purpose of an action brought before the Court under Article 63 of Regulation No 40/94 is the review of the lawfulness of a decision of a Board of Appeal of OHIM (Case T-247/01 *eCopy v OHIM (ECOPY)* [2002] ECR II-5301, paragraph 49; Case T-128/01 *DaimlerChrysler v OHIM (Grille)* [2003] ECR II-701, paragraph 18; and Case T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13).

- 25 Facts which are relied on before the Court without previously having been submitted in the proceedings before OHIM can affect the lawfulness of such a decision only if OHIM ought to have taken account of them of its own motion (*ECOPY*, cited above, paragraph 46, and *GAS STATION*, cited above, paragraph 13). As follows from the final clause in Article 74(1) of Regulation No 40/94, which states that, in proceedings relating to relative grounds for refusal of registration, OHIM's examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought, OHIM is not required to take account, of its own motion, of facts which were not submitted by the parties. Accordingly, such facts cannot call into question the lawfulness of a decision of a Board of Appeal (*GAS STATION*, paragraph 13).
- 26 If the applicant takes the view that the Board of Appeal, in breach of the second sentence of Article 73 of Regulation No 40/94, deprived it of the opportunity to produce the evidence in question in due time during the administrative procedure, it ought to have raised such a plea in support of its action for annulment of the contested decision. The Board of Appeal's infringement of the applicant's right to be heard cannot, however, lead to an assessment by the Court of facts and evidence which were not previously submitted in the proceedings before OHIM, at least in so far as OHIM was not required to take account of them of its own motion.
- 27 Considerations similar to those set out in paragraphs 24 and 25 apply with regard to the documents produced by the intervener. Since they were not produced in the proceedings before OHIM, they can neither call into question the lawfulness of the contested decision nor justify it a posteriori.
- 28 It follows that no account will be taken of the evidence submitted by the applicant and by the intervener in the annexes to their pleadings.

The general reference to the OHIM file

29 Both the applicant and the intervener refer, in their pleadings, to all of the pleas and arguments submitted during the administrative procedure.

30 Under Article 21 of the Statute of the Court of Justice and Article 44(1)(c) of the Rules of Procedure, the application must contain a summary of the pleas relied on. According to case-law, that summary must be sufficiently clear and precise to enable the defendant to prepare its defence and the Court to rule on the action, if necessary without any other supporting information. Moreover, the Court has held that, whilst the text of the application may be supported by references to specific passages in documents annexed to it, a general reference to other documents, even those annexed to the application, cannot make up for the absence of the essential arguments in the application and that it is not for the Court to take on the role of the parties by seeking to identify the relevant pleas and arguments in the annexes (see Case T-231/99 *Joyson v Commission* [2002] ECR II-2085 (upheld by order of 10 December 2003 in Case C-204/02 P *Joyson v Commission* [2003] ECR I-14736), paragraph 154, and order of 29 November 1993 in Case T-56/92 *Koelman v Commission* [1993] ECR II-1267, paragraphs 21 and 23, and the case-law cited). That case-law can also be applied to the response of the other party to the opposition proceedings before OHIM where it intervenes before the Court under Article 46 of the Rules of Procedure, which is applicable in the field of intellectual property pursuant to the second subparagraph of Article 135(1) of those rules (Case T-115/02 *AVEX v OHIM— Ahlers (a)* [2004] ECR II-2907, paragraph 11).

31 It follows that, in so far as they refer to the written pleadings submitted by the applicant and by the intervener before OHIM, the application and the response are inadmissible because the general reference made in them cannot be linked to the pleas and arguments put forward in the application or the response.

The claim for annulment of the contested decision in its entirety or, in the alternative, for partial annulment of the contested decision

Arguments of the parties

- 32 In support of its action, the applicant raises only one plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

— The target public

- 33 The applicant and OHIM take the view that the average consumer of the goods in question is the female consumer in France and Italy. The intervener submits that the only territory relevant in comparing the marks is France.

— Similarity of the goods

- 34 With respect to the similarity of the goods, the applicant submits that goods such as the ‘women’s footwear’ protected by the earlier marks, and the goods covered by the trade-mark application such as ‘leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags’ and, especially, ‘women’s bags’ are similar.

- 35 The applicant claims that both shoes and handbags serve an aesthetic and decorative purpose in women's clothing. The goods 'women's footwear' and 'women's bags' are of the same nature in that they are often made of the same material. Moreover, the end consumers and the distribution channels are identical. French and Italian female consumers perceive the bag and the shoes as a set. The applicant concludes that the goods are complementary to such a degree that they must be regarded as similar. At the hearing, it stated that OHIM itself had likewise taken this point of view in its Opposition Guidelines of 10 May 2004.
- 36 With respect to the similarity of the goods, OHIM shares the view taken by the Board of Appeal that 'women's footwear' and the goods 'leather and imitations of leather; and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags' are not similar.
- 37 Nevertheless, OHIM observes that, according to a practice adopted by the Opposition Divisions, 'clothing' and 'footwear' are regarded as complementary to 'goods made of leather and imitation leather and bags' and, in particular, handbags. By way of illustration, OHIM refers to Decisions No 1440/2000 of 30 June 2000 (*Local Boy'z v WHG Westdeutsche Handelsgesellschaft*) and No 2008/2000 of 9 August 2000 (*T. J. Hughes v TJ Investments*) of the Opposition Division. OHIM points out that, in paragraph 2.6.2 in Chapter 2 of Part 2 of the Opposition Guidelines, referred to in paragraph 35 above, it is stated, inter alia, that handbags, shoes and clothing are regarded as complementary goods by consumers. It added, in response to a question put by the Court at the hearing, that that paragraph was not the subject of unanimous criticism from the competent national trade mark authorities during the consultations which took place prior to the adoption of those guidelines by OHIM, because, had that been case, OHIM would not normally have adopted the criticised paragraph.
- 38 The intervener contends that the goods covered by the marks in question are not similar. It points out, first of all, that the applicant has put forward no argument against the Board of Appeal's finding that 'women's footwear' and the goods covered

by the trade-mark application other than ‘women’s bags’ are not similar. Moreover, the intervener claims that the mere fact that consumers look for shoes that match the bag is insufficient for the goods to be regarded as similar.

— Similarity of the marks

39 The applicant submits that the degree of similarity between the marks must be regarded as ‘considerable and not slight’. At the hearing, it stated that the fact that the name ‘Rossi’ is very common does not preclude it from being distinctive in relation to the goods designated by the mark MISS ROSSI.

40 OHIM adopts the finding made by the Board of Appeal that the degree of similarity between the marks is low.

41 The intervener contests the Board of Appeal’s finding that the marks MISS ROSSI and SISSI ROSSI are similar. It argues that the earlier marks are not highly distinctive. Since the applicant did not dispute that the surname ‘Rossi’ is a very common one, the assessment of the marks must focus on the first word in each of the marks (‘Miss’ and ‘Sissi’). According to the intervener, the first words are sufficiently different to rule out similarity between the marks in question. It adds that they have a different conceptual content, which may be sufficient to distinguish them (Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54, and Case T-185/02 *Ruiz-Picasso and Others v OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 56).

— The likelihood of confusion

42 The applicant claims that there is a likelihood of association between the marks in question because the mark SISSI ROSSI is specifically used for women's bags and because the applicant already operates in that sector.

43 OHIM contends that this argument is irrelevant.

Findings of the Court

44 Under 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 is a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

— The scope of the dispute

45 First of all, it is apparent from the application, in particular from the first head of claim and the oral argument put forward by the applicant, that it takes the view that all the goods in respect of which the opposition was entered are similar to the 'women's footwear' designated by the earlier marks.

- 46 However, as the intervener rightly stated, the line of argument put forward in the application refers only to 'women's bags' and 'women's footwear'. In the absence of any argument challenging the Board of Appeal's finding that the goods 'leather and imitations of leather; animal skins, hides; trunks and travelling bags' are dissimilar, there is no need for the Court to examine the alleged similarity between those goods. Moreover, the general reference to the observations made by the applicant during the proceedings before OHIM cannot make up for the absence of arguments in the application (see paragraph 31 above). Finally, it was only at the hearing and, therefore, too late that the applicant claimed that all of those goods are sold through the same channels and are made of the same raw material.
- 47 With respect to the earlier marks, the Board of Appeal's finding that, by virtue of the final sentence in Article 43(2) and of Article 43(3) of Regulation No 40/94, the earlier marks must be regarded as being registered only in respect of 'women's footwear' has not been challenged.
- 48 It follows from the preceding paragraphs that the principal head of claim, seeking annulment of the contested decision in its entirety, must be rejected and that only the alternative claim, seeking partial annulment of the contested decision, need be examined. It is therefore necessary to examine only whether there is a similarity between the goods 'women's bags' falling under 'goods made of leather and imitation leather not included in other classes' in Class 18 which are covered by the application for a Community trade mark and the goods 'women's footwear' in Class 25 designated by the earlier marks.

— The target public

49 Since ‘women’s footwear’ and ‘women’s bags’ are goods for everyday consumption intended for a female public, the target public is, essentially, composed of average female consumers.

50 Since the earlier marks are protected in France and Italy, the target public is, in principle, made up of French and Italian consumers.

51 The intervener claims, however, that the relevant territory in the present dispute is limited to France.

52 It is only if the French consumer has a different perception from that of the Italian consumer that it would be necessary for the Court to rule as to whether the territory relevant in the present dispute includes Italy. The Court observes that none of the parties to the dispute has drawn a distinction between the perception of the goods by the French public and the perception of the same goods by the Italian public. Accordingly, there is no need to draw a distinction when assessing the similarity between the goods as they are perceived by those consumers. The similarity between the marks will, where necessary, be examined by reference to the perception of those goods by French and Italian consumers.

— The similarity of the goods

53 Article 8(1)(b) of Regulation No 40/94 states clearly that in order for there to be a likelihood of confusion within the meaning of that provision, the goods or services

designated must be identical or similar. Thus, even where the mark applied for is identical to a mark which is distinctive to a particularly high level, it must be established that the goods or services designated by the opposing marks are similar (see, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 22).

- 54 In order to assess the similarity between the goods in question, account must be taken of all the relevant factors which characterise the relationship between those goods, those factors including, in particular, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (see, with respect to the application of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), *Canon*, cited above, paragraph 23, and, with respect to the application of Regulation No 40/94, Case T-85/02 *Díaz v OHIM — Granjas Castelló (CASTILLO)* [2003] II-4835, paragraph 32).
- 55 In the present case, it should be observed, first of all, that account may be taken of the fact that the goods in question are often made of the same raw material, namely leather or imitation leather, when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar.
- 56 The end consumers for whom the goods in question are intended do not feature among the relevant factors expressly referred to in paragraph 23 of the judgment in *Canon*, in which the Court made reference not to the ‘end consumers’ but rather to the intended purpose (‘Verwendungszweck’) of the goods. In any event, the Board of Appeal made the relevant point, in paragraph 36 of the contested decision, that the reference public is not specialised but potentially includes all French or Italian female consumers. Accordingly, the fact that the end consumers of the goods are

identical cannot be regarded as a significant factor in assessing the similarity between the goods.

57 The Board of Appeal rightly observed that the intended purposes of the goods are different, shoes being used to dress feet and bags to carry objects. It follows that the goods are not interchangeable and, therefore, not in competition.

58 The applicant's argument that the primary functions of the goods, described in the preceding paragraph, are secondary to their aesthetic function in women's clothing and that women's shoes and bags are luxury items does not convince the Court. First, whilst it is true that, particularly in the clothing and fashion sector, many products are capable of serving both their primary function and an aesthetic function, this alone cannot lead the consumer to believe that those products originate from the same undertaking or from economically linked undertakings. That factor is too general to permit a finding that the goods are similar. Secondly, women's shoes and bags are not merely luxury items the decorative function of which is more important than their primary function, which remains, in the case of shoes, the dressing of feet and, in the case of bags, the carrying of objects.

59 The applicant submits, in addition, that 'women's footwear' and 'women's bags' are complementary goods and, therefore, similar.

60 According to the definition given by OHIM in paragraph 2.6.1 in Chapter 2 of Part 2 of the Opposition Guidelines, referred to in paragraph 35 above, complementary goods are goods which are closely connected in the sense that one is indispensable

or important for the use of the other so that consumers may think that the same undertaking is responsible for the production of both goods.

- 61 In the present case, the applicant has failed to establish that, in terms of their function, the goods in question are complementary in this way. As is clear from paragraph 2.6.2 in Chapter 2 of Part 2 of the Opposition Guidelines, referred to in paragraph 35 above, OHIM appears to concede that the goods are aesthetically, and therefore subjectively, complementary in a way which is determined by the habits and preferences of consumers to which producers' marketing strategies or even simple fashion trends may give rise.
- 62 However, the applicant has failed to demonstrate, during either the proceedings before OHIM or those before the Court, that this aesthetic or subjective complementary nature has reached the stage of a true aesthetic 'necessity' in the sense that consumers would think it unusual or shocking to carry a bag which does not perfectly match their shoes. The Court takes the view, first of all, that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar. The Court observes, in addition, that the facts and evidence submitted by the applicant for the first time before the Court cannot, in the present case, call into question the lawfulness of the contested decision as shown in paragraphs 19 et seq. above.
- 63 Moreover, the fact that consumers regard a product as a complement of or accessory to another is not sufficient for them to believe that those products have the same commercial origin. For that to be the case, consumers would also have to consider it usual for those products to be sold under the same trade mark, which normally

implies that a large number of the producers or distributors of the goods are the same.

64 The Board of Appeal did not examine whether, as a general rule, producers of women's shoes also produce women's bags. However, the applicant failed, during the proceedings before OHIM, to submit detailed facts or substantiated evidence on the basis of which it could be concluded that, in the minds of the relevant public, producers of shoes and of bags are usually the same. It merely made a general assertion that producers selling such goods may be the same. In addition, it is acknowledged in both the Opposition Guidelines and the two decisions of the Opposition Division cited in paragraph 37 above that, traditionally, it is unusual for handbags and shoes to be distributed by the same producers or linked producers. In those circumstances, that aspect cannot call into question the outcome of the overall assessment of the likelihood of confusion carried out by the Board of Appeal.

65 Next, with respect to the channels of distribution, the Board of Appeal made the relevant point that the goods in question are sometimes, but not always and not necessarily, sold in the same shops. It also acknowledged that, whilst that fact was indeed an indication that the goods in question were similar, it did not suffice to cancel out the differences between those goods.

66 The applicant has failed to establish that the goods in question are normally sold in the same places or even that consumers necessarily expect to find in shoe shops not only shoes but also a wide choice of women's bags and vice versa. Nor has it demonstrated that consumers generally expect producers of shoes also to sell bags under the same trade mark or vice versa.

67 Accordingly, the Board of Appeal's finding that the differences between the goods outweigh the similarities must be upheld.

68 However, as follows from paragraphs 55 and 65 above, the goods do have some points in common, in particular the fact that they are sometimes sold in the same sales outlets. The differences identified between the goods are therefore not so great as to rule out, by themselves, the possibility of a likelihood of confusion, particularly where the mark applied for is identical to an earlier mark which is distinctive to a particularly high degree (see paragraph 53 above).

— The similarity between the marks

69 It is settled case-law that, in so far as the visual, aural or conceptual similarity of the marks in question is concerned, the comprehensive assessment of the likelihood of confusion must be based on the impression given by the marks as a whole, account being taken of, *inter alia*, their distinctive and dominant components (BASS, paragraph 47, and the case-law cited). In the present case, the assessment must be made by reference to the perception by French and Italian consumers (see paragraphs 49 to 52 above).

70 The second word in the marks in question, 'Rossi', is visually identical. The first words ('Sissi' and 'Miss') share common elements, the three letters 'iss'. However, the word 'Sissi' in the mark applied for is longer than the word 'Miss', the latter having only four letters instead of five like the mark applied for. The initial letters 's' and 'm' and the final letters 'i' and 's' are visually different.

- 71 With respect to phonetic similarity, the Board of Appeal rightly pointed out that both the marks in question are characterised by the strong sound of the double 's' and by the presence of the sole vowel 'i'. It also made the relevant point that the two words have a different number of syllables and that in French, unlike in Italian, the stress will be placed on the last syllable.
- 72 With respect to conceptual similarity, the Board of Appeal rightly found that Italian and French consumers would perceive the word 'Rossi' as a surname of Italian origin. The parties also agree that the word 'Sissi' will be recognised as being a female forename. Moreover, it is undisputed that the consumers targeted will understand the word 'Miss' in its English meaning. The applicant made the relevant point that both the mark MISS ROSSI and the mark SISSI ROSSI will create the impression of a woman with the surname 'Rossi'. Nevertheless, there is a conceptual difference between the word 'Miss' and a specific forename such as 'Sissi'.
- 73 Since the marks therefore bear a resemblance in some respects but are also different in others, the degree of similarity depends on whether the common element, the word 'Rossi', is the distinctive and dominant element of those marks.
- 74 In that regard, the Court observes, first of all, that the word 'Rossi' occupies the second place in the marks in question and is by no means prominent in those marks.
- 75 It should be noted, moreover, that the applicant did not claim that the word 'Rossi' was the dominant element in the mark but simply complained that the Board of Appeal had wrongly taken the view that the words 'Sissi' and 'Miss' were the dominant elements in the overall impression created by each of the two marks.

76 However, even if the word ‘Miss’ in the earlier marks and the word ‘Sissi’ in the mark applied for are not the dominant elements of those marks but rather have the same impact as the word ‘Rossi’, the differences, set out in paragraphs 70 to 72 above, are sufficient to reject the applicant’s argument that the similarity of the marks must be regarded as considerable. The degree of similarity is average, if not slight.

— The likelihood of confusion

77 According to settled case-law, a likelihood of confusion is the likelihood that the public might believe that the goods or services in question originate from the same undertaking or, as the case may be, economically linked undertakings. The likelihood of confusion as to the commercial origin of the goods must be assessed comprehensively, by reference to the perception by the relevant public of the marks and goods in question and taking account of all the factors relevant to the case, in particular the interdependence between the similarity of the trade marks and that of the goods or services (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 29 to 33, and the case-law cited).

78 According to that case-law, the more distinctive the earlier mark, the greater will be the likelihood of confusion (see, by analogy, *Canon*, paragraph 18, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 20).

79 It is common ground in the present case that the earlier marks are not highly distinctive. Therefore, it need only be examined whether the similarities between the marks are sufficient to outweigh the differences between the goods in question and to give rise to a likelihood of confusion on the part of the target public.

80 Given the differences between the goods, referred to in paragraph 57 et seq., and the differences between the marks, set out in paragraphs 70 to 72, the Court takes the view that consumers will not confuse the marks in question.

81 Nevertheless, according to the applicant, there is a likelihood of association in so far as the consumer might believe that the goods sold under the marks in question originate from the same undertaking or from economically linked undertakings.

82 In that connection, it should be observed, first of all, that the applicant has not challenged the Board of Appeal's finding that the surname 'Rossi' is very common and a typical Italian surname, not only in the eyes of Italian consumers but also in the eyes of French consumers.

83 In a sector such as that of clothing and fashion, in which it is common to use marks consisting of patronymics, it may be assumed, as a general rule, that a very common name will appear more frequently than a rare name. Thus, consumers will not believe that there is an economic link between all the proprietors of marks containing the surname 'Rossi'. Accordingly, they will not believe that the undertakings selling bags under the trade mark SISSI ROSSI are economically linked or identical to those selling shoes under the trade mark MISS ROSSI.

84 Finally, the fact that the applicant is also active in the sector of handbag production is irrelevant to the assessment of the likelihood of confusion between the earlier marks and the mark applied for. The goods designated by the marks in question must be examined as they are protected by those marks. The earlier marks are not registered for 'goods made of leather or imitation leather not included in other classes' but are regarded as registered in respect of 'women's footwear' only. It follows that the applicant is not entitled to rely on the marks in order to protect the line in handbags produced by him.

85 It follows from all of the above that the Board of Appeal was right to hold that there was no likelihood of confusion between the marks in question. There is no need for the Court to rule on whether the relevant territory is limited to France or whether the female consumers concerned pay particular attention to marks. Therefore, since the sole plea raised by the applicant is unfounded, the action must be dismissed.

Costs

86 Under Article 87(2) of the Rules of Procedure, 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 (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs.**

Pirrung

Meij

Papasavvas

Delivered in open court in Luxembourg on 1 March 2005.

H. Jung

Registrar

J. Pirrung

Le président