

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

13 December 2004*

In Case T-8/03,

El Corte Inglés, SA, established in Madrid (Spain), represented by J. Rivas Zurdo,
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 of OHIM, intervening
before the Court, being

Emilio Pucci Srl, established in Florence (Italy), represented by P.L. Roncaglia,
G. Lazzeretti and M. Boletto, lawyers,

* Language of the case: Italian.

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 3 October 2002 (Joined Cases R 700/2000-4 and R 746/2000-4) relating to the opposition entered by the proprietor of the national figurative marks EMIDIO TUCCI against registration of the figurative mark EMILIO PUCCI as a Community trade mark,

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: J. Palacio González, Principal Administrator,

having regard to the written procedure and further to the hearing on 9 June 2004,

gives the following

Judgment

Background to the dispute

1 On 1 April 1996, the intervener filed with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) an application for registration of 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).

- 2 The mark in respect of which registration was sought is the figurative sign EMILIO PUCCI shown below:



- 3 The goods in respect of which registration was sought are in Classes 3, 18, 24 and 25 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 correspond, for each of those classes, to the following description:

- Class 3 : ‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices’;

- Class 18: ‘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’;

- Class 24: ‘Textiles and textile goods, not included in other classes; bed and table covers’;

- Class 25: ‘Clothing, footwear, headgear’.

4 The application was published in *Community Trade Marks Bulletin* No 25/1998 of 6 April 1998.

5 On 3 July 1998, the applicant filed a notice of opposition under Article 42 of Regulation No 40/94 to registration of the mark sought in respect of all the goods covered by the application.

6 The applicant based its opposition on, first, a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, with various national trade marks owned by it and, in particular, two marks consisting of the figurative sign EMIDIO TUCCI shown below:



Those two trade marks were registered in Spain as follows:

- Registration No 1908876 of 5 December 1994 for goods in Class 3 ('Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices');

- Registration No 855782 of 30 May 1984 for goods in Class 25 ('clothing, including boots, shoes and slippers').

- 7 Secondly, the applicant claimed that those trade marks enjoyed a reputation in Spain and that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade marks within the meaning of Article 8(5) of Regulation No 40/94.
- 8 By decision of 20 April 2000, based solely on the two Spanish trade marks referred to in paragraph 6 above, the Opposition Division of OHIM:
- allowed the opposition in part and, accordingly, refused registration of the mark sought in respect of all the goods in Classes 3 and 25 and some of the goods in Class 18 ('Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags');
 - rejected the remainder of the opposition and, accordingly, allowed registration of the mark sought in respect of the goods 'umbrellas, parasols and walking sticks; whips, harness and saddlery' in Class 18 and all of the goods in Class 24.
- 9 Both the intervener and the applicant lodged with OHIM appeals under Articles 57 to 62 of Regulation No 40/94 against the Opposition Division's decision, the former with respect to the partial refusal to register the mark sought and the latter with respect to the partial rejection of the opposition.
- 10 Ruling on the two appeals, which were joined under Article 7(1) of Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of

the Boards of Appeal of OHIM (OJ 1996 L 28, p. 11), the Fourth Board of Appeal of OHIM, by decision of 3 October 2002 (Joined Cases R 700/2000-4 and R 746/2000-4, 'the contested decision'), of which the applicant was notified on 7 November 2002:

- annulled the Opposition Division's decision in so far as the opposition was allowed and, accordingly, the trade-mark application refused 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' in Class 18;

- dismissed the remainder of the appeals and upheld the Opposition Division's decision with regard to the goods in Classes 3, 24 and 25 and the goods 'umbrellas, parasols and walking sticks; whips, harness and saddlery' in Class 18.

Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision in so far as it allows the intervener's appeal, dismisses the applicant's appeal and allows the application for a Community trade mark in respect of the goods in Classes 18 and 24;

- refuse registration of the mark sought in respect of all the goods in Classes 18 and 24 covered by that application;

— order OHIM and the intervener to pay the costs.

12 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

13 In support of the form of order sought by it, the applicant relies on, essentially, one main plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94, and an alternative plea alleging infringement of Article 8(5) of that regulation.

The main plea: infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

14 The applicant claims that, contrary to what the Board of Appeal found in the contested decision, there is, in the present case, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94.

15 First, there is a close similarity, bordering on identity, between the conflicting signs.

16 Secondly, there is manifestly a very close link between the goods in Class 3 and, especially, Class 25 designated by the earlier marks and the goods in Classes 18 and 24 covered by the trade-mark application. The applicant claims that all those classes relate to the fashion and textile sectors and are concerned with clothing itself, textiles to be used in making them, accessories or cosmetics. They are indissociable from beauty, personal hygiene, physical appearance and personal image. The goods in question are sold through the same channels, with the result that consumers will inevitably associate them and attribute a common commercial origin to them. Moreover, in its decision of 20 April 2000, the Opposition Division conceded that a link could be established between Classes 18 and 25 if certain conditions are met, including the condition that the mark EMIDIO TUCCI have 'highly distinctive character'.

17 Thirdly, the applicant points out that, in any event, application of Article 8(1)(b) of Regulation No 40/94 requires that the likelihood of confusion be assessed comprehensively (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22), account being taken of both the highly distinctive character of the earlier marks and the principle of interdependence.

18 With regard to the first of those aspects, the applicant observes that the more distinctive the earlier mark, the greater will be the likelihood of confusion; marks with highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 20).

- 19 With regard to the second aspect, the applicant observes that an overall assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17, and *Lloyd Schuhfabrik Meyer*, cited in paragraph 18 above, paragraph 19).
- 20 In the present case, the applicant submits that, given the high level of distinctiveness of the earlier marks and the virtual identity of the conflicting signs, which means that it is possible to take account of the lesser degree of similarity between the goods, the application of those principles must lead to refusal to register the mark sought in respect of Classes 18 and 24.
- 21 Neither OHIM nor the intervener denies that the conflicting signs are very similar.
- 22 With respect to the similarity between the goods in question, OHIM divides the goods covered by the trade-mark application into two groups, drawing a distinction between, on the one hand, the goods ‘leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery’ in Class 18 and the goods in Class 24 (‘the goods in group 1’) and, on the other, the goods ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in Class 18 (‘the goods in group 2’).
- 23 OHIM shares the view taken by the Board of Appeal that there is generally no similarity between the goods in group 1 and the goods in Classes 3 and 25 designated by the applicant’s earlier marks.

24 OHIM observes that, when assessing the similarity between the goods in group 2 and the goods in Class 25 designated by one of the applicant's earlier marks, the Board of Appeal appears to have taken account only of their different nature and intended purposes and did not give any ruling as to whether they might be complementary.

25 However, the goods in group 2 include accessories made of leather or imitation leather, such as various types of bag and handbag, purses, wallets, etc., which according to OHIM the public will normally perceive as being largely complementary to clothing and shoes in Class 25. It is well known that women in particular take great care when choosing a bag or handbag, making sure that it matches a certain type of clothing or shoes.

26 In this connection, OHIM relies on the practice of the Opposition Division in past decisions and more specifically two decisions in which it was acknowledged that 'handbags' and 'articles made of leather or imitation leather and bags' are complements of 'clothing and shoes' since those goods in Class 18 are basically perceived by consumers as accessories of clothing and shoes in Class 25. That practice was reflected in the Opposition Guidelines adopted by the President of OHIM on 10 May 2004.

27 In light of the foregoing, OHIM states that it is for the Court to judge whether the goods in question are complementary.

- 28 However, according to the intervener, it is appropriate in the present case to apply the general rule referred to by the Board of Appeal that the goods in Classes 18 and 24 and those in Classes 3 and 25 must normally be regarded as dissimilar on account of the differences in their nature, intended purpose, method of use and means of distribution and marketing.
- 29 An exception to that rule may be made only in certain special cases, for example where a textile company has gained a certain reputation for its textiles and decides to capitalise on that success by extending its activities to making clothing. In such a case, the consumer would associate those goods with their single producer.
- 30 There is no such special link in this case since the applicant has never used the mark EMIDIO TUCCI outwith the specific sector of menswear.
- 31 As far as the overall assessment of the likelihood of confusion is concerned, both OHIM and the intervener take the view that the Board of Appeal was right to find that the evidence submitted by the applicant was insufficient to justify taking account of the allegedly high level of distinctiveness of the earlier marks.
- 32 With respect, moreover, to consideration of the principle of interdependence, OHIM considers, without prejudice to the reservation set out in paragraphs 24 to 27 above in relation to the goods in group 2, that the Board of Appeal was right to find that there was no objective relationship, even distant, between the goods in Classes 18 and 24 covered by the trade-mark application and the goods in Class 3 and, in particular, Class 25 designated by the earlier marks.

Findings of the Court

- 33 Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered where, 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 exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 34 For the purposes of that provision, Article 8(2)(a)(ii) of Regulation No 40/94 states that, in the case of trade marks registered in a Member State, earlier marks are those with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.
- 35 In the present case, the applicant based its opposition on four national trade marks, namely the two Spanish trade marks identified in paragraph 6 above and two other trade marks registered in Spain, one on 5 December 1996 under No 2027132 for goods in Class 18 and the other on 20 November 1997 under No 2092894 for goods in Class 24. At the hearing, the applicant requested that, for the purposes of the present action, account also be taken of the last two marks. In that connection, it is sufficient to point out, as did the Opposition Division, that the applications for registration of those marks were lodged on 6 May 1996 and 19 May 1997 respectively whereas the application for a Community trade mark was filed on 1 April 1996. Therefore, only the two trade marks identified in paragraph 6 above may be regarded as earlier marks within the meaning of Article 8(2)(a)(ii) and, accordingly, only they may be taken into account for the purposes of Article 8(1)(b) of Regulation No 40/94. Those two earlier marks were registered in Spain, which is therefore the relevant territory for the purposes of that provision. Given the nature of the goods designated by those two marks, the relevant public is composed of end consumers.

- 36 According to settled case-law, the likelihood that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings constitutes a likelihood of confusion.
- 37 According to the same line of case-law, the likelihood of confusion must be assessed comprehensively, regard being had to the perception by the relevant public of the signs and of the goods or services in question and account being taken of all factors relevant to the case, in particular the interdependence of the similarity between the trade marks and between the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 to 33 and the case-law cited there).
- 38 In the present case, neither OHIM nor the intervener has challenged the Board of Appeal's finding that the conflicting signs are similar for the purposes of Article 8(1)(b) of Regulation No 40/94.
- 39 It is therefore appropriate to examine whether the degree of similarity between the goods in question, namely the goods in Classes 3 and 25 designated by the earlier marks and the goods in Classes 18 and 24 covered by the trade-mark application, is sufficiently great for it to be possible to find that there is a likelihood of confusion between the marks.
- 40 In that context, it must be pointed out, first of all, that, as is stated in Rule 2(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), the classification of goods and services under the Nice Agreement is intended to serve exclusively administrative purposes. Therefore, goods may not be regarded as being dissimilar to each other on the sole ground that, as in the present case, they appear in different classes under that classification.

41 Moreover, it is settled case-law that when assessing the similarity of the goods concerned, all the relevant factors which characterise the relationship between those products should be taken into account, those factors including, in particular, their nature, their end users and their method of use and whether they are in competition with each other or are complementary (*Canon*, cited in paragraph 19 above, paragraph 23, and Case T-85/02 *Díaz v OHIM — Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 32).

42 Thus, in the present case, even if the applicant's claim that all the goods in question relate to beauty, personal hygiene, physical appearance or personal image were established, it would be insufficient for the goods to be regarded as similar if they are markedly different in the light of all the relevant factors characterising their relationship.

43 OHIM rightly argues that the goods in Class 18 have a different nature and purpose from the goods in Classes 3 and 25 designated by the earlier marks. The applicant does not seriously deny those differences with regard to the goods in Class 3. The goods in Class 25 are used to cover and dress the human body whilst the goods in Class 18 are used to carry objects, to decorate places or to serve as raw material for producers of goods made of leather or imitation leather. They are normally made by different producers and sold through different distribution channels. The fact that goods such as cases and umbrellas, or clothes and shoes, may be sold in the same commercial establishments, such as large shops and supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin. Nor are the goods in competition.

44 Similarly, the textiles and textile goods in Class 24 and the clothing and shoes in Class 25 differ in many respects, such as their nature, intended purpose, origin and

distribution channels. The Board of Appeal was therefore right to find, in paragraph 31 of the contested decision, that it is only in special cases, namely where a textile manufacturer exploits the reputation of its trade mark and decides to extend its activity to the production of clothing, that the same mark is used to designate finished goods (clothing) and semi-finished goods (textiles for clothing). It is not apparent from the file submitted by the applicant that this is the case here.

45 Therefore, far from being ‘manifestly and very closely linked’, the goods in Classes 18 and 24 and those in Classes 3 and 25 are normally not sufficiently similar for a likelihood of confusion as to their commercial origin to arise in the minds of the reference public, even where the signs are similar.

46 Nevertheless, it is necessary to examine in more detail OHIM’s argument that, of the goods in Class 18, those in group 2, such as bags, handbags, wallets, purses and other similar accessories, are so complementary in nature to the clothing and shoes in Class 25 that they might be regarded as similar within the meaning of the judgment in *Canon*, cited in paragraph 19 above.

47 According to the definition given by OHIM in paragraph 2.6.1 of the Opposition Guidelines, referred to in paragraph 26 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.

48 However, in the present case, OHIM has by no means established or even claimed that the goods in group 2 and the goods in Class 25 are complementary in this way.

Rather, OHIM appears to consider them to be aesthetically, and therefore subjectively, complementary in a way which is determined by the habits and preferences of consumers as may have been induced by producers' marketing strategies or even simple fashion trends. Moreover, according to OHIM's argument, this complementary nature does not appear to have reached the stage of an aesthetic 'necessity' in the sense that consumers would consider it unusual or shocking to carry a bag which does not match their clothing or shoes.

49 In the present case, not only were no arguments exchanged before the Board of Appeal with regard to the specific evidence on the basis of which the merits of OHIM's line of argument could be assessed but OHIM has likewise failed to produce such evidence in the present proceedings.

50 OHIM merely asserts that it is 'probable' that consumers, particularly female consumers, will regard the goods in group 2, and more specifically handbags, as 'accessories' for outer clothing and even shoes. OHIM submits that it is 'normal' for a sizeable fraction of the public to regard those goods as 'complementary accessories' because they are closely coordinated with outer clothing and shoes and because they 'may well' be sold by the same or linked producers.

51 First of all, those explanations are to a certain extent speculative and hypothetical, if not based on simple postulations.

52 Moreover, it is acknowledged in both the Opposition Guidelines and the two decisions of the Opposition Division relied on by OHIM that it is unusual for both handbags and clothing and shoes to be sold by the same or linked producers.

- 53 It is therefore inappropriate to call into question, solely on the basis of the unsubstantiated claims made by OHIM, the Board of Appeal's finding that the goods are similar.
- 54 The applicant also relied on the unusually high level of distinctiveness of its earlier mark as evidence to be taken into account in carrying out an overall assessment of the likelihood of confusion (see paragraphs 17, 18 and 20 above).
- 55 As the Opposition Division rightly pointed out (see paragraph III.B.4 of its decision of 20 April 2000), the unusually high level of distinctiveness of the earlier mark, resulting either from its inherent qualities or from recognition of it on the market, is one of the special circumstances in which the possibility that the goods in group 2 and the goods in Class 25 are complementary in aesthetic terms, because the former goods may be accessories for the latter, can be regarded as decisive in assessing the likelihood of confusion.
- 56 Nevertheless, first, the applicant has failed to put forward any evidence or argument to substantiate its claim that its earlier marks are inherently distinctive. Accordingly, that claim can only be rejected.
- 57 Secondly, although the high level of distinctiveness of those marks resulting from the recognition of them on the market was taken into account by the Opposition Division, the Board of Appeal was right to disregard it in the light of the evidence submitted by the applicant, as will be explained in paragraph 67 et seq. below.

58 The applicant therefore cannot rely on the high level of distinctiveness of its earlier marks.

59 It follows from the foregoing that the Board of Appeal did not err in law by finding that a likelihood of confusion could be ruled out in the present case because there is no similarity between the goods in question. Accordingly, the main plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94, must be rejected.

The alternative plea: infringement of Article 8(5) of Regulation No 40/94

Arguments of the parties

60 Even if it is assumed that there is no link between the goods in Class 3 and, especially, the goods in Class 25 designated by the earlier marks and the goods in Classes 18 and 24 covered by the trade-mark application, the applicant submits that OHIM ought to have refused to register the mark sought under Article 8(5) of Regulation No 40/94.

61 In the present case, it cannot, in the applicant's view, be denied that the earlier national marks EMIDIO TUCCI enjoy a reputation in the Member State concerned since a large section of the relevant public is familiar with them and since they are highly distinctive, particularly in the sector of men's fashion, as was recognised by the Opposition Division itself in its decision of 20 April 2000.

62 In that context, the applicant relies on the evidence produced during the procedure before OHIM.

63 In addition, the applicant claims to present new evidence in the form of documents and testimonies, including a request addressed to the Spanish Patents and Trade Marks Office for information on the fact that it has registered marks in the various classes of the international classification, as well as new photographs, brochures, written statements, advertisements, reviews and new promotional material.

64 According to the applicant, registration of the mark sought in respect of the goods in Classes 18 and 24 would entail an abusive use of the special distinctiveness which its earlier marks are acknowledged to have.

65 OHIM and the intervener take the view that the Board of Appeal was right to find inadequate the evidence submitted by the applicant in support of its opposition with a view to proving both the high level of distinctiveness of the marks EMIDIO TUCCI for the purpose of the assessment of the likelihood of confusion and the reputation of those marks for the purposes of Article 8(5) of Regulation No 40/94.

66 OHIM submits that the new evidence relied on by the applicant in support of its action cannot be submitted for the first time before the Court.

Findings of the Court

- 67 According to the Court's case-law on the interpretation of Article 5(2) 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), the substantive content of which is, in essence, identical to that of Article 8(5) of Regulation No 40/94, in order to satisfy the requirement of reputation, the earlier national mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the amount spent by the undertaking in promoting it (Case C-375/97 *General Motors* [1999] ECR I-5421, paragraphs 26 and 27).
- 68 In the present case, the Opposition Division drew a distinction between the reputation of a mark and its unusually high level of distinctiveness resulting from recognition of it on the market. Without its being necessary to decide whether such a distinction must be drawn, it should be observed that, in order for a mark to acquire an unusually high level of distinctiveness as a result of market recognition, at least a significant part of the relevant public must be familiar with it.
- 69 Since a mark cannot have a reputation unless it is, at the very least, recognised on the market, the following considerations apply in relation to both the assessment of the reputation allegedly enjoyed by the applicant's earlier marks for the purposes of Article 8(5) of Regulation No 40/94 and consideration, for the purposes of assessing the likelihood of confusion under Article 8(1)(b) of that regulation, of the unusually high level of distinctiveness allegedly acquired by those marks as a result of recognition of them on the market (see paragraph 54 et seq. above).

70 In the present case, it is apparent from the case file that, before the Opposition Division and subsequently before the Board of Appeal, the applicant produced the following evidence in order to establish both the reputation of its earlier national marks and the 'higher than normal distinctiveness' acquired by them as a result of their market recognition:

- 13 photocopies of advertisements for clothing bearing the mark EMIDIO TUCCI, which appeared in a variety of Spanish newspapers and magazines (*Tribuna, Tiempo, Epoca, El País* and *El Mundo*) in 1998;
- seven letters from a number of advertising directors (Grupo Zeta, *El País*, Diario ABC, RTVE, *El Mundo, Tribuna* and PCM), written in 1999 and confirming that clothing bearing the mark EMIDIO TUCCI had been advertised in the media concerned 'during the past five years' or, at best, between 1994 and 1998;
- a video cassette containing advertisements and confirmation that those advertisements were broadcast on television (Tele Cinco) 'between 1994 and 1999'.

71 Having examined that evidence, the Board of Appeal found that:

- the photocopies of advertisements which appeared in the Spanish press in 1998 were published after the application for registration of the Community trade mark in question (which was filed on 1 April 1996) and are therefore irrelevant in assessing whether, at that time, the earlier national trade mark had acquired a high level of distinctiveness as a result of recognition of it on the market;

- the majority of the confirmations given by the advertising directors of various media companies are drafted in a manner which does not make it possible to ascertain whether or to what extent the earlier marks were advertised before the decisive date of 1 April 1996; only two of them, namely those from the publishers of the magazines *Epoca* and *Tribuna*, state relevant dates between 1994 and 1995 on which one of those marks was advertised;

- the same objection may be made in relation to the video cassette;

- the applicant failed to provide any information on the turnover achieved on the sale of the goods bearing those marks or on the amount spent on advertising them during the relevant period.

72 In the light of the file, those findings must be upheld.

73 OHIM and the intervener are therefore right to take the view, like the Board of Appeal, that the high level of distinctiveness allegedly acquired by the applicant's earlier marks as a result of the recognition of those marks on the market and, accordingly, the reputation allegedly enjoyed by the marks were not sufficiently established by the material submitted by the applicant during the administrative procedure since it did not include adequately substantiated or verifiable objective evidence to make it possible to assess the market share held by the marks EMIDIO TUCCI in Spain, how intensive, geographically widespread and long-standing use of the marks has been or the amount invested by the undertaking in promoting them (see, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 51).

74 The new evidence produced by the applicant for the first time in the proceedings before the Court (see paragraph 63 above) must be rejected as inadmissible, in accordance with settled case-law (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-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67).

75 It should be added that the applicant has failed to put forward any evidence or argument capable of establishing that use of the mark sought would take unfair advantage of, or be detrimental to, the distinctiveness or the reputation of the earlier marks, so that, in any event, the conditions for applying Article 8(5) of Regulation No 40/94 are not met.

76 Accordingly, the alternative plea, alleging infringement of Article 8(5) of Regulation No 40/94, is unfounded and must therefore be rejected.

77 The action must therefore be dismissed in its entirety.

Costs

78 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 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

Forwood

Delivered in open court in Luxembourg on 13 December 2004.

H. Jung

Registrar

J. Pirrung

President