

Case T-364/05

Saint-Gobain Pam SA

v

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

(Community trade mark — Opposition proceedings — Application for Community word mark PAM PLUVIAL — Earlier national figurative marks PAM — Relative ground for refusal — Likelihood of confusion — Evidence of use — Article 8(1)(b) and Article 43 of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fifth Chamber), 22 March 2007 . . . II - 761

Summary of the Judgment

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

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*
(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*
(Council Regulation No 40/94, Art. 8(1)(b))
4. *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*
(Council Regulation No 40/94, Art. 8(1)(b))

1. Pursuant to Article 43(2) and (3) of Regulation No 40/94 on the Community trade mark, for the purposes of examining an opposition introduced under Article 42 of that regulation, the earlier mark is presumed to have been put to genuine use as long as the applicant does not request proof of that use before the Office for Harmonization in the Internal Market (Trade Marks and Designs).

Such a request, which must be submitted expressly and in a timely manner, cannot be presented for the first time before the Board of Appeal.

That request, which has the effect of shifting the burden of proof to the opponent to demonstrate genuine use of his mark (or the existence of proper reasons for non-use) upon pain of having his opposition dismissed, alters the content of the opposition procedure by adding a specific and preliminary question which must be settled before a decision is given on the opposition proper. It is for the Opposition Division, first of all, to determine the opposition, as defined by the various procedural acts and requests of the parties, including, where appropriate, a request for proof of genuine use of the earlier mark. To allow the possibility of making such a request before the Board of Appeal, which is uniquely competent to determine applications brought against decisions of the Opposition Divisions and not to deter-

mine new oppositions itself at first instance, would mean the Board of Appeal examining a very specific request related to new legal and factual matters that go beyond the opposition procedure as submitted and dealt with by the Opposition Division.

in competition with each other or are complementary. In this connection 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.

The principle of continuity of functions, which exists between the various instances of the Office, cannot justify the submission of such a request for the first time before the Board of Appeal, since it does not entail the Board of Appeal examining a case different from that submitted to the Opposition Division, that is to say a case whose scope has been extended by the addition of the preliminary issue of genuine use of the earlier mark.

(see paras 92, 94, 95)

- (see paras 32, 34-37, 39-41)
2. In applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the similarity of the goods covered by the conflicting marks must be assessed by taking into account all the relevant factors which characterise the relationship between the goods in question, including, inter alia, their nature, their end users and their method of use, the fact that they are generally marketed at the same outlets, and whether they are
 3. In applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, a complex trade mark may be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark where that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it. With regard to the assessment of the dominant character of one or more given components

of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.

(see para. 97)

4. For the average Spanish consumer there is a likelihood of confusion between the word mark PAM PLUVIAL, the registration of which as a Community mark is sought for 'pipes and tubes of metal' and 'fittings not of metal, for rigid pipes and tubes, not of metal' falling within Classes 6 and 17, respectively, of the Nice Agreement and the figurative mark whose verbal component 'PAM' is the central and dominant component, registered earlier in Spain in respect of 'construction materials' falling within Class 19.

Since, first, the conflicting marks are visually and aurally similar, and the dominant component 'PAM' of the earlier mark is also the dominant component of the mark sought, PAM PLUVIAL, because it is short and easily memorised, because it does not have any particular meaning in Spanish and because it appears at the beginning of the mark sought, and, secondly, the products covered by the conflicting marks are similar and complementary, the fact that the mark sought contains the word 'pluvial' does not exclude the likelihood of confusion since this component may lead the average consumer to suppose that the mark sought is derived from a principal 'pam' trade mark and designates a specific range forming part of the 'PAM family of trade marks'.

(see paras 98-100, 105)