

# CONTENTS

	<b>OJ 1/2006</b>
	<i>Page</i>
Decision No EX-05-3 of the President of the Office of 10 October 2005 concerning electronic filing of sound marks .....	7
Decision No EX-05-4 of the President of the Office of 10 October 2005 concerning the keeping of files .....	11
Communication No 7/05 of the President of the Office of 31 October 2005 concerning the registration of Community trade marks for retail services.....	15
Summarised version of OHIM budget 2006.....	22
List of professional representatives .....	26
Case-law of the Court of First Instance of the European Communities	
• Judgment of the Court of First Instance (First Chamber) of 17 November 2005 in Case T-154/03 ( <i>ARTEX / ALREX</i> ).....	35
• Judgment of the Court of First Instance (Fourth Chamber) of 24 November 2005 in Case T-135/04 ( <i>Online Bus / BUS</i> ) .....	61

**DECISION No EX-05-3 OF THE  
PRESIDENT OF THE OFFICE**

**of 10 October 2005**

**concerning electronic filing of  
sound marks**

THE PRESIDENT OF THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS),

Having regard to the Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (hereinafter referred to as 'the Implementing Regulation'), as amended by Commission Regulation No 1041/2005 of 29.6.2005, in particular Rule 3 (6) thereof,

Whereas Decision No EX-02-2 of the President of the Office of 7 November 2002, as amended by Decision No EX-04-3 of 26 November 2004, has provided for the availability of electronic filing of Community trade mark applications through the Internet, and in particular laid down the admissible formats of annexes to electronically filed applications;

Whereas Rule 3 (6) of the Implementing Regulation, as amended, allows for the filing of sound files as representations of sound marks and empowers the President of the Office to determine the formats and maximum size of the electronic file;

Whereas it is appropriate to amend Decision No EX-02-2 of the President of the Office of 7 November 2002 accordingly,

HAS ADOPTED THE FOLLOWING DECISION:

*Article 1*

Article 4 of Decision No EX-02-2 of the President of the Office of 7 November 2002 (OJ OHIM 2003, 14), as amended by Decision No EX-04-3 of 26 November 2004 (OJ OHIM 2005, 314), shall be replaced by the following:

*'Article 4  
Attachments*

(1) Where the applicant does not wish to claim any special graphic feature or colour (Rule 3 (1) of the Implementing Regulation), the trade mark shall be indicated as a 'word mark', and the respective field in the

electronic application form shall be filled in. In all other cases, the graphic representation shall be filed as an attachment to the electronic application form. The graphic representation shall be in the .jpeg data format.

(2) Where registration of a sound mark is applied for, one sound file containing the sound may be filed as an attachment to the electronic application form. The sound file shall be in the .mp3 format. Its file size shall not exceed one Megabyte. It shall not allow loops or streaming.

(3) Documents in support of a priority claim or a seniority claim in accordance with Rule 6 (1) or Rule 8 (1) of the Implementing Regulation, also in conjunction with Decision No EX-03-5 of the President of the Office of 20.1.2003, regulations governing the use of a collective mark in accordance with Article 65 of the Community Trade Mark Regulation, and the indications referred to in Rule 124 of the Implementing Regulation, may be sent as attachments to the electronic application form. Such attachments shall be in the .pdf or .jpeg data format.

(4) Any other attachments, or any attachments that do not comply with paragraphs 1, 2 or 3, shall be deemed not to have been filed.'

*Article 2  
Entry into force*

This decision shall enter into force on the day following its adoption. It shall be applicable as of 25 July 2005. It shall be published in the Official Journal of the Office.

Done at Alicante, 10 October 2005

Wubbo de Boer  
President

**DECISION No EX-05-4 OF THE  
PRESIDENT OF THE OFFICE**

**of 10 October 2005**

**concerning the keeping of files**

THE PRESIDENT OF THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS),

Having regard to the Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (hereinafter referred to as 'the Implementing Regulation'), as amended by Commission Regulation No 1041/2005 of 29.6.2005, in particular Rule 91 (2) thereof,

Whereas the files of the Office are kept electronically;

Whereas those parts of the files relating to procedures concerning Community trade mark applications that due to their physical form or volume have not been scanned into the electronic file system of the Office shall be kept pursuant to Rule 91 (3) of the Implementing Regulation;

Whereas colour representations of the trade mark are scanned into the electronic file system but kept separately so as to be able to control whether the scanned image contained in the electronic file corresponds to the document as filed;

Whereas all other paper originals of documents that have been scanned into the electronic file system may safely be disposed of after a reasonable period;

Whereas Rule 91 (2), second sentence, of the Implementing Regulation authorises the President to decide whether and after which period, counted from the reception at the Office, such documents shall be disposed of,

HAS ADOPTED THE FOLLOWING DECISION:

*Article 1*

(1) Where a Community trade mark application contained a representation of the mark which is in colour, or contains colour, and where the application was submitted pursuant to Rule 79 (a), the original docu-

ment, to the extent that it contains the representation of the mark, shall be kept without time limitation.

(2) All other original documents filed in proceedings under the Community Trade Mark Regulation which were submitted pursuant to Rule 79 (a) and which form the basis of files kept electronically, shall be disposed of after a period of three years following their reception by the Office.

*Article 2*  
**Entry into force**

This decision shall enter into force on 1 November 2005. It shall be published in the Official Journal of the Office.

Done at Alicante, 10 October 2005

Wubbo de Boer  
President

**Communication No 7/05 of the  
President of the Office  
of 31 October 2005  
concerning the registration of  
Community trade marks for retail  
services**

1. In its judgment of 7 July 2005 in Case C/418-02, 'Praktiker', the Court of Justice has ruled on the registrability of retail services. It has held that services provided in connection with retail trade in goods constitute 'services' for which a national trade mark can be registered in accordance with Article 2 of Council Directive 89/104/EEC of 21.12.1988. Furthermore it held that 'for the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the services in question. However, details must be provided with regard to the goods or types of goods to which those services relate.'

2. As a consequence, the practice of the Office regarding registrability of trade marks for retail as a service has again to be reviewed (see Communication No 3/01 of 12.3.2001, OJ OHIM 2001, 1222) in particular as regards the specification of the type of retail concerned. In pursuance of paragraph 2 of the operative part of the 'Praktiker' judgment, the Office considers the activity of retail in goods as a service for which protection of a Community trade mark can be obtained and that that service does not consist in the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are circumscribed in the explanatory note to class 35 of the Nice Classification by the terms 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods'. It is not required to specify in what activities these services exactly consist. Nor is it required to indicate the type of establishment undertaking the retail sales (for example, a supermarket or a department store).

3. On the other hand, the 'Praktiker' judgment requires to 'provide details with regard to the goods or types of goods to which those services relate'. This means that specifications merely claiming 'retail services', the exact wording of the ex-

planatory note to class 35, or 'retail services of a supermarket', while previously accepted by the Office, are no longer acceptable.

4. What is required is a reference to the goods or type of goods sold at retail. It has to be observed that the judgment does not require an exact specification of the goods to be sold, but merely the provision of details concerning the goods or types of goods. The Office will therefore accept any reference to the goods expressed in broad categories, regardless of whether they could be properly classified as goods under the goods classes. The reasoning is that the protection for marks claiming retail services is exactly not conferred to the actual act of sale of those goods. Indications such as 'retail trade in building, home improvement and gardening tools for the do it yourself sector' (see paragraph 11 and 50 of the judgment), foodstuff, or any other general category of goods, as long as the type of goods is readily ascertainable, are acceptable. It is equally acceptable to refer to class headings. However, it is not acceptable to refer to goods falling into a particular class or into a number of classes, for example 'retail services in respect of goods falling in class 9' or 'retail services in respect of goods in classes 7, 9, 12, and 16'.

5. Pending Community trade mark applications that do not comply with the above principles will be objected to. Applicants are also free to limit the list of goods and services during the examination procedure, until registration, on their own volition. Registered Community trade marks may be partially surrendered pursuant to Article 49 CTMR by limiting the list of goods and services in the appropriate manner.

6. The Office will draw the appropriate conclusions from these principles when it comes to judging the similarity of goods and services, or the fulfilment of the use requirement. 'Retail services' as such will not be considered similar to any goods. Conflicts between trade marks claiming retail services for different goods will be judged according to the normal criteria. Earlier rights invoked in opposition proceedings, or Community trade marks attacked on revocation, will be considered to

be registered or limited in relation to retail services for those goods which have actually been sold at retail.

7. The same principles set out above will be applied by the Office to similar services rendered in connection with other forms exclusively related to the sales of goods, such as wholesale, Internet shopping, or catalogue or mail order services (to the extent that these fall into class 35). Such services have in common with retail services that they exclusively consist of services around the actual sale of goods, so that the same considerations apply. Furthermore, as the sales of goods is not a service, the term 'sales' as such, whether or not coupled with the indications of the type of goods sold, is not sufficient.

8. On the other hand, the Office will not apply the above principles to other services which are not limited to services around the sales of goods, or which do not fall into class 35, such as distribution services falling into class 39, transport or repair, or training or education, which may have different goods or activities as their subject but do not consist in services ancillary to the purchase of goods. Those services have in common that they had already been acceptable, and could always have been properly classified, even before the Office started accepting Community trade mark applications for retail services.

Wubbo de Boer  
President

### SUMMARISED VERSION OF OHIM BUDGET 2006

The present budget for 2006 approved by the OHIM Budget Committee on 25 November 2005 was established under the following main parameters:

Year	Budget 2005	Budget 2006	Δ %
<b>CTM applications</b> .....	<b>55.000</b>	<b>60.000</b>	<b>9,1%</b>
Via MP.....	11.000	12.000	9,1%
Direct filings.....	44.000	48.000	9,1%
<b>Publications</b> .....	<b>68.000</b>	<b>57.000</b>	<b>-16,2%</b>
<b>Registrations</b> .....	<b>50.000</b>	<b>54.500</b>	<b>9,0%</b>
<b>Community Designs received</b> .....	<b>55.000</b>	<b>59.000</b>	<b>7,3%</b>
Renewal rate.....	50%	50%	50%
CTM renewals (first full year).....	800	17.100	N/A
Men/years.....	719	696	-3,2%
Teleworking staff.....	100	150	+50%
Inflation rate (E.U. average).....	3,0%	2,0%	(-)
Inflation rate (Spain).....	3,5%	2,5%	(-)

- CTM renewals will impact on a full financial year for the first time in 2006.
- 35% of CTM applications will reach the Office through e-filing, and some 12 000 via the Madrid Protocol.
- Another key factor is the fee reduction: 2006 will be the first year during which the fee reduction will fully impact on the budget of the Office.
- The overall staff figure will fall by 3.2%.
- Efforts will continue regarding IT developments, particularly on re-engineering the CTM targeted IT core system (Euromarc) and speeding up the shift towards e-business.
- Cooperation with the National IP Offices will be strengthened.

Given these parameters, the overall budget for 2006 is estimated as follows:

	REVENUE (€ Mio)	Budget 2005	Budget 2006	Δ %
Title 1	Revenue accruing from operation.....	137.04	151.93	10.9%
Title 3	Balance from previous year.....	81.35	59.80	-26.5%
<b>Total Revenue</b>		<b>218.39</b>	<b>211.73</b>	<b>-3.0%</b>

	EXPENDITURE (€ Mio)	Budget 2005	Budget 2006	Δ %
Title 1	Staff cost.....	60.50	59.07	-2.4%
Title 2	Buildings, equipment, etc.....	33.62	39.13	16.4%
Title 3	Special functions.....	35.19	28.27	-19.7%
<b>Total Expenditure</b>		<b>129.31</b>	<b>126.47</b>	<b>-2.2%</b>
Title 10	Provisions.....	89.08	85.26	-4.3%
<b>Overall budget</b>		<b>218.39</b>	<b>211.73</b>	<b>-3.0%</b>

The complete version of the budget may be found at the following address: <http://oami.eu.int/en/office/marque/finan.htm>

LISTA DE LOS REPRESENTANTES AUTORIZADOS ANTE LA OFICINA  
DE ARMONIZACIÓN DEL MERCADO INTERIOR  
(MARCAS, DIBUJOS Y MODELOS)

LISTE DER ZUGELASSENEN VERTRETER BEIM  
HARMONISIERUNGSAMT FÜR DEN BINNENMARKT  
(MARKEN, MUSTER UND MODELLE)

LIST OF PROFESSIONAL REPRESENTATIVES BEFORE THE OFFICE  
FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

LISTE DES MANDATAIRES AGRÉÉS AUPRÈS DE L'OFFICE  
DE L'HARMONISATION DANS LE MARCHÉ INTÉRIEUR  
(MARQUES, DESSINS ET MODÈLES)

ELENCO DEI MANDATARI ABILITATI PRESSO L'UFFICIO  
PER L'ARMONIZZAZIONE NEL MERCATO INTERNO  
(MARCHI, DISEGNI E MODELLI)

*(Véanse también las comunicaciones del Presidente de la Oficina / Siehe auch die  
Mitteilungen des Präsidenten des Amtes / See also the communications of the  
President of the Office / Voir aussi les communications du président de l'Office /  
Vedi anche le comunicazioni del presidente dell'Ufficio)*

*n° 1/95, DO/ABI./OJ/JO/GU n° 1/95, p. 16  
n° 2/99, DO/ABI./OJ/JO/GU n° 7-8/99, p. 1003  
n° 10/02, DO/ABI./OJ/JO/GU n° 9/02, p. 1636  
n° 12/02, DO/ABI./OJ/JO/GU n° 3/03, p. 525*

**PARTE A: / TEIL A: / PART A: / PARTIE A: / PARTE A:**

**Lista de representantes autorizados contemplada en el artículo 89  
del Reglamento sobre la marca comunitaria  
Liste der zugelassenen Vertreter gemäß Artikel 89  
der Gemeinschaftsmarkenverordnung  
List of professional representatives according to Article 89  
Community Trade Mark Regulation  
Liste des mandataires agréés conformément à l'article 89  
du règlement sur la marque communautaire  
Elenco dei mandatari abilitati ai sensi dell'articolo 89  
del regolamento sul marchio comunitario**

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**Lista especial de representantes autorizados contemplada en el artículo 78  
del Reglamento sobre los dibujos y modelos comunitarios**

**Besondere Liste zugelassener Vertreter gemäß Artikel 78 der  
Gemeinschaftsgeschmacksmusterverordnung**

**Special list of professional representatives according to Article 78  
Community Designs Regulation**

**Liste spécifique des mandataires agréés conformément à l'article 78  
du règlement sur les dessins ou modèles communautaires**

**Elenco speciale di mandatari abilitati ai sensi dell'articolo 78  
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**CASE-LAW OF THE COURT OF  
FIRST INSTANCE OF THE  
EUROPEAN COMMUNITIES**

**Judgment of the Court  
of First Instance**

**(First Chamber)**

**of 17 November 2005**

**in Case T-154/03 (action brought against the decision of the Third Board of Appeal of OHIM of 5 February 2003 (Case R 370/2002-3), concerning opposition proceedings between Biofarma SA and Bausch & Lomb Pharmaceuticals, Inc.): Biofarma SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**

*(Community trade mark – Opposition proceedings – Earlier national word mark ARTEX – Application for Community word mark ALREX – Relative ground for refusal – Likelihood of confusion – Article 8(1)(b) of Regulation (EC) No 40/94)*

*(Language of the case: Dutch)*

**Background to the dispute**

1 On 6 April 1998, Bausch & Lomb Pharmaceuticals, Inc. ('the intervener') filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to 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 trade mark for which registration was sought is the word mark ALREX.

3 The goods in respect of which registration of the trade mark was sought are in Class 5 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 to the following description: 'Ophthalmic pharmaceutical preparations, namely eye drops, solutions, gels and ointments used for the treatment of eye infection and inflammation'.

4 On 12 July 1999, Biofarma SA ('the applicant') already the proprietor of the word marks ARTEX registered in France, the Benelux countries and in Portugal, in respect of goods belonging to Class 5 ('Pharmaceutical speciality used in the cardiovascular field; pharmaceutical, veterinary and sanitary products; material for

stopping teeth, dental wax'), filed an opposition against the mark applied for, claiming that a likelihood of confusion existed between the marks at issue for the purpose of Article 8(1)(b) of Regulation No 40/94.

5 On 18 January 2000, OHIM notified the applicant of an amendment made by the intervener to the list of products covered by the trade mark applied for, which would now read: 'Antiallergic, steroidal, ophthalmic preparations, namely eye drops, solutions, gels and ointments used for the treatment of eye infection and inflammation'. In the same letter OHIM invited the applicant to inform it whether it maintained its opposition, which it did by letter of 4 February 2000.

6 By decision of 28 February 2002 the Opposition Division upheld the opposition. It held that a likelihood of confusion existed as the signs ALREX and ARTEX, as well as the goods covered by the marks at issue, were similar.

7 On 25 April 2002, the intervener brought an appeal against the Opposition Division's decision.

8 By decision of 5 February 2003 ('the contested decision'), notified to the applicant on 4 March 2003, the Third Board of Appeal annulled the decision of the Opposition Division and rejected the opposition, on the grounds, in particular, that, despite the fact that the goods at issue belonged to the same class, there existed only a fairly vague degree of similarity between them.

**Forms of order sought by the parties**

9 The parties presented oral argument and answered the questions put to them by the Court at the hearing on 4 May 2005.

10 The applicant claims that the Court should:

— annul the contested decision and 'declare that there is in fact a likelihood of confusion between the marks ARTEX and ALREX, which designate similar products';

— order OHIM to pay the costs.

11 OHIM contends that the Court should:

— dismiss the action;  
— order the applicant to pay the costs.

12 The intervener contends that the Court should:

— dismiss the action;  
— order the applicant to pay the costs.

**Law**

*Arguments of the parties*

13 In support of its application, the applicant essentially claims that the Board of Appeal infringed Article 8(1)(b) of Regulation No 40/94.

14 Firstly, the applicant emphasises that the products designated by the marks at issue are similar by reason of their nature and their identical purpose, being the treatment of human health problems, their manufacture by the same undertakings, in the same laboratories, as well as by reason of the fact that they are marketed through the same channels, for example, by medical representatives, that their advertising appears in the same specialist journals, that they are sold in the same establishments, i.e., pharmacies, and administered in the same places, i.e., hospitals, health centres, etc.

15 The applicant adds that, while the medicinal product against hypertension designated by the earlier mark ARTEX comes in tablet form, it could very well in the future be presented in another dosage form in order to facilitate its being administered to certain categories of patients, for example, in the form of drops, in other words, in the same form as the products designated by the ALREX mark for which application was made.

16 Secondly, the applicant suggests that the simple visual comparison of the signs ARTEX and ALREX allows their degree of similarity to be established. Their visual similarity results from the manifest coincidence of their initial letter 'a' and from their two last letters 'ex'. They also have the central consonant 'r' in common. All of these factors produce a visual impact easily leading to the confusion of one name with another, which should be considered sufficient to demonstrate the existence of a likelihood of confusion. In this regard the applicant claims that the reading of a prescription written in haste by a doctor could lead to errors with fatal consequences when the names of the two products present such a degree of similarity. The only differences relate to the central letters of the words, which cannot be perceived at first glance. Indeed the only difference is one of the central consonants ('t' instead of 'l') and its position relative to the other consonant common to the two names. A

consumer generally retains the first and last letters and not the central letters.

17 Also, from the aural perspective, the likelihood of confusion is evident principally because the vowels 'a' and 'e' occupy the same place in the two words. Further, the two signs are made up of only two syllables and this coincidence has a major effect, the more so as the sound of the vowels, in particular the vowels 'a' and 'e', is that which is retained initially and the most clearly. Moreover, the fact that the vowel 'a' is the first letter of the two signs reinforces the resonance of the consonant which follows it. The applicant also explains that in France, Portugal and the Benelux countries, where the conflicting marks would be required to coexist should the contested decision be confirmed, the second syllable of these marks is fully pronounced and carries the main stress. It specifies that, in this syllable the vowel 'e' coincides with the final consonant 'x', such that that syllable is pronounced in French like the letters 'k' and 's' pronounced consecutively. In combination with the vowel 'e', the letter 'x' thereby forms a very powerful sound which dominates the whole. In both cases the first syllable starts with the vowel 'a', which itself also has a very strong resonance and which tends to weaken the sound, already weak in itself, of the consonant which follows ('l' in one case and 'r' in the other). The applicant finally adds that both of the names have the letter 'r', which is a fricative consonant, in their centre.

18 In this regard the applicant emphasises the fact that the consumer rarely has the opportunity to directly compare the signs ALREX and ARTEX and must place his trust in the imperfect picture which he has kept of them in his mind.

19 The applicant also maintains that the Institut national de la propriété intellectuelle (National Institute for Intellectual Property), before which it opposed the registration of the mark ALREX in France, indicated in its decision of 28 April 2000 that the sign ALREX constituted an imitation of the earlier sign and could not therefore benefit from protection in France as a mark to designate identical and similar products.

20 In relation to the representation of the packaging furnished by the intervener, reproduced at paragraph 35 below, the applicant maintains in its reply that it is necessary only to take account of the actual form under which the ARTEX marks were regis-

tered and to compare it with the actual form of the ALREX mark for which registration was sought at OHIM. It is a question in this case of two signs written in capital letters, purely nominative, without graphic elements, colours, different letters or characteristics which would permit one to be distinguished from the other.

21 Thirdly, the applicant reveals that the Board of Appeal appeared to presuppose that the consumers are professionals or specialists, which is not the case. The end user of the products in question will always be a sick person, in other words, an adolescent or older person, who may or may not benefit from some training and may or may not possess some general education. A nurse or a carer in a hospital could moreover also confuse these two medicines because their respective names are very similar.

22 Fourthly, the applicant explains that the function of the mark is not only to prevent the consumer from believing that products or services come from the same company, but also to guarantee the identification of products in themselves in the interest of the consumer. In the case of a medicinal product, the user wants to obtain the product of a specific mark because he is counting on it for beneficial effects for his health. Consequently, this consumer has a particular interest that the product be clearly identified and cannot be confused with another, at the risk of affecting his health.

23 The fact that other official institutions or bodies that have the responsibility of authorising the marketing of pharmaceutical products exist does not exonerate the institution responsible for registration from taking this function of the mark into consideration.

24 The applicant concludes from the statistics of the World Health Organisation and the Spanish Ministry of Health and Consumption that it is not unusual that two individuals, suffering respectively from arterial hypertension, treated by ARTEX, and from conjunctivitis as a result of seasonal allergies, for which ALREX is prescribed, are found either in the same family or professional context, or that the same patient suffers from those two illnesses and that it is not therefore exceptional that the two medicines are to be found in the same place at the same time.

25 In this regard the applicant adds that ARTEX could very well be made available

in the future in the form of drops, and, as can be supported by affidavits or expert evidence which it is in a position to produce, the confusion of one medicinal product with another can have serious consequences, particularly in the case of external usage. The risks to health, should confusion arise, should therefore be taken into account in the assessment of the likelihood of confusion.

26 In relation to the similarity between the products, OHIM, relying on the judgment of the Court in Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 23, admits that a similarity does exist in general when pharmaceutical products are compared with other pharmaceutical products. It considers, however, that the degree of similarity can vary, particularly in the case of products used for treating different health problems. Even if the purpose of all the pharmaceutical products is identical, that is the treatment of health problems, the nature of those problems can vary to the point where there exists only a faint degree of similarity, which can, on taking all of the relevant factors into account, lead to the conclusion that no likelihood of confusion exists.

27 Ocular infections and hypertension are treated by different specialists, in different places, which also means the existence of different channels of distribution. Further, the method of administering the two products is also different. While ARTEX is offered in the form of pills or tablets for oral use, ALREX is available as substances of a more or less liquid form applied locally on the human body. The market for medicinal products used for the reduction of eye infections and inflammations is thereby different from the market for the reduction of hypertension.

28 In short, while it is possible that in the future ARTEX will not only be produced in the form of pills or tablets but also in the form of drops, this is not the case today. According to OHIM, the comparison between products cannot be made on the basis of possible changes that may be brought about in the future.

29 In relation to the similarity between the signs, OHIM states that the Board of Appeal concluded that the two signs ARTEX and ALREX are ordinary names of pharmaceutical products composed of standard syllables, without any striking or surprising element. The register of Community trade marks thus has 296 registered trade marks ending in the suffix 'ex' in Class 5.

30 OHIM admits that the signs are similar, but considers that the fact of knowing whether the marks present a similarity sufficient for the conclusion that a likelihood of confusion exists depends on other factors which must be taken into consideration. Those factors are in particular the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22). At the hearing, OHIM added in this regard that professionals will make the connection between ARTEX and the French word 'artery'.

31 In relation to the relevant public, OHIM points out that the Board of Appeal decided at point 11 of its decision that, having regard to the fact that medicinal products directed at reducing hypertension are exclusively available on medical prescription, that public is made up of experts. OHIM adds that, in its judgment in Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma(BSS)* [2003] ECR II-411, paragraph 42, the Court decided that the public targeted by ophthalmic pharmaceutical preparations and sterile solutions for ophthalmic surgery comprised medical specialists, including in particular ophthalmologists and ophthalmic surgeons. That public, by reason of its knowledge, is more attentive than the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.

32 OHIM also points out that, given that Article 8(1)(b) of Regulation No 40/94 does not contain any reference to the moment at which the confusion can arise, no reason exists to assume that the moment of confusion is limited to the moment of purchase. The confusion can arise once the trade-marked product is in circulation. However, if it is decided that no likelihood of confusion existed at the time of purchase, there is no reason to think that it could be otherwise at any other time, for example, at the time of the taking of the medication, unless different categories of the public, having different degrees of attention, are involved. However, in this case there are no different categories of public.

33 OHIM also refers to the judgment of the Court of First Instance in Case T-224/01 *Durferrit v OHIM – Kolene(NUTRIDE)* [2003] ECR II-1589, paragraph 52), which decided, having determined that the public was made up of experts, that the degree of similarity between the marks in question was not sufficiently high for a

finding that a likelihood of confusion existed between them. That conclusion was corroborated, according to OHIM, by the fact that the relevant public was highly specialised in the sector of the goods and services in question and, accordingly, likely to take great care in the selection of those goods and services.

34 Finally, OHIM considers that the Board of Appeal correctly decided that a potential risk to health should not play a part in the assessment of a likelihood of confusion. Article 8(1)(b) of Regulation No 40/94 contains no indication to that effect. That article aims solely at preventing the registration of marks in the case of a likelihood of confusion between the mark for which registration is sought and another already registered mark.

35 The intervener, who endorses the essential parts of OHIM's arguments, emphasises in particular the fact that the tablets marketed by the applicant are contained in transparent plastic wrapping whereas the ophthalmic drops sold by the intervener are presented in a small bottle, the cap of which is fitted with a pipette, as is shown by the following reproductions:



36 Even though the goods in question were both presented in an identical form, the factors that must be taken into account, according to the judgment in *Canon*, cited above, in order to assess their degree of similarity would indicate clearly that they are not similar or, at least, that they present only a very weak degree of similarity.

37 At the hearing, the intervener mentioned two judgments of the Court given after the lodging of its statement in intervention. In Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi(SISSI ROSSI)* [2005] ECR II-0000, the Court decided that women's bags and women's footwear, even though they were fancy leather goods, could not be considered to be similar, as they were not substitutable for each other and were not in competition. In Case T-296/02 *Lidl Stiftung v OHIM – REWE-Zentral(LINDENHOF)* [2005] ECR II-0000, the Court decided that sparkling wines, on the one hand, and beers, cocktails and mineral waters, on the other, were not similar, consumers being in the habit of consuming them under different circumstances and at different events.

38 In contrast to OHIM, the intervener does not consider that the signs at issue are similar. It maintains that, by virtue of paragraph 25 of the judgment of the Court in Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, it is necessary to take account in particular of the distinctive and dominant components of the trade marks. The ending 'ex' is extremely common for all sorts of marks and goods, particularly in the pharmaceutical field. While the Board of Appeal found a 'certain similarity' resulting from the number of identical letters, that is the initial 'a' and the ending 'ex', it emphasised the visual difference created by the position of the letter 't' in the middle of the sign ARTEX and considered that this difference had a big effect on the visual impression of short signs, such as those in this case.

39 Finally, the intervener takes the view that the purpose of trade mark law is not to protect patients against an incorrect usage. Such a responsibility comes within the competence of bodies other than OHIM. Additionally, the hypothesis of the poisoning of a patient who suffers hypertension and an ocular infection or inflammation at the same time and who had been prescribed the two products in question is absurd, as it supposes that the patient has long been confusing tablets and drops. Further, a particular caution in relation to the medication which they administer to themselves should be expected of patients suffering from a relatively serious ailment, such as hypertension.

## Findings of the Court

40 As set out in 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 exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark. Moreover, under Article 8(2)(a)(ii) of Regulation No 40/94, 'earlier trade marks' means, inter alia, trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

41 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 from economically-linked companies constitutes a likelihood of confusion, and this likelihood must be assessed globally, according to the perception that the relevant public has of the signs and goods or services in question and taking into account all relevant factors of the case at issue.

42 That global assessment implies some interdependence between the relevant factors taken into account and, particularly, the similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between those goods or services designated may be offset by a greater degree of similarity between the marks and vice versa (*Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, cited above, paragraph 19).

43 In the present case the earlier marks ARTEX are registered in France, in the Benelux countries and in Portugal, which therefore constitute the relevant territory for the purpose of applying Article 8(1)(b) of Regulation No 40/94.

44 In relation to the relevant public, OHIM, like the intervener, maintains that the medicinal products which are at issue in the case are prescribed by different specialists. However, the fact remains that these medicinal products are in sufficiently common usage to also be prescribed by general practitioners.

45 Furthermore, since the applicant's tablets, like the intervener's eye drops, are to be taken by patients at home, the latter, as end users, are also part of the relevant public in the same way as pharmacists who sell those medicinal products in their pharmacies.

46 Both the professionals in the medical sector (specialist doctors, general practitioners and pharmacists) and patients, contrary to the finding of the Board of Appeal, therefore form part of the relevant public.

47 In relation to the comparison of products, it must be recalled that, in assessing the similarity of the goods or the services concerned, all the relevant factors relating to the goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (*Canon*, paragraph 23).

48 In the present case, as the applicant correctly points out, the products in question have the same nature (pharmaceutical products), purpose (treatment of human health problems), are directed at the same consumers (professionals in the health sector and patients) and use the same distribution channels (typically pharmacies).

49 However, as stated by OHIM and the intervener, these products are neither complementary nor in competition with each other. Having regard to the elements of similarity previously mentioned, this difference between the goods in question is not, however, such that it excludes, of itself, the possibility of a likelihood of confusion.

50 Furthermore, the intervener's argument that the products, being administered differently, are not similar must be rejected. That difference is of less significance in the present case than the fact that the products concerned have a common nature and purpose.

51 Accordingly, as the similarities between the goods outweigh the differences, it must be concluded that there exists, as correctly found by the Board of Appeal in the contested decision, some degree of similarity between the goods in question.

52 Concerning the comparison of the signs, it must be recalled and is settled case-law that the global assessment of the likelihood of confusion must, as far as it concerns the visual, aural or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, inter alia, their distinctive and dominant components (see the judgment in Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel*(BASS) [2003] ECR II-4335, paragraph 47, and the case-law cited therein).

53 Only the intervener considers that the signs ALREX and ARTEX are not similar. It emphasises in particular the fact that the ending 'ex' is extremely common for all sorts of marks, particularly in the pharmaceutical field.

54 However, as observed by the Opposition Division, the two signs are composed of a word containing five letters. The only difference is that one includes the letter 't' between the letters 'r' and 'e' and the other has an 'l' between the letters 'a' and 'r'. Aside from this difference, four of the five letters are identical and are placed in the same order: 'arex'. Therefore, the visual similarity between the signs is very high.

55 Also, at an aural level, the signs have the same structure, that is, two syllables each, the first comprising two letters and the second having three. Each sign begins with the letter 'a' and finishes with the suffix 'ex'. Further, the second and third letters of each sign are consonants, one of which is common (the letter 'r').

56 Finally, at the conceptual level, while OHIM maintained at the hearing that professionals would make the connection between the sign ARTEX and the French word 'artery', which the Opposition Division considered to be insufficient to discount the visual and aural similarities between the signs, it is appropriate to point out, firstly, that supposing this to be the case, professionals are not, as has been stated at paragraphs 45 and 46 above, the only relevant public and, secondly, that the public in the territories concerned, being the Benelux countries, Portugal and France, is not exclusively French-speaking.

57 In the circumstances it must be concluded, contrary to the finding in the con-

tested decision, that there exists a high degree of similarity between the two signs.

58 Therefore, having regard to, firstly, the high degree of similarity between the signs in question and, secondly, the degree of similarity between the goods concerned, the differences between them are not sufficient to remove a likelihood of confusion in the perception of the relevant public.

59 On the basis of the foregoing, the Court takes the view that there is a likelihood that that public will be led to believe that the goods designated by the signs at issue are from the same undertaking or from economically-linked undertakings.

60 Finally, the existence of that likelihood of confusion is reinforced by the fact that the relevant public only rarely has the chance to make a direct comparison between the different marks but must place its trust in the imperfect picture of them which it has kept in its mind (*Lloyd Schuhfabrik Meyer*, paragraph 26, and Case T-115/03 *Samar v OHIM – Grotto(GAS STATION)* [2004] ECR II-0000, paragraph 37).

61 Consequently, it must be held that there is a likelihood of confusion between the ALREX and ARTEX trade marks, within the meaning of Article 8(1)(b) of Regulation No 40/94.

62 It follows from all of the foregoing that the grounds on which the applicant seeks a declaration that the Board of Appeal infringed Article 8(1)(b) of Regulation No 40/94 must be upheld. Consequently, the contested decision must be annulled.

63 (...) Costs

#### OPERATIVE PART:

1. **Annuls the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 5 February 2003 (Case R 370/2002-3);**
2. **Orders OHIM to bear its own costs and to pay those incurred by the applicant;**
3. **Orders the intervener to bear its own costs.**

## CASE-LAW OF THE COURT OF FIRST INSTANCE OF THE EUROPEAN COMMUNITIES

### Judgment of the Court of First Instance

(Fourth Chamber)

of 24 November 2005

**in Case T-135/04 (application for annulment of the decision of the First Board of Appeal of OHIM of 4 February 2004 (Case R 327/2003-1), relating to opposition proceedings brought by the owner of a German figurative mark, composed of the word 'BUS' and a figure made up of three interlaced triangles, against the registration of the Community word mark Online Bus for services in Class 35): GfKAG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**

*(Community trade mark – Application for the Community word mark Online Bus – Earlier figurative trade mark composed of the word 'BUS' and a figure made up of three interlaced triangles – Genuine use of the earlier mark – Article 15(2)(a) and Article 43(2) and (3) of Regulation (EC) No 40/94 – Likelihood of confusion – Article 8(1)(b) of Regulation No 40/94)*

*(Language of the case: German)*

#### Background to the dispute

1 On 15 November 1999 the applicant submitted an application for a Community trade mark to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) 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 trade mark in respect of which registration was sought was the word mark Online Bus.

3 Registration was requested for services covered by Class 35 of the Nice Agreement on the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponding to the following description: 'drawing up statistics in the fields of economics, marketing, market research and market analysis, business consultancy, organisation consultancy, professional business consultancy, news agency services in the field of economics'.

4 The application was published in *Community Trade Marks Bulletin* No 57/2000 of 17 July 2000.

5 On 6 October 2000, BUS – Betreuungs- und Unternehmensberatungs GmbH brought opposition proceedings against the registration of the mark applied for in respect of all the services to which the trade mark application related. The company based its opposition on the likelihood of confusion with its German trade mark, registered on 12 September 1988 for, inter alia, 'business consultancy', covered by Class 35, and protecting the figurative sign reproduced below:



6 The applicant having requested that proof of the use of the earlier trade mark be submitted, pursuant to Article 43(2) and (3) of Regulation No 40/94, the other party to the proceedings before OHIM furnished proof of the use of the sign reproduced below:



7 By decision of 25 February 2003 the Opposition Division upheld the opposition.

8 On 29 April 2003, the applicant filed an appeal with OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94, against the Opposition Division's decision.

9 By decision of 4 February 2004 (Case R 327/2003-1), notified to the applicant on 13 February 2004 ('the contested decision'), the First Board of Appeal of OHIM rejected the appeal. It considered, first, that the figurative element made up of interlaced triangles and the word 'bus' were the two distinctive elements of the earlier trade mark. The use of the sign, which had been proven, had not undermined the distinctive character of the registered trade mark. Next, the Board of Appeal found that, although there was little similarity between the trade marks at issue at the visual level,

they were similar aurally, which, given the high degree of similarity between the services in question, provided proof of a likelihood of confusion on the part of the relevant German public.

### Forms of order sought

10 The applicant claims that the Court should:

- annul the contested decision;
- reject the opposition of the other party to the proceedings before OHIM;
- order OHIM to pay the costs.

11 OHIM contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

### The scope of the form of order sought by the applicant

12 As regards the first head of claim, the applicant restricted it, at the hearing, to a request for the annulment of the contested decision only so far as it concerns the services ‘market research and market analysis’ designated in its trade mark application.

13 This request must be interpreted as meaning that the applicant is merely seeking a partial annulment of the contested decision (see, to that effect, Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 14). Such a request is not, as such, contrary to the prohibition in Article 135(4) of the Rules of Procedure of the Court of First Instance on changing, before the Court, the subject-matter of the proceedings before the Board of Appeal (see, in support, the *Ovoid tablet* judgment, paragraph 15). The applicant must therefore be considered to have withdrawn its application to the extent that it requested the annulment of the contested decision in respect of services other than the services ‘market research and market analysis’.

### Admissibility

14 By its second head of claim, the applicant is essentially asking the Court to order OHIM to reject the opposition against the registration of its trade mark.

15 It is appropriate to recall in that regard that, under Article 63(6) of Regulation No 40/94, OHIM is required to take the measures necessary to comply with judgments of the Community Courts. Accordingly, it is not for the Court of First Instance to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part of the Court’s judgments (see the judgment of the Court of First Instance in Case T-164/03 *Am- pafrance v OHIM – Johnson & Johnson(monBeBé)* [2005] ECR I-0000, paragraph 24, and the case-law cited). The applicant’s second head of claim is therefore inadmissible.

### Merits

16 The applicant raises two pleas in support of its action. The first alleges an infringement of Article 15(2)(a) and Article 43(2) of Regulation No 40/94. The second is based on an infringement of Article 8(1)(b) of the same regulation.

*The first plea, alleging an infringement of Article 15(2)(a) and Article 43(2) of Regulation No 40/94*

#### Arguments of the parties

17 The applicant claims that, as the trade mark was not used in the form in which it had been registered, the opposition should be rejected on the basis of the second sentence of Article 43(2) of Regulation No 40/94.

18 The relevant provision for assessing the use, in a different form from that registered, of the German trade mark relied on in this instance is Paragraph 26(3) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German law on trade marks, BGB1. 1994 I, p. 3082 and BGB1. 1995 I, p. 156, ‘the Markengesetz’), transposing into German law Article 10(2) of the 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 applicant also cites a judgment of 13 April 2000 of the Bundesgerichtshof (Federal Court of Justice) (Germany) on the interpretation of the abovementioned provisions of the Markengesetz.

19 In this instance, the applicant submits that the distinctive elements of the sign used differ from those of the registered trade mark.

20 First, the sign used does not contain the words ‘Betreuungsverbund für Unternehmer und Selbständige e.V.’ The failure to include those words means that the public will not understand the meaning of the word ‘bus’, which is the acronym of the previous owner of the earlier mark.

21 Next, in the registered sign the word ‘bus’ is written in black lettering and situated under the figurative element made up of three interlaced triangles, while, in the sign used, it is in white lettering in a different font, written in black rectangles and placed to the left of the symbol in question. In that context, account should be taken of the fact that, since the earlier trade mark is a figurative mark, the typographical presentation of the word ‘bus’ is itself protected. Consequently, its owner does not have as much discretion to use it in a different form as, for example, in the case of a word mark.

22 Lastly, the colour of the figurative element made up of three interlaced triangles is different in the sign used and this sign also includes an extra figurative element, namely, a black square.

23 All these differences alter the distinctive character of the trade mark relied upon, so that the public would not associate it with the sign used.

24 OHIM points out that Regulation No 40/94 does not contain any express provisions on the use, in a different form from that registered, of a national mark cited in support of the opposition. However, Article 10(2)(a) of Directive 89/104 includes a harmonised provision, similar to Article 15(2)(a) of Regulation No 40/94. Thus, it is necessary to apply that harmonised provision, in accordance with Article 15(2)(a) of Regulation No 40/94 or the corresponding provision of Directive 89/104. Use of national legislation is precluded, as the Community trade mark regime is an autonomous system.

25 The distinctive character of the earlier trade mark relied on in this instance is not altered at all in the form in which it is used. The removal of the element ‘Betreuungsverbund für Unternehmer und Selbständige e.V.’ is insignificant, because this element is not only of secondary importance at the visual level, but also constitutes a descriptive reference. The represen-

tation of the word ‘bus’ and the figurative element made up of three interlaced triangles in negative form is acceptable as a current variation of the form registered, which has no effect on its distinctive character. The addition of a black square is insignificant, since it is a basic geometrical figure.

26 Finally, taking account of the objective of Article 15(2)(a) of Regulation No 40/94, a margin of flexibility should be available to the owner of a trade mark when using it, in order to adapt the representation of the protected sign to the norms of advertising graphics and the style of the period.

#### *Findings of the Court*

27 Under Article 43(2) of Regulation No 40/94:

‘If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community ... In the absence of proof to this effect, the opposition shall be rejected.’

28 Article 43(3) of the same regulation makes that provision applicable to earlier national marks, substituting use in the Member State where the earlier national mark is protected for use in the Community.

29 Pursuant to Article 15(2)(a) of Regulation No 40/94, use of the Community trade mark includes ‘use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered’.

30 In this instance, given that the trade mark invoked in support of the opposition is a national trade mark, the subject of the first plea must first be clarified: in reality the applicant alleges that the Board of Appeal infringed the combined provisions of Article 43(2) and (3) of Regulation No 40/94.

31 Next, it must be stated that, by virtue of the combined application of Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94, proof of genuine use of an earlier national or Community trade mark on which opposition proceedings against an application for a Community trade mark

are based also includes proof of use of the earlier mark in a form that differs in respect of elements which do not alter the distinctive character of that trade mark in the form registered (see, to this effect, the judgment of the Court of First Instance in Case T-156/01 *Laboratorios RTB v OHIM – Giorgio Beverly Hills(GIORGIO AIRE)* [2003] ECR II-2789, paragraph 44).

32 Consequently, the reference made by the applicant to national law is not relevant.

33 Having regard to those considerations, it is appropriate to consider whether the form used of the earlier trade mark contains differences which alter its distinctive character.

34 Firstly, the two forms of the earlier mark, namely, that registered and that used, include the word ‘bus’ and a figurative element made up of three interlaced triangles, whose distinctive character is not disputed by the parties.

35 As regards the different presentation of those elements in the form used, neither the typography of the word ‘bus’ nor the colours of the earlier trade mark, black and white, are particularly original or unusual in either of the two forms of the earlier trade mark. The variation of them is thus not such as to affect the distinctive character of that trade mark.

36 Secondly, so far as concerns the reference ‘Betreuungsverbund für Unternehmer und Selbständige e.V.’, it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see, to that effect, Case T-6/01 *Matratzen Concord v OHIM–HuklaGermany(MATRATZEN)* [2002] ECR II-4335, paragraphs 33 to 35).

37 In the present case, the reference in question is a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive.

38 That conclusion is not called into question by the applicant’s argument that the removal of the element in question renders meaningless the word ‘bus’, which constitutes the acronym of the former owner of the earlier mark. The parties agree that the word ‘bus’ has an intrinsic distinctive character. Even assuming that the relevant public were to notice that it may also constitute an acronym, its distinctive character is not affected by the removal of the explicative element.

39 Nor is that conclusion weakened by the argument, advanced by the applicant at the hearing, that the words at issue refer to the former owner of the sign and, thus, individualise the earlier trade mark. Even if it is conceded that the words refer to the name of the trade mark’s former owner, that fact would have no effect on the assessment of that element’s descriptive content and of its place in the visual presentation of the sign, which, here, support the conclusion that the element lacks distinctive character.

40 Concerning, lastly, the black square in the form used, which is absent in the registered form, it is a basic geometrical figure and, for that reason, has no distinctive character. That conclusion is not influenced by its position in the form used.

41 It follows from the foregoing that the form used of the earlier trade mark used does not contain any differences such as to alter the distinctive character of that trade mark for the purpose of the combined provisions of Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94. The Board of Appeal was, therefore, fully entitled to hold that use of the opponent’s trade mark had been proven.

42 Consequently, the first plea must be rejected.

*The second plea, based on an infringement of Article 8(1)(b) of Regulation No 40/94*

#### *Arguments of the parties*

43 The applicant submits that the Board of Appeal was wrong in considering the earlier trade mark to be dominated by the word ‘bus’, common to both signs, and the signs at issue to be similar.

44 Firstly, the earlier trade mark contains other distinctive elements which charac-

terise the overall impression it creates. In particular, the earlier trade mark's figurative element depicts an elaborate graphical shape, with a strong distinctive character. In some cases, only the figurative element of the earlier trade mark is used by the other party to the proceedings before OHIM. It is thus at least as important as the word 'bus'. The element 'Betreuungsverbund für Unternehmer und Selbständige e.V.' is important since it explains the meaning of the acronym 'bus'.

45 Secondly, the word 'bus', by itself, is not capable of characterising the earlier trade mark because of its weak distinctive character, having regard to the services concerned. A number of trade marks containing the word 'bus' are registered in class 35 and, on the internet, the word 'bus' is very often used with the term 'marketing'.

46 Thus, the signs at issue are not similar. At the visual level, the earlier trade mark is characterised by the figurative element, which is missing in the trade mark applied for. At the aural level, the word mark applied for, 'Online Bus', is considerably longer and, therefore, different from the word 'bus' in the earlier trade mark. Furthermore, as the word 'online' is situated at the beginning of the word sign, it should be accorded more importance at the aural level. As regards the conceptual point of view, the word 'bus' in the earlier trade mark suggests a means of public transport, while the sign Online Bus refers to the field of computing. Thus, the concepts of the signs at issue are also different.

47 OHIM contends, citing the judgment in *MATRATZEN* (paragraphs 33 and 34), that the overall impression created by a complex trade mark may be dominated by a single element. The similarity of the signs at issue follows from the concordance of the dominant element.

48 As regards the aural comparison of the signs at issue, the Board of Appeal rightly conceded that they were highly similar, the word 'bus' being dominant in each of them.

49 The applicant's argument designed to demonstrate the weak distinctive character of the word 'bus' was submitted for the

first time before the Board of Appeal and is out of time for the purpose of Article 74(2) of Regulation No 40/94.

50 Moreover, it was not substantiated in the application. The list of registered trade marks containing the word 'bus' does not constitute appropriate evidence, since the weakening of distinctive character can only be a consequence of trade marks that have been used. The internet search as to the combined use of the terms 'bus' and 'marketing' does not furnish such proof. First, only a small part of the services at issue relate to marketing. Secondly, it does not show whether the word 'bus' is used on the internet as a means of distinguishing the services at issue. Lastly, the search includes the bus transport sector, with which this case is not concerned, and it is not limited to Germany, which constitutes the relevant territory.

51 The signs at issue are also similar at the visual and conceptual levels.

52 Concerning the visual comparison, the earlier trade mark is not characterised visually by its figurative element. Generally, the public refer to the words in complex trade marks. In the present case, the value that may be attached to the figurative element is at best comparable to that of the dominant verbal element 'bus'.

53 Concerning the conceptual comparison, the term 'bus' constitutes, in both signs, a current abbreviation in Germany for *Autobus* or *Omnibus*. In this respect, by analogy with the judgments of the Court of First Instance in Cases T-186/02 *BMI Bertollo v OHIM – Diesel(DIESELIT)* [2004] ECR II-0000, paragraph 58, and T-115/03 *Samar v OHIM –Grotto(GAS STATION)* [2004] ECR II-0000, paragraph 36, there is a conceptual similarity between the signs at issue.

#### *Findings of the Court*

54 Under Article 8(1)(b) of Regulation No 40/94, the trade mark applied for shall not be registered if, because of its identity or similarity to an earlier trade mark and the identity or similarity of the goods or

services covered by the earlier trade mark and the trade mark applied for, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

55 According to settled case-law, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the signs and the goods or services in question and taking into account all factors relevant to the circumstances of the case, in particular, the interdependence between the similarity of the signs and the similarity of the goods or services designated (see the judgment of the Court of First Instance in Case T-162/01 *Laboratorios RTB v OHIM –Giorgio Beverly Hills(GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraph 33, and the case-law cited).

56 In the present case, the parties dispute neither the definition of the relevant public used by the Board of Appeal nor the finding of a high degree of similarity between the services in question (paragraphs 25 and 26 of the contested decision). On the other hand, the applicant claims that the trade marks at issue are not similar and that there is no likelihood of confusion between them. The examination of the present plea must therefore be limited to those two aspects.

57 According to settled case-law, the global assessment of a likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, concerning the interpretation of Directive 89/104, the judgments of the Court of Justice in Cases C-251/95 *SABEL* [1997] ECR I-6191, paragraphs 22 and 23, and C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

58 In the case in point, it should be pointed out that one of the components of the signs at issue, namely the word 'bus', is identical.

59 It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other compo-

nents are insignificant (*MATRATZEN*, paragraph 33).

60 The Board of Appeal considered (paragraph 22 of the contested decision) that the word 'bus' constituted the dominant element of the trade mark applied for and one of the dominant elements of the earlier trade mark.

61 The applicant contends that the word 'bus' is not very distinctive in relation to the services in question and therefore does not, by itself, characterise the signs at issue.

62 It relies, firstly, on the submission presented for the first time at the hearing, that the term 'bus' refers to a type of survey used when carrying out market research.

63 However, that submission of fact, which had not previously been raised before any of the bodies of OHIM, may not be taken into account by the Court of First Instance. It follows from Article 74(1), in fine, of Regulation No 40/94, under which, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought, that it is not required, of its own motion, to take into consideration facts which were not put forward by the parties (judgment in Case T-296/02 *Lidl Stiftung v OHIM – REWE-Zentral(LINDENHOF)* [2005] ECR I-0000, paragraph 31). It follows that no contention of illegality on the part of OHIM may be made regarding matters of fact which were not submitted to it.

64 Secondly, the applicant quotes the results of searches carried out on the internet as well as on the Cedexlex trade marks database. OHIM contends that that evidence, presented for the first time before the Board of Appeal, was submitted out of time.

65 According to the case-law, the Boards of Appeal may, subject only to Article 74(2) of Regulation No 40/94, allow the appeal on the basis of new facts relied on by the party who has brought the appeal or on the basis of new evidence adduced by that party (judgment in Case T-308/01 *Henkel v OHIM –LHS(UK) (KLEEN-CARE)* [2003] ECR II-3253, paragraph 26). Therefore, the evidence in question is admissible.

66 However, the searches submitted by the applicant are not sufficient to establish

that the distinctive character of the term 'bus' has been weakened with regard to the services concerned.

67 As regards the list of results obtained using the Google search engine, showing that the term 'bus' is very often found on the internet next to the term 'marketing', such a search, defined by very general criteria, is not enough to prove that there is an association between those two terms on the part of the relevant public. In fact, it contains no information as to the use of the term 'bus' in the relevant territory to allow the services at issue to be distinguished.

68 As regards the search of the Cedexlex database, the mere fact that a number of trade marks relating to Class 35 contain the word 'bus' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word 'bus' is used descriptively by public transport businesses.

69 The other words in the earlier trade mark, 'Betreuungsverbund für Unternehmer und Selbständige e.V.', have no distinctive character and are therefore insignificant in the overall impression produced by that trade mark (see paragraphs 37 to 39 above).

70 The word 'online' in the trade mark applied for cannot be regarded as the distinctive element. It is, in fact, a well-known term, associated with internet communication. To the extent that that form of communication may be used for the provision of the services in question, the term is descriptive. According to settled case-law, the public will not, generally, consider a descriptive element forming part of a complex mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM–Naulover(NLSPORT, NL-JEANS, NLACTIONE and NLCollection)* [2004] ECR I-0000, paragraph 34, and the case-law cited).

71 It follows from the foregoing that the Board of Appeal was able to lawfully find

that the word 'bus' constituted the dominant verbal element in each of the two signs at issue.

72 The signs at issue should be compared in the light of those considerations.

73 Concerning the visual comparison, it should be noted that the Board of Appeal considered, in paragraph 20 of the contested decision, that the earlier mark was characterised by the verbal element 'bus' as well as by its figurative element made up of three interlaced triangles. That assessment is not inconsistent with the applicant's argument that the figurative element of the earlier mark is at least as distinctive as the word 'bus'.

74 Although there is a visual difference between the signs at issue, which must be taken into account during the global assessment of the likelihood of confusion, this difference does not affect the fact that there is a visual similarity created by the identical word 'bus', which constitutes the dominant element of the trade mark applied for and, at the visual level, one of the dominant elements of the earlier trade mark.

75 Concerning the aural comparison, it must be concluded, taking account of the one identical dominant word in the signs at issue ('bus'), that they possess a high degree of aural similarity.

76 Concerning the conceptual comparison, the Board of Appeal correctly took the view that a conceptual comparison of the signs at issue was not possible.

77 Although the applicant maintains that the sign Online Bus refers to the field of computing, that reference is linked to the word 'online' in the trade mark applied for. As that word has no distinctive character within the trade mark applied for, it cannot determine its underlying concept.

78 The Court cannot uphold the applicant's argument that the earlier mark refers to the concept of an autobus, and there is no need to take a view on OHIM's argument that a like reference characterises both signs. It is common ground that the services concerned have no link whatsoever with public transport. Even if it is indeed the case that the conceptual analysis of a sign is not invalidated by the fact that the meaning of that sign bears no relation to

the services concerned, the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the circumstances, in view of the nature of the services in question, the relevant public will not spontaneously associate the word ‘bus’ with a means of public transport.

79 Finally, as regards the global assessment of the signs at issue, it is possible that the mere aural similarity between two trade marks may create a likelihood of confusion (*Lloyd Schuhfabrik Meyer*, paragraph 28, and Case T-99/01 *Mystery Drinks v OHIM –Karlsberg Brauerei(MYSTERY)* [2003] ECR II-43, paragraph 42).

80 In the light of all the preceding considerations and, in particular, of the high degree of similarity between the services in question and the high degree of aural similarity between the trade marks at issue, the mere visual difference between those trade marks created by the presence of the figurative element in the earlier mark is not such as to preclude a likelihood of confusion in the present case. The relevant consumer, faced by the trade marks in question, will remember only the word ‘bus’, which is present in both trade marks and dominates their pronunciation. Therefore, the Board of Appeal correctly concluded that there was a likelihood of confusion between the trade marks at issue.

81 As a result, the second plea cannot be upheld.

82 Accordingly, the application must be rejected in its entirety.

83 (...) **Costs**

**OPERATIVE PART:**

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