JUDGMENT OF THE GENERAL COURT (sixth chamber, extended composition)

17 March 2010 *

In Case T-63/07,

Mäurer + Wirtz GmbH & Co. KG, established in Stolberg (Germany), represented by D. Eickemeier, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Botis, acting as Agent,

defendant,

* Language of the case: English.

the other party to the proceedings before the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) being

Exportaciones Aceiteras Fedeoliva, AIE, established in Jaén (Spain),

ACTION brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 18 December 2006 (Case R 761/2006-2), concerning opposition proceedings between Mülhens GmbH & Co. KG and Exportaciones Aceiteras Fedeoliva, AIE,

THE GENERAL COURT (Sixth Chamber, Extended Composition),

composed of A.W.H. Meij (Rapporteur), President, V. Vadapalas, I. Labucka, N. Wahl and L. Truchot, Judges,

Registrar: N. Rosner, Administrator,

having regard to the application lodged at the Registry of the Court on 1 March 2007,

having regard to the response lodged at the Court Registry on 20 June 2007,

having regard to the order of 30 March 2009 authorising the replacement of Mülhens GmbH & Co. KG by Mäurer + Wirtz GmbH & Co. KG,

having regard to the designation of I. Labucka as judge to complete the Chamber as Judge T. Tchipev was prevented from attending,

further to the hearing on 11 June 2009,

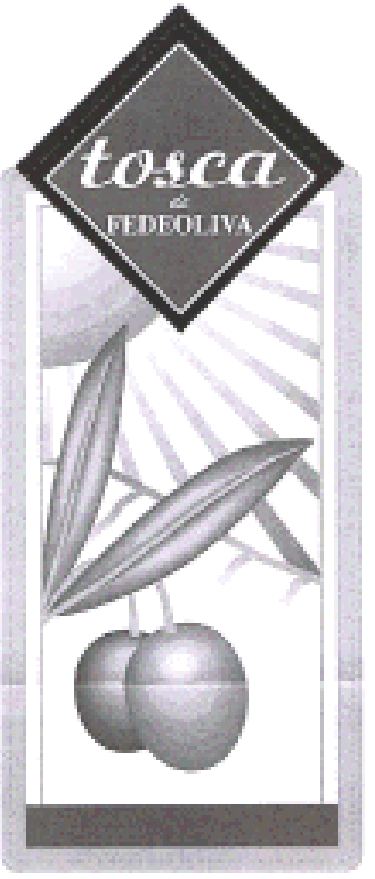
gives the following

Judgment

Background to the dispute

1 On 29 October 2003, Exportaciones Aceiteras Fedeoliva, AIE 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 (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The application was for registration of the following figurative mark:



3 The goods and services for which registration was sought are in Classes 16, 29, 35 and 39 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 16: 'Paper, cardboard and goods made from these materials, not in other classes; printing materials; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' material; paint brushes; typewriters and office requisites (except furniture); instruction and teaching material (except apparatus); plastic materials for packing (not included in other classes); printing types; printing blocks;

— Class 29: 'Edible oils, in particular olive oil';

— Class 35: 'Advertising, business management, business administration, import and export, business management assistance in relation to franchising; retailing and retailing via global computer networks, promotion and representation services for goods';

— Class 39: 'Transportation; packaging and storage of goods; arranging travel'.

4 The application for the trade mark was published in *Community Trade Marks Bulletin* No 41/2004 of 11 October 2004.

5 On 7 January 2005, Mülhens GmbH & Co. KG filed a notice of opposition to the registration of that trade mark, on the basis of Article 8(1)(b) and Article 8(5) of Regulation No 40/94 (now Article 8(1)(b) and Article 8(5) of Regulation No 207/2009).

6 In support of its opposition, Mülhens referred to the registration of the following earlier trade marks:

— Community word mark No 90 852 TOSCA, registered on 16 February 2001, for 'perfumeries, essential oils, cosmetics, dentifrices, toilet soaps;

— German word mark No 102 194 TOSCA, registered on 26 October 1907, for "household and toilette soaps in solid and powder form, perfumeries, eau de cologne, lanolin, cosmetic pomades, make-up products, powders, hair oils, hair lotions, scalp lotions, utensils for the care of teeth and mouth, for the care of skin and beard, hair colouring preparations, perfumed sachets, brushes for teeth and finger nails, bath salts';

— German word mark No 258 495 TOSCA, registered on 10 January 1921, for 'cosmetic preparations, especially scented preparations';

— German word mark No 301 590 TOSCA, registered on 7 May 1923, for 'household and toilette soaps in solid and powder form, perfumeries, eau de cologne, lanolin, cosmetic pomades, make-up products, powders, hair oils, hair lotions, scalp lotions, utensils for the care of teeth and mouth, for the care of skin and

beard, hair colouring preparations, perfumed sachets, brushes for teeth and finger nails, bath salts';

— German word mark No 1 048 297 TOSCA, registered on 13 May 1983, for 'perfumery, essential oils, non-medicated toilet preparations and cosmetics, soaps, dentifrices, hair lotions, chemical preparations for health care, disinfectants';

— the well-known trade mark TOSCA, used in Germany for 'perfume, eau de toilette, eau de cologne, body lotion, toilette soaps, shower gel, deodorants, talcum powder'.

7 The opposition was based in particular on 'perfume, eau de toilette, eau de cologne, body lotion, toilette soaps, shower gel, deodorants and talcum powder', goods in respect of which, according to Mülhens, the earlier trade marks had established a reputation, and was directed at all the goods and services covered by the trade mark application.

8 On 10 April 2006, the Opposition Division rejected the opposition in its entirety on the grounds, first, that the goods and services covered by the conflicting marks were clearly dissimilar, which precluded any likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 and, second, that the applicant had failed to submit facts, evidence or arguments capable of showing that use of the mark applied for would be detrimental to the applicant, or would take unfair advantage of the distinctive character or the repute of the earlier trade marks, within the meaning of Article 8(5) of Regulation No 40/94.

9 On 31 May 2006, Mülhens appealed to OHIM against the decision of the Opposition Division.

10 By decision of 18 December 2006 ('the contested decision'), the Board of Appeal dismissed the appeal. First, it confirmed the Opposition Division's finding that the goods and services covered by the marks at issue were different and, therefore, that there was no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. Second, the Board of Appeal rejected the opposition in so far as it was based on Article 8(5) of Regulation No 40/94, on the ground that Mülhens had confined itself to submitting arguments and evidence to show that the earlier TOSCA marks had acquired a reputation in Germany, but had not submitted evidence or arguments to show that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks. Moreover, the Board of Appeal rejected Mülhens argument that there was a risk of dilution by blurring of the distinctive character of the earlier trade marks, since that argument was put forward for the first time during the proceedings before it.

Forms of order sought by the parties

11 The applicant claims that the Court should:

— annul the contested decision;

— reject the application for registration of the Community trade mark;

— order OHIM to pay the costs.

12 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Admissibility of the second head of claim

13 By its second head of claim, the applicant requests the Court to reject the application for registration of the Community trade mark.

14 In that regard, since that head of claim by the applicant must be interpreted as seeking, essentially, an order that OHIM reject the application for registration of the Community trade mark, it must be pointed out that, under Article 63(6) of Regulation No 40/94 (now Article 65(6) of Regulation No 207/2009), OHIM is required to take the necessary measures to comply with a judgment of the Courts of the European Union. Accordingly, it is not for the General Court to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part and grounds of the Court's judgments (Case T-164/03 *Ampafrance* v *OHIM - Johnson and Johnson (mon-Bebé)* [2005] ECR II-1401, paragraph 24 and the case-law cited).

15 The second head of claim must therefore be declared inadmissible.

Substance

16 The applicant relies, essentially, on three pleas in law alleging, first, an infringement of Article 43(1), Article 73 and Article 74(1) and (2) of Regulation No 40/94 (now, respectively, Article 42(1), Article 75 and Article 76(1) and (2) of Regulation No 207/2009), second, an infringement of Article 8(5) of Regulation No 40/94 and, third, an infringement of Article 8(1)(b) of Regulation No 40/94.

17 The Court considers that the third plea in law should be examined first.

The third plea in law, alleging an infringement of Article 8(1)(b) of Regulation No 40/94

— Arguments of the parties

18 The applicant submits that the goods and services covered by the trade marks at issue are to some extent similar, in so far as, (i) olive oil is often used for cosmetic purposes in shower gels and shampoos in Class 29 and, (ii) the packaging of those goods bears the sign covered by the earlier trade marks, so that similarity with 'packaging and storage of goods' in Class 39 must be noted.

19 The applicant also submits that there is a likelihood of confusion and considers that the average consumer would be likely to assume that the goods designated in the trade mark application came from the same undertaking as the applicant's goods.

20 OHIM contests the applicant's arguments.

— Findings of the Court

21 As pointed out by the Board of Appeal in paragraph 16 of the contested decision, the applicant submitted no arguments whatsoever, in the appeal before it, to dispute the decision of the Opposition Division insofar as it rejected the opposition based on Article 8(1)(b) of Regulation No 40/94.

22 Under Article 74(1) of Regulation No 40/94, in proceedings relating to relative grounds for refusal of registration, the examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought. It follows that, in relation to a relative ground for refusal of registration, elements of law and of fact which are pleaded before the Court without having previously been raised before the Board of Appeal cannot affect the legality of a decision of that Board (Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 54, and Case T-169/02 *Cervecería Modelo* v *OHIM - Modelo Continente Hipermercados (NEGRA MODELO)* [2005] ECR II-505, paragraph 22).

23 It follows that, in the review of the legality of decisions of OHIM's Boards of Appeal for which the Court has jurisdiction under Article 63 of Regulation No 40/94, elements of fact and of law which are pleaded before the Court without having previously been raised before the departments of OHIM cannot be examined for the purpose of assessing the legality of the decision of the Board of Appeal and must therefore be declared inadmissible (*NEGRA MODELO*, paragraphs 22 and 23).

24 Since the applicant put forward no arguments whatsoever, in support of its appeal before the Board of Appeal, to dispute the merits of the Opposition's Division decision on the application of Article 8(1)(b) of Regulation No 40/94, the third plea in law must be rejected as inadmissible.

The first plea in law, alleging infringement of Article 43(1), Article 73 and Article 74(1) and (2) of Regulation No 40/94

— Arguments of the parties

25 The applicant submits that the Board of Appeal was wrong to find inadmissible – inasmuch as it introduced a new element of fact – its argument that there was a likelihood of dilution by blurring of the distinctive character of the earlier trade marks. It submits that that argument merely concerns one aspect of determining whether the trade mark applied for would be detrimental to the distinctive character and the repute of the earlier trade marks and that, consequently, it was made within the period fixed by OHIM. Furthermore, the applicant takes the view that there is no prohibition on introducing new arguments after the expiry of the period provided for in Article 42(3) of Regulation No 40/94 (now Article 41(3) of Regulation No 207/2009) and Rule 19 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), and that, in the present case, the Board of Appeal failed to exercise the discretion conferred on it by Article 74(2) of Regulation No 40/94.

26 In addition, the applicant submits that by not informing it that it was not going to take into consideration the new argument submitted for the first time before it, the Board of Appeal infringed Article 43(1) of Regulation No 40/94, in so far as it did not invite the parties, as often as necessary, to file observations. It also infringed Article 73 of

Regulation No 40/94 by basing its decision on reasons or evidence on which the applicant had not been heard.

27 OHIM maintains, first, that the first plea in law is redundant to the extent that, even if the Board of Appeal had examined the argument that there was a risk of dilution by blurring of the distinctive character, the outcome of the case would have been the same, given that the applicant had provided no evidence to support its claim.

28 Second, OHIM contends that, since that new argument is manifestly insufficient to justify application of Article 8(5) of Regulation No 40/94 and, therefore, to affect the outcome of the case, one of the conditions laid down in *OHIM* v *Kaul* for taking into account evidence filed late is not fulfilled. Furthermore, the applicant intentionally employed delaying tactics, or was at least extremely negligent, when it failed to submit to the Opposition Division an argument so crucial that the ground of refusal relied on cannot be discussed effectively without it. OHIM contends in this respect that the applicant does not explain why it failed to submit that argument to the Opposition Division.

— Findings of the Court

29 It should be recalled that, in paragraph 31 of the contested decision, the Board of Appeal found that the applicant had ticked box 95 of the notice of opposition, indicating that the opposition brought against the registration of the mark applied for was based on the contention that the mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark and, therefore, that the opposition was based on Article 8(5) of Regulation No 40/94.

30 In paragraph 35 of the contested decision, the Board of Appeal also found that, within the period prescribed in Article 42(3) of Regulation No 40/94 for substantiating its opposition, the applicant had filed arguments and evidence before the Opposition Division to prove the reputation in Germany of its earlier word marks TOSCA, but had not provided any evidence or arguments showing that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks.

31 It must also be pointed out that, as is apparent from paragraph 37 of the contested decision, the applicant, during the proceedings before the Board of Appeal, argued that use of the mark applied for would lead to an erosion of the earlier marks 'reputation, since the public would no longer associate the applicant's products with the mark TOSCA. However, in paragraph 38 of the contested decision, the Board of Appeal classified that claim as a 'new fact, the admissibility of which it rejected under Article 74(2) of Regulation No 40/94, on the grounds that it had been submitted after the period specified by the Opposition Division and that the applicant had not claimed that there were new factors or some factual or legal difficulty that made it impossible for it to submit that argument during the opposition proceedings (paragraph 41 and paragraphs 43 to 45 of the contested decision).

32 Contrary to the Board of Appeal, the Court considers, however, that that argument only expresses, in proceedings before the Board of Appeal, a matter already raised when the notice of opposition was filed. By ticking box 95 of the notice of opposition, the applicant indicated that its opposition was based on the contention that the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks.

33 Thus, the argument put forward in the proceedings before the Board of Appeal explains at most the nature of the harm caused to the earlier marks – identified by the applicant as erosion of their reputation – and provides brief reasons for that argument, in the form of the claim that 'the public would no longer associate [its] products … with the mark TOSCA'.

34 It should be recalled, in that regard, that the criteria for applying a relative ground for refusal or any other provision relied on in support of arguments put forward by the parties are naturally part of the matters of law submitted for examination by OHIM (Case T-57/03 *SPAG* v *OHIM - Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 21, and Case T-53/05 *Calavo Growers* v *OHIM - Calvo Sanz (Calvo)* [2007] ECR II-37, paragraph 59). The applicant's argument states only that the conditions laid down in Article 8(5) of Regulation No 40/94 are met in the present case and explains briefly why that is the case, namely because the public would no longer associate its goods with the earlier marks covering those goods.

35 In the light of the grounds of opposition put forward by the applicant before the Opposition Division, the Court considers that that argument merely clarifies the nature of the alleged likelihood of harm and provides reasons in that regard, and does not add a new fact or evidence for the purposes of Article 74(2) of Regulation No 40/94.

36 Thus, the Board of Appeal made an error of law by classifying that argument – which seeks to clarify the nature and origin of the harm which opposition to registration of the mark applied for aims to prevent pursuant to Article 8(5) of Regulation No 40/94 – as a new fact for the purposes of Article 74(2) of Regulation No 40/94, and by rejecting it as inadmissible. The applicant's argument should have been taken into account by the Board of Appeal under Article 74(1) of that regulation.

37 OHIM submits, in the alternative, that the applicant's argument is in any case manifestly insufficient to allow an opposition to be upheld under Article 8(5) of Regulation No 40/94, since it had not submitted any evidence to support it.

38 In that regard, it must be held that there was no assessment in the contested decision of the question whether the applicant's argument was in any case manifestly insufficient to justify the application of Article 8(5) of Regulation No 40/94.

39 It should be noted that the extent to which the opposing party who intends to rely on the relative ground for refusal referred to in Article 8(5) of Regulation No 40/94 must plead and prove that the mark applied for gives rise to a future, non-hypothetical risk of detriment to the earlier marks, or of unfair advantage being taken of them, varies depending on whether the mark applied for appears capable, at first sight, of giving rise to one of the risks referred to in that provision.

40 It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla* v *OHIM - Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).

41 In the present case, taking into account, inter alia, the evidence submitted regarding the reputation of the earlier marks, it was thus for the Board of Appeal to assess whether the clarification by the applicant of the type of risk posed to those marks by registration of the mark applied for – namely, in the applicant's view, the erosion of their reputation – and the reasoning put forward in that regard – namely, the contention that the public would no longer associate its goods with the earlier marks which covered those goods – were sufficient to allow the opposition to be upheld pursuant to Article 8(5) of Regulation No 40/94.

42 However, as has already been stated, it is apparent from the contested decision that the Board of Appeal did not assess that issue at all, since it simply rejected the applicant's argument as inadmissible.

43 In those circumstances, it must be held that OHIM's contention that the applicant's argument was in any case manifestly insufficient to justify the application of Article 8(5) of Regulation No 40/94, because the applicant had not submitted any evidence to substantiate its claim, cannot be taken into consideration by the Court when assessing the legality of the contested decision.

44 In the context of an application for annulment, the Court reviews the legality of the decisions of the Boards of Appeal. If such a decision is contested in an action before it and held to be unlawful, the Court is obliged to annul it; it may not dismiss the action with the substitution of its own reasoning for that of the Board of Appeal which adopted the contested act.

45 Having regard to the foregoing, it must be held that, by rejecting as inadmissible in the proceedings before it the applicant's argument that the registration of the mark applied for would cause the reputation of the earlier marks to be eroded on account of the fact that the public would no longer associate them with the products which they covered, the Board of Appeal misinterpreted Article 74(1) of Regulation No 40/94.

46 Consequently, the applicant's first plea in law must be upheld and the contested decision annulled, in so far as the Board of Appeal rejected the opposition based on Article 8(5) of Regulation No 40/94, and it is not necessary to examine whether the second plea is well founded.

Costs

47 Under Article 87(3) of the Rules of Procedure of the Court, where each party succeeds on some and fails on other heads, the Court may order that the costs be shared or that each party bear its own costs. Since OHIM and the applicant have each been partly unsuccessful, they should be ordered to bear their own costs.

On those grounds,

THE GENERAL COURT (Sixth Chamber, Extended Composition)

hereby:

1. **Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 18 December 2006 (Case R-761/2006-2), to the extent that it rejects the opposition brought on the basis of Article 8(5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (now Article 8(5) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark);**

2. **Dismisses the action as to the remainder;**

3. Orders Mäurer + Wirtz GmbH & Co. KG and the Office for Harmonisation in the Internal Market (Trade Marks and Designs) each to bear its own costs.

Meij Vadapalas Labucka

Wahl Truchot

Delivered in open court in Luxembourg on 17 March 2010.

[Signatures]