JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

22 January 2009 *

In Case T-316/07,

Commercy AG, established in Weimar (Germany), represented initially by F. Jaschke, and subsequently by S. Grosse and I. Müller, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by S. Schäffner, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

* Language of the case: German.

easyGroup IP Licensing Ltd, established in London (United Kingdom), represented by T. Koerl and S. Möbus, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 19 June 2007 (Case R 1295/2006-2), concerning invalidity proceedings between Commercy AG and easyGroup IP Licensing Ltd,

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

composed of M. Vilaras (Rapporteur), President, M. Prek and V. Ciucă, Judges,

Registrar: C. Kantza, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 20 August 2007,

having regard to the response of OHIM lodged at the Court Registry on 7 January 2008,

having regard to the response of the intervener lodged at the Court Registry on 21 December 2007,

having regard to the application for legal aid lodged by the applicant on 18 September 2008,

further to the hearing on 18 September 2008,

having regard to the written observations on the applicant's application for legal aid lodged by OHIM and the intervener on 2 October 2008,

having regard to the decision of the President of 9 October 2008 to close the oral procedure,

gives the following

Judgment

Factual background

1 On 21 September 2000, the intervener, easyGroup IP Licensing Ltd, filed an application for registration of a Community trade mark with the Office for Harmonization 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 mark for which registration was sought is the word sign easyHotel.

3 The goods and services for which the mark was sought belong to Classes 9, 16, 25, 32, 33, 35, 36, 38, 39, 41 and 42 of the Nice Agreement of 15 June 1957 concerning the international classification of goods and services for the purposes of the registration of marks, as revised and amended.

4 On 30 June 2004, the Community trade mark was registered under number 1 866 706 for all the goods and services covered by the application for registration.

5 On 11 February 2005, the applicant, Commercy AG, filed an application pursuant to Article 55 of Regulation No 40/94 for a declaration that the trade mark at issue was invalid. The grounds cited were those provided for in Article 52(1)(a) of that regulation in conjunction with Article 8(1) thereof.

6 The application for a declaration of invalidity was based on the earlier national word mark EASYHOTEL, registered in Germany for various goods and services, particularly in Classes 9 and 42, for each Class described as follows:

— Class 9: 'Computer software for the production of platform-independent internet shops and internet authoring systems chiefly for the reservation, booking and payment of accommodation';

— Class 42: 'Development and design of computer software, namely for internet shops and internet authoring systems, especially for the reservation, booking and payment of accommodation'.

7 The application for a declaration of invalidity was directed against all the goods and services covered by the mark at issue.

8 On 12 February 2005, the intervener, pursuant to Article 49 of Regulation No 40/94, surrendered the trade mark at issue in respect of all the goods and services in Classes 9 and 38, as well as some of the services in Class 42, for which the mark had been registered. That surrender was registered by OHIM on 28 June 2005.

9 The services in Classes 39 and 42 covered by the mark at issue following that surrender include, in particular, those that are, for Classes 39 and 42, described as follows:

— Class 39: 'Information services relating to transportation services, including information services provided on-line from a computer database or the internet; travel reservation and travel booking services provided by means of the world wide web';

— Class 42: 'Computerised hotel reservation services'.

10 By decision of 31 July 2006, the Cancellation Division rejected the application for invalidity on the ground that one of the necessary conditions for the application of Article 8(1)(b) of Regulation No 40/94 was not fulfilled, namely the identical nature or similarity of the goods and services covered by the two marks.

11 On 29 September 2006, the applicant filed a notice of appeal under Articles 57 to 62 of Regulation No 40/94 against the decision of the Cancellation Division in so far as it had rejected the application for a declaration of invalidity of the mark at issue for the services in Classes 39 and 42, on the ground that the goods and services in Classes 9 and 42 covered by the earlier trade mark and set out in paragraph 6 above are similar to the services in Classes 39 and 42 covered by the mark at issue and set out in paragraph 9 above.

12 By decision of 19 June 2007 ('the contested decision'), which was notified to the applicant on the following day, the Second Board of Appeal dismissed the applicant's appeal and upheld the decision of the Cancellation Division.

13 In essence, the Board of Appeal found that the goods and services concerned were neither identical nor similar and that, consequently, Article 8(1)(b) of Regulation No 40/94 did not apply.

Forms of order sought by the parties

14 The applicant claims that the Court should declare the mark at issue invalid.

15 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

The application for legal aid

16 Pursuant to the second subparagraph of Article 94(1) of the Rules of Procedure of the Court of First Instance, legal aid is to cover, in whole or in part, the costs involved in legal assistance and representation by a lawyer in proceedings before the Court of First Instance. The cashier of the Court of First Instance is to be responsible for those costs. Article 94(2) adds that any natural person who, because of his economic situation, is wholly or partly unable to meet the costs referred to in paragraph 1 is to be entitled to legal aid.

17 It follows from those provisions that a legal person, such as Commercy, cannot be entitled to legal aid.

18 However, at the hearing, the applicant's representative submitted that it is Ms B., who, having brought the action in her capacity as receiver in the insolvency proceedings initiated in respect of the assets of the Commercy company, was to be considered to be the applicant in these proceedings. Ms B., a natural person, is entitled to receive legal aid.

19 That argument cannot be accepted. It is true that the file relating to the proceedings before OHIM, which was forwarded to the Court in accordance with Article 133(3) of the Rules of Procedure, shows that the relevant application for a declaration of invalidity was brought by Ms B., in her abovementioned capacity. However, OHIM

rightly examined that application as having been brought in the name of the Commercy company, the proprietor of the earlier mark.

20 OHIM would have had to declare inadmissible an application for a declaration of invalidity brought by Ms B. in her own name. According to Article 55(1)(b) of Regulation No 40/94 in conjunction with Articles 42(1) and 52(1) of that regulation, an application for a declaration of invalidity based on Article 8(1) of the regulation can be brought only by the proprietors of the earlier marks cited in support of that application, or by licensees authorised by those proprietors. A receiver in insolvency proceedings regarding a commercial undertaking does not fall into either of those two categories.

21 Both the appeal before the Board of Appeal and the action before the Court must also be considered to have been brought by Commercy. Since the application for a declaration of invalidity was examined as having been brought by Commercy, an interpretation of those two sets of proceedings to the effect that they were brought by Ms B. must necessarily lead to them being dismissed, on the ground that, in contrast to what is envisaged by Articles 58 and 63(4) of Regulation No 40/94 respectively, they were brought by a person who is not entitled to bring proceedings against the decisions at issue, namely, respectively, the decision of the Cancellation Division and that of the Board of Appeal.

22 However, the applicant submits that German procedural rules provide that a receiver in insolvency proceedings has *locus standi* in his own name in his capacity as 'Partei kraft Amtes', and not in the name of the natural or legal person to which the insolvency proceedings relate.

23 That argument cannot be accepted. In addition to the fact that German procedural rules are not relevant here, since the proceedings before the Court are governed by the Rules of Procedure, it is sufficient to note that this argument, which refers only to judicial proceedings, does not call in question the finding that, in order to be admissible, the application for a declaration of invalidity before OHIM should have been made in the name of Commercy. As stated above, if Commercy made the application for a declaration of invalidity, it is that company — where appropriate, represented by a receiver — which is entitled to bring proceedings against the decisions of the Cancellation Division and the Board of Appeal.

24 It follows from the foregoing that, given that the applicant in this case is the Commercy company, namely a legal person, it cannot be granted the benefit of legal aid.

25 In any event, even if Ms B. should be considered to be the applicant in the present case, the application for legal aid still cannot be successful.

26 In the application for legal aid, the applicant submits that, for the purposes of assessing the merits of the application, the Court must take into consideration the economic situation of Commercy and not the personal economic situation of the company's receiver. As OHIM contended in its written observations on the application for legal aid, the applicant's argument is derived from Paragraph 116(1) of the Zivilprozessordnung (the German Code of Civil Procedure), which provides that legal aid can be granted to a 'Partei kraft Amtes' where the assets administered by that person are insufficient to cover the costs of judicial proceedings.

27 It suffices, in this respect, to note that the Rules of Procedure do not contain any provision comparable to Paragraph 116(1) of the Zivilprozessordnung and state, expressly, that the benefit of legal aid is to be granted to natural persons only, by taking into account their personal economic situation.

28 In addition, at the hearing, the applicant's representative stated, in response to a question put by the Court, that, if the action were dismissed or the applicant ordered to pay the costs, those costs would be chargeable to Commercy's assets, and not the personal assets of Ms B. That statement was recorded in the minutes of the hearing.

29 In those circumstances, to grant the application for legal aid in the present case would, in actual fact, amount to conferring that benefit on a legal person, in breach of Article 94(2) of the Rules of Procedure.

30 Having regard to all the foregoing considerations, the application for legal aid must be dismissed.

The action

31 The applicant seeks a declaration that the mark at issue is invalid. In support of that claim, it put forward, in its application, a single plea in law, alleging infringement of Article 52(1)(a) of Regulation No 40/94 in conjunction with Article 8(1)(a) of the

regulation. The applicant submits that, taking into account the identical nature of the two marks, there is a likelihood of confusion, given that, in contrast to what the Board of Appeal held in the contested decision, the goods and services concerned are at least slightly similar.

32 However, at the hearing, the applicant's representative explained that the reference, in the single plea in law raised in the application, to Article 8(1)(a) of Regulation No 40/94 and not Article 8(1)(b) of the regulation, which is the relevant provision in the present case, is the result of a clerical error. The other parties indicated that they had no objection to this clarification. Those statements were recorded in the minutes of the hearing.

33 Principally, OHIM and the intervener plead that the applicant's single head of claim is inadmissible, on the ground that the Court has no jurisdiction, pursuant to Article 63(3) of Regulation No 40/94, to declare the mark at issue invalid or to issue directions to OHIM to that effect.

34 Alternatively, OHIM and the intervener contend that the Board of Appeal was right in concluding that the goods and services concerned were neither identical nor similar and that, therefore, Article 8(1)(b) of Regulation No 40/94 did not apply in the present case.

35 The Court considers it appropriate to rule first on the substance of the case, namely the lawfulness of the contested decision in the light of the arguments put forward by the applicant in the context of its single plea in law, and then to examine, if appropriate, the admissibility of the action, contested, principally, by OHIM and the intervener.

36 Article 52(1)(a) of Regulation No 40/94 provides that a Community trade mark is to be declared invalid on application to OHIM where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in Article 8(1) or (5) are fulfilled.

37 Article 8(1)(b) of the regulation presupposes, if it is to be applied, the existence of a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected, because of that earlier trade mark's identity with or similarity to the mark at issue and the identity or similarity of the goods or services covered by the trade marks.

38 Pursuant to Article 8(2)(a)(ii) of the regulation, '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.

39 In the present case, the Cancellation Division and the Board of Appeal both acknowledged that the two marks are identical. However, they found that the goods and services concerned were neither identical nor similar and that, consequently, the registration of the mark at issue was not incompatible with Article 8(1) of Regulation No 40/94.

40 In support of its single plea in law, the applicant challenges that finding, by claiming that it is based on an interpretation of Article 8(1)(b) of Regulation No 40/94 that is too narrow. The applicant submits that, according to the case-law, that provision must be interpreted as meaning that, where, as in the present case, the two marks are identical, the goods or services concerned have to be very different to exclude any likelihood of confusion.

41 According to the case-law, the existence on the part of the public of a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, must be assessed globally, taking into account all factors relevant to the circumstances of the case. That global assessment implies some interdependence between the relevant factors, so that a low degree of similarity between the goods or services covered may be offset by a high degree of similarity between the marks, and vice versa (see judgment of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland* v *OHIM and Cornu*, not published in the ECR, paragraphs 44 and 45, and the case-law cited).

42 It has also been held that, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, a likelihood of confusion presupposes both that the two marks are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see, to that effect, Case C-106/03 P *Vedial* v *OHIM* [2004] ECR I-9573, paragraph 51, and Case C-234/06 P *Il Ponte Finanziaria* v *OHIM* [2007] ECR I-7333, paragraph 48).

43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan* v *OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens* v *OHIM — Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraph 27).

44 In the light of those considerations and in the absence of any challenge to the fact that the two marks are identical, it is appropriate, in order to respond to the applicant's single plea in law, to examine the correctness of the Board of Appeal's finding in the contested decision that the goods and services concerned are not similar and, in that

context, to examine the applicant's argument that, in essence, those goods and services are at least slightly similar.

45 According to consistent case-law, in order to assess the similarity of goods and services, all the relevant features of the relationship between those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 85, and order in *Alecansan* v *OHIM*, paragraph 43 above, paragraph 28).

46 In the present case, the Board of Appeal, in paragraphs 18 to 21 of the contested decision, compared the goods and services concerned. The Board of Appeal noted that the relevant goods and services covered by the earlier mark are the building blocks of a website or are used to create, within a website, a reservation, booking and payment facility in relation to accommodation, and to enable a business to set up such a facility on the internet. According to the Board of Appeal, they are different from the relevant services covered by the trade mark at issue, which are, essentially, information services and travel and hotel reservation and booking services, whose purpose is to allow members of the general public to book hotel accommodation or travel, for business, holiday or other purposes.

47 Likewise, the Board of Appeal highlighted the fact that the goods and services covered by the earlier mark are in a specialised sector, namely that of goods and services relating to the development and operation of software systems, and are designed for a limited public, in so far as they are intended only to enable a business in the hotel or travel industry to set up an online reservation system, accessible via the internet. That limited public made up of those businesses is very different from the public at large, for which the relevant services covered by the mark at issue are intended.

48 Given that the goods and services concerned are sold to different publics, the Board of Appeal reached the conclusion that those goods and services are also not in competition with each other.

49 In addition, the Board of Appeal examined whether the goods and services concerned may be complementary. According to its findings, complementarity had to be excluded in the present case since the public at large, for which the services covered by the mark at issue are intended, does not purchase the relevant goods and services covered by the earlier mark, which are exclusively intended for businesses which, subsequently, provide services to the public at large.

50 Finally, the Board of Appeal found, in the same context, that users of the internet who purchase travel services on-line are not likely to be aware of who provided the software that allows an internet shop to operate and are, in any event, able to distinguish between a company that provides sophisticated technology and another company that sells travel services via the internet.

51 Those findings must be upheld. They show, to the requisite legal standard, that the goods and services concerned differ in respect of their nature, intended purpose and method of use and are neither in competition with each other nor complementary. First of all, the relevant goods and services covered by the earlier trade mark are computer-related whereas the information, booking and reservation services covered by the mark at issue are different and use computer technology only to support the transmission of information or to make it possible to reserve hotel accommodation or travel.

52 Further, the relevant goods and services covered by the earlier trade mark are especially intended for businesses in the hotel and travel sector, and the information, booking and reservation services covered by the trade mark at issue are intended for the public at large.

53 In addition, the relevant goods and services covered by the earlier mark are used to enable a software system, and, more specifically, an internet shop, to function, whereas the information, booking and reservation services covered by the trade mark at issue are used to reserve hotel accommodation or travel.

54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services — for example, a certain type of software or operating system — may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else — in terms of their nature, intended purpose or method of use — solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi* v *OHIM — Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution* v *OHIM — Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés* v *OHIM — Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-837, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.

59 Although it accepts that the end users of the goods and services concerned are different, the applicant maintains that a likelihood of confusion cannot be ruled out in the present case since the relevant goods and services covered by the earlier mark have the sole

purpose of making it possible to provide the information, booking and reservation services covered by the mark at issue. As a general rule, the public concerned by those services does not know who developed the necessary software and likewise cannot distinguish between the information on the intervener's website which comes from the intervener itself and that which derives from the software or services provided by an undertaking specialised in computing, such as the applicant. In short, on the intervener's website the services covered by the mark at issue are indissociable from the relevant goods and services covered by the earlier mark.

60 That argument cannot be accepted. The commercial origin of the software and the computer services which enable the intervener's website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener's website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61 If, however, some of the intervener's customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener's website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62 The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned.

63 Lastly, the applicant disputes the reference made in the contested decision to a judgment of the Oberlandesgericht Dresden (Higher Regional Court, Dresden) of 12 May 2006, which was relied on by the intervener before the Board of Appeal. In that judgment, the Oberlandesgericht Dresden, ruling on a trade mark infringement action between the applicant and the intervener, found that software and software development and design services were not similar to services which use that software since the public is aware that services in many sectors are provided by virtue of electronic support. In paragraph 22 of the contested decision, the Board of Appeal fully agrees with the reasoning and conclusions of the judgment in question.

64 The applicant submits, however, that that reference confirms the error in the Board of Appeal's finding to the effect that the goods and services concerned are not similar. According to the applicant, the judgment of the Bundesgerichtshof (German Federal Court of Justice) of 13 November 2003 (I ZR 103/01, GRUR 2004, p. 241), which the judgment of the Oberlandesgericht Dresden cites in the grounds for its above-mentioned judgment, relates to a case in which the means of transmitting certain information and orders, namely by a computerised system or by other means, such as ordinary mail, was held to be irrelevant to the outcome of the proceedings. The present case is different since the relevant services covered by the mark at issue are provided exclusively over the internet.

65 As was stated above, the mere fact that the relevant services provided by the intervener, which are covered by the mark at issue, will be supplied only over the internet is not sufficient to support the conclusion that those services and the goods and services covered by the earlier mark are similar. Therefore, contrary to what the applicant maintains, the reference in the contested decision to the abovementioned judgment of the Oberlandesgericht Dresden does not in any way demonstrate an error in the finding of a lack of similarity between the goods and services covered by the two marks, and it is not necessary to examine whether the case-law of the Bundesgerichtshof was correctly applied in that judgment, since that question goes beyond the jurisdiction of the Court and is, in any event, irrelevant to the present proceedings.

66 It is apparent from all of the above that the applicant's single plea in law must be rejected as unfounded.

67 As the single plea relied on by the applicant in support of its action has been rejected, the action must, in any event, be declared unfounded, without its being necessary to rule on the plea of inadmissibility raised by OHIM and the intervener in their responses (see, to that effect, Case C-23/00 P *Council* v *Boehringer* [2002] ECR I-1873, paragraph 52, and Case C-233/02 *France* v *Commission* [2004] ECR I-2759, paragraph 26).

Costs

68 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by OHIM and the intervener, as applied for by them.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. Dismisses the application for legal aid;

2. Dismisses the action;

3. Orders Commercy AG to pay the costs.

Vilaras Prek Ciucă

Delivered in open court in Luxembourg on 22 January 2009.

[Signatures]