JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

27 October 2005 *

In Case T-336/03,

Les Éditions Albert René, established in Paris (France), represented by J. Pagenberg, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by S. Laitinen, 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: English.

Orange A/S, established in Copenhagen (Denmark), represented by J. Balling, lawyer,

ACTION against the decision of the Fourth Board of Appeal of OHIM of 14 July 2003 (Case R 0559/2002-4) in opposition proceedings between Les Éditions Albert René and Orange A/S,

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

composed of M. Jaeger, President, V. Tiili and O. Czúcz, Judges,

Registrar: I. Natsinas, Administrator,

having regard to the application lodged at the Court Registry on 1 October 2003,

having regard to the response lodged at the Court Registry on 30 July 2004,

further to the hearing on 2 June 2005,

gives the following

Judgment

Background to the dispute

1 On 7 November 1997, Orange A/S ('the trade mark applicant') filed an application under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM').

2 The trade mark which it sought to register is the word mark MOBILIX.

3 The goods and services in respect of which registration was sought are, for the purposes of the present action, in Classes 9, 16, 35, 37, 38 and 42 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:

— 'apparatus, instruments and installation for telecommunication, including for telephony, telephones and cellular telephones, including antennae, aerials and parabolic reflectors, accumulators and batteries, transformers and convertors, coders and decoders, coded cards and card for coding, telephone calling cards, signalling and teaching apparatus and instruments, electronic telephone books,

parts and accessories (not included in other classes) for the aforementioned goods', within Class 9;

— 'telephone calling cards', within Class 16;

— 'telephone-answering service (for temporarily absent subscribers), business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties', within Class 35;

— 'telephone installation and repairs, construction, repairs, installation', within Class 37;

— 'telecommunications, including telecommunications information, telephone and telegraph communications, communications through computer screens and cellular telephones, facsimile transmission, radio and television broadcasting, including through cable television and the Internet, message sending, leasing of message sending apparatus, leasing of telecommunications apparatus, including of telephony apparatus', within Class 38;

— 'scientific and industrial research, engineering, including projecting facilities and telecommunications installations, particularly for telephony, and computer programming, design, maintenance and updating of software, leasing of computers and computer programs', within Class 42;

4 The Community trade mark application was published in the *Community Trade Marks Bulletin* No 1/1999 of 4 January 1999.

5 It was the subject of an opposition filed by Les Éditions Albert René ('the applicant') based on the following earlier rights relating to the term 'obelix':

(a) earlier registered trade mark, protected by registration of Community trade mark No 16 154 of 1 April 1996 in respect of the following goods and services in so far as they are relevant to the present proceedings:

— 'electrical and electronic photographic, cinematographic and optical teaching apparatus and instruments (except projection apparatus) so far as included in Class 9, electronic apparatus for games, with and without screens, computers, program modules and computer programs recorded on data carriers, especially video games', within Class 9;

— 'paper, cardboard; goods made from paper and cardboard, printed goods (so far as included in Class 16) newspapers and magazines, books, book binding material, namely bookbinding cords, cloth and other materials for bookbinding; photographs; stationery; adhesives (for paper and stationery); artists' materials, namely goods for drawing, painting and modelling; paint brushes; typewriters and office requisites, (except furniture) and machines for office use (so far as included in Class 16); instructional and teaching material (except apparatus); plastic materials for packaging not included in other classes; playing cards; printers' type; printing blocks', within Class 16;

— 'games and playthings; gymnastic and sporting articles (so far as included in Class 28); decorations for Christmas trees', within Class 28;

— 'marketing and publicity', within Class 35;

— 'film presentation, film production, film rental; publication of books and magazines; education and entertainment; organisation and presentation of displays and exhibitions; public entertainment, amusement parks, production of live orchestral and spoken-word performances; presentation of reconstructions of historico-cultural and ethnological characters', within Class 41;

— 'accommodation and catering; p;; hotography; translations; copyright management and exploitation; exploitation of industrial property rights', within Class 42;

(b) earlier well-known mark in all the Member States in respect of goods and services falling within Classes 9, 16, 28, 35, 41 and 42.

6 In support of its opposition, the applicant claimed that there was a likelihood of confusion within the meaning of Article 8(1)(b) and (2) of Regulation No 40/94.

7 By decision of 30 May 2002, the Opposition Division rejected the opposition and authorised the continuation of the procedure for the registration of the application for a Community trade mark. After finding that it had not been conclusively demonstrated that the earlier trade mark was well known, the Opposition Division found that the trade marks were not similar overall, that there was a certain aural similarity but that that was offset by the visual appearance of the trade marks and, more particularly, by the very different concepts which they express: mobile phones in the case of MOBILIX and obelisks in the case of OBELIX. Moreover, the earlier registration is more associated with the famous comic strip, which distinguishes it even more, from the conceptual point of view, from the trade mark applied for.

8 In response to the application filed by the applicant on 1 July 2002, the Fourth Board of Appeal delivered its decision on 14 July 2003 ('the contested decision'). It partially annulled the decision of the Opposition Division. The Board of Appeal, first of all, stated that the opposition should be regarded as being based exclusively on the likelihood of confusion. It then stated that it was possible to detect a certain similarity between the trade marks. In comparing the goods and services the Board found that 'the signalling and teaching apparatus and instruments' of the application for a Community trade mark and 'the optical and teaching apparatus and instruments' of the earlier registration falling within Class 9 were similar. It reached the same conclusion in respect of the Class 35 services referred to as 'business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties' in the Community trade mark application and 'marketing and publicity' in respect of the earlier registration. The Board found that, given the degree of similarity between the signs in question and between those particular goods and services, there was a likelihood of confusion in the mind of the relevant public. It therefore refused the application for a Community trade mark in respect of 'signalling and teaching apparatus and instruments' and services known as 'business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties', and granted it in respect of the remaining goods and services.

Forms of order sought by the parties

9 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

10 At the hearing, the applicant further claimed that the Court should remit the case for hearing by the Board of Appeal.

11 The defendant contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

Law

12 In support of its action the applicant advances three pleas in law alleging, first, infringement of Article 8(1)(b) and 8(2) of Regulation No 40/94, second,

infringement of Article 8(5) of Regulation No 40/94 and, third, infringement of Article 74 of Regulation No 40/94.

1. *Admissibility*

Admissibility of new evidence

Arguments of the parties

13 The defendant submits that the five documents which the applicant appends to its application to prove that the OBELIX sign is well known were not previously disclosed in the proceedings before OHIM and therefore they should not be taken into account.

14 When questioned by the Court at the hearing, the applicant claimed that the documents in question were admissible.

Findings of the Court

15 Appended to its application are some documents with which the applicant intends to prove that the sign OBELIX is well known. It is not in dispute that those documents were not disclosed in the course of the earlier proceedings before OHIM.

16 It should be noted that the purpose of an action before the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94 and, in proceedings for annulment, the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted (Case T-164/03 *Ampafrance* v *OHIM — Johnson & Johnson (monBéBé)* [2005] ECR II-1401, paragraph 29). It is thus not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. To admit such evidence is contrary to Article 135(4) of the Rules of Procedure of the Court of First Instance, which prohibits the parties from changing the subject-matter of the proceedings before the Board of Appeal. Accordingly the documents produced for the first time before the Court of First Instance are inadmissible.

The admissibility of the plea based on Article 8(5) of Regulation No 40/94

Arguments of the parties

17 The applicant submits that, since OBELIX is a well-known mark, and even a famous one, it is clear from Article 8(5) of Regulation No 40/94 that it is protected, even outside the area of similarity of the goods and services, against use of the distinctive character or the repute or against impairment of the distinctive character or repute, given that it suffices that the applicant's trade mark has a reputation in respect of some of the goods or services registered.

18 The defendant claims that the applicant errs in alleging that the Board of Appeal infringed Article 8(5) of Regulation No 40/94, and in requesting the Court to make a ruling in an action concerning the application of that provision when that request was not duly submitted during the administrative phase of the proceedings before OHIM.

Findings of the Court

19 Article 8(5) of Regulation No 40/94 provides that, 'upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community ... and where 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 mark'.

20 It is common ground in this case that at no time did the applicant request the Board of Appeal to apply that provision and that it therefore did not examine it. The applicant expressly stated before the Board of Appeal that its action was founded on Article 8(1)(b) and 8(2) of Regulation No 40/94. More specifically, although the applicant did invoke the reputation of its earlier trade mark in its opposition to the trade mark application and before the Board of Appeal, this was exclusively within the context of the application of Article 8(1)(b) of that regulation, that is to say, for the purpose of substantiating the likelihood of confusion in the mind of the relevant public.

21 It should also be pointed out, first, that, under Article 74 of Regulation No 40/94, 'in proceedings relating to relative grounds for refusal of registration, [OHIM] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought'.

22 It should, second, be noted that, as stated at paragraph 16 above, the purpose of actions brought before the Court of First Instance is to review the legality of the

decisions of the Boards of Appeal within the meaning of Article 63 of Regulation No 40/94 (Case T-237/01 *Alcon* v *OHIM — Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 61; Case T-128/01 *DaimlerChrysler* v *OHIM (Grille)* [2003] ECR II-701, paragraph 18; and Case T-129/01 *Alejandro* v *OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67). The Court's review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal (see, to that effect, Case T-194/01 *Unilever* v *OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 16, and Case T-311/01 *Éditions Albert René* v *OHIM — Trucco (Starix)* [2003] ECR II-4625, paragraph 70).

23 Furthermore, Article 135(4) of the Rules of Procedure, also referred to at paragraph 16 above, expressly states that '[t]he parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal'.

24 The applicant cannot therefore argue that the Board of Appeal breached Article 8(5) of Regulation No 40/94 or call on the Court to rule on a request for application of that provision.

25 The present plea must therefore be rejected as inadmissible.

The new claim for relief submitted at the hearing

Arguments of the parties

26 At the hearing, the applicant claimed in the alternative that the Court should remit the case to the Board of Appeal so that it might demonstrate to the Board that its trade mark had a reputation within the meaning of Article 8(5) of Regulation No 40/94.

27 The defendant contends that that claim is inadmissible.

Findings of the Court

28 Under Article 44(1) of the Rules of Procedure an applicant is required to state in the application the subject-matter of the proceedings and the form of order sought. Although Article 48(2) of those rules authorises, in certain circumstances, new pleas in law to be introduced in the course of proceedings, the provision cannot in any circumstances be interpreted as authorising the applicant to bring new claims before the Court and thereby to modify the subject-matter of the proceedings (Case 232/78 *Commission* v *France* [1979] ECR 2729, paragraph 3, and Case T-3/99 *Banatrading* v *Council* [2001] ECR II-2123, paragraph 28).

29 It follows that the applicant is not entitled to bring new claims before the Court thereby modifying the subject-matter of the proceedings. The claim to the relief in question can therefore only be rejected as inadmissible.

2. *Merits*

The breach of Article 74 of Regulation No 40/94

Arguments of the parties

30 The applicant submits that the trade mark applicant did not challenge its assertion made during the opposition proceedings that its OBELIX trade mark is distinctive. According to the applicant, in the absence of a challenge, the Board of Appeal

should have started from the principle that OBELIX — the trade mark of the opposing party — has a reputation. It concludes from this that the Board of Appeal breached Article 74(1) of Regulation No 40/94.

31 The defendant submits that the Opposition Division of OHIM thoroughly evaluated the evidence adduced and arrived at the conclusion that it did not suffice to show either that the unregistered sign was well known or that the registered one enjoyed enhanced distinctiveness. Accordingly, the applicant's first plea in law must be declared manifestly unfounded.

Findings of the Court

32 As noted in paragraph 21 above, according to Article 74(1) of Regulation No 40/94, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

33 That provision restricts the examination carried out by OHIM in two ways. It relates, first, to the factual basis of decisions of OHIM, that is, the facts and evidence on which those decisions may be validly based (see, to that effect, Case T-232/00 *Chef Revival USA* v *OHIM — Massagué Marín (Chef)* [2002] ECR II-2749, paragraph 45), and, second, to the legal basis of those decisions, that is, the provisions which the jurisdiction hearing the case is obliged to apply. Thus the Board of Appeal, when hearing an appeal against a decision terminating opposition proceedings, may base its decision only on the relative grounds for refusal which the party concerned has relied on and the related facts and evidence it has presented (Case T-308/01 *Henkel* v *OHIM — LHS (UK) (KLEENCARE)* [2003] ECR II-3253, paragraph 32, and Case T-185/02 *Ruiz-Picasso and Others* v *OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 28).

34 In that respect, whilst it is apparent from Article 74(1) of Regulation No 40/94 that, in the course of opposition proceedings, OHIM cannot examine the facts of its own motion, that does not mean however that it is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established. That provision only binds OHIM with regard to the facts, evidence and observations on which that decision is based.

35 In the present case the applicant put forward before OHIM a particular legal assessment but neither the Opposition Division nor the Board of Appeal found that the applicant had substantiated that assessment conclusively by facts or evidence. They concluded from this that the facts and evidence were not sufficient to prove the legal assessment in question, namely that the unregistered sign was well known and that the registered sign was highly distinctive.

36 Consequently, the applicant's plea in law alleging infringement of Article 74 of Regulation No 40/94 must be declared unfounded.

Article 8(1)(b) and (2) of Regulation No 40/94

Arguments of the parties

37 First, as regards the comparison of the goods and services, the applicant submits that the goods covered by the trade mark applied for and falling within Class 9, other than 'signalling and teaching apparatus' are also largely similar at least to those covered by the applicant's opposing trade mark which fall within Class 9.

38 It submits that all of the remaining goods covered by the trade mark applied for which fall within Class 9, like 'apparatus, instruments and installation for telecommunication, including for telephony, telephones and cellular telephones, including antennae, aerials and parabolic reflectors, accumulators and batteries, transformers and convertors, coders and decoders, coded cards and card for coding, telephone calling cards, electronic telephone books, parts and accessories (not included in other classes) for the aforementioned goods' include essential constituent parts of the applicant's goods. Thus, the trade mark applicant's digital cellular telephones and telephones appear in the applicant's program modules. As the list of the trade mark applicant's goods also includes parts and accessories for its main products, the trade mark applicant's program modules and parts are even identical.

39 According to the applicant, the same applies to the trade mark applicant's other goods such as 'apparatus, instruments and installation for telecommunication, including for telephony, coders and decoders', because they too contain program modules. Added to that is the fact that those goods covered by the trade mark application which fall within Class 9 are essentially controlled by a processor and so could be controlled by software. The list of its goods includes software programs. It concludes from this that the Class 9 goods referred to in the trade mark application and its own goods falling within that class are not remotely similar but averagely so.

40 Next, the applicant submits that the trade mark applicant's telephone calling cards, which fall within Class 16, are coded telephone calling cards. According to a judgment of the German Federal Patents Court of 7 July 1997, they are similar to the applicant's goods known as 'computer programs recorded on data carriers'.

41 The applicant further points out that the Board of Appeal found that the other services of the trade mark applicant were not similar to its goods, namely:

— 'telephone-answering service (for temporarily absent subscribers)', within Class 35;

— 'telephone installation and repairs, construction, repairs, installation', within Class 37;

— 'telecommunications, including telecommunications information, telephone and telegraph communications, communications through computer screens and cellular telephones, facsimile transmission, radio and television broadcasting, including through cable television and the Internet, message sending, leasing of message sending apparatus, leasing of telecommunications apparatus, including of telephony apparatus', within Class 38;

— 'scientific and industrial research, engineering, including projecting facilities and telecommunications installations, particularly for telephony, and computer programming, design, maintenance and updating of software, leasing of computers and computer programs', within Class 42.

42 It submits that the principles developed by case-law applicable to the similarity between goods apply by analogy to the relationship between goods and services and

vice versa. The decisive point is to determine whether, where similar signs are used, the persons concerned are likely to be misled as to the place of origin of the goods and services.

43 Applying those principles, it must be accepted that there is a similarity between the trade mark applicant's services referred to above and the applicant's goods because manufacturers of goods such as 'computers, program modules and computer programs recorded on data carriers' also cover the trade mark applicant's corresponding services. Citing a decision of the German Federal Patents Court, the applicant concludes that the trade mark applicant's services falling within Class 38 and its own goods falling within Class 9 are similar since a significant part of the public concerned might believe that the manufacturers and distributors of data-processing equipment also supply the corresponding telecommunications services if the trade mark is the same.

44 The applicant submits that it must be accepted, for the same reasons, that the trade mark applicant's services within Classes 35, 37 and 42 and its own goods within Class 9 are similar. Those services, such as 'telephone-answering service (for temporarily absent subscribers)' and 'telephone installation and repairs, construction, repairs, installation', are also, it submits, provided by manufacturers of computer hardware and operated by software.

45 The same applies by analogy in respect of the following services of the trade mark applicant: 'Scientific and industrial research, engineering, including projecting facilities and telecommunications installations, particularly for telephony, and computer programming, design, maintenance and updating of software, leasing of computers and computer programs'. According to the applicant, scientific and industrial research, engineering, including projecting facilities and telecommunications installations is an area which in technical as well as economic terms is so close

to computer hardware and software that the idea has become accepted by the trade or at least by some of the key players that the manufacturers or distributors of data processing equipment also operate, for example, in the area of projecting the corresponding telecommunications service, provided that the same trade mark is used.

46 The applicant states that it does not understand the Board of Appeal's argument that there is no similarity between the trade mark applicant's services consisting of 'the leasing of computers and computer programs' and its own goods called 'computers and computer programs recorded on data carriers'. A quick search on the internet suffices to show that the distributors of computers also provide facilities for leasing them. The same applies to software.

47 Second, as regards comparison of the signs, the applicant submits that the two signs OBELIX and MOBILIX are very similar. Since OBELIX is protected for the whole of the internal market, it is necessary in particular to have regard to the way in which the trade marks are understood in that market on the basis of their aural and conceptual impression and to take account of market conditions and consumer habits in that market.

48 The applicant submits that it is above all necessary to take account of the fact that consumers consider the two signs to be trisyllabic trade marks with the accent on the same syllables and in which the sequence of consonants is the same and the sequence of vowels almost so, since the 'e' and 'i' sounds are very similar. The sole difference is the initial 'm' of the trade mark applicant's mark which, by reason of its weak sound, could however easily be missed by the listener in circumstances where the noise level is quite high.

49 The applicant submits that it is the overall impression which matters and that it is the visual memory which is most often decisive. A purchaser who only vaguely recollects the trade mark OBELIX would believe that he recognises in the similar sign MOBILIX the trade mark which he already knows, and would confuse the companies which make the goods.

50 Third, as regards the likelihood of confusion, the applicant submits that if account is taken of the interdependence between the similarity between the goods, the similarity between the trade marks and the distinctiveness of the applicant's opposing trade mark, the differences between the trade marks in the case of identical goods and services and, to a large extent, of similar goods and services are not enough to prevent, in particular, auditory confusion given that the opposing party's trade mark is well known.

51 The applicant submits that the trade mark OBELIX forms part of a family of trade marks which also comprises the trade marks inspired by other characters from the 'Asterix' series and which is protected in 50 countries throughout the world. The harm to the distinctive character arises from the fact, first, that an attempt has been made to refer to the model of repute by an accumulation of auditory, visual and conceptual factors and that, second, use has knowingly been made in the present case, without any plausible linguistic reason, of a characteristic feature which exists for the series of trade marks arising from the 'Asterix' family: the 'ix' suffix. It is entirely conceivable that the term 'mobilix' would insinuate itself into that family of trade marks and that it would be understood as a derivation of the term 'obelix'.

52 The defendant submits that there is no likelihood of confusion in the mind of the relevant public. The clear visual difference and the particularly marked conceptual difference between the signs makes up for any auditory resemblance, even for the goods and services which are slightly similar.

Findings of the Court

53 Under 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. In addition, 'earlier trade marks' include Community trade marks with a date of application for registration which is earlier than the date of application for registration of the Community trade mark (Article 8(2)(a)(i) of Regulation No 40/94).

54 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion.

55 According to the same line of case-law, the likelihood of confusion must be assessed globally by reference to the perception which the relevant public has of the signs and of the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 to 33, and the case-law cited).

56 In the present case, the earlier rights were invoked relating to the term 'obelix', corresponding to a Community trade mark and a well known trade mark in all the Member States.

57 Furthermore, the large majority of the goods and services in question are everyday consumer goods and services. In the trade mark application, it is only the services falling within Class 42 (scientific and industrial research etc.) which are intended for a specialist public. Consequently, the target public in relation to which the likelihood of confusion should be assessed is the average consumer of those goods and services in the European Union who is reasonably well informed and reasonably observant and circumspect.

58 It is in the light of those considerations that an examination should be made of the comparison by the Board of Appeal of the goods in question and of the opposing signs.

— The comparison of the goods

59 In assessing the similarity of the goods or services in question, all the relevant factors relating to the link between those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (see, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 23).

60 As to the goods in Classes 9 and 16 in respect of which registration is sought, such as 'apparatus, instruments and installation for telecommunication', 'cellular telephones', 'coders and decoders', etc., the applicant essentially submits that they all contain essential components of the goods covered by the trade mark.

61 The applicant's arguments can only be rejected. It is true that computers in different forms are necessary for the proper operation of 'instruments and installations for telecommunication' and 'telephone-answering service (for temporarily absent subscribers)' may occasionally be supplied by the body which manufactures the necessary equipment, but that is not enough to conclude that those goods and services are similar, still less 'very similar'. The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.

62 Furthermore, it is clear from the list of goods and services falling within Class 9 covered by the earlier registration that the sectors covered by that right are photography, cinema, optics, teaching and video games. That list of goods and services is close to that which is claimed in the Community trade mark application, which shows that the sector in question is, almost exclusively, telecommunications of all forms. Telecommunications equipment falls within the category of 'apparatus for recording, transmission or reproduction of sound and/or images', which forms part of the official title of Class 9 of the Nice Agreement. However, that part of the class title ('telecommunications') was not claimed in the earlier right, which implies that telecommunications equipment was not intended to be covered. The applicant registered its trade mark in respect of a large number of classes, but it did not refer to 'telecommunications' in the specification and it even excluded the whole of Class 38 from the registration. Class 38 concerns precisely 'telecommunications' services.

63 The Court shares the view of the Board of Appeal that the earlier registration protects 'electrotechnical apparatus and instruments, electronics', but that that wide formulation cannot be used by the applicant as an argument for finding that the goods are very similar, still less that they are identical to the goods referred to in the application, when specific protection of telecommunications apparatus and instruments could have been easily obtained.

64 Consequently, the Board of Appeal did not err in finding that the goods referred to in the Community trade mark application falling within Classes 9 and 16 should not be regarded as included in the list of goods and services, drafted in wide terms, in the earlier registration.

65 Next, the applicant submits in respect of the services covered by the Community trade mark application and included in Classes 35, 37, 38 and 42 that, contrary to the findings of the Board of Appeal, those goods are also similar to its own because the manufacturers of goods such as 'computers, program modules and computer programs recorded on data carriers' also provide the services for which registration was sought. Citing a decision of the German Federal Patents Court, the applicant concludes that the trade mark applicant's services falling within Class 38 and its own goods falling within Class 9 are similar since a significant part of the public concerned might believe that the manufacturer and distributors of data-processing equipment also supply the corresponding telecommunications services if the trade mark used is the same. Furthermore, the applicant submits that that observation also applies in respect of the services included in Classes 35 and 37, as services such as 'telephone-answering service' (Class 35) and 'telephone installation and repairs' (Class 37) are sometimes provided by the manufacturers of the computer hardware used and sometimes operated by means of software. In the case of services entitled 'scientific and industrial research, engineering, including projecting facilities and telecommunications installations' within Class 42, the applicant submits that they are so closely linked to the computer hardware and software sector that the public might believe that they come from the same manufacturers or distributors. Lastly, as regards the 'leasing of computers and computer programs' (Class 42), included in the Community trade mark application, the applicant disputes the finding of the Board that such services differ from 'computers' and 'computer programs recorded on data carriers'.

66 As a preliminary point, it should be noted that the principles applicable to the comparison of the goods also apply to the comparison between the services and between the goods and services. It is true as the defendant points out that, by reason

of their very nature, goods are generally different from services, but it nevertheless remains the case that they can be complementary, in the sense that, for example, the maintenance of the goods complements the goods themselves, or that services may have the same purpose or use as the goods, and thus compete with each other. It follows that, in certain circumstances, even goods and services may be found to be similar.

67 In the present case, as regards, first, the services referred to in the trade mark application within Classes 37 and 42, the Board of Appeal's position that they cannot be regarded as similar to the services covered by the earlier registration cannot be criticised. The applicant's services included in Class 42 ('accommodation and catering; photography; translations; copyright management and exploitation; exploitation of industrial property rights') are unrelated to the services entitled 'scientific and industrial research, engineering, including projecting facilities and telecommunications installations, particularly for telephony, and computer programming, design, maintenance and updating of software, leasing of computers and computer programs', also included in Class 42, in respect of which protection is sought. That conclusion also applies to the services covered by the trade mark application included in Class 37, namely 'telephone installation and repairs, construction, repairs, installation'.

68 Second, the Board of Appeal did not err when it asserted that the services listed in the Community trade mark application under Class 38 (as described in paragraph 3 above) are sufficiently different from those covered by the earlier registration and included in Class 41 (as described in paragraph 5 above), given their technical nature, the skills required to offer them and the needs of the consumers which they are intended to satisfy. Consequently, the services appearing in the trade mark application included in Class 38 are at most slightly similar to the services falling within Class 41 protected by the earlier right.

69 Next, the Court must reject the applicant's argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to 'computers' and 'computer programs' (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today's high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software. That exclusion is not in any event legitimate in the present case, since the Community trade mark application is exclusively for telecommunications in their various forms, whereas the earlier registration makes no reference to any activity in that sector. Furthermore, as the Board of Appeal rightly pointed out, there is nothing to stop the applicant from also registering its trade mark in respect of telephony.

70 Consequently, it must be found that the goods and services in question are not similar. There is however one exception. The 'leasing of computers and computer programs' which appears in the Community trade mark application (Class 42) and the applicant's 'computers' and 'computer programs recorded on data carriers' (Class 9) are similar by reason of their complementarity.

71 It follows from the foregoing that the Court must reject the applicant's arguments in respect of the comparison of the goods and services, with the exception of that in respect of the similarity between the 'leasing of computers and computer programs' which appears in the Community trade mark application (Class 42) and the applicant's 'computers' and 'computer programs recorded on data carriers' (Class 9).

— The comparison of the signs

72 It is clear from established case-law that the global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (see 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).

73 The applicant considers that the two signs OBELIX and MOBILIX are very similar. Visually, they are almost the same length and have a similar sequence of letters and, aurally, they sound very similar. Given that the initial letter 'm' of the mark applied for produces a weak sound, it is moreover likely that it would be misheard in a noisy environment.

74 In the contested decision, the Board of Appeal found that the signs in question were similar. It stated that the two signs were composed of the same number of syllables, the same sequence of consonants B-L-X, a similar sequence of vowels O-I (or E)-I and were of the same length. Those common characteristics give the general impression of similarity. That impression is stronger aurally but is also appreciable visually, particularly given the 'ix' suffix. Lastly, it concluded that whilst the conceptual differences between the two trade marks were not negligible, they did not offset the visual and aural similarities.

75 First, as regards the visual comparison it should be found at the outset that the trade marks in question are both word marks. MOBILIX is made up of seven letters and the earlier trade mark OBELIX of six letters. Although they have in common the

'OB' combination of letters and the 'LIX' ending, they have a number of significant visual differences, such as the letters following 'OB' ('E' in the first case and 'I' in the second), the beginning of the words (the Community trade mark applied for begins with 'M' and the earlier trade mark with 'O') and their length. It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés* v *OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 83).

76 Consequently, it must be concluded that the signs in question are not visually similar or that, at most, they are visually very slightly similar.

77 Second, as regards the aural comparison, it should be noted that the two trade marks are pronounced with three syllables, O-BE-LIX and MO-BIL-IX or MO-BI-LIX. It is true that the first syllable of the Community trade mark applied for, 'MO', is clearly pronounced, which helps to distinguish the marks in question, but it should not be forgotten that the initial 'M', because weakly voiced, may nevertheless sometimes be missed by the listener. Furthermore, the second and third syllables are pronounced in a very similar way, and indeed identically in the case of the third syllable.

78 Given those factors, it must be found that the signs in question have a certain aural similarity.

79 Third, as regards the conceptual comparison, it should be noted that the words 'mobilix' and 'obelix' have no meaning in any of the official languages of the

European Union. However, whilst the term 'mobilix' may readily be perceived as referring to something mobile or to mobility, the term 'obelix', even if the name has been registered as a word mark, that is to say with no visual reference to the comic strip character, will readily be identified by the average member of the public with the corpulent character from the comic strip series, widely known throughout the European Union, which tells of his adventures together with Asterix. This specific representation of a popular character makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar (*Starix*, paragraph 22 above, paragraph 58).

80 Such conceptual differences can in certain circumstances counteract the visual and aural similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately (*BASS*, paragraph 72 above, paragraph 54, and *PICARO*, paragraph 33 above, paragraph 56). In the present case, this is so for the word sign OBELIX, as has just been pointed out in the previous paragraph.

81 It follows that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above.

82 With regard to the assessment of the likelihood of confusion, it should be observed that the differences between the signs in question are sufficient to rule out any likelihood of confusion in the perception of the target public. Such a likelihood

would presuppose that both the degree of similarity of the trade marks in question and that of the goods or services designated by those marks were sufficiently high (*Starix*, paragraph 22 above, paragraph 59).

83 In those circumstances, the Board of Appeal's assessment of the distinctiveness of the earlier trade mark and the applicant's claims as to the reputation of that trade mark have no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in the present case (see, to that effect, *Starix*, paragraph 22 above, paragraph 60).

84 A likelihood of confusion presupposes that the signs as well as the goods and services designated are identical or similar, and the reputation of a mark is one factor which must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a risk of confusion (see, to that effect and by analogy, *Canon*, paragraph 59 above, paragraph 22 and 24). Since, however, in the present case, the signs in dispute cannot be regarded as identical or similar, the fact that the earlier mark is widely known or enjoys a reputation in the European Union cannot alter the overall assessment of the likelihood of confusion (see to that effect, *Starix*, paragraph 22 above, paragraph 61).

85 Lastly, the Court must reject the applicant's argument that, because of the 'ix' suffix, it is entirely conceivable that the term 'mobilix' would insinuate itself into the family of trade marks made up of the characters from the 'Asterix' series and that it would be understood as a derivation of the term 'obelix'. It suffices to note in that regard that the applicant cannot claim an exclusive right to the use of the 'ix' suffix.

86 It is clear from the foregoing that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 has not been satisfied. It therefore follows that the Board of Appeal was right in finding that there is no likelihood of confusion between the mark claimed and the earlier mark.

87 In those circumstances, the plea alleging an infringement of that provision must be rejected and it is not necessary to examine the applicant's arguments under that plea regarding the alleged reputation of the earlier trade mark. Similarly, there is no need to accede to the applicant's request for witnesses to be heard in order to demonstrate that reputation. Lastly, it is also apparent that the finding that the 'leasing of computers and computer programs' which appears in the Community trade mark application (Class 42) and the applicant's 'computers' and 'computer programs recorded on data carriers' (Class 9) (see paragraph 71 above) is irrelevant.

88 Accordingly, the action brought by the applicant must be dismissed.

Costs

89 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, as applied for by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Jaeger Tiili Czúcz

Delivered in open court in Luxembourg on 27 October 2005.

E. Coulon M. Jaeger

Registrar President