JUDGMENT OF THE COURT (Fourth Chamber)

13 September 2007 *

In Case C-234/06 P,

APPEAL under Article 56 of the Statute of the Court of Justice, lodged on 23 May 2006,

Il Ponte Finanziaria SpA, established in Scandicci (Italy), represented by P.L. Roncaglia, A. Torrigiani Malaspina and M. Boletto, avvocati,

appellant,

the other parties to the proceedings being:

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto and M. Buffolo, acting as Agents,

defendant at first instance,

* Language of the case: Italian.

F.M.G. Textiles Srl, formerly Marine Enterprise Projects — Società Unipersonale di Alberto Fiorenzi Srl, established in Numana (Italy), represented by D. Marchi, avvocato,

intervener at first instance,

THE COURT (Fourth Chamber),

composed of K. Lenaerts (Rapporteur), President of the Chamber, E. Juhász, R. Silva de Lapuerta, G. Arestis and J. Malenovský, Judges,

Advocate General: E. Sharpston,
Registrar: R. Grass,

having regard to the written procedure,

after hearing the Opinion of the Advocate General at the sitting on 29 March 2007,

gives the following

Judgment

1 By its appeal, Il Ponte Finanziaria SpA ('the appellant') asks the Court to set aside the judgment of the Court of First Instance of the European Communities of 23 February 2006 in Case T-194/03 *Il Ponte Finanziaria* v *OHIM — Marine Enterprise Projects (BAINBRIDGE)* [2006] ECR II-445 ('the judgment under appeal')

dismissing its action for annulment of the decision of the Fourth Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 17 March 2003 relating to opposition proceedings between the appellant and Marine Enterprise Projects — Società Unipersonale di Alberto Fiorenzi Srl ('the contested decision').

Legal context

2 Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) provides that, 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'. Under Article 8(2)(a)(ii) of that regulation, earlier trade marks are to be understood, inter alia, as trade marks registered in a Member State with a date of application for registration which is earlier than that of the Community trade mark.

3 Article 15(1) of Regulation No 40/94 provides that if, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark is to be subject to the sanctions provided for in that regulation, unless there are proper reasons for non-use. Under Article 15(2)(a) of the regulation, use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered is to constitute use within the meaning of Article 15(1).

4 Article 43(2) of Regulation No 40/94 deals with opposition to an application for registration of a Community trade mark and provides that, if his opposition is not to be rejected, the proprietor of an earlier Community trade mark must furnish proof that, during the five-year period preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. Under Article 43(3) of Regulation No 40/94, paragraph 2 of that article is also to apply to earlier national trade marks by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

Background to the dispute

5 On 24 September 1998, Marine Enterprise Projects — Società Unipersonale di Alberto Fiorenza Srl, subsequently F.M.G. Textiles Srl, ('the intervener') submitted an application to OHIM for registration of the figurative mark BAINBRIDGE (No 940007) as a Community trade mark. The goods in respect of which registration was sought are in Class 18 — 'leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery' — and in Class 25 — 'clothing, footwear, headgear' — 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.

6 On 7 September 1999, the appellant gave notice of opposition to that registration pursuant to Article 8(1)(b) of Regulation No 40/94. That opposition was based on

the existence of 11 earlier trade marks registered in Italy in respect of Classes 18 and/or 25, all of which had the word component 'bridge' in common. These are the figurative signs 'Bridge' (No 370836), 'Bridge' (No 704338), 'Old Bridge' (No 606709), 'The Bridge Basket' (No 593651), the word sign 'THE BRIDGE' (No 642952), the three-dimensional signs 'The Bridge' (No 704372) and 'The Bridge' (No 633349), the word sign 'FOOTBRIDGE' (No 710102), the figurative sign 'The Bridge Wayfarer' (No 721569) and, lastly, the word signs 'OVER THE BRIDGE' (No 630763) and 'THE BRIDGE' (No 642953).

7 By decision of 15 November 2001, the Opposition Division of OHIM rejected the opposition, taking the view that, notwithstanding the interdependence between the degree of similarity of the goods concerned and the degree of similarity of the conflicting signs, any likelihood of confusion, within the meaning of Regulation No 40/94, could reasonably be ruled out in view of the aural and visual dissimilarities between the marks in question. The appellant then filed notice of appeal against that decision.

8 By the contested decision, the Fourth Board of Appeal of OHIM dismissed that appeal. First of all, it excluded from its assessment 5 of the 11 earlier registrations (Nos 370836, 704338, 606709, 593651 and 642952) on the ground that use of the corresponding trade marks had not been established. With regard to the six other earlier marks (Nos 704372, 633349, 710102, 721569, 630763 and 642953), it refused to classify them as marks 'in a series' since proof had not been furnished that a sufficient number of them had been used. It then concluded that there was no likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, between those six marks and the Community trade mark applied for in view of the absence, as between the conflicting marks, of the minimum degree of similarity required in order to justify the application of the principle of interdependence, by virtue of which a lesser degree of similarity between the marks may be offset by a higher degree of similarity between the designated goods and vice versa.

Procedure before the Court of First Instance and the judgment under appeal

9 By application lodged at the Registry of the Court of First Instance on 30 May 2003, the present appellant brought an action for annulment of the contested decision.

10 OHIM and the intervener contended that that action should be dismissed.

11 By its first plea, alleging infringement of Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94 and infringement of Rule 22 of Commission Regulation No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), the appellant submitted that the Board of Appeal erred in excluding from its assessment several of the appellant's earlier trade marks on the ground that use of those marks had not been established.

12 First of all, the Court of First Instance found, at paragraphs 27 and 28 of the judgment under appeal, with regard to the six earlier marks (Nos 704372, 633349, 710102, 721569, 630763 and 642953) on which the Board of Appeal had based its assessment of the likelihood of confusion with the trade mark applied for, that it was only when it examined the argument that there was a 'family of marks' that it established that only two of those marks had been put to use and could therefore be taken into account in that assessment.

13 In that regard, the Board of Appeal expressly affirmed that those earlier trade marks were not subject to proof of use in accordance with Article 43 of Regulation No 40/94 because the five-year period following their registration, required under that provision, had not yet elapsed. It therefore concluded that those six earlier marks had to be taken into consideration for the purpose of assessing the existence of a likelihood of confusion with the trade mark applied for. The Italian consumer

was actually confronted on the market with only two of those earlier marks, with the result that the extended protection claimed by the appellant, connected with the existence of an alleged 'family of marks', was not justified in this case. The Court of First Instance concluded from this that the complaint raised before it by the appellant concerning the Board of Appeal's treatment of the six earlier marks at issue was actually intended to dispute the assessments made by the Board of Appeal in its substantive analysis of a likelihood of confusion between the conflicting signs, which should be considered in the context of the second plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

14 Second, in relation to the disregarding of the earlier mark THE BRIDGE (No 642952), the Court of First Instance held, at paragraphs 31 to 37 of the judgment under appeal, that if a mark is to be regarded as being in genuine use, it must be objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign. The Board of Appeal was correct in law to take the view that genuine use of the trade mark in question had not been proved. In that context, the Court declared the documents produced by the appellant for the first time before it to be inadmissible.

15 Third, with regard to the four other earlier trade marks (Nos 370836, 704338, 606709 and 593651) which were not taken into account for the purposes of assessing the likelihood of confusion with the trade mark in the application for registration, the Court of First Instance held, at paragraphs 42 to 45 of the judgment under appeal, that the Board of Appeal was entitled to reject what were described as the 'defensive' registrations of those marks. According to the Court of First Instance, the taking into account of such registrations is not compatible with the system of protection of the Community trade mark intended by Regulation No 40/94, which requires proof of use as an essential precondition for conferring exclusive rights on the proprietor of the mark. Moreover, with regard to whether the trade mark BRIDGE (No 370836) could be regarded as broadly equivalent to the mark THE BRIDGE (No 642952) for the purposes of Article 15(2)(a) of Regulation No 40/94, the Court of First Instance held, at paragraphs 50 and 51 of the judgment under appeal, that the conditions for the application of that provision were not satisfied in this case. According to that Court, that provision does not allow the proprietor of a registered trade mark to demonstrate use of that mark by relying on the use of a similar mark covered by a separate registration.

16 With regard to the second plea, alleging infringement of Article 8(1)(b) of Regulation No 40/94, the Court of First Instance first of all found, at paragraphs 75 to 117 of the judgment under appeal, that the goods covered by the Community trade mark application and the goods covered by the six earlier national marks which were taken into account by the Board of Appeal for the purposes of assessing whether there was a likelihood of confusion are identical but that the conflicting signs display similarities only aurally and not visually or conceptually. The Court of First Instance therefore considered that the Board of Appeal did not make any errors of assessment in concluding that there was no likelihood of confusion on the part of the consumer between the trade mark applied for and each of the six earlier marks considered individually. Second, as regards the argument that the earlier trade marks constitute a 'family of marks' or 'marks in a series', the Court of First Instance held, at paragraph 128 of the judgment under appeal, that, in the absence of evidence of use of all of the marks belonging to the 'series' or, at the very least, of a number of marks capable of constituting a 'family', the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'.

17 The Court of First Instance accordingly dismissed the action for annulment.

Forms of order sought by the parties

18 The appellant claims that the Court should:

— set aside the judgment under appeal;

— annul the contested decision;

— order OHIM and the intervener to pay the costs both of the proceedings before the Court of First Instance and of those before the Court of Justice.

19 OHIM contends that the Court should:

— dismiss the appeal;

— order the appellant to pay the costs.

20 The intervener contends that the Court should:

— declare the appeal inadmissible under Article 119 of the Rules of Procedure;

— principally, dismiss the appeal and uphold the judgment under appeal;

— in any event, order the appellant to pay the costs incurred by the intervener in connection with the proceedings before the Court of First Instance and those before the Court of Justice.

The appeal

21 As a preliminary point, the intervener states that, in the introductory paragraph of the appeal, the appellant's lawyers state that they are acting pursuant to an authentic special authority 'annexed as an administrative document to the application brought before the Court of First Instance'. Since that document is not on the court file, the appeal should, it submits, be regarded as inadmissible.

22 In that regard, it is sufficient to state that the document in question was indeed on the file which was compiled before the Court of First Instance. The appeal is therefore not in any way inadmissible.

23 By its first and fifth pleas, which it is appropriate to consider first of all, the appellant submits that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94 in its assessment of the likelihood of confusion between the trade mark in the application for registration and the appellant's six earlier trade marks which were taken into account for that purpose (Nos 704372, 633349, 710102, 721569, 630763 and 642953). The second plea alleges misapplication of Article 43(2) and (3) of that regulation, which resulted in the earlier mark THE BRIDGE (No 642952) being disregarded. The third plea alleges infringement of Article 15(2)(a) of Regulation No 40/94, which resulted in the earlier mark 'Bridge' (No 370836) being disregarded. As to the fourth plea, this alleges misapplication of Article 43(2) and (3) of that regulation, which resulted in the earlier mark 'Bridge' (No 370836) and the earlier marks Nos 704338, 606709 and 593651 being disregarded as defensive marks.

The first plea: infringement of Article 8(1)(b) of Regulation No 40/94 in the assessment of the likelihood of confusion with the earlier marks, considered individually

Arguments of the parties

24 By its first plea, which falls into three parts, the appellant submits that the Court of First Instance misapplied Article 8(1)(b) of Regulation No 40/94, since the conflicting marks displayed the minimum degree of similarity required in order to establish a likelihood of confusion.

25 In the first place, it argues, the Court of First Instance acknowledged, at paragraph 105 of the judgment under appeal, that there were aural similarities between all of the conflicting marks and a 'marked' aural similarity between the trade mark applied for and the word marks THE BRIDGE (No 642953) and FOOTBRIDGE (No 710102) and the earlier three-dimensional marks which included the word element 'the bridge' (Nos 704372 and 633349). According to the appellant, it is settled case-law that aural similarity prevails over the fact that there may be no visual similarity from a graphic point of view.

26 Second, the appellant considers that the Court of First Instance erred in finding that there was no likelihood of confusion on account of the visual and conceptual dissimilarities between the trade mark applied for and the earlier marks. The appellant is of the view that the assessment made by that Court at paragraphs 107 to 113 of the judgment under appeal, which led it to conclude that there was no conceptual similarity, was based on an estimate of the average Italian reference consumer's degree of knowledge of English, whereas the appellant considers, on the basis of the most recent survey conducted by Eurobarometer (the body of the European Commission responsible for monitoring public opinion), that only 15 to 20% of the Italian public would know the meaning of the English word 'bridge'. The appellant submits that, in so far as the element 'bridge' is common to all the marks, there is also a degree of visual similarity between them.

27 Third, in view of the fact that the goods covered by the conflicting marks are absolutely identical and of the highly distinctive character of the earlier marks, the Court of First Instance should have compared the marks at issue on the basis of a full assessment based on the principle of the interdependence of factors, which could not have led, without any error of law, to the likelihood of confusion being ruled out, in view of the significant aural similarity and the conceptual and visual similarity of the marks at issue.

28 According to OHIM, a degree of aural similarity alone may be disregarded if it has no influence on the consumer and is only one of the elements in the consumer's overall assessment.

29 The intervener submits, with regard to the aural aspect, that the appellant is reinterpreting the judgment under appeal in an arbitrary manner. As regards the conceptual aspect, the intervener submits that it cannot be inferred from the survey referred to by the appellant that the average Italian consumer would not know the meaning in his or her own language of the English word 'bridge' and that, by choosing the trade mark THE BRIDGE, the meaning of which corresponds to the distinctive part of its name, 'Il Ponte', the appellant itself intended to create a link between that name and the goods marketed, since it considers that the Italian consumer is able to perceive that link. As regards the principle of the interdependence of factors, the intervener submits, as does OHIM, that, as the Court of First Instance rightly concluded that there was a difference between the trade mark applied for and the appellant's trade marks, that principle does not therefore apply.

Findings of the Court

— The first part of the first plea

30 It should be noted that, at paragraphs 102 to 106 of the judgment under appeal, the Court of First Instance found that the aural similarities are quite weak if the trade mark applied for is compared with the earlier mark including the word element 'The Bridge Wayfarer' (No 721569) and the earlier word mark OVER THE BRIDGE (No 630763). It went on to state that the aural similarities are more marked when a comparison is made with the earlier word marks THE BRIDGE and FOOTBRIDGE (Nos 642953 and 710102) and the earlier three-dimensional marks including the word element 'the bridge' (Nos 704372 and 633349). However, at the same time, the Court of First Instance took the view that that similarity was weakened both by the presence of the word 'the' and the prefix 'foot' in the earlier marks and by the presence of the prefix 'bain' in the trade mark applied for. Accordingly, it accepted that there was a degree of aural similarity between the trade mark applied for and those four earlier marks only.

31 Thus, contrary to what is claimed by the appellant, the Court of First Instance did not take the view that there were aural similarities between all of the marks at issue. As regards the aural similarity between the trade mark applied for and the four abovementioned earlier marks, while the Court of First Instance described this as 'marked' at paragraph 115 of the judgment under appeal, that finding did not lead to any error of law.

32 Even though it is conceivable that aural similarity alone could create a likelihood of confusion, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue (see Case C-206/04 P *Mülhens* v *OHIM* [2006] ECR I-2717, paragraph 21; see also, to that effect, Case C-334/05 P *OHIM* v *Shaker* [2007] ECR I-4529, paragraphs 34 and 35).

33 Such a global assessment of the likelihood of confusion must be based on the overall impression created by those marks, bearing in mind, in particular, their distinctive and dominant components (see *Mülhens* v *OHIM*, paragraph 19, and, in particular, in respect of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

34 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-643, paragraph 20; *Mülhens* v *OHIM*, paragraph 35; and Case C-171/06 P *T.I.M.E ART* v *OHIM*, not published in the ECR, paragraph 49).

35 In that regard, as the Advocate General observed at point 56 of her Opinion, the assessment of any aural similarity is but one of the relevant factors for the purpose of the global assessment. Therefore, one cannot deduce that there is necessarily a likelihood of confusion where mere phonetic similarity between two signs is established (*Mülhens* v *OHIM*, paragraphs 21 and 22).

36 In the present case, the Court of First Instance considered, at paragraphs 116 and 117 of the judgment under appeal, that it cannot be concluded that there is a likelihood of confusion solely on the basis of aural similarities, the degree of aural similarity being of less importance on account of the manner in which the goods in question are marketed, so that, when making a purchase, the relevant public usually perceives visually the mark designating those goods.

37 Thus, the Court of First Instance examined the overall impression created by the signs at issue, as regards any conceptual, visual and aural similarities between them, as part of a global assessment of the likelihood of confusion. It is in that context that it was able, without erring in law, to conclude that there was no such likelihood in the absence of any conceptual or visual similarity.

38 Moreover, the applicant cannot require the Court to substitute its own assessment for that of the Court of First Instance. It is settled case-law that the effect of Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice is that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts and evidence are distorted, which is not alleged in this case, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see, inter alia, Case C-214/05 P *Rossi* v *OHIM* [2006] ECR I-7057, paragraph 26, and Case C-412/05 P *Alcon* v *OHIM* [2007] ECR I-3569, paragraph 71).

39 The findings made by the Court of First Instance at paragraphs 115 to 117 of the judgment under appeal constitute appraisals that are factual in nature. The Court of First Instance made a global assessment of the likelihood of confusion, based on the overall impression created by the conflicting marks, taking into account in particular their distinctive and dominant components.

40 The argument put forward by the appellant must therefore be regarded as inadmissible since it seeks to require the Court to substitute its own assessment of the facts for that of the Court of First Instance.

41 Consequently, the first part of the plea must be rejected as unfounded in part and inadmissible in part.

— The second part of the first plea

42 First of all, the Court rejects from the outset as inadmissible the argument by which the appellant, referring to a recent survey, effectively seeks to call into question the purely factual assessments made by the Court of First Instance at paragraphs 107 to 114 of the judgment under appeal concerning the conceptual similarities between the signs at issue.

43 Indeed, as was pointed out at paragraph 38 above, it is not for the Court, on appeal, to call into question such assessments, save where they are the result of distortion of the documents on the file, which is not alleged in this case.

44 With regard, next, to the appellant's criticism concerning the Court of First Instance's assessment of the visual similarity, as set out at paragraphs 92 to 101 of the judgment under appeal, it should be recalled that, according to settled case-law, it follows from Article 225 EC, the first paragraph of Article 58 of the Statute of the Court of Justice and Article 112(1)(c) of the Court's Rules of Procedure that an appeal must indicate precisely the contested elements of the judgment which the appellant seeks to have set aside and also the legal arguments specifically advanced in support of the appeal (Case C-352/98 P *Bergaderm and Goupil* v *Commission* [2000] ECR I-5291, paragraph 34, and Case C-286/04 P *Eurocermex* v *OHIM* [2005] ECR I-5797, paragraph 42).

45 The argument put forward by the appellant does not meet those requirements. In fact, it does not contain any legal argument to demonstrate the manner in which the Court of First Instance allegedly erred in law. The appellant does no more than reproduce the plea which it invoked before the Court of First Instance, without furnishing any further clarification and without identifying clearly the elements of the judgment under appeal that it wishes to challenge.

46 Thus, that argument merely constitutes a request to have the action brought at first instance re-examined, in breach of the rules imposed by both the Statute of the Court of Justice and its Rules of Procedure.

47 Accordingly, the second part of the first plea must be rejected as inadmissible.

— The third part of the first plea

48 While it is the case that, under the principle of the interdependence of relevant factors, in particular the similarity between the trade marks and between the goods

or services covered, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (see, inter alia, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17; *Lloyd Schuhfabrik Meyer*, paragraph 19; and *T.I.M.E. ART* v *OHIM*, paragraph 35), the Court has held that, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark was registered. Those conditions are cumulative (see Case C-106/03 P *Vedial* v *OHIM* [2004] ECR I-9573, paragraph 51).

49 In that regard, the Court of First Instance held, at paragraph 116 of the judgment under appeal, that even if the conflicting signs are aurally similar, that factor is ultimately of lesser importance since the relevant public usually perceives visually the mark designating the goods in question. Moreover, in its assessment, which, for the reasons set out in relation to the second part of this plea, cannot be called into question, the Court was also entitled to conclude that there was no conceptual or visual similarity.

50 Therefore, the Court of First Instance was able to conclude, without erring in law, that the conflicting marks, considered individually, did not display the minimum degree of similarity required for it to be possible to establish a likelihood of confusion solely on the basis of the highly distinctive character of the earlier marks or of the fact alone that the goods covered by the earlier marks and those covered by the trade mark applied for are identical.

51 In the absence of a minimum degree of similarity, the Court of First Instance cannot be criticised for having failed to apply the principle of interdependence in its overall assessment of the likelihood of confusion.

52 In those circumstances, the third part of the first plea must be dismissed as unfounded.

53 It follows that the first plea must be rejected in its entirety.

The fifth plea: infringement of Article 8(1)(b) of Regulation No 40/94 in the assessment of the likelihood of confusion in relation to the earlier marks as marks belonging to a 'family' or 'series' of marks

Arguments of the parties

54 The appellant submits that the Court of First Instance misapplied Article 8(1)(b) of Regulation No 40/94 in its assessment of the likelihood of confusion in relation to the 'family' or 'series' of marks constituted by its earlier marks. According to the appellant, during the five-year period preceding the date of the Community trade mark application, the likelihood of confusion should be assessed by comparing the marks as they were registered without requiring compliance with any criterion such as actual use. First, the appellant states that that is the case where opposition by the proprietor of an earlier mark is based solely on the existence of that earlier mark, which is not subject to an obligation of use. Second, to require that earlier marks should have been used is tantamount to depriving the proprietor who is about to launch on the market goods designated by that proprietor's 'marks in a series' which are registered but as yet unused of the protection due to 'marks in a series' against a third party who has legitimately filed an application for a similar trade mark and decided to put his mark to actual use at the same time.

55 OHIM submits that, in the first place, the concept of 'marks in a series' is irrelevant for the purposes of Regulation No 40/94 and is simply a legal concept under Italian trade mark law which gives legal effect to a factual situation in which it is possible

for there to be an association between the marks of a series and the trade mark in an application for registration. That association is therefore liable to give rise to confusion in the mind of the public concerned as a result of the presence at the same time on the market of a number of marks having a distinctive component in common and covering identical or similar goods. As a consequence, those marks must be present on the market.

56 In second place, the taking into account of the serial nature of the earlier marks would entail widening the scope of the protection of such marks considered individually. Therefore, any assessment in the abstract of the likelihood of confusion, based exclusively on the existence of several registrations covering marks reproducing the same distinctive element, must, in the absence of any actual use of those marks, be excluded.

57 In third place, OHIM submits that the issue of 'marks in a series' is a question of fact, which is connected to the perception consumers have of the conflicting signs. OHIM states that the alleged 'marks in a series' were not used and that they do not, as among themselves, display the characteristics which might permit them to be regarded as a family.

58 The intervener observes that, while the appellant was not required to prove use of the earlier marks having the word element 'bridge' in common in order to prevent revocation of the respective registrations, it should nonetheless have done so to lend support to its argument that there was a 'family' of marks containing that word element.

Findings of the Court

59 Under Article 8(1)(b) of Regulation No 40/94, the existence of a likelihood of confusion resulting from the similarity, on the one hand, between the trade mark in

the application for registration and an earlier trade mark and, on the other hand, between the goods or services covered by the trade marks, must be assessed on the part of the public in the territory in which the earlier trade mark is protected.

60 In the present case, the Court of First Instance found, at paragraph 78 of the judgment under appeal, that, given the nature of the goods concerned, the description of which is reproduced at paragraph 5 above, the targeted public in relation to which the analysis of the likelihood of confusion must be carried out consists, for all the goods in question, of the average consumers of the Member State in which the earlier trade marks are protected, namely Italy.

61 First of all, it should be noted that, under Articles 4 to 6 of Regulation No 40/94, a trade mark may be registered only individually and the minimum five-year protection afforded by such registration is conferred on it only as an individual trade mark, even where several trade marks having one or more common and distinctive elements are registered at the same time.

62 While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon* v *OHIM*, paragraph 55, and, to that effect,

Canon, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'.

67 Accordingly, the fifth plea must be rejected as unfounded.

The second plea: infringement of Article 43(2) and (3) of Regulation No 40/94 in so far as the Court of First Instance excluded from its assessment the earlier mark THE BRIDGE (No 642952)

Arguments of the parties

68 According to the appellant, the Court of First Instance misapplied Article 43(2) and (3) of Regulation No 40/94. It failed to evaluate the relevance of documents produced by the appellant relating to the use, during 1995, of goods in Class 25 relating to the trade mark THE BRIDGE (No 642952) in order to determine whether that mark had been in genuine use during the five-year period preceding the date of publication of the Community trade mark application.

69 By requiring continuous use of the trade mark THE BRIDGE (No 642952) during the period in question, the Court of First Instance, the appellant contends, added a condition that is not laid down in Article 43(2) and (3) of Regulation No 40/94.

70 OHIM submits, first, that the examination of the evidence submitted by the appellant falls within the scope of the assessment of the facts carried out by the Court of First Instance. Second, by requiring continuous use of the trade mark during the five-year period in question, the Court of First Instance did not impose a condition that is not laid down in Article 43(2) and (3). It simply required consistent use of that mark, in accordance with that article. That plea must therefore be regarded as inadmissible and unfounded.

71 The intervener submits that merely producing the 1994/1995 catalogue and a small number of advertisements for 1995 does not suffice to establish the quantitative extent of use of that mark. The intervener therefore considers that this is merely a question of 'token use', the purpose of which is to avoid any risk of revocation.

Findings of the Court

72 With regard, first of all, to the objection that the Court of First Instance required continuous use of the trade mark THE BRIDGE (No 642952) during the whole of the reference period, there is, as is apparent from the case-law of the Court of Justice, genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration. When assessing whether use of a trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark in the course of trade is real, including, inter alia, the scale and frequency of use of the mark (see Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 70; see also, to that effect, regarding Article 10(1) of Directive 89/104/EEC, a provision which is identical to Article 15(1) of Regulation No 40/94, the judgment in Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 27).

73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider* v *OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).

74 By stating, at paragraph 35 of the judgment under appeal, that the evidence is very limited with regard to 1994 and non-existent for the period from 1996 to 1999, the Court of First Instance did not in any way require the appellant to establish continuous use of the trade mark THE BRIDGE (No 642952) throughout the whole

of the period in question. In accordance with the Court's case-law cited in paragraphs 72 and 73 of the present judgment, the Court of First Instance examined whether that trade mark had been put to genuine use during that period. To that end, the Court of First Instance assessed, at paragraphs 32 to 36 of the judgment under appeal, whether the scale and frequency of use of that mark were capable of demonstrating that it was present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign.

75 Next, in so far as the appellant complains that the Court of First Instance failed properly to evaluate the evidence adduced, it is sufficient to state that the Court of First Instance carried out an assessment of the evidence in order to determine whether, in accordance with Article 43(2) of Regulation No 40/94, read in conjunction with Article 43(3) thereof, the use of the trade mark THE BRIDGE (No 642952) had been established for the five-year period preceding the date of publication of the Community trade mark application. At paragraphs 33 to 36 of the judgment under appeal, the Court of First Instance considered whether there had been genuine use of the trade mark THE BRIDGE (No 642952) between 14 June 1994 and 14 June 1999, the date of publication of the Community trade mark application, solely on the basis of the evidence adduced by the appellant concerning the use of that mark (a 1994/1995 autumn-winter catalogue and advertisements produced in 1995) and concluded that that was not the case. Having established that the other catalogues produced were not dated, the Court of First Instance cannot be criticised for failing to take them into account in its assessment. It must also be observed that the conclusion which the Court of First Instance reached on the evidence available to it falls well within the scope of the assessment of the facts.

76 By its arguments, the appellant seeks to call into question that purely factual assessment. As was pointed out at paragraph 38 above, save where the facts in the case are distorted, which is not alleged here, that issue is not subject to review by the Court of Justice on appeal.

77 The second plea must therefore be rejected as inadmissible in part and unfounded in part.

The third plea: infringement of Article 15(2)(a) of Regulation No 40/94 in so far as the Court of First Instance excluded from its assessment the earlier trade mark Bridge (No 370836)

Arguments of the parties

78 The appellant states that the Court of First Instance misapplied Article 15(2)(a) of Regulation No 40/94 in so far as it excluded the trade mark Bridge (No 370836) from its assessment of the likelihood of confusion without determining whether that mark could be regarded as a slightly modified version of the trade mark THE BRIDGE (No 642952), it being of little importance in that connection that that mark was already registered. While the appellant acknowledges that it did not produce the necessary evidence of use with regard to the trade mark Bridge (No 370836), it is of the view that it did not need to do so in the light of the evidence of use adduced for the trade mark THE BRIDGE (No 642952) on account of the fact that the goods covered by both those marks are totally identical. The only difference between them is due to the presence of the definite article 'the'. The appellant considers that the addition of the definite article cannot alter the distinctive character of the trade mark 'Bridge' (No 370836). Moreover, the Court of First Instance's interpretation of Article 15(2)(a) of Regulation No 40/94 could give rise to discrimination as between the proprietor of a trade mark who registers it only in its 'basic' version, whilst at the same time using a number of versions, and the proprietor of a trade mark who chooses to register all the versions of his trade mark.

79 According to OHIM, that plea must be rejected as being inadmissible and unfounded. In the first place, the precondition of actual use of the trade mark THE BRIDGE (No 642952), which is simply a slightly modified form of the trade mark Bridge (No 370836), has not been met. In second place, the addition of the definite article constitutes a substantive change which alters the distinctive character of the registered trade mark. In third place, the assessment as to whether there is a 'minimum difference' between the registered sign and the sign that is actually used is a question of fact.

80 The intervener submits that Article 15(2)(a) of Regulation No 40/94 does not apply in this case because, in order for it to apply, there must be a trade mark that is registered in a certain form and used in a slightly different form, which is not the case here. Moreover, the existence, as regards the appellant, of two separate registrations constitutes of itself evidence that the appellant itself took the view that those trade marks were sufficiently different from each other.

Findings of the Court

81 Under Article 15(1) of Regulation No 40/94, a trade mark which has not been put to genuine use during the relevant period is subject to the sanctions provided for in that regulation, unless there are proper reasons for non-use.

82 Under Article 15(2)(a) of that regulation, use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered also constitutes use within the meaning of Article 15(1).

83 Those provision are essentially the same as those in Article 10(1) and (2)(a) of Directive 89/104 to approximate the laws of the Member State relating to trade marks.

84 In that regard, it must be held that the Court of First Instance did not commit any error of law in disregarding the appellant's argument that use of the trade mark Bridge (No 370836) during the reference period was established by evidence adduced for the purpose of demonstrating use of the trade mark THE BRIDGE (No 642952).

85 Without it being necessary to examine whether the trade mark THE BRIDGE (No 642952) may be regarded as being different solely by reason of elements which do not alter the distinctive character of the trade mark Bridge (No 370836), it must be stated that use of the former mark has not been established and cannot therefore in any way serve as evidence of use of the latter.

86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.

87 The third plea must therefore be rejected as unfounded.

The fourth plea: infringement of Article 43(2) and (3) of Regulation No 40/94 in so far as the Court of First Instance excluded from its assessment what are known as the 'defensive' earlier trade marks

Arguments of the parties

88 According to the appellant, the Court of First Instance misapplied Article 43(2) and (3) of Regulation No 40/94 by considering the concept of defensive trade marks to be incompatible with the system of protection of the Community trade mark.

89 First of all, the Court of First Instance ought to have treated that argument, which was raised for the first time before OHIM, as inadmissible.

90 The Board of Appeal concluded that the earlier marks Nos 370836, 704338, 606709 and 593651 should be excluded from the assessment of the likelihood of confusion solely because they predated the principal trade mark and not because the concept of 'defensive trade marks' was as such incompatible with Community legislation. The appellant maintains that the Court of First Instance should simply have assessed whether those marks met the conditions laid down under the new Italian Code on industrial property for them to be regarded as defensive, in the same way as the Board of Appeal had done.

91 Next, it would be incorrect to maintain, as did the Court of First Instance, that the Italian Code on intellectual property protects unused marks. In fact, under that code, there cannot be revocation for lack of use where the proprietor of an unused defensive trade mark is at the same time proprietor of one or more similar trade marks which are still in force, at least one of which is actually used to designate the same goods or services as those protected by that defensive mark. Lastly, the appellant adds that recognition at national level of defensive trade marks can constitute a 'proper reason' for non-use within the meaning of Article 43(2) of Regulation No 40/94.

92 According to OHIM, this plea must be regarded as inadmissible in so far as recognition of 'defensive' trade marks is dependent on actual use of the principal trade mark THE BRIDGE (No 642952). That is a question of fact which has already been decided in the negative by the Court of First Instance. Next, the argument raised before that Court that the Italian law recognising the concept of defensive trade marks is incompatible with the system of protection of the Community trade mark is not inadmissible on the ground that the issue was not debated *inter partes*, since, according to OHIM, it is simply an extension of the argument already raised before the Board of Appeal, according to which there is an obligation to use defensive trade marks.

93 As to the substance, OHIM points out, first, that actual use of a trade mark is an essential precondition for conferring exclusive property rights on the proprietor of a trade mark. Second, OHIM considers that the appellant is placing the protection relating to the concept of 'defensive marks' on the same footing as the protection conferred in the context of Article 15(2)(a) of Regulation No 40/94. However, the differences between what are described as the 'defensive' trade marks and the unused principal trade mark THE BRIDGE (No 642952) are of sufficient magnitude to change the distinctive character of that mark.

94 The intervener submits, in the first place, that the Italian law on trade marks requires the date of application for registration of defensive trade marks to be the same as or later than that of the principal trade mark. Secondly, it submits that an application for registration of a defensive mark must be made in respect of the same classes of goods as the principal trade mark, whereas the appellant considers that trade marks which are in a different class to that of its principal mark are also defensive marks. Thirdly, the intervener maintains that defensive trade marks need display only a slight variation vis-à-vis the principal trade mark. None of those conditions is met in the present case. In any event, the taking into account of defensive registrations is incompatible with the Community system for the protection of trade marks.

Findings of the Court

95 First of all, the Court of First Instance did not err in law in its decision on OHIM's argument that the concept of defensive trade marks is incompatible with Regulation No 40/94.

96 Admittedly, in proceedings concerning an action against a decision of an appeal board of OHIM on an opposition to registration of a mark based on the likelihood of confusion with an earlier mark, OHIM cannot alter the terms of the dispute before

the Court of First Instance, as delimited in the respective claims and allegations of the applicant for registration and of the opposing party (see, to that effect, Case C-106/03 P *Vedial* v *OHIM* [2004] ECR I-9573, paragraph 26, and, by analogy, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 58).

97 However, it may be noted that one of the arguments put forward by the appellant before the Board of Appeal with regard to the assessment of the likelihood of confusion was that, on the basis of the use of the trade mark THE BRIDGE (No 642952), a number of other marks should be taken into account as defensive marks. In so far as that argument raised the question whether, under Italian law, trade marks the use of which had not been established could nevertheless be regarded as 'defensive trade marks', OHIM's argument before the Court of First Instance that such a possibility was not permitted under Community law did not depart from the confines of the dispute before the Board of Appeal.

98 Moreover, as the Advocate General observed in point 87 of her Opinion, in so far as the Board of Appeal based its decision, albeit implicitly, on a misinterpretation of Community law, the Court of First Instance cannot be criticised for substituting a correct interpretation of that law for that used by the Board of Appeal.

99 Next, it is necessary to consider the Court of First Instance's conclusion, at paragraph 47 of the judgment under appeal, that the appellant could not rely on the allegedly defensive nature, under the Italian law on trade marks, of certain earlier trade marks disregarded by the Board of Appeal.

100 In that regard, it should be noted that, under Article 43(2) and (3) of Regulation No 40/94, opposition to registration of a Community trade mark by the proprietor of an earlier Community or national trade mark must be rejected if that proprietor

does not, at the request of the applicant, furnish proof that, during the five-year period preceding the date of publication of the Community trade mark application, the earlier trade mark has been put to genuine use in the Community or in the Member State in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use. Furthermore, Article 56(2) of Regulation No 40/94 contains an identical rule for cases involving applications for revocation or for a declaration of nullity of a Community trade mark.

101 The Court of First Instance did not err in law in holding, at paragraph 46 of the judgment under appeal, that a proprietor of a national registration who opposes a Community trade mark application cannot, in order to avoid the burden of proof which rests upon him under Article 43(2) and (3) of Regulation No 40/94, rely on a national provision which allows the registration, as trade marks, of signs not intended to be used in trade on account of their purely defensive function in relation to another sign which is being commercially exploited.

102 The concept of 'proper reasons' mentioned in that article refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark, rather than to national legislation which makes an exception to the rule that a trade mark that has not been used for a period of five years must be revoked, even where such lack of use is intentional on the part of the proprietor of the trade mark.

103 The argument that the holder of a national registration who opposes a Community trade mark application can rely on an earlier trade mark the use of which has not been established on the ground that, under national legislation, that earlier mark constitutes a 'defensive trade mark' is therefore incompatible with Article 43(2) and (3) of Regulation No 40/94.

104 It follows that the fourth plea must be rejected as unfounded.

105 It follows from the foregoing that the appeal must be dismissed in its entirety.

Costs

106 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM and the intervener have applied for costs and the appellant has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Fourth Chamber) hereby:

1. Dismisses the appeal;

2. Orders Il Ponte Finanziaria SpA to pay the costs.

[Signatures]