OPINION OF ADVOCATE GENERAL KOKOTT

delivered on 26 October 2006 [1]

I — Introduction

1. The present case concerns the question whether two trade marks in respect of medicinal products, the word mark TRAVATAN and the earlier Italian word mark TRIVASTAN, may be confused, which would mean that registration of TRAVATAN as a Community mark is not permissible. Such a likelihood of confusion has been found to exist at every instance to date, that is to say by the Opposition Division and the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM' or 'the Office') and by the Court of First Instance.

2. In the appeal, it must be examined, first, whether the Court of First Instance was right in dismissing submissions by the appellant because they were made too late and, second, whether it examined the likelihood of confusion correctly, in particular as regards the relevant public.

II — Legal context

3. Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [2] governs the relative ground for refusal constituted by a likelihood of confusion:

'Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) ...

1 — Original language: German.

2 — OJ 1994 L 11, p. 1.

(b) 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.'

4. The seventh recital in the preamble explains the concept of 'likelihood of confusion' in the case of similarity between marks and between goods or services. The likelihood of confusion, 'the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for ... protection'.

5. An earlier mark can prevent registration of a new mark, however, only if it is still being put to genuine use. Article 43(2) and (3) of Regulation No 40/94 therefore provides:

'2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in 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. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

III — Background to the dispute and the judgment of the Court of First Instance

6. The Court of First Instance set out the background to the dispute as follows in paragraphs 1 to 11 of the contested judgment of 22 September 2005 in Case T-130/03: [3]

'1 On 11 June 1998, Alcon Inc. filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark in respect of which registration was sought is the word mark TRAVATAN.

3 The goods in respect of which registration of the trade mark was sought are in Class 5 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: "Ophthalmic pharmaceutical preparations".

4 The application was published in *Community Trade Marks Bulletin* No 23/99 of 22 March 1999.

5 On 22 June 1999, Biofarma SA filed an opposition under Article 42 of Regulation No 40/94 against the registration of that Community trade mark. The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of Regulation No 40/94. The opposition was based on the existence of the national word mark TRIVASTAN, registered in Italy on 27 January 1986 under No 394980.

6 The opposition was filed against all goods covered by the trade mark application. It was based on all the goods covered by the earlier mark, namely "Pharmaceutical, veterinary and hygiene products; dietary products

3 — *Alcon* v *OHIM* [2005] ECR II-3859.

for infants or patients; plasters; materials for dressings; tooth fillings and dental impressions; disinfectants; herbicides and pesticides", in Class 5.

7 By letter of 5 May 2000, the applicant requested that the intervener furnish proof, in accordance with Article 43(2) and (3) of Regulation No 40/94, that the earlier mark had, during the period of five years preceding the date of publication of the Community trade mark application, been put to genuine use in the Member State in which it is protected in connection with all the goods on which the opposition is based. By letter of 29 May 2000, the Opposition Division requested the intervener to furnish such proof within two months.

8 On 28 July 2000, the intervener sent documents to OHIM intended to demonstrate genuine use of the earlier mark in Italy. In particular, among these documents were invoices, the explanatory notice relating to the intervener's medicinal product, an extract from the Italian directory *L'Informatore Farmaceutico* and an extract from the *Pharmaceutical Trade Mark Directory.*

9 By decision of 26 September 2001, the Opposition Division found that the use of the earlier mark was proven in respect of a specific pharmaceutical product, namely a "peripheral vasodilator intended to treat peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear", and it allowed the opposition for all the goods claimed. It therefore refused registration of the mark applied for on the ground that there was a risk of confusion, including the risk of association, in Italy, given the fact that the marks were similar both visually and phonetically and that there was a degree of similarity between the goods.

10 On 13 November 2001, the applicant filed an appeal with OHIM against the decision of the Opposition Division pursuant to Articles 57 to 62 of Regulation No 40/94.

11 By decision of 30 January 2003 ("the contested decision"), the Third Board of Appeal dismissed the appeal. It essentially held that, since the goods designated by the marks at issue displayed a high degree of similarity and there were considerable visual and phonetic similarities between the marks, there was a likelihood of confusion, including a likelihood of association, between the goods in question.'

7. The Court of First Instance dismissed the action brought by Alcon against the decision of the Board of Appeal.

8. It held that the plea that the conditions concerning genuine use in accordance with the judgment in *MFE Marienfelde* v *OHIM — Vétoquinol (HIPOVITON)*[4] were not satisfied was inadmissible because it had been put forward too late and, moreover, had not been advanced before the Board of Appeal (paragraph 19 et seq.).

9. Nor did Alcon refute the finding of the Board of Appeal that the evidence provided by the intervener demonstrated genuine use of the earlier mark in respect of a 'peripheral vasodilator intended to treat peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear' (paragraph 29 et seq.).

10. Finally, according to the Court of First Instance, the Board of Appeal was also right in finding that there was a likelihood of confusion between the two marks. Both the respective goods (paragraph 55 et seq.) and the signs to be compared (paragraph 65 et seq.) were very similar. Italian consumers in particular could confuse the two signs (paragraph 72 et seq.).

IV — The appeal

11. Alcon challenges the dismissal by the Court of First Instance of its plea concerning the conditions for genuine use as inadmissible, and takes the view that the Court erred in its assessment of the likelihood of confusion, in particular by failing to have sufficient regard to the role of healthcare professionals.

12. Alcon accordingly claims that the Court should:

(1) set aside the decision challenged;

(2) if necessary, remit the case back to the Court of First Instance; and

4 — Case T-334/01 [2004] ECR II-2787.

(3) order OHIM and/or the intervener to pay the costs.

V — Appraisal

A — *First ground of appeal — admissibility of the plea concerning genuine use of the earlier mark*

13. OHIM considers the appeal essentially to be unfounded, but in several respects also to be inadmissible, and therefore contends that the Court should:

(1) dismiss the appeal as partly inadmissible and partly unfounded; and

(2) order the appellant to pay the costs.

14. Biofarma did not take part in the proceedings until the oral procedure and endorses the form of order sought by OHIM.

15. The Court of First Instance observed in paragraph 20 of the contested judgment 'that, in its application, the applicant did not complain that the Board of Appeal had infringed Article 43(2) and (3) of Regulation No 40/94 in so far as the conditions concerning genuine use of the earlier mark were not satisfied, but only in so far as the evidence of genuine use submitted by the intervener did not show that the earlier mark had actually been used in respect of ophthalmic products'. It concluded from this that Alcon's plea at the hearing in respect of the conditions concerning genuine use was a new plea in law and therefore inadmissible.

16. Alcon states in objection that its plea as to the conditions concerning genuine use is only a new argument to substantiate the actual plea in law, namely infringement of Article 43(2) and (3) of Regulation No 40/94.

17. Under Article 48(2) of the Rules of Procedure of the Court of First Instance, no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. A plea which may be regarded as amplifying a plea made previously, whether directly or by implication, in the original application must, however, be considered admissible. [5]

18. The application of this procedural provision can be illustrated by cases from areas of law other than trade mark law. Thus, in a case where the original complaint was that several requirements of Article 87(1) EC had been infringed, the Court of Justice held that a new plea that the measure in question benefited not only undertakings for the purposes of Article 87(1) EC but also other persons was a permissible amplification. [6] It likewise regarded the complaint that the Commission had failed to investigate the effect on trade adequately as an amplification of the plea that there was no effect on trade at all. [7] A complaint alleging a procedural error, namely a failure to give a hearing, has been found to be a permissible amplification, after it was initially argued only that compliance with the substantive conditions for the adoption of the safeguard measure at issue had not been sufficiently clarified. [8] Finally, the Court has also found a newly raised argument that in a selection procedure under the Staff Regulations an age-limit should have been made publicly known to be an amplification of the plea that there was no legal basis for applying the age-limit. [9]

19. The situation is similar in the present case. In its application Alcon had challenged the findings on genuine use in accordance with Article 42(2) and (3) of Regulation No 40/94. It submitted that Biofarma had not proved any use that would have been capable of giving the mark a sufficient reputation with the relevant Italian public. Nor had use of the medicinal product for ophthalmic purposes been proved. According to what is stated by the Court of First Instance in paragraph 17 of the contested judgment, at the hearing Alcon then 'referred to the judgment in Case T-334/01 *MFE Marienfelde* v *OHIM — Vétoquinol (HIPOVITON)* [2001] ECR II-2787 in order to claim that the conditions concerning genuine use were not satisfied, in particular because of the low volume of sales of the earlier mark'.

5 — See, on the Rules of Procedure of the Court of Justice which are couched in identical terms, Case 306/81 *Verros* v *Parliament* [1983] ECR 1755, paragraph 9; Case C-301/97 *Netherlands* v *Council* [2001] ECR I-8853, paragraphs 166 and 169; and Case C-66/02 *Italy* v *Commission* [2005] ECR I-10901, paragraphs 85 and 86.

6 — *Italy* v *Commission*, cited in footnote 5, paragraphs 87 and 88.

7 — *Italy* v *Commission*, cited in footnote 5, paragraphs 103 and 108.

8 — *Netherlands* v *Council*, cited in footnote 5, paragraphs 157 et seq. and 169.

9 — *Verros* v *Parliament*, cited in footnote 5, paragraphs 7 and 10.

20. This plea clearly amplifies the reasoning in support of the plea that Article 43(2) and (3) of Regulation No 40/94 had been infringed. It is therefore not an inadmissible new plea, but a permissible amplification of a plea put forward at the appropriate time. The finding that it was made too late in the judicial proceedings is therefore wrong in law.

21. However, in paragraph 23 of the contested judgment the Court of First Instance dismissed this plea additionally on the basis of a second reason, stating that its review could not go beyond the factual and legal context of the dispute as brought before the Board of Appeal. The Court further correctly found that according to the case-file Alcon did not in fact call into question before the Board of Appeal or the Opposition Division the fact that the earlier mark had been put to genuine use, and indeed expressly waived any challenge to the evidence of its genuine use. [10] The arguments contested only that the mark had been used for a comparable product. [11] The Court therefore came to the conclusion that the arguments contesting genuine use of the earlier mark were also inadmissible because the proceedings before the Board of Appeal had not concerned them.

22. This alternative basis for dismissing the arguments contesting genuine use corresponds to Article 135(4) of the Rules of Procedure of the Court of First Instance. Under this provision, the parties before the Court may not change the subject-matter of the proceedings before the Board of Appeal. Since Alcon waived its right to dispute the relevant evidence, the subject-matter of the proceedings before the Board of Appeal did not include whether there was genuine use. Therefore, the Court of First Instance rightly dismissed this plea as inadmissible.

23. It is true that Alcon puts forward the view that to restrict in this way the subject-matter of proceedings before the Court of First Instance to the subject-matter of the proceedings before the Board of Appeal would preserve decisions which, in the light of subsequent case-law, are clearly contrary to the law. However, this view is misconceived. If a party contests throughout a certain aspect of the Office's application of the law, he can of course successfully challenge that application if the Court of First Instance has in the meantime decided this legal question in a manner favourable to him. However, if a party — like Alcon in the present case — chooses not to raise arguments on a particular issue, even subsequent case-law will not enable him to put forward for the first time before the Court of First Instance a plea to that effect.

24. The first ground of appeal should therefore be dismissed.

10 — See the second set of observations before the Opposition Division, Annex 7 to the application at first instance (p. 73 of the annexes).

11 — See the grounds in support of the appeal before the Board of Appeal, Annex 3 to the application at first instance (p. 38 of the annexes).

B — *Second ground of appeal — infringement of Article 8(1)(b) of Regulation No 40/94*

25. By the second ground of appeal, Alcon puts forward arguments, divided into six limbs, challenging the application of Article 8(1)(b) of Regulation No 40/94.

1. The sixth limb — restriction of the list of goods

26. In the sixth limb, which is to be dealt with first, Alcon objects to the products compared by the Board of Appeal and the Court of First Instance. It submits that before the Board of Appeal it deliberately confined the specification of its product to 'ophthalmic pharmaceuticals for the treatment of glaucoma', thus diminishing further any similarity between the goods.

27. In paragraphs 51 to 55 of the contested judgment, the Court of First Instance stated that this restriction had not been made in accordance with the requirements of Article 44 of Regulation No 40/94 and Rule 13 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94.[12] Also, a restriction of goods contained in an application for a Community trade mark had to be made expressly and unconditionally. The Court found that Alcon had not submitted a request that the specification of the products be restricted, but merely expressed its willingness to restrict it. Therefore, in accordance with the trade mark application, regard had to be had to all ophthalmic pharmaceutical products.

28. It must be stated that in principle Alcon was entitled to restrict the specification of the product before the Board of Appeal since Article 44(1) of Regulation No 40/94 allows the list of goods or services contained in the trade mark application to be restricted at any time. It is only in judicial proceedings that Article 135(4) of the Rules of Procedure precludes a restriction since it would change the subject-matter of the proceedings.[13]

29. However, the Court of First Instance rightly requires in settled case-law that a

12 — OJ 1995 L 303, p. 1.

13 — Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 58.

restriction of goods contained in an application for a trade mark be made expressly and unconditionally. [14] The restriction may be of considerable significance for the scope of protection under the trade mark and — as is clear in the present case — for the mark's registrability.

30. Since Alcon did not declare a restriction, but merely stated that it was willing so to do, the Court of First Instance was able, without distorting Alcon's statement, to come to the conclusion that the goods contained in the application had not been restricted.

31. Nor can the Board of Appeal be regarded as having made a procedural error by not calling on Alcon to clarify its statement. Such a clarification would, it is true, probably have been useful from the point of view of procedural economy, but there is no provision that would oblige the Board of Appeal to bring about such clarification. Rather, Rule 13(3) of Regulation No 2868/95 relates to some other (formal) deficiencies of which the Office must notify the applicant, specifying a period for their remedy, if the requirements governing amendment of the application are not fulfilled. This obligation arises, however, only once the applicant has made a request for amendment.

14 — See the references in paragraph 51 of the contested judgment.

32. In the present case, there is no reason to burden OHIM with further notification obligations that are not expressly laid down. Like most parties to proceedings before OHIM, Alcon is a large undertaking operating internationally which must have sufficient expertise to participate on its own responsibility in trade mark proceedings or — as here — to instruct qualified representatives. Alcon should therefore have realised itself that a statement of willingness to restrict the goods contained in the application is not equivalent to their restriction.

33. The Court of First Instance therefore did not err in law when, like the Board of Appeal, it used for the comparison of the products the goods contained in the application for a trade mark, namely ophthalmic pharmaceutical preparations. This limb is therefore unfounded.

2. The second limb — comparison of the products

34. It likewise follows from the findings on the sixth limb that the second limb too — in so far as it is not inadmissible from the outset — is in any event unfounded.

35. In this limb, Alcon complains that the Court of First Instance failed to require Biofarma to produce evidence of the similarity of both products. It submits that Travatan is administered in the form of eye drops, while Trivastan is a tablet. For that reason alone the products are not similar.

36. This limb is inadmissible in so far as it ostensibly concerns the actual comparison of the products. It is clear from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal lies on points of law only. The Court of First Instance has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal.[15] Distortion of evidence is not apparent here, nor is it pleaded by Alcon.

37. However, in this limb Alcon also objects to the determination of the products compared. The question whether the comparison must be limited to two specific medicinal products in the respective forms in which they are administered is a point of law to be examined on appeal.

38. Alcon is wrong though in its submission that it is in eye-drop form that the medicinal product Travatan is to be considered. As already explained, for the trade mark applied for here the group of goods constituted by ophthalmic pharmaceutical preparations must be used as the basis for comparison. This group encompasses medicinal products which are sold for administration in various forms, hence also products which, like the product to be compared, are offered in tablet form.

39. This limb too should therefore be dismissed.

3. The first limb — the relevant public

40. In the first limb, Alcon submits that OHIM defined the relevant public incorrectly.

15 — See specifically in respect of trade mark law, Case C-136/02 P *Mag Instrument* v *OHIM* [2004] ECR I-9165, paragraph 39, and Case C-37/03 P *BioID* v *OHIM* [2005] ECR I-7975, paragraph 43; see to this effect also Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 22, and, more generally, Case C-390/95 P *Antillean Rice Mills and Others* v *Commission* [1999] ECR I-769, paragraph 29, Case C-237/98 P *Dorsch Consult* v *Council and Commission* [2000] ECR I-4549, paragraphs 35 and 36, and Joined Cases C-204/00 P, C-205/00 P, C-211/00 P, C-213/00 P, C-217/00 P and C-219/00 P *Aalborg Portland and Others* v *Commission* [2004] ECR I-123, paragraph 49.

41. In paragraph 49 of the contested judgment the Court of First Instance found:

'It is common ground that the products in question are medicinal products requiring a doctor's prescription prior to their sale to end users in pharmacies. Consequently, the relevant public is composed not only of end users, but also of professionals, that is doctors who prescribe the medicinal product and pharmacists who sell that prescribed product.' [16]

42. In its statements on the likelihood of confusion in paragraphs 68, 69 and 72 et seq., the Court confirms the analysis of the Board of Appeal on the basis of the perception of consumers. Only in paragraph 73 are professionals mentioned as a possible component of the relevant public, but the findings are again based on the perception of consumers.

43. Alcon contests the inclusion of end users in the relevant public. Since the products require a prescription, solely the doctor makes the decision as to their acquisition. Therefore only the perception of healthcare professionals is relevant. Another OHIM Board of Appeal, [17] the Court of First Instance [18] and the Court of Justice [19] have already so decided.

44. The Office and Biofarma, on the other hand, take the view that the perception of patients matters too. The Office stresses that when patients are confronted by a mark, they are not to be misled as to the origin of the goods designated. Their perception is irrelevant only if their being confronted with the mark can be ruled out. [20] Biofarma supplements this with the practical example of confusing two medicinal products in the medicine cabinet at home.

45. This limb relates, first, to a factual element, namely the determination as to

16 — Similarly, Case T-154/03 *Biofarma* v *OHIM — Bausch & Lomb Pharmaceuticals (ALREX)* [2005] ECR II-4743, paragraph 45; the appeal (Case C-95/06 P) against this judgment has in the meantime been withdrawn.

17 — Alcon relies on the decision of the First Board of Appeal of 12 May 2004 in Case R 304/2003-1 *Pierre Fabre Medicament, SA* v *Fujisawa Deutschland GmbH (RIBOMUSTIN/ RIBOMUNYL).*

18 — Alcon relies on Case T-237/01 *Alcon* v *OHIM — Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 42.

19 — Alcon relies on the order in Case C-192/03 P *Alcon* v *OHIM — Dr. Robert Winzer Pharma (BSS)* [2004] ECR I-8993, paragraph 30.

20 — This seems to be so in the case of the mark BSS, which is used for a product for ophthalmic surgery and the distinctive character of which is determined by the perception of medical professionals (see the order in *BSS*, cited in footnote 19, paragraph 30).

the public addressed by the goods in question, and is inadmissible to that extent. [21]

46. Second, at the same time it contests the interpretation of Article 8(1)(b) of Regulation No 40/94 with regard to the definition of the relevant public. In addition, it implies that the reasoning for the findings of the Court of First Instance is insufficient, since reasons are not stated for the inclusion of end users despite submissions to the contrary. Both aspects concern points of law, and the limb is therefore admissible to this extent.

47. The Court of Justice focuses on the perception of the mark in the mind of the average consumer of the type of goods or services in question. [22] In general, the perception of consumers or end users will play a decisive role as the aim of the whole commercialisation process is the purchase of the product by those persons. [23] However, this is true only where the end user makes the decision on the purchase.

48. In the case of medicinal products available only on prescription, the choice between various products is made not upon acquisition but earlier, during the medical consultation. Medicinal products available only on prescription are, because of the risks attaching to them, subject to special control by doctors, and also by pharmacists. This justifies even restrictions on intra-Community trade [24] and finds expression in the relevant secondary legislation. Under the first indent of Article 88(1) of Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 on the Community code relating to medicinal products for human use, [25] Member States are to prohibit the advertising to the general public of medicinal products which are available on prescription only. In principle, therefore, the acquisition of medicinal products available only on prescription is to be decided upon by health professionals and not end consumers.

49. Even if regard is nevertheless in principle had to patients too, because — as submitted

21 — See above, point 36.

22 — 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, which concern Article 4(1)(b) 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), a provision corresponding to Article 8(1)(b) of Regulation No 40/94.

23 — Case C-371/02 *Björnekulla Fruktindustrier* [2004] ECR I-5791, paragraph 24.

24 — Case C-322/01 *Deutscher Apothekerverband* [2003] ECR I-14887, paragraph 119.

25 — OJ 2001 L 311, p. 67.

in particular by the Office at the hearing — they can influence a doctor's prescription, in the case of medicinal products available only on prescription their influence has very little significance when compared with the doctor's responsibility for the decision. [26]

50. In particular, the possible influence exerted by patients cannot mean that the *patient* is regarded as the reasonably well informed and reasonably observant and circumspect consumer of those products. The average consumer must rather be determined by reference to the group that largely determines decisions on the acquisition of medicinal products available only on prescription, that is to say by reference to prescribing doctors.

51. The risk, pointed out by OHIM and Biofarma, of confusion on the part of a patient who, independently of prescription, is confronted with the mark, is also of little significance, under trade mark law at any rate. In the *Picasso* judgment, the Court of Justice regarded the moment when the choice between the goods and marks is made as crucial for assessing the likelihood of confusion. [27] Other points in time, at which confusion on the part of consumers might be more likely because they display a lesser level of attention, are by contrast of secondary importance. [28]

52. Therefore, Alcon is correct in its argument that the relevant public for medicinal products available only on prescription is to be determined by reference to healthcare professionals, and not patients. Despite this submission, the Court of First Instance does not deal with the legal question of how the public under Article 8(1)(b) of Regulation No 40/94 is to be defined, nor does it explain why, contrary to Alcon's submission, it includes end users in the relevant public.

53. Consequently, at the very least the reasoning in the contested judgment is insufficient, both so far as the interpretation of Article 8(1)(b) of Regulation No 40/94 is concerned and with regard to the specific inclusion of end users. If the Court of First Instance were in fact to be proceeding on the basis that, irrespective of the product at

26 — See the judgments of the Bundesgerichtshof (Federal Court of Justice, Germany) of 15 October 1992 in Case I ZR 259/90 (CORVATON/CORVASAL, Gewerblicher Rechtsschutz und Urheberrecht 1993, 118, 119), of 2 February 1989 in Case I ZR 150/86 (Herzsymbol, Gewerblicher Rechtsschutz und Urheberrecht 1989, 425, 428) and of 25 January 1990 in Case I ZR 83/88 (L-THYROXIN, Gewerblicher Rechtsschutz und Urheberrecht 1990, 453, 455). See, to similar effect, the decision of the Hearing Officer of the UK Patent Office, S.J. Probert, of 29 January 1998 (Application No 1582474 filed by Dallas Burston Ashbourne Limited and Opposition No 42375 filed by Warner-Lambert Company (DICLOTARD), http://www.patent.gov.uk/tm/legal/decisions/inter1998/o01198.pdf, p. 13, line 12 et seq.).

27 — Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-643, paragraph 40.

28 — The *Picasso* judgment, cited in footnote 27, paragraph 41 et seq.

issue, it is always the average end user that matters, that would involve, in addition to the defective reasoning, an incorrect interpretation of Article 8(1)(b) of Regulation No 40/94.

54. In the present case, however, inclusion of the end user can be upheld at least on other grounds. Here it is not two medicinal products available only on prescription that are to be compared but, on the one hand, the group of goods — ophthalmic pharmaceutical preparations — specified in the application and, on the other, the medicinal product available only on prescription that has been marketed under the trade mark TRIVASTAN. As Alcon acknowledged in response to a question put in the course of the oral procedure, on the Italian market not all ophthalmic pharmaceutical preparations are available only on prescription.

55. In the case of trade marks for medicinal products sold without a prescription, the perception of the end user is of very much greater importance. While it is true that these products may be acquired at the instigation of doctors, in many cases the end users decide by themselves on their purchase. Therefore they are also advertised to end users. [29]

29 — See Article 88(2) of Directive 2001/83.

56. The perception of the end user is also of importance in particular for an examination, as must be conducted here, of the likelihood of confusion between, on the one hand, a group of goods including both medicinal products sold without a prescription and medicinal products available only on prescription and, on the other hand, a medicinal product available only on prescription. If the end user wants to purchase the product sold without a prescription but, as the result of confusion, asks for the product requiring a prescription, the pharmacy will refuse to sell the latter. If, on the other hand, because of confusion, he asks for the product sold without a prescription although he actually wanted the product available only on prescription for his ailment, it is possible that he will obtain a product that does not help him.

57. The reduction of the relevant public to doctors which Alcon seeks would therefore be permissible in the present case only if the likelihood of confusion in respect of ophthalmic pharmaceutical preparations available only on prescription could be examined separately. That would presuppose that the list of goods can be split.

58. In principle it is possible to limit the grant or refusal of a trade mark application to certain constituents of the list of goods. Under the first sentence of Article 43(5) of

Regulation No 40/94, an application for a trade mark is to be refused only in respect of those goods or services which, on the basis of the opposition, may not be registered.

59. In the present case, however, this is irrelevant since Alcon did not subdivide the comprehensive generic term 'ophthalmic pharmaceutical preparations' and neither the Office nor the courts can correct the list of goods accordingly of their own motion. It is admittedly possible to refuse registration for individual, expressly named goods or groups of goods, but the further subdivision into groups of goods would encroach upon the applicant's powers over his application. Furthermore, the formal requirements for restricting the list of goods would be circumvented and — should the subdivision be made in judicial proceedings — the facts upon which the Office has ruled would be altered. [30]

60. Consequently, the Court of First Instance was able to determine whether there was a likelihood of confusion solely on the basis of the perception of the end user. Hence, notwithstanding the legal errors in the contested judgment, it is not to be set aside as a result of the first limb of the second ground of appeal.

4. The third and fourth limbs — comparison of the signs

61. In the third and fourth limbs, Alcon contests the visual and phonetic comparison of the signs. However, Alcon thereby challenges exclusively the findings of fact made by the Court of First Instance. The appeal is therefore inadmissible in this regard. [31]

5. The fifth limb — likelihood of confusion

62. In so far as Alcon challenges the assessment of the likelihood of confusion, it essentially relies on the fact that insufficient account was taken of doctors and pharmacists. As already explained, a likelihood of confusion on the part of end users is, however, sufficient, since the list of goods for the mark TRAVATAN also included medicinal products sold without a prescription. [32] The appeal is therefore unfounded in this regard.

30 — A similar result was reached in the judgments of the Bundespatentgericht (Federal Patents Court, Germany) of 20 November 1997 in Case 30 W (pat) 123/97 ('Plantapret', Gewerblicher Rechtsschutz und Urheberrecht 1998, 725 (727)) and of the Bundesgerichtshof of 12 February 1998 in Case I ZB 32/95 ('salvent/Salventerol', BGH Gewerblicher Rechtsschutz und Urheberrecht 1998, p. 924 (925)).

31 — See above, point 36.

32 — See above, point 54.

VI — Costs

63. Under Article 122 of the Rules of Procedure of the Court of Justice, in conjunction with Articles 118 and 69(2) 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 Alcon is unsuccessful with its appeal, it has to bear the costs.

VII — Conclusion

64. I accordingly propose that the Court should:

(1) dismiss the appeal;

(2) order Alcon Inc. to pay the costs of the proceedings.