JUDGMENT OF THE COURT (Fifth Chamber)

24 March 2011 *

In Case C-552/09 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, lodged on 23 December 2009,

Ferrero SpA, established in Alba (Italy), represented by C. Gielen, advocaat,

appellant,

the other parties to the proceedings being:

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

defendant at first instance,

* Language of the case: English.

Tirol Milch reg. Gen.mbH Innsbruck,

party to the procedure before the Board of Appeal,

THE COURT (Fifth Chamber),

composed of A. Borg Barthet (Rapporteur), acting as President of the Fifth Chamber, M. Ilešič and E. Levits, Judges,

Advocate General: J. Kokott,
Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 30 November 2010,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

Judgment

1 By its appeal, Ferrero SpA ('Ferrero') requests the Court to set aside the judgment of 14 October 2009 in Case T-140/08 *Ferrero* v *OHIM - Tirol Milch (TiMi KiNDERJOGHURT)* [2009] ECR II-3941 ('the judgment under appeal'), by which the Court of First Instance of the European Communities (now 'the General Court') dismissed the action which Ferrero had brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 30 January 2008 (Case R 682/2007-2), concerning invalidity proceedings between Ferrero and Tirol Milch reg. Gen.mbH Innsbruck ('the contested decision').

Legal context

2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Nevertheless, in view of the time at which the events occurred, the present case remains governed by Regulation No 40/94.

3 The seventh recital in the preamble to Regulation No 40/94 stated:

'… the protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and the goods or services; … the

protection applies also in cases of similarity between the mark and the sign and the goods or services; … an interpretation should be given of the concept of similarity in relation to the likelihood of confusion; … 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 such protection.'

4 Article 8(1) of Regulation No 40/94 provided:

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

…

(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.'

5 Under Article 8(5) of Regulation No 40/94:

'Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or

services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.'

6 Under Article 49(1) and (2) of Regulation No 40/94:

'1. A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.

2. The surrender shall be declared to [OHIM] in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.'

7 Paragraph 1 of Article 52 of Regulation No 40/94, which was entitled 'Relative grounds for invalidity', provided:

'A Community trade mark shall be declared invalid on application to [OHIM] or on the basis of a counterclaim in infringement proceedings:

(a) where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;

…'

8 Article 54(2) of Regulation No 40/94 provided:

'The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.'

Background to the dispute

9 On 8 April 1998, Tirol Milch reg. Gen.mbH Innsbruck ('Tirol Milch'), established in Innsbruck (Austria), filed an application with OHIM for registration of the following figurative sign as a Community trade mark:



10 The goods for which registration was sought fall within Class 29 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 ('the Nice Agreement'), and correspond to the following description:

'Yoghurt, fruit yoghurt, yoghurt drinks, yoghurt drinks containing fruit; semi-prepared and ready-to-serve meals based mainly on yoghurt or yoghurt products; yoghurt creams.'

11 On 14 January 1999, Ferrero filed a notice of opposition to registration of the trade mark applied for, in respect of all of the goods covered by that mark, on the basis of its earlier word mark KINDER, registered in Italy since 28 January 1965 under No 168 843 and after renewal under No 684 985, for goods in Class 30 of the Nice Agreement which correspond to the following description:

'coffee, tea, sugar, rice, tapioca, sago, coffee substitutes; bread, biscuits, cakes, pastry and confectionery, edible ice-creams; honey, treacle, yeast and baking powders; salt, mustard; pepper, vinegar, sauces, spices; edible ice; cocoa, cocoa products, namely cocoa paste for cocoa drinks, chocolate paste, coverings, namely chocolate coverings, chocolate, pralines, decorations for Christmas trees made of chocolate, goods made of an edible chocolate case with an alcoholic filling, sugar articles, confectionery, including fine and hard pastry.'

12 By decision of 29 September 2000, the Opposition Division of OHIM rejected the opposition on the basis of Article 8(1)(b) and (5) of Regulation No 40/94.

13 That decision was upheld on 3 November 2003 by the Fourth Board of Appeal of OHIM.

14 The mark TiMi KiNDERJOGHURT was registered on 20 August 2004 and was published in the *Community Trade Marks Bulletin* of 11 October 2004.

15 On 19 August 2005, Ferrero filed an application with OHIM under Article 52(1)(a) of Regulation No 40/94 for a declaration that registration of that Community trade mark was invalid. The application related to all the goods covered by that trade mark.

16 By decision of 14 March 2007, the Cancellation Division of OHIM declared the Community trade mark TiMi KINDERJOGHURT invalid pursuant to Article 8(5) of Regulation No 40/94.

17 On 4 May 2007, Tirol Milch filed an appeal with OHIM, under Article 59 of Regulation No 40/94, against the Cancellation Division's decision.

18 By the contested decision, the Second Board of Appeal of OHIM annulled the decision of the Cancellation Division and dismissed the application for a declaration of invalidity.

19 The Board of Appeal held in essence, first, that although decisions in opposition proceedings do not in law have the force of *res judicata*, the Cancellation Division

remained bound by the substantive findings and conclusions of the earlier OHIM decisions by virtue of the principle *nemo potest venire contra factum proprium*, in accordance with which the administration must comply with its own acts, particularly where those acts have enabled parties to the proceedings legitimately to acquire rights in a registered trade mark. Secondly, the Board of Appeal upheld the findings made in the decision of the Opposition Division and the decision of the Fourth Board of Appeal of 3 November 2003 to the effect that, in view of their substantial visual and phonetic differences, the marks were dissimilar overall. Lastly, the Board dismissed the application for a declaration of invalidity on the ground that one of the conditions for the application of Article 8(1)(b) and (5) of Regulation No 40/94 – that the signs must be identical or similar – was not satisfied.

The proceedings before the General Court and the judgment under appeal

20 By application lodged at the Registry of the General Court on 14 April 2008, Ferrero brought an action against the contested decision, and claimed that OHIM should be ordered to pay the costs.

21 In support of its action before the General Court, Ferrero relied on two pleas in law: (i) incorrect application of the principle of *res judicata* and (ii) infringement of Article 8(1)(b) and (5) of Regulation No 40/94.

22 In respect of the first plea in law, the General Court observed in paragraph 32 of the judgment under appeal that the Board of Appeal had carried out an independent and comprehensive examination of the substance of the dispute and, in particular, of the

similarity of the signs at issue, and went on to conclude that, notwithstanding the statements made in paragraph 30 of the contested decision, the Board of Appeal had not applied the principle of *res judicata*. The General Court found, in paragraph 33 of that judgment, that the first plea in law was based on a mistaken premiss and, accordingly, had to be rejected.

23 However, the General Court stated in paragraph 36 of the judgment under appeal that the Board of Appeal was wrong to hold that, by virtue of the rule *nemo potest venire contra factum proprium*, the protection of acquired rights, and the principles of legal certainty and the protection of legitimate expectations, the adjudicating bodies of OHIM were bound in invalidity proceedings by findings made in a final decision handed down in opposition proceedings.

24 In respect of the second plea in law relied on by Ferrero in support of its action, the General Court noted, first, in paragraph 53 of the judgment under appeal, that the existence of a similarity between the earlier mark and the challenged mark was a precondition both for the application of Article 8(1)(b) and for the application of Article 8(5) of Regulation No 40/94, to which Article 52(1)(a) of that regulation refers, and that that condition requires the existence, in particular, of elements of visual, aural or conceptual similarity.

25 Secondly, in paragraph 54 of the judgment under appeal, the General Court referred to the case-law according to which it is not necessary, in order to satisfy the condition of similarity under Article 8(5) of Regulation No 40/94, to prove that there exists a likelihood of confusion, on the part of the relevant section of the public, between the earlier mark with a reputation and the challenged mark; rather, it is sufficient if, owing to the degree of similarity between those marks, the relevant section of the public establishes a link between them. Lastly, the General Court pointed out that the existence of such a link had to be assessed globally, account being taken of all factors relevant to the circumstances of the case, and that the comparison of the signs had to be based, so far as the visual, aural and conceptual similarities of the marks at issue were concerned, on the overall impression produced by the marks, account being taken, inter alia, of their distinctive and dominant elements.

26 However, the General Court held in paragraphs 55 to 59 of the judgment under appeal that, notwithstanding the fact that the word 'kinder' is present in both of the signs at issue, there were a number of visual and phonetic features which precluded the signs from being perceived as similar.

27 In paragraph 61 of the judgment under appeal, the General Court held, in relation to Ferrero's argument based on the reputation of the earlier mark and its argument based on the similarity between the goods covered by the marks at issue, that even if those factors could be taken into consideration for the purposes of assessing likelihood of confusion, they none the less do not affect the assessment of the similarity of the signs. The General Court also held, in paragraph 62 of the judgment, that the lack of similarity between the signs at issue was so pronounced that the reputation of the KINDER mark, whether or not it was undisputed, was incapable of calling into question that lack of similarity.

28 The General Court found in paragraph 63 of the judgment under appeal that the existence of a family or series of marks was irrelevant to the assessment of whether or not the precondition for the application both of Article 8(1)(b) of Regulation No 40/94 and of Article 8(5) of that regulation – that the earlier mark and the challenged mark be similar – is satisfied. The Court added, in paragraph 64 of that judgment, that even if the existence of a family or series of marks were a relevant factor in the assessment of whether there is such a similarity, the likelihood in the case at issue that consumers might actually consider that the challenged mark is part of that family or series of marks was very slight, if not non-existent, given the great differences between the challenged mark and the signs listed in paragraph 5 of the application, all of which contain the element 'kinder' and an additional element and/or figurative elements.

29 As regards the argument that the Board of Appeal did not take account of the fact that, under Article 8(5) of Regulation No 40/94, the assessment of the degree of similarity

does not require an assessment of whether there is a likelihood of confusion, the General Court held in paragraph 67 of the judgment under appeal that the factors put forward by the Board of Appeal demonstrated the lack of similarity, irrespective of whether a degree of similarity could give rise to a likelihood of confusion.

30 Lastly, the General Court held in paragraph 68 of the judgment under appeal that the Board of Appeal had not erred by carrying out an 'analytical dissection' of the challenged mark. The General Court found that when it comes to assessing the degree of similarity, the need to take account of the overall impression produced by the combined elements of those marks is not incompatible with examination of each element in turn. The General Court also pointed out that, in the case at issue, the Board of Appeal, after finding that the differences between the signs at issue outweighed the single element of similarity, stated that when they were compared as wholes, the overall impressions given by those signs were different, which meant that the 'analytical dissection' had not detracted from a consideration of the overall impression produced by the combination of the constituent elements of the marks at issue.

31 Accordingly, the General Court rejected as unfounded the second plea in law relied on by Ferrero in support of its action and, in consequence, dismissed the action.

Forms of order sought

32 By its appeal, Ferrero claims that the Court should:

— set aside the judgment under appeal;

— uphold its action against the contested decision or, alternatively, refer the case back to the General Court for reconsideration; and

— order OHIM to bear its own costs and to pay those of Ferrero, both at first instance and on appeal.

33 OHIM contends that the Court should:

— take note of Tirol Milch's surrender of the contested Community trade mark and, in the event that Ferrero agrees to discontinue the proceedings, or fails to demonstrate that it has a legal interest in continuing, declare that the appeal is devoid of purpose and that there is no need to adjudicate, and order each party to bear its own costs;

— or, in the event that the Court should hold that Ferrero has an interest in continuing the proceedings, allow OHIM to lodge further submissions against the appeal; and

— in the alternative, directly dismiss the appeal in its entirety, as either inadmissible or clearly unfounded, and order Ferrero to bear OHIM's costs.

The appeal

Ferrero's legal interest in bringing proceedings

Arguments of the parties

34 In its response, OHIM states that Tirol Milch informed OHIM, by letter of 15 February 2010, that it wished to surrender the contested Community trade mark in its entirety, pursuant to Article 49 of Regulation No 40/94.

35 By letter of 15 March 2010, OHIM confirmed to Tirol Milch that its surrender had been accepted and that the mark for which it had obtained registration had been removed from the register of Community trade marks. By letter dated the following day, OHIM informed Ferrero of the withdrawal.

36 Accordingly, OHIM contends that Ferrero now has no interest in having the judgment under appeal set aside, with the result that there is no need to adjudicate on the present appeal and that the proceedings should be declared devoid of purpose.

37 At the hearing, Ferrero submitted, however, that the contested decision and the judgment under appeal have produced legal effects which are detrimental to it.

38 Ferrero also submits that, despite Tirol Milch's surrender of the disputed mark, Ferrero retains an interest in having the judgment under appeal set aside and the contested decision annulled in so far as a declaration of invalidity, unlike a surrender, produces effects as of the date on which the application for registration of that mark was filed.

Findings of the Court

39 It should be recalled at the outset that the interest in bringing proceedings – a condition of admissibility – must continue up until the Court's ruling on the substance. According to the case-law of the Court, such an interest exists as long as the appeal may, if successful, procure an advantage for the party bringing it (Case C-550/07 P *Akzo Nobel Chemicals and Akcros Chemicals* v *Commission* [2010] ECR I-8301, paragraphs 22 and 23).

40 In the present case, it must be noted, first, that, by the judgment under appeal, the General Court dismissed the action brought by Ferrero against the contested decision, by which the Board of Appeal of OHIM had rejected the application for a declaration of invalidity which Ferrero had filed against registration of the Community trade mark TiMi KiNDERJOGHURT.

41 Consequently, if the ground of appeal relied on by Ferrero were to be well founded, it could result in the setting aside of the judgment under appeal and might even lead to the annulment of the contested decision and, as a consequence, to the annulment of the decision of 20 August 2004 to register that mark.

42 Secondly, contrary to OHIM's contention, the surrender by Tirol Milch of the Community trade mark TiMi KiNDERJOGHURT is not, in itself, capable of rendering the appeal lodged by Ferrero devoid of purpose.

43 Ferrero retains an interest in the present appeal in so far as – as Ferrero argued at the hearing – the effects of a surrender and those of a declaration of invalidity are not the same. That is to say, whereas a Community trade mark which has been surrendered ceases to have effects only as from the registration of that surrender, a Community trade mark which has been declared invalid will be deemed, in accordance with Article 54(2) of Regulation No 40/94, not to have had any effects from the outset, with all the legal consequences that such invalidity implies.

44 Accordingly, in so far as the present appeal could procure an advantage for Ferrero, that company retains a legal interest in bringing proceedings.

Substance

45 Ferrero puts forward a sole ground of appeal: infringement of Article 8 of Regulation No 40/94. That plea is composed of five parts, alleging respectively:

— (i) failure to comply with the system established under Article 8 of Regulation No 40/94;

— (ii) failure to take proper account of elements other than similarity and, in particular, failure to take proper account of reputation;

— (iii) the application of rules of evidence which are erroneous and have no basis in law;

— (iv) failure to have regard to the fact that the earlier trade marks are in part word marks, whereas the challenged trade mark is a figurative mark; and

— (v) failure to take proper account of the existence of a family of trade marks.

The first part of the sole ground of appeal

Arguments of the parties

46 By the first part of the sole ground of appeal, Ferrero alleges that, by undertaking a single factual assessment of similarity under Article 8(1)(b) and Article 8(5) of Regulation No 40/94, even though each of those provisions calls for the application of an entirely distinct set of tests, the General Court failed to comply with the system established under Article 8 of Regulation No 40/94.

47 According to Ferrero, it is apparent from the case-law that, under both of those provisions, similarity must be assessed interdependently with a set of other factors, but that those factors differ according to the provision concerned.

48 It is clear, in particular, from the judgment in Case C-252/07 *Intel Corporation* [2008] ECR I-8823 that, under Article 8(5) of Regulation No 40/94, account must be taken, for the purposes of the assessment of similarity, of the reputation of the sign at issue, as well as of its distinctive and dominant elements.

49 By contrast, under Article 8(1)(b) of that regulation, the taking into account of reputation and distinctive character is relevant for the purposes of the global assessment of the likelihood of confusion.

50 OHIM contends that the first part of the sole ground of appeal is clearly unfounded. It argues that the Court has held that, under both provisions referred to in paragraph 46 above, similarity must be assessed by reference to elements of visual, aural and conceptual similarity between the signs (Case C-408/01 *Adidas-Salomon and Adidas Benelux* [2003] ECR I-12537, paragraph 28). According to OHIM, if that examination reveals that, overall, the signs are not similar, that finding is valid in the context both of Article 8(1)(b) of Regulation No 40/94 and of Article 8(5) of that regulation.

— Findings of the Court

51 It should be noted at the outset that, as the General Court pointed out in paragraph 53 of the judgment under appeal, the existence of a similarity between the earlier mark and the challenged mark is a precondition for the application both of Article 8(1)(b) of Regulation No 40/94 and of Article 8(5) of that regulation.

52 That condition of similarity between the mark and the sign requires, in the context both of Article 8(1)(b) and of Article 8(5) of Regulation No 40/94, the existence, in particular, of elements of visual, aural or conceptual similarity (see, to that effect, *Adidas-Salomon and Adidas Benelux*, paragraph 28).

53 It is true that those provisions differ in terms of the degree of similarity required. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue such that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see, to that effect, *Adidas-Salomon and Adidas Benelux*, paragraphs 27, 29 and 31, and *Intel Corporation*, paragraphs 57, 58 and 66).

54 On the other hand, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, according to whether the assessment is carried out under Article 8(1)(b) of Regulation No 40/94 or under Article 8(5).

55 As regards the argument put forward by Ferrero on the basis of inferences drawn from *Intel Corporation*, this is based on an erroneous reading of that judgment.

56 In *Intel Corporation*, the Court confirmed its case-law to the effect that the existence of a link between the marks at issue must, like the existence of a likelihood of confusion, be assessed globally, account being taken of all factors relevant to the circumstances of the case, which include not only the degree of similarity between the conflicting marks, but also the degree of the earlier mark's distinctive character and the strength of its reputation (see *Intel Corporation*, paragraphs 41 and 42 and the case-law cited).

57 As regards in particular the strength of the earlier mark's reputation, the Court has stated that, for the purposes of assessing whether there is a link between the marks at issue, it may be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark. The Court explained inter alia in that regard that it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the marks at issue, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered (see *Intel Corporation*, paragraphs 52 and 53).

58 It is also clear from *Intel Corporation* that, contrary to the assertions made by Ferrero, the Court held in that judgment that the reputation and the distinctive character of the earlier mark constitute relevant factors for the purposes of assessing, not whether the marks at issue are similar, but whether the relevant section of the public makes a link between them.

59 Accordingly, the first part of the ground of appeal must be rejected as unfounded.

The second part of the sole ground of appeal

— Arguments of the parties

60 By the second part of the sole ground of appeal, Ferrero submits that, in paragraphs 55 to 59 of the judgment under appeal, the General Court erred in law by assessing the likelihood of confusion under Article 8(1)(b) and (5) of Regulation No 40/94 solely from the perspective of the similarity of the trade marks at issue and by refusing to examine the other applicable factors – in particular, the recognition enjoyed by the earlier trade mark on the relevant market – which could offset any lack of similarity between the signs.

61 Furthermore, Ferrero submits that the General Court's statement in paragraph 62 of the judgment under appeal that 'the lack of similarity between the signs at issue … is so pronounced that the reputation of the KINDER mark, whether or not it is undisputed, is incapable of calling into question that lack of similarity' is incorrect in that the reputation of a trade mark has a direct effect on the scope of its protection in terms of similarity. According to Ferrero, a trade mark with a considerable reputation will inevitably have acquired a highly distinctive character. As a consequence, if a later mark is to be differentiated from the earlier mark with reputation, the differences between them will have to be substantial. To carry out a comparison between two trade marks without taking into account their respective reputations therefore amounts to an error in law.

62 Ferrero also claims that if paragraph 62 of the judgment under appeal were to be interpreted as meaning that both Article 8(1)(b) and Article 8(5) of Regulation No 40/94 require the existence of a minimal degree of similarity and that it would be impossible for a degree of similarity which falls short of that minimum to be offset by an

overwhelming reputation, that finding would have to be set aside as well, for lack of a legal basis under Article 8 of Regulation No 40/94. Ferrero submits that, on the contrary, the interdependency of similarity and reputation under both provisions implies that even a minimal degree of similarity could be offset by reputation, thus creating a link for the purposes of Article 8(5) or even a likelihood of confusion for the purposes of Article 8(1)(b).

63 OHIM contends that the second part of the sole ground of appeal is clearly unfounded. The case-law shows that, if the signs are dissimilar, the reputation which the earlier marks may have cannot cause those provisions to be applied, since one of the necessary conditions for their application is not met. That is the position both with regard to Article 8(1)(b) of Regulation No 40/94, pursuant to which the similarity as between signs or as between goods is a *sine qua non* for its application, and with regard to Article 8(5) of that regulation, pursuant to which the similarity of the signs is one of the independent and cumulative conditions that must be met.

— Findings of the Court

64 As was pointed out in paragraph 56 above, the existence of a link between the earlier mark and the challenged mark for the purposes of Article 8(5) of Regulation No 40/94 must – like a likelihood of confusion under Article 8(1)(b) – be assessed globally, account being taken of all factors relevant to the circumstances of the case, which include inter alia the degree of similarity between the marks at issue and the goods covered by those marks and also the strength of the earlier mark's reputation and its degree of distinctive character, whether inherent or acquired through use.

65 Although that global assessment implies some interdependence between the relevant factors, and a low degree of similarity between the marks may therefore be offset by the strong distinctive character of the earlier mark (see, to that effect, judgment of 7 May 2009 in Case C-398/07 P *Waterford Wedgwood* v *Assembled Investments (Proprietary) and OHIM*, not published in the ECR, paragraph 33), the fact remains that where there is no similarity between the earlier mark and the challenged mark, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue or that the relevant public makes a link between them (see, to that effect, Case C-254/09 P *Calvin Klein Trademark Trust* v *OHIM* [2010] ECR I-7989, paragraph 53 and the case-law cited).

66 As is apparent from paragraph 51 above, in order for Article 8(1)(b) or (5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, those provisions are manifestly inapplicable where the General Court has ruled out any similarity between the marks at issue (see, to that effect, *Calvin Klein Trademark Trust* v *OHIM*, paragraph 68). It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public.

67 In paragraphs 55 to 59 of the judgment under appeal, the General Court found that a certain number of visual and phonetic features of the signs at issue precluded them from being perceived as similar.

68 In those circumstances, the General Court was right to find, in paragraphs 61 and 62 of the judgment under appeal, that the reputation of the earlier mark and the similarity between the goods respectively covered by the marks at issue – even if those factors may be taken into consideration in order to assess likelihood of confusion – do not affect the assessment of the similarity of the signs at issue, with the result that they are incapable of calling into question the lack of similarity that was found to exist (see, to that effect, judgment of 11 December 2008 in Case C-57/08 P *Gateway* v *OHIM*, not published in the ECR, paragraphs 55 to 57).

69 It follows that the second part of the ground of appeal must be held to be unfounded.

The third part of the sole ground of appeal

— Arguments of the parties

70 By the third part of the sole ground of appeal, Ferrero submits that, in paragraphs 56 to 58 of the judgment under appeal, the General Court erred in law or distorted the facts placed before it by applying, for the purposes of assessing the similarity of the signs at issue, rules of evidence which were erroneous and for which there was no basis in law, and for which no reasons were given.

71 According to Ferrero, those rules are the following: (i) where words merge, each one of them loses its specific, independent existence; (ii) if a figurative sign consists in the representation of two words, one centred above the other, the focal point of the sign

is the topmost word, as the central positioning is able to offset a smaller font size and poorer legibility caused by the background to the centrally placed word; (iii) where a sign contains two words, the focal point of the sign is the first of those words; and (iv) where a sign contains three words, the middle word is a negligible element.

72 OHIM contends that the third part of the sole plea in law is clearly inadmissible because Ferrero does not raise any points of law and merely challenges the General Court's factual assessments, contrary to the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union.

— Findings of the Court

73 It should be noted at the outset that it is apparent from the second subparagraph of Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court that an appeal lies on a point of law only. The General Court therefore has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence placed before it. 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, as such, is open to review by the Court of Justice on appeal (see, inter alia, *Calvin Klein Trademark Trust* v *OHIM*, paragraph 49 and the case-law cited, and Case C-92/10 P *Media-Saturn-Holding* v *OHIM* [2011], paragraph 27).

74 However, provided that the appellant challenges the interpretation or the application of European Union law by the General Court, the points of law examined at first instance may be discussed again in the context of an appeal (see, inter alia, Case C-488/06 P *L & D* v *OHIM* [2008] ECR I-5725, paragraph 43).

75 As it is, by the third part of its sole ground of appeal, Ferrero alleges that the General Court introduced, for the purposes of assessing similarity, implicit rules of evidence which are not provided for in Regulation No 40/94. Ferrero is thus seeking specifically to have it established that errors of law were made by the General Court in the judgment under appeal.

76 Consequently, that part of the ground of appeal must be declared admissible.

77 It must nevertheless be held that that part has no factual basis: in order to come to the conclusion, in paragraph 59 of the judgment under appeal, that the Board of Appeal had not erred in finding that the signs at issue were dissimilar, the General Court undertook a specific assessment of the particular visual and aural characteristics of those signs, but did not – contrary to the submission made by Ferrero – introduce rules of evidence which are general in scope.

78 Moreover, in so far as Ferrero alleges distortion of the facts submitted to the General Court for assessment, it should be borne in mind that, under the second subparagraph of Article 256(1) TFEU, the first paragraph of Article 58 of the Statute of the Court of Justice and point (c) of the first subparagraph of Article 112(1) of the Rules of Procedure of the Court of Justice, the appellant must indicate precisely the evidence alleged to have been distorted by the General Court and show the errors of appraisal which, in his view, led to that distortion (see, inter alia, 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 50).

79 It must be stated that Ferrero has not provided any evidence capable of substantiating that allegation.

80 The third part of the ground of appeal must therefore be rejected as unfounded.

The fourth part of the sole ground of appeal

— Arguments of the parties

81 By the fourth part of the sole ground of appeal, Ferrero submits that, according to the case-law, similarity under Article 8(l)(b) and Article 8(5) of Regulation No 40/94 can be visual, aural or conceptual and that those aspects of similarity must be examined globally. However, in paragraphs 56 to 58 of the judgment under appeal, the General Court undertook an assessment from a predominantly visual – and, to a certain extent, aural – perspective, focusing to a great extent on design issues, such as the position and fonts of the three words contained in the challenged trade mark, as well as the background against which those words were presented.

82 In so doing, the General Court failed, according to Ferrero, to take account of the fact that the earlier trade marks – and especially the Spanish, French and Italian trade marks relating to the word 'KINDER' – are word marks, the scope of whose protection is not influenced by design issues, such as position or font, or the background against which those words are represented.

83 OHIM contends that the fourth part of the sole plea in law is clearly inadmissible because it does not raise any points of law and merely challenges the factual assessments made by the General Court.

— Findings of the Court

84 First of all, OHIM's argument relating to the inadmissibility of the fourth part of the sole ground of appeal must be rejected. Contrary to the assertions made by OHIM, that part relates to a point of law, in that it claims that the General Court did not have regard to the scope of Article 8(1)(b) or (5) of Regulation No 40/94, in so far as it should have taken account, in assessing the similarity of the signs at issue, of the fact that the earlier mark is a word mark.

85 As to substance, it should be borne in mind that, in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, account being taken of the category of goods or services in question and the circumstances in which they are marketed (Case C-334/05 P *OHIM* v *Shaker* [2007] ECR I-4529, paragraph 36).

86 Furthermore, the visual, aural and conceptual similarities between the signs at issue must be the subject of a global assessment in which the assessment of any aural similarity is but one of the relevant factors (see, to that effect, Case C-206/04 P *Mülhens* v *OHIM* [2006] ECR I-2717, paragraph 21).

87 The General Court was therefore correct in examining, in paragraphs 56 to 58 of the judgment under appeal, the overall impression created by the two signs at issue, in terms of their possible visual and aural similarities.

88 The fourth part of the sole ground of appeal must therefore be rejected as unfounded.

89 As to the remainder, in so far as it seeks to secure a new assessment of the facts, that part of the ground of appeal is, in accordance with the case-law referred to in paragraph 73 above, inadmissible since Ferrero has not alleged any distortion of the facts or evidence submitted to the General Court.

The fifth part of the sole ground of appeal

— Arguments of the parties

90 By the fifth part of the sole ground of appeal, Ferrero submits that the General Court erred in law by not taking proper account of the existence in the present case of a family of trade marks, on the ground that this is irrelevant for the purposes of assessing similarity.

91 In so doing, the General Court misinterpreted the case-law in that, although, in the context of Article 8(1)(b) of Regulation No 40/94, the existence of a family of trade marks increases the likelihood of confusion by leading the consumer to believe that the challenged trade mark is part of that family, that is precisely because of the similarity between the challenged trade mark and the family of marks, or, more specifically, on account of the element common to them (Case C-234/06 P *Il Ponte Finanziara* v *OHIM* [2007] ECR I-7333, paragraph 63).

92 Ferrero further submits that the very existence of a family of trade marks increases the likelihood that the trade mark of a third party containing the element shared by that family will automatically be perceived by the relevant consumer as similar to that common element.

93 According to Ferrero, that applies fully to the situation where the challenged trade mark contains the word 'KINDER', which enjoys a considerable reputation and is compared with a family of 36 trade marks, all of which contain the same word, either alone or in combination with other words.

94 OHIM contends that the fifth part of the sole ground of appeal is both inadmissible and clearly unfounded. First, the challenge to the General Court's finding that Ferrero could not rely on the existence of a 'family' of similar trade marks would involve a new factual assessment, which cannot be made in the context of an appeal. Secondly, OHIM argues that the possible existence of a family of marks is relevant only in the context of Article 8(1)(b) of Regulation No 40/94, in so far as it can create indirect confusion, by leading the public to believe that the later mark is yet another mark in that family. As regards Article 8(5) of Regulation 40/94, however, that argument is not legally sound because confusion itself is not relevant. Likewise, the lack of similarity

between, on the one hand, all the marks in the series and, on the other, the challenged sign is enough to rule out definitively the possibility both of a likelihood of confusion and of detriment or unfair advantage.

— Findings of the Court

95 First of all, OHIM's argument relating to the inadmissibility of the fifth part of the sole ground of appeal must be rejected. It is apparent from its arguments that Ferrero is seeking to claim that, in taking the view that the existence of a family of trade marks is not relevant for the purposes of assessing similarity, the General Court failed to have regard to the scope of Article 8(1)(b) of Regulation No 40/94.

96 A part of a plea which is submitted to that effect thus relates to a matter of law and must therefore be declared admissible.

97 As to the substance, it should be borne in mind that it is settled law that the existence of a 'family' or a 'series' of trade marks is an element which must be taken into account for the purposes of assessing the likelihood of confusion. In those circumstances, the likelihood of confusion results 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 and may consider, erroneously, that that trade mark is part of that family or series of marks (*Il Ponte Finanziaria* v *OHIM*, paragraph 63).

98 However, as is apparent from paragraph 52 above, that element is irrelevant for the purposes of assessing the existence of a similarity between the earlier mark and the challenged mark.

99 Consequently, as is apparent from paragraph 66 above, it is only if there is some similarity between the marks at issue that the General Court must take into account, in the global assessment of a likelihood of confusion or of a link being made between those marks, the existence of a 'family' or 'series' of trade marks.

100 In so far as the General Court found, in paragraphs 55 to 59 of the judgment under appeal, that a certain number of visual and phonetic features of the signs at issue precluded them from being perceived as similar, it could, without erring in law, hold, in paragraphs 63 to 66 of that judgment, that that finding is not called into question by the existence of a 'family' or 'series' of trade marks.

101 Consequently, the fifth part of the sole ground of appeal must be rejected as unfounded and the ground of appeal must therefore be rejected in its entirety.

102 In view of all the foregoing considerations, the appeal must be dismissed as unfounded.

Costs

103 Under Article 69(2) of the Rules of Procedure, which applies to the procedure on appeal 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 has applied for costs and Ferrero has been unsuccessful, it must be ordered to pay the costs.

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

1. Dismisses the appeal;

2. Orders Ferrero SpA to pay the costs.

[Signatures]