JUDGMENT OF THE COURT (First Chamber)

18 December 2008 *

In Case C-16/06 P,

APPEAL under Article 56 of the Statute of the Court of Justice, lodged on 12 January 2006,

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

appellant,

the other party to the proceedings being:

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

defendant at first instance,

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

intervener at first instance,

* Language of the case: English.

THE COURT (First Chamber),

composed of P. Jann, President of the Chamber, A. Tizzano, A. Borg Barthet, M. Ilešič and E. Levits (Rapporteur), Judges,

Advocate General: V. Trstenjak,
Registrar: J. Swedenborg, Administrator,

having regard to the written procedure and further to the hearing on 25 October 2007,

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

gives the following

Judgment

1 By its appeal, Les Éditions Albert René Sàrl ('the appellant') requests the Court to set aside the judgment of the Court of First Instance of the European Communities of 27 October 2005 in Case T-336/03 *Les Éditions Albert René* v *OHIM — Orange (MOBILIX)* [2005] ECR II-4667 ('the judgment under appeal'), dismissing its action against the decision of the Fourth Board of Appeal of the Office for Harmonization in the Internal market (Trade Marks and Designs) (OHIM) of 14 July 2003

(Case R 0559/2002-4; 'the contested decision'), concerning the opposition filed by the appellant, the proprietor of the earlier mark OBELIX, to the registration as a Community trade mark of the word sign 'MOBILIX'.

Legal context

2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended by Council Regulation (EC) No 3288/94 of 22 December 1994 (OJ 1994 L 349, p. 83; 'Regulation No 40/94'), provides in Article 8 thereof, entitled 'Relative grounds for refusal':

'1. 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.

2. For the purposes of paragraph 1, "Earlier trade marks" means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) Community trade marks;

…

(c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words "well known" are used in Article 6 bis of the Paris Convention.

…

5. 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.'

3 According to Article 63 of that regulation, entitled 'Actions before the Court of Justice':

'1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

3. The Court of Justice has jurisdiction to annul or to alter the contested decision.

4. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.

…'

4 Article 74 of Regulation No 40/94, entitled 'Examination of the facts by the Office of its own motion', is worded as follows:

'1. In proceedings before it [OHIM] shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. [OHIM] may disregard facts or evidence which are not submitted in due time by the parties concerned.'

5 Under Article 76(1) of that regulation, entitled 'Taking of evidence':

'In any proceedings before [OHIM], the means of giving or obtaining evidence shall include the following:

…

(b) requests for information;

(c) the production of documents and items of evidence;

…'

6 Article 135(4) of the Rules of Procedure of the Court of First Instance provides that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

Background to the dispute

7 On 7 November 1997, Orange A/S ('Orange') filed an application under Regulation No 40/94 with OHIM for registration of the word sign 'MOBILIX' as a Community trade mark.

8 The goods and services in respect of which that registration was sought are in Classes 9, 16, 35, 37, 38 and 42 of the Nice Agreement of 15 June 1957 concerning the

International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond, for each of those classes, to the following description:

— 'apparatus, instruments and installation for telecommunication, including for telephony, telephones and cellular telephones, including antennae, aerials and parabolic reflectors, accumulators and batteries, transformers and converters, coders and decoders, coded cards and card for coding, telephone calling cards, signalling and teaching apparatus and instruments, electronic telephone books, parts and accessories (not included in other classes) for the aforementioned goods', within Class 9;

— 'telephone calling cards', within Class 16;

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

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

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

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

9 That application for registration was the subject of a notice of opposition filed by the appellant, who relied on the following earlier rights relating to the word 'OBELIX':

— the earlier registered trade mark, protected by registration of Community trade mark No 16 154 of 1 April 1996 in respect of the following goods and services:

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

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

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

— 'marketing and publicity', within Class 35;

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

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

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

10 The procedure before OHIM was summarised by the Court of First Instance in paragraphs 6 to 8 of the judgment under appeal as follows:

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

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

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

application for a Community trade mark in respect of [those goods and services] and granted it in respect of the remaining goods and services.'

The action before the Court of First Instance and the judgment under appeal

11 By application lodged at the Registry of the Court of First Instance on 1 October 2003, the appellant sought the annulment of the contested decision, advancing three pleas in law alleging: first, infringement of Article 8(1)(b) and (2) of Regulation No 40/94; second, infringement of Article 8(5) thereof and, third, infringement of Article 74 thereof.

12 At the hearing, the appellant requested, in the alternative, that the Court remit the case to the Fourth Board of Appeal of OHIM so that it might demonstrate that its trade mark had a 'reputation' within the meaning of Article 8(5) of Regulation No 40/94.

13 The Court of First Instance, in paragraphs 15 and 16 of the judgment under appeal, started by determining whether the five documents attached to the application and intended to prove that the word sign 'OBELIX' is well known were admissible. Having established that those documents had not been produced in the proceedings before OHIM, the Court declared them to be inadmissible in so far as their admission was contrary to Article 135(4) of the Rules of Procedure.

14 Then, referring to Articles 63 and 74 of Regulation No 40/94 and Article 135 of its Rules of Procedure, the Court declared inadmissible the plea based on infringement of Article 8(5) of Regulation No 40/94.

15 The Court of First Instance pointed out, inter alia, in paragraph 20 of the judgment under appeal, that at no time had the appellant requested the Board of Appeal to apply Article 8(5) and that it therefore had not examined it. It declared that, although the appellant did invoke the reputation of its earlier trade mark in its opposition to the trade mark application and before the Board of Appeal, this was exclusively within the context of the application of Article 8(1)(b) of that regulation, that is to say, for the purpose of substantiating the likelihood of confusion in the mind of the relevant public.

16 Lastly, the Court of First Instance, under Article 44(1) of its Rules of Procedure, declared inadmissible the head of claim submitted at the hearing,

17 As regards the substance, the Court went on in paragraphs 32 to 36 of the judgment under appeal to examine the merits of the appellant's plea alleging infringement of Article 74 of Regulation No 40/94 and according to which, in the absence of any challenge by Orange, the Board of Appeal should have started from the principle that the OBELIX mark had a reputation.

18 The Court held in paragraph 34 of the judgment under appeal that Article 74 of Regulation No 40/94 could not be interpreted to mean that OHIM is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established.

19 It then stated in paragraph 35 of the judgment under appeal that, in the present case, neither the Opposition Division nor the Board of Appeal had found that the appellant had substantiated conclusively by facts or evidence the legal assessment it was putting forward, namely that the unregistered sign was well known and the registered sign highly distinctive. Therefore, in paragraph 36 of the judgment under appeal, the Court declared that plea to be unfounded.

20 In paragraphs 53 to 88 of the judgment under appeal, the Court examined the appellant's plea based on infringement of Article 8(1)(b) and (2) of Regulation No 40/94.

21 As regards the similarity between the goods and services at issue, the Court of First Instance rejected the appellant's argument that the goods referred to by the trade mark application, included in classes 9 and 16, all contain essential components of the goods covered by the earlier trade mark. It stated in paragraph 61 of the judgment under appeal that the mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different. The Court of First Instance also stated, in paragraph 63 of the judgment under appeal, that the wide formulation of the list of goods and services protected by the earlier registration could not be used by the appellant as an argument for finding that the goods are very similar, still less that they are identical to the goods referred to in the application for registration.

22 The Court of First Instance also rejected, in paragraphs 66 to 70 of the judgment under appeal, the appellant's arguments seeking to prove that the services in the Community trade mark application and included in Classes 35, 37, 38 and 42 are similar to those protected by the earlier mark, while none the less acknowledging an exception. According to the Court, 'the "leasing of computers and computer programs" which appears in the Community trade mark application (Class 42) and the [appellant's] "computers" and "computer programs recorded on data carriers" (Class 9) are similar by reason of their complementarity'.

23 As regards the comparison of the signs at issue, the Court of First Instance, in paragraphs 75 and 76 of the judgment under appeal, held, inter alia, that, despite the combination of the letters 'OB' and the '-LIX' ending, common to both signs, they had a number of significant visual differences, such as the letters following 'OB', the beginning of the words and their length. Having pointed out that the attention of the

consumer is usually directed to the beginning of the word, the Court held that 'the signs in question are not visually similar or..., at most, they are visually very slightly similar'.

24 After carrying out an aural comparison of the signs the Court stated, in paragraphs 77 and 78 of the judgment under appeal, that in this respect they had a certain similarity.

25 As regards the conceptual comparison, the Court stated in paragraph 79 of the judgment under appeal that, even if the word 'OBELIX' had been registered as a word mark, it would readily be identified by the average member of the public with the famous character from a comic strip series, which made it extremely unlikely that there could be any conceptual confusion in the public mind between words which were more or less similar.

26 The Court concluded, in paragraphs 80 and 81 of the judgment under appeal, that since the word sign 'OBELIX' had from the point of view of the relevant public a clear and specific meaning so that the public was capable of grasping it immediately, the conceptual differences separating the signs at issue were such as to counteract the aural similarities and any visual similarities.

27 Concerning the likelihood of confusion, the Court held in paragraph 82 of the judgment under appeal that 'the differences between the signs in question are sufficient to rule out any likelihood of confusion in the perception of the target public. Such a likelihood would presuppose that both the degree of similarity of the trade marks in question and that of the goods or services designated by those marks were sufficiently high'.

28 Consequently, the Court of First Instance concluded in paragraphs 83 and 84 of the judgment under appeal that the Board of Appeal's assessment of the distinctiveness of the earlier mark and the appellant's claims as to the reputation of that trade mark had no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in the present case.

29 Lastly, in paragraph 85 of the judgment under appeal, noting that the appellant could not claim an exclusive right to the use of the '-ix' suffix, the Court rejected its argument that, because of that suffix, it was entirely conceivable that the term 'MOBILIX' would insinuate itself into the family of trade marks made up of the characters from the 'Asterix' series and that it would be understood as a derivation of the term 'OBELIX'.

30 Having thus held that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 had not been satisfied and that, consequently, there was no likelihood of confusion between the mark applied for and the earlier mark, the Court dismissed the action brought by the appellant.

The appeal

31 In its appeal, in support of which it advances six grounds, the appellant claims that the Court should set aside the judgment under appeal and annul the contested decision, refuse application No 671396 for registration of the word sign 'MOBILIX' in respect of all the goods and services for which registration is sought and order OHIM to pay the costs of the proceedings before the Court of First Instance and the Court of Justice. In the alternative, the appellant claims that the Court should set aside the judgment under appeal and remit the case to the Court of First Instance.

32 OHIM contends that the Court should dismiss the appeal and order the appellant to pay the costs.

The first ground of appeal, alleging infringement of Article 63 of Regulation No 40/94 and of the rules of Community administrative and procedural law (reformatio in pejus)

Arguments of the parties

33 In its first ground of appeal, the applicant alleges that the Court of First Instance infringed Article 63 of Regulation No 40/94, and that, contrary to the rules of Community administrative and procedural law, it committed *reformatio in pejus* by concluding, contrary to the contested decision and to the detriment of the appellant, that the signs at issue were not similar, whereas the issue of their similarity was not part of the subject-matter of the dispute before the Court of First Instance and that court was therefore not competent to make that assessment.

34 In accordance with Article 63(4) of Regulation No 40/94, the appellant brought an action against the contested decision only in so far as it was adversely affected by that decision and therefore it challenged only the Board of Appeal's refusal to examine the opposition in the light of Article 8(5) of Regulation No 40/94, its refusal to take into account the distinctive character and reputation of the OBELIX trade mark, and the finding that the goods and services designated by the marks at issue were not similar.

35 By contrast, the Board of Appeal's assessment of the similarity of the signs at issue was not challenged before the Court of First Instance either by the appellant or by Orange, the other party to the proceedings before the Board of Appeal. The appellant submits that while OHIM is not automatically obliged to defend the contested decision, it has no

power to alter the subject-matter of the dispute before the Court of First Instance to the detriment of the appealing party.

36 According to OHIM, since the appellant had challenged the findings of the Board of Appeal as to the likelihood of confusion and since the similarity of the signs at issue is an aspect of those findings, the Court of First Instance, in order to review the legality of the findings of the Board of Appeal in the light of Article 8(1)(b) of Regulation No 40/94, was required to examine the assessment made by the Board when it compared those signs. Consequently, it submits, the Court of First Instance had jurisdiction to examine the similarity of the signs.

37 As regards the infringement of the principle prohibiting *reformatio in pejus*, OHIM maintains that, since the Court of First Instance did not alter the contested decision by which the Board of Appeal partly upheld the opposition, the appellant has not been placed in a position worse than that it was in before its application was lodged at the Court of First Instance.

Findings of the Court

38 Pursuant to Article 63(2) of Regulation No 40/94, the Court of First Instance is called upon to assess the legality of the decisions of the Boards of Appeal of OHIM by reviewing their application of Community law, having regard, in particular, to the facts which were submitted to them (see, to that effect, judgment of 4 October 2007 in Case C-311/05 P *Naipes Heraclio Fournier* v *OHIM*, paragraph 38 and the case-law cited).

39 Thus, within the restrictions of Article 63 of Regulation No 40/94, as interpreted by the Court of Justice, the Court of First Instance can carry out a full review of the legality of the decisions of OHIM's Boards of Appeal, if necessary examining whether those

boards have made a correct legal classification of the facts of the dispute (see, to that effect, *Naipes Heraclio Fournier* v *OHIM*, paragraph 39) or whether their assessment of the facts submitted to them was flawed.

40 It should be recalled that the appellant argued before the Court of First Instance that the Fourth Board of Appeal of OHIM infringed Article 8(1)(b) and (2) of Regulation No 40/94.

41 Under that plea, first, the appellant raised the question of the similarity of the signs at issue. In particular, as shown in paragraphs 8 and 47 to 49 of the judgment under appeal, whereas the Board of Appeal had found that there was a certain similarity between those signs, the appellant submitted that they were in fact very similar and sought a finding that there was a higher degree of similarity than that found by the Board of Appeal.

42 Therefore, as the Advocate General also observes in point 41 of her Opinion, the appellant itself included the issue of the similarity of the signs at issue within the subject-matter of the proceedings.

43 Secondly, the appellant also submitted that, as far as the likelihood of confusion is concerned, if account is taken of the interdependence between the similarity of the goods, the similarity of the signs and the distinctiveness of the earlier mark, the differences between the signs in the case of the identical goods and services and, to a large extent, in the case of the similar goods and services, are not enough to prevent, in particular, auditory confusion given that the earlier trade mark is well known.

44 In this respect, the Court notes 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 by 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, and Case C-234/06 P *Ponte Finanziaria* v *OHIM and F.M.G Textile (formerly Marine Enterprise Projects)* [2007] ECR I-7333, paragraph 48).

45 The existence of a likelihood of confusion on the part of the public must therefore be assessed globally, taking into account all factors relevant to the circumstances of the case (judgment of 15 March 2007 in Case C-171/06 P *T.I.M.E. ART* v *OHIM*, paragraph 33).

46 That global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular the similarity of the trade marks and that of the goods or services covered. Accordingly, a low degree of similarity between the goods or services may be offset by a high degree of similarity between the marks, and vice versa (see *T.I.M.E. ART* v *OHIM*, paragraph 35, and, as regards 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-39/97 *Canon Kabushiki Kaisha* v *Metro-Goldwyn-Mayer*: [1998] ECR I-5507, paragraph 17; and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 19).

47 Therefore, since the appellant called into question the Board of Appeal's assessment relating to the likelihood of confusion by virtue of the principle of the interdependence of the factors taken into account, in particular the similarity of the trade marks and that of the goods and services covered, the Court of First Instance was competent to examine the Board of Appeal's assessment of the similarity of the signs at issue.

48 Where it is called upon to assess the legality of a decision of the Board of Appeal of OHIM, the Court of First Instance cannot be bound by an incorrect assessment of the facts by that Board, since that assessment is part of the findings whose legality is being disputed before the Court of First Instance.

49 Lastly, as regards the appellant's reference to the principle prohibiting *reformatio in pejus*, even on the assumption that such a principle may be relied upon in proceedings for the review of the legality of a decision of a Board of Appeal of OHIM, it suffices to observe that, by finding that there was no likelihood of confusion and dismissing the appellant's action, the Court of First Instance maintained in force the contested decision. Therefore, since the contested decision did not grant the appellant's claims, the appellant is not, following the judgment under appeal, in a less favourable legal position than it was in before the action was brought.

50 It follows that the first ground of appeal must be rejected as unfounded.

The second ground of appeal, alleging infringement of Article 8(1)(b) of Regulation No 40/94

The first part of the second ground of appeal

— Arguments of the parties

51 By the first part of the second ground of appeal, the appellant alleges that, when assessing the similarity of the goods and services, the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94.

52 First, the appellant criticises the Court for having applied an incorrect legal criterion to establish whether the respective goods and services were similar. The appellant asserts that they should have been compared on the assumption that the marks at issue are identical and that the earlier mark is highly distinctive or has a reputation.

53 Second, the appellant calls into question the coherence and basis of the actual assessment of the similarity of those goods and services carried out by the Court of First Instance.

54 As regards the comparison of the goods in Classes 9 and 16 covered by the MOBILIX mark and the goods designated by the OBELIX mark in the same classes, the appellant claims that the Court of First Instance clearly misread the lists of those goods and distorted them. Its statements in paragraph 62 of the judgment under appeal relating to those lists are inaccurate and conflict with those lists, and with the statements of the Court of First Instance itself in paragraph 63 of the judgment under appeal.

55 The appellant also draws attention to a contradiction between the statement made in paragraph 62 of the judgment under appeal in the language of the case ('That list of goods and services is close to that which is claimed in the Community trade mark') and the finding that the goods protected by the earlier trade mark and those covered by the trade mark sought are not similar.

56 Lastly, the appellant submits that the Court of First Instance erred in law in confirming in paragraph 64 of the judgment under appeal the incorrect assessment of the Board of Appeal that the goods referred to in the Community trade mark application, included in Classes 9 and 16, were not included in the list of goods and services, drafted in wide terms, in the earlier registration. In addition, it submits that the Court of First Instance neither answered adequately the appellant's argument that the goods referred to in the MOBILIX trade mark application fall within the sector 'electrical and electronic... apparatus and instruments' covered by the OBELIX mark nor analysed the similarity of those goods.

57 As regards the comparison of the services covered by the Community trade mark application, falling within Classes 35, 37, 38 and 42, and the goods covered by the OBELIX mark, it submits that the Court of First Instance erred in holding, in paragraph 70 of the judgment under appeal, that those goods and services were not similar.

58 First, such a finding conflicts with the finding made by the Court of First Instance in paragraph 68 of the judgment under appeal that the services appearing in the trade mark application, included in Class 38, are slightly similar to those protected by the earlier right, included in Class 41. It is moreover inaccurate, the services 'film presentation, film production, film rental' falling within Class 41, covered by the earlier mark, being similar to the services 'radio and television broadcasting, including through cable television and the Internet' proposed by Orange.

59 Secondly, as regards the comparison of the goods in Class 9 protected by the OBELIX mark and the services falling within Class 42 covered by the application for registration of the MOBILIX mark, the appellant claims that the Court should have found that 'computers, program modules and computer programs recorded on data carriers' were similar to the services 'computer programming, design, maintenance and updating of software', and it incorrectly disregarded the fact that the production of 'electric and electronic... apparatus and instruments' in Class 9 necessarily involves the research and engineering services falling within Class 42.

60 Lastly, the Court was wrong to consider, in paragraph 69 of the judgment under appeal, that the Community trade mark application was exclusively for telecommunications in their various forms and that the earlier registration made no reference to any activity in that sector. In addition, the Court did not rely on any facts or evidence when it held, in that same paragraph of the judgment under appeal, that to acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark.

61 OHIM submits that, by its arguments relating to the similarity of the goods and the services designated by the marks at issue, the applicant is seeking to question the findings of fact made by the Court of First Instance, which is not permitted in the context of an appeal. The Court did not distort the facts or evidence, correctly reproduced the lists of those goods and of those services and then carried out a comparative analysis, based on criteria such as the kind of manufacturer or the way of distributing the goods.

— Findings of the Court

62 First, it must be recalled that, pursuant to the seventh recital in the preamble to Regulation No 40/94, the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trademark 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 the protection afforded by the Community trade mark in accordance with Article 8(1)(b) of Regulation No 40/94.

63 As recalled in paragraph 46 of this judgment, the global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular the similarity of the trade marks and that of the goods or services covered; a low degree of similarity between those goods or services may be offset by a high degree of similarity between the marks, and vice versa.

64 Therefore, the Court has held, concerning Article 4(1)(b) of Directive 89/104, a provision which is essentially identical to Article 8(1)(b) of Regulation 40/94, that the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to a likelihood of confusion (see *Canon*, paragraph 24).

65 However, as the Court of First Instance rightly observed in paragraph 59 of the judgment under appeal, in order to assess whether the goods and the services are similar or identical, all the relevant factors relating to the link between those goods or those services should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (see *Canon*, paragraph 23, and Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237, paragraph 85).

66 In accordance with that case-law, the Court, in paragraphs 61 to 70 of the judgment under appeal, compared the goods and the services designated by the marks at issue, carrying out a detailed analysis describing the relationship between those goods and those services.

67 Consequently, the Court did not err in law in comparing those goods and those services, without relying, for that purpose, on the assumption that the marks at issue are identical and that the earlier mark has a distinctive character.

68 Secondly, since the appellant is calling into question the consistency and basis of the findings of the Court of First Instance in the comparison of the goods and services designated by the marks at issue, it should be recalled that, in accordance with Article 225(1) EC and the first paragraph of Article 58 of the Statute of the Court of Justice, an appeal lies on a point of law only. The Court of First Instance thus 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 the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal (see, in particular, Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 22; Case C-173/04 P *Deutsche SiSi-Werke* v *OHIM* [2006] ECR I-551, paragraph 35; and Case C-25/05 P *Storck* v *OHIM* [2006] ECR I-5719, paragraph 40).

69 Such distortion must be obvious from the documents on the Court's file, without there being any need to carry out a new assessment of the facts and the evidence (see Case C-8/95 P *New Holland Ford* v *Commission* [1998] ECR I-3175, paragraph 72; Case C-551/03 P *General Motors* v *Commission* [2006] ECR I-3173, paragraph 54; and Case C-167/04 P *JCB Service* v *Commission* [2006] ECR I-8935, paragraph 108).

70 On a reading of the list of goods and services falling within Class 9 and covered by the earlier registration, reproduced in paragraph 5 of the judgment under appeal and paragraph 9 of this judgment, the Court of First Instance held, in paragraph 62 of the judgment under appeal, that 'the sectors covered by that right are photography, cinema, optics, teaching and video games'.

71 Concerning the list of goods and services falling within Classes 9 and 16 claimed in the Community trade mark application, reproduced in paragraph 3 of the judgment under appeal and paragraph 8 of this judgment, the Court of First Instance also held in paragraph 62 that the sector concerned by the Community trade mark application is, almost exclusively, telecommunications of all forms.

72 It is not manifestly apparent that the Court of First Instance's reading of the lists of goods and services covered by the marks at issue was materially inaccurate or that the Court of First Instance could not legitimately take those lists as a basis for the findings called into question by the appellant.

73 Therefore, the appellant's argument that the Court of First Instance distorted the content of the lists of goods and services at issue must be rejected as unfounded.

74 Concerning the alleged contradiction between the statement in paragraph 62 of the judgment under appeal in the language of the case ('That list of goods and services is close to that which is claimed in the Community trade mark') and the finding that the goods protected by the earlier mark and those covered by the mark for which registration is sought are not similar, it should be noted that the question whether the grounds of a judgment of the Court of First Instance are contradictory or inadequate is a point of law which is amenable, as such, to judicial review on appeal (see Case C-401/96 P *Somaco* v *Commission* [1998] ECR I-2587, paragraph 53; Case C-446/00 P *Cubero Vermurie* v *Commission* [2001] ECR I-10315, paragraph 20; and Case C-3/06 P *Groupe Danone* v *Commission* [2007] ECR I-1331, paragraph 45).

75 It should be noted in this connection that paragraph 62 of the judgment under appeal seeks to analyse the scope of the list of goods and services covered by the earlier registration and that of the list of goods and services covered by the trade mark application.

76 It is evident from that objective and the content of paragraph 62 of the judgment under appeal that the statement in the language of the case 'That list of goods and services is close to that which is claimed in the Community trade mark' should be redrafted to reflect the following meaning:

'That list of goods and services is to be compared with that claimed in the Community trade mark application.'

77 However, that error in drafting does not affect the coherence of the reasoning of the judgment under appeal, inasmuch as the observations made by the Court of First Instance in paragraph 62 of that judgment as regards the scope of the lists of goods and services covered by the marks at issue do not contradict the conclusions it drew from this in paragraphs 63 and 64 of that judgment.

78 As a result, the drafting error pointed out by the appellant cannot be regarded as an error of reasoning which could justify the annulment of the judgment under appeal on that point (see Case C-326/91 P *de Compte* v *Parliament* [1994] ECR I-2091, paragraph 96).

79 Lastly, as regards the rest of the arguments put forward by the appellant under the first part of the second plea, it should be observed that, although formally it is pleading errors of assessment and reasoning, the appellant is essentially seeking to call into question the findings of fact made by the Court of First Instance.

80 As recalled in paragraph 68 of this judgment, the appraisal of the facts and the assessment of the evidence do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal.

81 Consequently, the first part of the second ground of appeal must be rejected as in part unfounded and in part inadmissible.

The second part of the second ground of appeal

— Arguments of the parties

82 By the second part of the second ground of appeal, which it submits in the alternative to the first ground of appeal, the appellant alleges the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94 by holding that the marks at issue were different.

83 According to the appellant, the Court of First Instance did not apply the correct legal criteria to assess the similarity of those marks, but proceeded in a mechanical fashion, without taking into account the purpose of the comparison.

84 As regards the visual similarity, the Court of First Instance arbitrarily highlighted the differences between the marks, whereas, according to the general principles of trade-mark law, the common elements are usually more important than those which differ.

85 In addition, in paragraph 75 of the judgment under appeal, the Court failed to have regard to its own case-law stemming from the judgment in Case T-292/01 *Phillips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 50, according to which the public's attention focuses with at least the same intensity on the first letters of a word mark as on the central letters of that mark.

86 The assessments of the aural similarity and the conceptual similarity, carried out by the Court in paragraphs 77 to 79 of the judgment under appeal, are flawed in so far as, according to the appellant, those assessments are not substantiated by facts submitted to the Court.

87 Moreover, the Court of First Instance's reasoning in paragraph 79 of the judgment under appeal infringes the principle that the more well known or the more distinctive an earlier mark, the greater the likelihood of confusion.

88 The appellant also criticises the Court of First Instance for having applied, in paragraphs 80 to 82 of the judgment under appeal, the 'counteraction' theory, since that theory is only applicable in the final evaluation of whether there is a likelihood of confusion, and not where the conflicting marks are either visually or aurally, or visually and aurally, similar.

89 Lastly, the appellant asserts that the Court of First Instance misunderstood its argument when it observed in paragraph 85 of the judgment under appeal that the appellant was claiming an exclusive right to the use of the '-ix' suffix, whereas the appellant had stated that it was the proprietor of a family of marks which had been created in a similar way to MOBILIX. The existence of a family of marks is generally regarded as a separate cause for a likelihood of confusion, even if there is no aural or visual similarity.

90 According to OHIM, out of the arguments put forward by the appellant, the only question of law is whether the Court of First Instance could lawfully conclude, in paragraph 81 of the judgment under appeal, that the conceptual differences separating the signs at issue are such as to counteract the existing aural and visual similarities. It submits that the Court of First Instance correctly examined all the elements which have to be taken into account in accordance with established case-law to carry out a global assessment of the likelihood of confusion.

— Findings of the Court

91 First, as regards the argument that the Court highlighted, in the visual comparison of the two signs at issue, the differences between them instead of looking for their similarities, it suffices to observe that the appellant is in fact seeking to call in question the appraisal of the facts made by the Court of First Instance, which, in accordance with

the case-law recalled in paragraph 68 of this judgment, does not, save where the facts have been distorted, constitute a point of law subject to review by the Court of Justice on appeal.

92 As regards, secondly, the claim that the Court of First Instance failed to have regard to its own case-law by declaring that the public's attention usually focuses on the beginning of a word, that finding does not conflict with what was stated by the appellant and, moreover, far from presenting that rule as an absolute rule, the Court of First Instance merely held that it applied in the case in question. Furthermore, that finding of fact is not subject to review by the Court in the context of an appeal.

93 Likewise, thirdly, by claiming that the assessments of the aural and conceptual similarity, made by the Court of First Instance in paragraphs 77 to 79 of the judgment under appeal, are flawed in so far as they are not substantiated by facts submitted to that court, the appellant is seeking to have the Court of Justice substitute its own assessment of the facts for that made by the Court of First Instance.

94 Since it has not been alleged that that court distorted the facts or evidence, the Court of Justice is not competent to carry out an assessment of them.

95 Fourthly, it must be stated that the appellant is relying on a misinterpretation of the judgment under appeal, in claiming that the Court of First Instance's reasoning in

paragraph 79 of the judgment under appeal infringes the principle of trade mark law that the more well known an earlier mark or the greater its distinctiveness, the greater the likelihood of confusion.

96 In fact, in paragraph 79 of the judgment under appeal the Court of First Instance merely stated, in a factual assessment, which it is not for the Court to review, that the 'OBELIX' sign conveys a reference to a famous character from a comic strip and, as a result, is conceptually different from the 'MOBILIX' sign; it did not thus rule on the well known nature of the OBELIX trade mark.

97 Inasmuch as, fifthly, the appellant calls into question the Court of First Instance's application of the 'counteraction' theory, it must be observed that that court examined all the evidence which, in accordance with settled case-law, must be taken into consideration in order to carry out a global assessment of the likelihood of confusion.

98 Case-law shows that the global assessment of the likelihood of confusion implies that conceptual differences between two signs may counteract aural and visual 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, to that effect, Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-643, paragraph 20, and Case C-206/04 P *Mühlens* v *OHIM* [2006] ECR I-2717, paragraph 35 et seq.).

99 Therefore, the Court of First Instance cannot be criticised for having applied the 'counteraction' theory in paragraph 81 of the judgment.

100 Finally, sixthly, as regards the appellant's argument derived from the fact that it is the proprietor of a family of marks characterised by the '-ix' suffix, the Court notes that, although the appellant has invoked a number of earlier marks which, it submits, are part of that family, it based its opposition solely on the earlier mark OBELIX.

101 However, it is where an opposition is based on the existence of several marks with shared characteristics enabling them to be regarded as part of the same 'family' or 'series' of trade marks that account should be taken, in the assessment of the likelihood of confusion, of the fact that, in the case of a 'family' or 'series' of trade marks, a likelihood of confusion results from the fact that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for and considers erroneously that the latter trade mark is part of that family or series of marks (see, to that effect, *Ponte Finanziaria* v *OHIM and F.M.G Textiles (formerly Marine Enterprise Projects)*, paragraphs 62 and 63).

102 Consequently, in the light of the foregoing, the second part of the second ground of appeal must be rejected as in part inadmissible and in part unfounded.

The third ground of appeal, alleging infringement of Article 74 of Regulation No 40/94

Arguments of the parties

103 First, the appellant alleges that the Court of First Instance infringed Article 74 of Regulation No 40/94 by rejecting, in paragraph 36 of the judgment under appeal, its claim that the Board of Appeal should have accepted that the OBELIX trade mark was

well known, highly distinctive and had a reputation, the other party to the proceedings before the Board of Appeal not having challenged those facts.

104 The appellant submits that it is necessary to distinguish between a situation in which Orange did not take part in the opposition proceedings before the Board of Appeal, in which case OHIM could adopt its decision solely on the basis of the evidence produced by the appellant, the opponent in the proceedings, and a situation in which Orange took part in those proceedings. In the second case, since Orange did not challenge the appellant's claims, it was absurd to require the appellant to provide all the evidence to support those claims, since there is no rule or principle of Community law which requires a party to produce evidence to prove something which is not contested by the other party.

105 Secondly, the appellant submits that the Court of First Instance infringed Article 74 of Regulation No 40/94 by itself refusing, like the Board of Appeal, to accept that the OBELIX trade mark was well known, highly distinctive and had a reputation.

106 OHIM submits, referring to the judgment in *Vedial* v *OHIM*, that even if the parties do not disagree on the issue of the reputation of the OBELIX trade mark, the Court of First Instance is not bound by such a finding and is required to consider whether, by finding in the contested decision that there was no similarity between the marks at issue, the Board of Appeal may have infringed Regulation No 40/94. In the context of inter partes proceedings before OHIM, there is no principle that requires that facts not contested by the other party should be regarded as established.

Findings of the Court

107 It must be stated at the outset that the appellant's claim that the Court of First Instance infringed Article 74 of Regulation No 40/94 in refusing to accept that the OBELIX trade mark was well known, highly distinctive and had a reputation, is founded on a misinterpretation of paragraphs 32 to 36 of the judgment under appeal and, as a result, is unfounded.

108 In fact, in paragraphs 32 to 36 of the judgment under appeal the Court of First Instance did not itself examine whether the OBELIX trade mark was well known, highly distinctive and had a reputation, but merely examined the merits of the appellant's plea alleging infringement of Article 74(1) of Regulation No 40/94, namely that, in the absence of any challenge by Orange, the Board of Appeal should have deemed the appellant's assessment concerning the OBELIX mark to have been established.

109 As the appellant has submitted in this connection that, by declaring that the Board of Appeal had not infringed Article 74(1) of Regulation No 40/94, the Court of First Instance itself infringed that provision, that head of claim should be rejected as inadmissible.

110 Admittedly, provided that an appellant challenges the interpretation or application of Community law by the Court of First Instance, the points of law examined at first instance may be discussed again in the course of an appeal. Indeed, if an appellant could not thus base his appeal on pleas in law and arguments already relied on before the

Court of First Instance, an appeal would be deprived of part of its purpose (see, in particular, Case C-41/00 P *Interporc* v *Commission* [2003] ECR I-2125, paragraph 17, and *Storck* v *OHIM*, paragraph 48).

111 However, 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 Rules of Procedure of the Court of Justice, 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. That requirement is not satisfied by an appeal which, without even including an argument specifically identifying the error of law allegedly vitiating the judgment under appeal, merely repeats or reproduces verbatim the pleas in law and arguments previously submitted to the Court of First Instance (see, in particular, Case C-352/98 P *Bergaderm and Goupil* v *Commission* [2000] ECR I-5291, paragraphs 34 and 35, and *Storck* v *OHIM*, paragraph 47).

112 Having already argued before the Court of First Instance that, since Orange did not challenge its claims put forward during the opposition proceedings, OHIM should have started by assuming that the OBELIX mark was well known, the applicant is merely repeating in this ground of appeal the argument submitted before the Court of First Instance, without explaining on what grounds that court erred in law by rejecting that argument in paragraphs 32 to 36 of the judgment under appeal.

113 The appellant's third ground of appeal, alleging an infringement of Article 74(1) of Regulation No 40/94, must therefore be dismissed as in part unfounded and in part inadmissible.

The fourth ground of appeal, alleging that the Court of First Instance infringed Article 63 of Regulation No 40/94 and Article 135(4) of its Rules of Procedure by rejecting the head of claim seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94

Arguments of the parties

114 According to the appellant, by rejecting as inadmissible its head of claim based on Article 8(5) of Regulation No 40/94, the Court of First Instance relied on an incorrect interpretation of the subject-matter of the appeal procedure and thus infringed Article 63 of Regulation No 40/94 and Article 135(4) of its Rules of Procedure.

115 The Court of First Instance failed to have regard to its own case-law, cited in its judgment in Case T-275/03 *Focus Magazin Verlag* v *OHIM — ECI Telecom (Hi-FOCuS)* [2005] ECR II-4725, paragraph 37, pursuant to which it follows from the continuity in terms of functions between the departments of OHIM that, within the scope of application of Article 74(1) in fine of Regulation No 40/94, the Board of Appeal is required to base its decision on all the matters of fact and of law which the party concerned introduced either in the proceedings before the department which heard the application at first instance or, subject only to Article 74(2), in the appeal.

116 The appellant states that, while the arguments on which it relied before the Board of Appeal were based on Article 8(1)(b) of Regulation No 40/94, a reasonable reading of the documents adduced in the context of the opposition proceedings and the appeal make it clear that the appellant has always maintained that a trade mark which is well known and which comes within the combined provisions of Article 8(1) and 8(2)(c) of

Regulation No 40/94 is also a mark with a reputation for the purposes of Article 8(5) of Regulation No 40/94 and should also be protected under that latter provision.

117 Moreover, the Board of Appeal's finding that the appellant expressly limited its appeal to matters pertaining to Article 8(1) of Regulation No 40/94 is incorrect and was challenged by the appellant before the Court of First Instance. The appellant also debated before the Court of First Instance the relationship between Articles 8(2) and 8(5) of Regulation No 40/94 to establish that the marks protected by those provisions have the same connotation today. The Court of First Instance incorrectly failed to examine that argument in the judgment under appeal, and ruled that head of claim inadmissible.

118 OHIM submits that, whereas it should have challenged the Board of Appeal's decision to regard the appeal as based solely on Article 8(1) of Regulation No 40/94 and submitted that the Board thus infringed Article 74 of that regulation, the appellant alleged, in its application to the Court of First Instance, that the Board infringed Article 8(5) of Regulation No 40/94. Since the Board of Appeal had not considered Article 8(5) of Regulation No 40/94, the Court of First Instance concluded correctly, in the light of Article 135(4) of its Rules of Procedure, that the appellant's request that the Court of First Instance rule on the application of that provision was inadmissible.

Findings of the Court

119 First it must be stated, as regards the analysis carried out by the Court of First Instance in order to establish the subject-matter of the proceedings before the Board of Appeal, that although in paragraph 20 of the judgment under appeal the Court of First Instance held that at no time had the appellant requested the Board of Appeal to apply Article 8(5) of Regulation No 40/94 and that the Board therefore had not examined that article, the Court also held in that paragraph that the appellant, in its opposition to the trade mark application and before the Board of Appeal, had invoked the reputation of its earlier trade mark exclusively within the context of the application of Article 8(1)(b)

of that regulation, that is to say for the purpose of substantiating the likelihood of confusion in the mind of the relevant public.

120 The Court of First Instance therefore cannot be criticised for relying only on the appellant's claims before the Board of Appeal in order to establish the subject-matter of the proceedings before the latter. On the contrary, the Court of First Instance satisfied itself that it did not follow from the appellant's claims before the Opposition Division that it had based its opposition also on Article 8(5) of Regulation No 40/94.

121 Consequently, having found that the relative ground for refusal of registration under Article 8(5) of Regulation No 40/94 was not part of the proceedings before the Board of Appeal, the Court of First Instance correctly rejected that plea as inadmissible.

122 The appellant did not have the power to alter before the Court of First Instance the terms of the dispute as delimited in the respective claims and allegations submitted by Orange and itself (see, to that effect, Case C-412/05 P *Alcon* v *OHIM* [2007] ECR I-3569, paragraph 43).

123 First, the review carried out by the Court of First Instance under Article 63 of Regulation No 40/94 is a review of the legality of the decisions of the Boards of Appeal of OHIM. The Court of First Instance may annul or alter a decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by

one of the grounds for annulment or alteration set out in Article 63(2) of that regulation (see, to that effect, Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 53).

124 Secondly, it is evident from Article 135(4) of the Rules of Procedure of the Court of First Instance that the parties may not change the subject-matter of the proceedings before the Board of Appeal.

125 Secondly, as regards the assertion that the Board of Appeal was wrong to decide that Article 8(5) of Regulation No 40/94 was not part of the subject-matter of the dispute, it should be observed that, as the appellant has raised a ground of appeal which was not part of the action brought against that decision before the Court of First Instance, that argument constitutes a new plea which extends the subject-matter of the dispute and which therefore cannot be put forward for the first time at the appeal stage.

126 Indeed, to allow a party to put forward for the first time before the Court of Justice a plea in law which it has not raised before the Court of First Instance would be to authorise it to bring before the Court of Justice, whose jurisdiction in appeals is limited, a case of wider ambit than that which came before the Court of First Instance. In an appeal, the jurisdiction of the Court of Justice is thus confined to a review of the findings of law on the pleas argued before the Court of First Instance (see Case C-136/92 P *Commission* v *Brazzelli Lualdi and Others* [1994] ECR I-1981, paragraph 59; Case C-266/97 P *VBA* v *VGB and Others* [2000] ECR I-2135, paragraph 79; Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 50; and *JCB Service* v *Commission*, paragraph 114).

127 It follows that the fourth ground of appeal must be rejected as in part unfounded and in part inadmissible.

The fifth ground of appeal, alleging that the Court of First Instance infringed Article 63 of Regulation No 40/94 and its Rules of Procedure by declaring inadmissible the appellant's head of claim seeking that the case be remitted to the Board of Appeal

Arguments of the parties

128 The appellant submits that the claim which it submitted at the hearing before the Court of First Instance was not a new claim, but a claim in the alternative to that based on Article 8(5) of Regulation No 40/94. Since the main form of order sought necessarily covers all the subsidiary claims, the subject-matter of the proceedings is not amended every time a claim is added to the initial form of order sought.

129 Consequently, by declaring that head of claim submitted by the appellant inadmissible, as a new claim changing the subject-matter of the proceedings, the Court of First Instance infringed Article 63 of Regulation No 40/94, and Articles 44, 48 and 135(4) of its Rules of Procedure.

130 OHIM contends that the head of claim in question is based on a new plea in law claiming that the Board of Appeal infringed Article 74(1) of Regulation No 40/94 by failing to rule on the applicability of Article 8(5) of that regulation, and was only raised by the appellant when it realised that its plea of infringement of Article 8(5) was inadmissible. Given that that head of claim put forward in the alternative was only submitted at the hearing stage, the Court of First Instance was correct in declaring it inadmissible, relying on Articles 44 and 48 of its Rules of Procedure.

Findings of the Court

131 As paragraphs 119 and 124 of this judgment show, the Court of First Instance was correct in dismissing as inadmissible the plea alleging infringement of Article 8(5) of Regulation No 40/94.

132 Consequently, this ground of appeal by which the appellant criticises the Court of First Instance for having regarded as new claims the claims which the appellant asserts were submitted by it in the alternative to the plea alleging infringement of Article 8(5) of Regulation No 40/94 and on the assumption that the Court of First Instance were to consider that plea well founded, must be held to be inoperative.

The sixth ground of appeal, alleging that the Court of First Instance infringed Article 63 of Regulation No 40/94 and Article 135(4) of its Rules of Procedure by refusing to admit certain documents

Arguments of the parties

133 The appellant claims that, by declaring inadmissible certain documents produced for the first time before the Court of First Instance, that court infringed Article 63 of Regulation No 40/94 and Article 135(4) of its Rules of Procedure.

134 The appellant submits that in the present case it adduced new evidence before the Court of First Instance only because the Board of Appeal had held that the evidence submitted to it by the appellant was unsatisfactory.

135 According to OHIM, the sixth ground of appeal must be dismissed since the function of the Court of First Instance is to review the legality of the decisions of the Board of Appeal and not, when ruling on an appeal against one of those decisions, to establish whether it may lawfully adopt a new decision with the same operative part as the contested decision. Consequently, the Board of Appeal cannot be accused of any illegality with regard to factual evidence which was not submitted to it.

Findings of the Court

136 As the Court of First Instance rightly stated in paragraph 16 of the judgment under appeal, the purpose of an action before it is to review the legality of the decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94.

137 It follows from that provision that facts not submitted by the parties before the departments of OHIM cannot be submitted at the stage of the appeal brought before the Court of First Instance.

138 It is also apparent from that provision that the Court of First Instance cannot re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. The legality of a decision of a Board of Appeal of OHIM must be assessed in the light of the information available to it when it adopted that decision.

139 In this connection, the Court has already observed that it follows from Articles 61(2) and 76 of Regulation No 40/94 that, for the purposes of the examination as to the merits of the appeal brought before it, the Board of Appeal is to invite the parties, as often as necessary, to file observations on communications issued by itself and that it may also order preliminary measures, among which feature the submission of matters of fact or

evidence. Article 62(2) of Regulation No 40/94 states that if the Board of Appeal remits the case for further prosecution to the department whose decision was appealed against, that department is to be bound by the *ratio decidendi* of the Board of Appeal,'in so far as the facts are the same'. In turn, such provisions demonstrate the possibility of seeing the underlying facts of a dispute multiply at various stages of the proceedings before OHIM (*OHIM* v *Kaul*, paragraph 58).

140 Therefore the appellant cannot argue that it did not have adequate opportunities to submit evidence to OHIM.

141 In addition, it must be recalled that Article 74(2) of Regulation 40/94 provides that OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

142 The Court has stated in this connection that where such facts and evidence have not been submitted and produced by the party concerned within the time-limit set to that end under the provisions of Regulation No 40/94, and thus not 'in due time' within the meaning of Article 74(2) of that regulation, that party does not enjoy an unconditional right to have such information taken into account by the Board of Appeal of OHIM. On the contrary, that board has a discretion as to whether or not to take such information into account when making the decision which it is called upon to give (see *OHIM* v *Kaul*, paragraph 63).

143 Moreover, evidence which has never been produced before OHIM has not, in any event, been produced in due time and cannot be used as a criterion with which to assess the legality of the decision of the Board of Appeal.

144 Since the Court of First Instance's decision to disregard as inadmissible the documents produced for the first time before it is warranted in the light of the provisions of

Article 63 of Regulation No 40/94, there is no further need to examine the appellant's arguments concerning the alleged infringement of Article 135(4) of the Rules of Procedure of the Court of First Instance.

145 In the light of the foregoing, the sixth ground of appeal must be rejected as unfounded.

146 Since none of the appellant's grounds of appeal can be upheld, the appeal must be dismissed in its entirety.

Costs

147 Under Article 62(2) of the Rules of Procedure of the Court, applicable to appeal proceedings by virtue of Article 118 of those rules, the unsuccessful party is to be ordered to pay the costs if they have been asked for in the successful party's pleadings. Since OHIM sought such an order and the appellant has failed in its appeal, it must be ordered to pay the costs.

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

1. Dismisses the appeal;

2. Orders Les Éditions Albert René Sàrl to pay the costs.

[Signatures]