Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

20 March 2013*

(Community trade mark — Opposition proceedings — Application for Community word mark CLUB GOURMET — Earlier national figurative mark CLUB DEL GOURMET, EN ... El Corte Inglés — Relative ground for refusal — Lack of similarity between the goods and services — Article 8(1)(b) of Regulation (EC) No 207/2009 — Arguments and evidence adduced for the first time before the General Court)

In Case T-571/11,

El Corte Inglés, SA, established in Madrid (Spain), represented by E. Seijo Veiguela and J.L. Rivas Zurdo, lawyers,

applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM being

Groupe Chez Gerard Restaurants Ltd, established in London (United Kingdom),

ACTION brought against the decision of the First Board of Appeal of OHIM of 28 July 2011 (Case R 1946/2010-1) relating to opposition proceedings between El Corte Inglés, SA and Groupe Chez Gerard Restaurants Ltd,

THE GENERAL COURT (Fourth Chamber),

composed of I. Pelikánová (Rapporteur), President, K. Jürimäe and M. van der Woude, Judges,

Registrar: C. Heeren, Administrator,

having regard to the application lodged at the Court Registry on 7 November 2011,

having regard to the response lodged at the Court Registry on 8 March 2012,

having regard to the written questions put to the parties by the Court and their replies to those questions lodged on 5 and 14 November 2012,

* Language of the case: Spanish.

further to the hearing on 11 December 2012,

gives the following

Judgment

Background to the dispute

1 On 24 May 2004 Groupe Chez Gerard Restaurants Ltd filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The mark in respect of which registration was sought is the word sign CLUB GOURMET.

3 The goods in respect of which registration was sought, after the restriction made during the proceedings before OHIM, are in Classes 16, 21, 29, 30, 32 and 33 of the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, in respect of each of those classes, to the following description:

— Class 16: 'Stationery, paper coasters, table cloths, table mats and table napkins of paper, paper gift bags';

— Class 21: 'Basting spoons, non-electric blenders, bottle openers, brushes for cooking, ceramics for household purposes, coffee grinders, coffee percolators, confectioner's decorating bags, cookery moulds, cooking skewers, cooking utensils, corkscrews, food presses, funnels, graters, griddles, ice buckets, ice-cube moulds, kitchen containers, kitchen mixers, kitchen utensils, mills for domestic purposes, mixing machines, mixing spoons, noodle machines, nozzles, pepper and salt mills, pipettes, pitchers, pots, rolling pins, tableware services, spatulas, sprinklers, tea-balls, tea caddies, tea infusers, tea services, trays, vacuum flasks, and wine tasters; food storage containers, glassware, porcelain and earthenware';

— Class 29: 'Preserved, dried and cooked fruits and vegetables; jellies, jams, meat, fish, poultry and game, charcuterie, cheese, soups, yogurt, olive oil, pâtés';

— Class 30: 'Coffee, pasta, tea, cocoa, flour, sugar, bread, pastry, confectionery, cakes, ice creams and sorbets, sandwiches, honey, treacle, mustard, vinegar, sauces, condiments and spices, fruit sauces';

— Class 32: 'Beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages';

— Class 33: 'Alcoholic beverages (except beers); wines; liqueurs'.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 17/2005 of 25 April 2005.

5 On 22 July 2005 the applicant, El Corte Inglés, SA, gave notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) to registration of the trade mark applied for in respect of all the goods referred to in paragraph 3 above.

6 The opposition was initially based on the following four earlier marks:

— the Spanish figurative mark No 1817328, registered for services in Class 35;

— Spanish word mark application No 2229135, designating goods in Class 16;

— Spanish word mark application No 2589335, designating goods in Classes 29, 30, 31, 32, 33 and 34;

— Community word mark application No 3789054, designating goods and services in Classes 29, 30, 31, 32, 33 and 35.

7 Subsequently, Community trade mark application No 3789054 was dismissed by decision of the Second Board of Appeal of 17 July 2006 (Case R 343/2006-2), which decision has become final. In addition, by letters of 24 November 2009 and 11 August 2010, in the context of the procedure before the Opposition Division, the applicant renounced Spanish trade mark applications Nos 2229135 and 2589335, respectively, as a basis for its opposition.

8 Consequently, the opposition is now based only on the earlier Spanish figurative mark No 1817328



registered for the following services in Class 35: ‘An advertising sentence. It will be applied to the products covered by the trade marks Nos 1013156 (Class 29), 1013157 (Class 30) and 1815538 (Class 31), 1815539 (Class 32), 1013158 (Class 33), 1815547 (Class 42) “El Corte Inglés” (figurative)’ (‘the earlier mark’).

9 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and (5) of Regulation No 40/94 (now Article 8(1)(b) and (5) of Regulation No 207/2009).

10 On 3 September 2010 the Opposition Division rejected the opposition.

11 On 6 October 2010 the applicant filed a notice of appeal at OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.

12 By decision of 28 July 2011 (‘the contested decision’) the First Board of Appeal of OHIM dismissed the appeal. In particular, it found, principally, that the description of the services designated by the earlier mark was ‘an advertising sentence’ which did not allow any comparison with the goods designated by the mark applied for, inasmuch as it designated neither goods nor a service. In the alternative, even if the earlier mark were considered to designate ‘advertising services’ in Class 35, the goods and services designated by the marks at issue are dissimilar. The public targeted by the goods designated by the mark applied for is the average consumer, whereas that targeted by the advertising services allegedly designated by the earlier mark is composed mainly of professionals. Lastly, the marks at issue are, first, overall visually dissimilar, secondly, they are in no way phonetically similar and, lastly, there is only a weak degree of conceptual similarity.

Forms of order sought by the parties

13 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

14 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

15 The applicant relies on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009.

16 Article 8(1)(b) of Regulation No 207/2009 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark. Moreover, under Article 8(2)(a) of Regulation No 207/2009, 'earlier trade marks' means trade marks registered in a Member State, with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

17 In accordance with settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. In accordance with that same case-law, the likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and goods or services concerned, and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services covered (see Case T-162/01 *Laboratorios RTB* v *OHIM - Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33 and the case-law cited).

18 In the first place, it is necessary to examine which goods are designated by the earlier mark, in that the Board of Appeal's assessment is being challenged by the applicant.

19 The Board of Appeal found, in paragraph 17 of the contested decision, that the description of the goods and/or services for which the earlier mark was registered did not indicate clearly the nature of the services covered by the earlier mark and that it did not correspond to any of the goods or services listed in the Nice Classification. In addition, an 'advertising sentence' is neither a good nor a service within the meaning of Article 8(1)(b) of Regulation No 207/2009. Consequently, that description does not allow any comparison of the goods or services covered by the marks at issue, so that the opposition had to be rejected. It was only in the alternative that it then examined the appeal on the basis of the Opposition Division's interpretation that the expression 'an advertising sentence' had to be equated to 'advertising services' in Class 35.

20 In that connection, the applicant submits, in essence, that, in accordance with the practice followed by the Spanish Patent and Trade Mark Office (SPTO) until 1997, a 'slogan mark' such as the earlier mark is protected not only for services in Class 35, but also for all the goods and services designated by one or more 'basic marks'. In this case, the earlier mark, applied for on 26 April 1994 and registered on 5 January 1996, is therefore also protected for goods and services in Classes 29, 30, 31, 32, 33 and 42 designated by the marks referred to in the earlier mark's description of services. Consequently, those goods and services should be taken into account for the comparison with those designated by the mark applied for and not only those in Class 35.

21 OHIM contends in that connection, essentially, that it is not possible to extend the protection of the earlier mark to goods in other classes or goods and services protected by other rights which have not been relied upon as the basis for the opposition.

22 Accordingly, it is appropriate, first of all, to ascertain the scope of the description of the goods and/or services for which the earlier mark has been registered. In that connection, in the first place, it will be necessary to have regard to the wording of the description of the goods and/or services referred to, as set out in paragraph 8 above. In the second place, the additional information provided by the applicant before OHIM must be assessed and, in the third place, the question whether and to what extent there is any obligation on OHIM to undertake an examination of its own motion of certain matters must be considered.

The wording of the description of the goods and/or services designated by the earlier mark

23 In the first place, it should be recalled that the list of goods and/or services designated by the earlier mark is worded as follows: '[class 35] An advertising sentence. It will be applied to the products covered by the trade marks Nos 1013156 (Class 29), 1013157 (Class 30) and 1815538 (Class 31), 1815539 (Class 32), 1013158 (Class 33), 1815547 (Class 42) "El Corte Inglés" (figurative)'.

24 The Court notes, in that connection, that the list identifies a single service, in Class 35, namely 'an advertising sentence', whose envisaged use is then indicated. On the other hand, it is not apparent from the wording cited in the previous paragraph that the earlier mark is supposed also to designate the goods covered by the marks stated as constituting the scope of application of the service in question. Moreover, contrary to what the applicant claimed at the hearing, it is not possible, from that list alone, to know which goods are designated by the marks which that list enumerates, since those goods are not identified specifically, but only by reference to the marks by which they are designated and their classes. However, since the classes of the Nice Agreement often cover a large number of very different goods, such information is not sufficient in order to identify the goods specifically covered (see, to that effect and by analogy, Case C-307/10 *The Chartered Institute of Patent Attorneys* [2012] ECR, paragraphs 49, 56, 61 and 62).

The information provided by the applicant before OHIM

25 In the second place, in accordance with settled case-law, the purpose of an action before the General Court is to review the legality of the decisions of the Boards of Appeal of OHIM within the meaning of Article 65 of Regulation No 207/2009. 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 action brought before the General Court and that the latter 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 (Case C-214/05 P *Rossi* v *OHIM* [2006] ECR I-7057, paragraphs 50 to 52, and Case C-16/06 P *Les Éditions Albert René* v *OHIM* [2008] ECR I-10053, paragraphs 136 to 138).

26 It must be observed that the applicant relies for the first time before the General Court on the specific practice of the SPTO concerning the treatment of 'slogan marks' until 1997 and on the case-law of the national courts and tribunals as to the scope of the protection conferred by registrations prior to that date. It is apparent from its pleadings submitted to OHIM that the applicant at no stage expressly argued, either before the Opposition Division or the Board of Appeal, that the protection conferred by the earlier mark went beyond the services in Class 35 alone.

27 In particular, first, in the notice of opposition submitted to OHIM on 22 July 2005, the applicant put a cross in the box indicating that the opposition was based on 'all the goods/services for which earlier mark [was] registered', without its being apparent from the notice which goods and services were concerned, or even the classes of such goods and services.

28 Secondly, in the annex to that notice, setting out the grounds of the opposition, the applicant relied on the four earlier rights referred to in paragraph 6 above, including the earlier mark, indicating, for each of those rights, the classes of the goods and/or services designated by them. However, for the earlier mark, it referred only to Class 35, not to Classes 29, 30, 31, 32, 33 and 42 to which, in the applicant's opinion, the protection of that mark extends.

29 Thirdly, by letter of 27 October 2005 OHIM notified the applicant that its opposition contained no indication of the goods and services on which it was based and that a mere indication that the opposition was based on all the goods and services for which the earlier trade mark was registered was not sufficient in that regard. In its reply of 28 October 2005 the applicant merely supplied, with regard to the earlier mark, extracts from the database concerning the legal situation of the matters before the SPTO ('the sitadex database'), in Spanish and English, which contained, under the heading 'Class', only the entry '35'.

30 Fourthly, in its observations of 10 July 2008 on the opposition, the other party to the proceedings before OHIM stated that the earlier mark was registered for services in Class 35, defined as an advertising slogan applying to numerous marks, and that those services bore no resemblance to or connection with the goods designated by the mark applied for. It further stated that the applicant had not based its opposition on any registrations in Classes 29, 30, 32 and 33. In its observations of 15 December 2008 before the Opposition Division, submitted in response to those of the other party to the proceedings before OHIM, the applicant simply stated that the earlier rights designated goods and services in Classes 16, 29, 30, 31, 32, 33, 34, 35 and 42. Given that, as at that date, the applicant still based its opposition not only on the earlier mark, but also on two Spanish national trade mark applications (see paragraphs 6 and 7 above), the applicant's statement did not enable the Opposition Division to ascertain that the earlier mark was supposed to designate the goods in classes other than Class 35.

31 Fifthly, in its decision of 3 September 2010, the Opposition Division stated, as regards the services designated by the earlier mark, that those services were 'identified, in essence, as an *advertising sentence* in class 35' and that it interpreted that 'rather unusual and unclear list' as referring to advertising services relating to the goods in Classes 29, 30, 31, 32, 33 and 42. The Opposition Division further stated that, 'as the … list [of services was] headed with the class number 35 only, the Opposition Division interpret[ed] the list as covering only services in class 35 and not the goods/services in classes 29, 30, 31, 32, 33 and 42'.

32 Notwithstanding that express refusal by the Opposition Division to take into account the goods in those classes in so far as they were designated by the earlier mark, the applicant still did not consider it necessary, in the grounds of its appeal before the Board of Appeal, to argue clearly that, in its view, the earlier mark was also protected for those goods. On the contrary, the applicant first of all stated, in the section headed 'Facts and procedure' of its appeal, that its opposition was based on 'the earlier trademark [registration] … in class 35'. Next, it stated, in the passages on the comparison of the goods, that '[T]he earlier trademark cover[ed] services in Class 35 "advertising services relating to the

goods in classes 29, 30, 31, 32, 33 and 42"'. Lastly, the applicant relied solely on the argument that the 'advertising services' in Class 35 are complementary to the goods designated by the mark applied for and are related to some of those goods. In that connection, first, it must be noted that the earlier mark designated 'an advertising sentence', not 'advertising services' and that the information submitted by the applicant before the Board of Appeal had no basis in fact. Second, if the applicant had intended to rely on the fact that the protection of the earlier mark extended to the goods and services in Classes 29, 30, 31, 32, 33 and 42, it would have sufficed for it to argue that the goods and services at issue were similar or identical, at least in part, rather than asserting an alleged complementary link between the services in Class 35 and the goods designated by the earlier mark in Classes 16, 21, 29, 30, 32 and 33.

33 It follows that, contrary to what the applicant claimed at the hearing, the evidence which it submitted during the administrative procedure, as a whole, did not provide any express indication that the protection conferred by the earlier mark was supposed, in its mind, to extend beyond the services in Class 35 alone. On the contrary, that evidence contained numerous indications, both explicit and implicit, that the earlier mark was supposed to designate only services in Class 35. However, at this stage of the proceedings, that does not prejudice the issue of how the indication 'an advertising sentence' should be construed.

The obligation on OHIM to take into account Spanish national law of its own motion

34 In the third place, it is, however, necessary to examine whether, as the applicant argued at the hearing, OHIM was required to take into account of its own motion the fact that, under Spanish national law, the protection conferred by the earlier mark extended to the goods in Classes 29, 30, 31, 32, 33 and 42 designated by the marks referred to in the description of services.

35 In that connection, it must be noted, first, that, generally, for the institutions of the European Union, determining and interpreting rules of national law, in so far as so doing is essential to their activity, is a matter of establishing the facts, not applying the law. Indeed, the only law which is applied is European Union law ('EU law'). Therefore, while it is true that Article 65(2) of Regulation No 207/2009, relied on by the applicant, must be construed as meaning that rules of law whose infringement may give rise to an action before the General Court may be the province of national or EU law, it is, however, only EU law which falls within the area of law, in which the maxim *iura novit curia* applies, whereas national law is an issue of fact, where facts must be adduced and the requirements of the burden of proof apply, and the content of national law must be demonstrated where necessary by the production of evidence (Opinion of Advocate General Kokott in Case C-263/09 P *Edwin* v *OHIM* [2011] ECR I-5853, points 55, 56, 75 and 77; see, by analogy, the judgment in *Edwin* v *OHIM*, paragraphs 47 to 50).

36 As regards, in particular, the scope of the protection conferred by an earlier national mark, such an interpretation may, moreover, also be based on the wording of Rule 19(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended, which provides that, '[w]ithin the period [set by OHIM], the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right …'. In accordance with Rule 20(1) of that regulation, '[i]f until expiry of the period …, the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, … the opposition shall be rejected as unfounded'. In accordance with those provisions, it is therefore for the opposing party to file proof of the scope of protection of the earlier mark relied on, not for OHIM to investigate such matters.

37 Consequently, the Court must reject the applicant's contention that national law forms part of the EU law framework relevant for the purposes of the General Court's examination of the lawfulness of OHIM's decisions. Although the General Court may, in the context of that examination, also penalise

OHIM's errors of assessment of the facts, it remains the case that, in order to be taken into account by OHIM, the facts at issue must have been adduced and, where necessary, proved by the party relying on them.

38 It follows that, as a rule, in the context of a procedure before the EU institutions, it is for the party relying on national law to show that it supports his claims.

39 Admittedly, the General Court has qualified that principle, holding that OHIM must, of its own motion and by whatever means considered appropriate, obtain information about the national law of the Member State concerned, where such information is necessary to assess the applicability of the ground for refusal of registration in question and, in particular, the correctness of the facts pleaded or the probative value of the documents lodged (see Case T-318/03 *Atomic Austria* v *OHIM - Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* [2005] ECR II-1319, paragraph 35 and case-law cited).

40 That led the General Court to hold that OHIM was required to take into account, in its assessment of the evidence submitted to it, national law and practice, in a situation in which the opposing party had produced register extracts certifying the registration of its national marks, but was not in a position to prove that they had been renewed, because the national trade mark office in question did not, as a rule, issue official documents to certify such a renewal (*ATOMIC BLITZ*, paragraphs 43 to 47).

41 However, in accordance with the passage cited in paragraph 39 above, the obligation on OHIM to obtain of its own motion information about national law was made conditional upon 'such information [being] necessary to assess the applicability of the ground for refusal of registration in question and, in particular, the correctness of the facts pleaded or the probative value of the documents lodged'. It is therefore only where OHIM already has information relating to national law, either in the form of claims as to its meaning, or in the form of evidence submitted and whose probative value has been adduced, that it is required, if necessary, to obtain of its own motion information about national law.

42 In the present case, as observed in paragraphs 27 to 33 above, the applicant has at no stage expressly argued before OHIM that the earlier mark in particular is protected for goods and services other than those in Class 35. On the contrary, it has even provided, on a number of occasions, indications that the mark related exclusively to Class 35.

43 In such circumstances, it was impossible for either the Opposition Division or the Board of Appeal to take cognisance of the claim that the earlier mark was supposed to cover in addition the goods and services designated by the 'basic marks', in Classes 16, 29, 30, 31, 32, 33 and 42. Consequently, in the present case, OHIM was not required to obtain information about Spanish national law or to carry out investigations in that regard.

44 Lastly, the Court must reject the applicant's argument that OHIM did not in fact even need to obtain information or make enquiries concerning Spanish national law, since, in the applicant's submission, in a decision of the Second Board of Appeal of 17 July 2006 in Case R 343/2006-2, also involving the applicant, OHIM had 'recognise[d] the existence, meaning and effects … of the "slogan marks"' and the Opposition Division took account of that decision in its decision of 3 September 2010 in the present case.

45 First, the first passage of the decision of 17 July 2006, cited by the applicant, appears in the section of that decision headed 'Arguments of the applicant', and the Second Board of Appeal was therefore merely setting out the arguments put forward by the applicant. It should be noted in this respect that the applicant cannot be permitted, in order to challenge the lawfulness of the decision contested in the present case, to rely on arguments and facts which it did not raise before OHIM in the context of the present *inter partes* proceedings but rather in *ex parte* proceedings concerning another trade mark application.

46 Secondly, in the second passage cited by the applicant, the Board of Appeal clearly stated that the SPTO's specific practice in relation to 'slogan marks', relied on by the applicant in an argument based on the existence of earlier national registrations, '[did not] appear relevant *prima facie*'. In the decision relied on by the applicant, OHIM did not therefore even consider the substance of the applicant's argument based on the specific features of the Spanish national law concerning 'slogan marks'. *A fortiori*, OHIM cannot be regarded as having recognised the existence, meaning and effects of those specific features.

47 Thirdly, contrary to what the applicant claims, there can be no question of the specific features of the Spanish national law in question being 'known and cited by OHIM itself in the opposition proceedings [in the present case]'. As is apparent from the Opposition Division's preliminary remarks in its decision of 3 September 2010 in the present case, it took into account only the operative part of the Second Board of Appeal's decision of 17 July 2006 in Case R 343/2006-2 which, by dismissing the applicant's appeal, definitively refused registration of one of the earlier marks on which the applicant had initially relied in support of its opposition in the present case.

48 It follows from all the foregoing that OHIM could not ascertain, either from the description of the services designated by the earlier mark or on the basis of the information supplied before it by the applicant, that the protection conferred by the earlier mark was supposed to extend to the goods designated by the applicant's 'basic marks' in Classes 29, 30, 31, 32, 33 and 42. Similarly, in the circumstances of this case, OHIM was not required to take into account of its own motion the specific features of the Spanish national law concerning 'slogan marks' or to conduct of its own motion any investigation of those features.

49 It follows that all the applicant's evidence and arguments relating to Spanish national law must be rejected as inadmissible, in accordance with the case-law cited in paragraph 25 above.

50 Consequently, for the purposes of the present case, the description of the services designated by the earlier mark is limited to the services in Class 35, as identified in the description in paragraph 8 above.

Interpretation of the description of the services designated by the earlier mark

51 The Board of Appeal found, principally, that the indication 'an advertising sentence', as a description of the services designated by the earlier mark, did not correspond to any of the goods or services listed by the Nice Classification, was neither a good nor service within the meaning of Article 8(1)(b) of Regulation No 207/2009, and could not be interpreted as covering 'advertising services' without constituting an inadmissible extension of the scope of the services covered by the earlier mark.

52 Invited, in the context of written questions from the Court and at the hearing, to make its views known on that assessment, the applicant stated at the hearing that it did not in principle object to the words 'an advertising sentence' being interpreted, as the Opposition Division did, as referring, in point of fact, to advertising services, but it emphasised that it disputed that the protection of the earlier mark should be limited to those services, excluding the goods designated by the 'basic marks'. The applicant submits, in addition, that the services in Class 35 designated by the earlier mark are similar, complementary or closely linked to the goods designated by the mark applied for. It relies, in that connection, on two judgments in which the General Court recognised that services, inter alia, in Class 35, on the one hand, and goods and services in Classes 5, 14, 18 and 25, on the other, were similar.

53 In that regard, suffice it to state that those arguments of the applicant in no way concern the Board of Appeal's assessment as set out in paragraph 51 above and that, *a fortiori*, they cannot call it into question.

54 As stated above, the circumstances of the present case are characterised by the fact that, first, it was not apparent from either the wording of the description of the services designated by the earlier mark or from the submissions and contentions of the applicant during the procedure before OHIM that the scope of the protection of the mark in question went beyond that strict wording. Secondly, the specific features of Spanish national law, enabling, in the applicant's view, the meaning of that description of the services to be usefully clarified, may not, for procedural reasons, be taken into account by the General Court. Accordingly, the Court must hold, as did the Board of Appeal, that the description of the services designated by the earlier mark, as set out in paragraph 8 above, does not allow them to be compared with the goods designated by the mark applied for.

55 Consequently, the Board of Appeal did not err in finding that the opposition had to be rejected for that reason.

56 In the light of all the foregoing, the applicant's single plea in law must be rejected and the action must therefore be dismissed in its entirety.

Costs

57 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

58 Since the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Fourth Chamber)

hereby:

1. Dismisses the action;

2. Orders El Corte Inglés, SA to pay the costs.

Pelikánová Jürimäe Van der Woude

Delivered in open court in Luxembourg on 20 March 2013.

[Signatures]