

European Court of Justice, 18 December 2008, Mobilix



TRADEMARK LAW

Counteraction of similarities

- 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

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

Series of trade marks

- 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, account should be taken, in the assessment of the likelihood of confusion, of the fact that, 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.

Finally, 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. 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.

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European Court of Justice, 18 December 2008

(P. Jann, A. Tizzano, A. Borg Barthet, M. Ilešič and E. Levits)

JUDGMENT OF THE COURT (First Chamber)

18 December 2008 (*)

(Appeals – Community trade mark – Regulation (EC) No 40/94 – Articles 8 and 63 – Word mark MOBILIX – Opposition by the proprietor of the Community and national word mark OBELIX – Partial rejection of the opposition – Reformatio in pejus – ‘Counteraction’ theory – Modification of the subject-matter of the dispute – Documents included as an annex to the application as new evidence before the Court of First Instance)

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 Harmonisation 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,

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 Harmonisation 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 Textilver-](#)

trieb 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 distinc-

tive 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 Bergadermand 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 Regu-

lation 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 VGBand 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.

OPINION OF ADVOCATE GENERAL
TRSTENJAK

delivered on 29 November 2007 1(1)

Case C-16/06 P

Les Éditions Albert René SARL

v

Office for Harmonisation in the Internal Market (Trade marks and designs)

(Appeals – Community trade mark – ‘MOBILIX’ word mark – Opposition by the proprietor of the Community and national word mark ‘OBELIX’ – Reformatio in pejus – Doctrine of ‘counteraction’ – Change to the subject-matter of the proceedings – Documents annexed as new evidence to the application to the Court of First Instance)

I – Introduction

1. The appellant – Les Éditions Albert René SARL – is requesting the Court to set aside the judgment of the Court of First Instance of the European Communities (Third Chamber) (‘the Court of First Instance’) in Case T-336/03 Les Éditions Albert René v OHIM – Orange (MOBILUX) [2005] ECR II-4667 (‘the judgment under appeal’), by which the Court of First Instance dismissed its appeal against the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade marks and designs) (OHIM) of 14 July 2003 (Case R 0559/2002-4) relating to opposition proceedings between the appellant and Orange A/S (‘Orange’) concerning the opposition by the appellant, proprietor of the earlier trade mark ‘OBELIX’, to registration as a Community trade mark of the sign ‘MOBILIX’. The Opposition Division dismissed the appellant’s opposition; the fourth Board of Appeal upheld its appeal in part.

2. The appellant considers principally that, in that judgment, the Court of First Instance failed to take account of the principle of the prohibition on reformatio in pejus and mechanically applied the doctrine of ‘counteraction’ when assessing the likelihood of confusion between the goods and services covered by two similar marks.

II – Legal framework

3. Article 8 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, (2) as amended, governs relative grounds for refusal and provides as follows:

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

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(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;

- (ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;
- (iii) trade marks registered under international arrangements which have effect in a Member State;
- (b) applications for the trade marks referred to in subparagraph (a), subject to their registration;
- (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'.

4. Article 74 of that regulation governs examination of the facts by the Office of its own motion and provides 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. Article 44 of the Rules of Procedure of the Court of First Instance (3) provides as follows:

'1. An application of the kind referred to in Article 21 of the Statute of the Court of Justice shall state:

- (a) the name and address of the applicant;
- (b) the designation of the party against whom the application is made;
- (c) the subject-matter of the proceedings and a summary of the pleas in law on which the application is based;
- (d) the form of order sought by the applicant;
- (e) where appropriate, the nature of any evidence offered in support.

2. For the purposes of the proceedings, the application shall state an address for service in the place where the Court of First Instance has its seat and the name of the person who is authorised and has expressed willingness to accept service.

In addition to or instead of specifying an address for service as referred to in the first subparagraph, the application may state that the lawyer or agent agrees that

service is to be effected on him by telefax or other technical means of communication.

If the application does not comply with the requirements referred to in the first and second subparagraphs, all service on the party concerned for the purposes of the proceedings shall be effected, for so long as the defect has not been cured, by registered letter addressed to the agent or lawyer of that party. By way of derogation from the first paragraph of Article 100, service shall then be deemed to have been duly effected by the lodging of the registered letter at the post office of the place where the Court of First Instance has its seat.

3. The lawyer acting for a party must lodge at the Registry a certificate that he is authorised to practise before a Court of a Member State or of another State which is a party to the EEA Agreement.

4. The application shall be accompanied, where appropriate, by the documents specified in the second paragraph of Article 21 of the Statute of the Court of Justice.

5. An application made by a legal person governed by private law shall be accompanied by:

(a) the instrument or instruments constituting and regulating that legal person or a recent extract from the register of companies, firms or associations or any other proof of its existence in law;

(b) proof that the authority granted to the applicant's lawyer has been properly conferred on him by someone authorised for the purpose.

5a. An application submitted under Article 238 of the EC Treaty, Article 42 of the ECSC Treaty or Article 153 of the EAEC Treaty pursuant to an arbitration clause contained in a contract governed by public or private law, entered into by the Community or on its behalf, shall be accompanied by a copy of the contract which contains that clause.

6. If an application does not comply with the requirements set out in paragraphs 3 to 5 of this Article, the Registrar shall prescribe a reasonable period within which the applicant is to comply with them whether by putting the application itself in order or by producing any of the abovementioned documents. If the applicant fails to put the application in order or to produce the required documents within the time prescribed, the Court of First Instance shall decide whether the non-compliance with these conditions renders the application formally inadmissible.'

6. Article 48 of the Rules of Procedure of the Court of First Instance provides as follows:

'1. In reply or rejoinder a party may offer further evidence. The party must, however, give reasons for the delay in offering it.

2. No new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. If in the course of the procedure one of the parties puts forward a new plea in law which is so based, the President may, even after the expiry of the normal procedural time-limits, acting on a report of the Judge Rapporteur and after hearing the Advocate General, allow the other party time to answer on that plea.

Consideration of the admissibility of the plea shall be reserved for the final judgment.’

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

III – Facts

8. On 7 November 1997, Orange filed an application with OHIM for registration of the word sign ‘MOBILIX’ as a Community trade mark under Regulation No 40/94.

9. The goods and services in respect of which registration was sought are in Classes 9, 16, 35, 37, 38 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description:

– ‘apparatus, instruments and installation for telecommunication, including for telephony, telephones and cellular telephones, including antennae, aerials and parabolic reflectors, accumulators and batteries, transformers and convertors, 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.

10. The Community trade mark application was the subject of an opposition brought by the appellant based on the following earlier rights relating to the term ‘OBELIX’:

– the earlier registered trade mark, protected by registration of Community trade mark No 16 154 of 1 April 1996 in respect of certain goods and services in Classes 9, 16, 28, 35, 41 and 42 of the Nice agreement for the following goods and services in so far as they are relevant to the present proceedings:

– ‘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 well-known mark in all the Member States. (4)

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

12. By decision of 30 May 2002, the Opposition Division rejected the opposition and authorised the continuation of the procedure for registration of the application for a Community trade mark. The Opposition Division considered that it had not been conclusively demonstrated that the earlier trade mark was well known, and found that, overall, the trade marks were not similar. There was a certain aural similarity but that was counteracted by the visual appearance of the trade marks and, more particularly, by the very different concepts which they express: mobile phones in the case of ‘MOBILIX’ and obelisks in the case of ‘OBELIX’.

13. Following an appeal filed by the appellant on 1 July 2002, the Fourth Board of Appeal delivered its decision on 14 July 2003. It annulled in part the decision of the Opposition Division. The Board of Appeal stated, first of all, 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 'signalling and teaching apparatus and instruments' in the Community trade mark application and 'optical and teaching apparatus and instruments' in the earlier registration in 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 the earlier registration. The Board found that, given the degree of similarity between the signs in question and between these 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 'signalling and teaching apparatus and instruments', and services described as 'business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties', and granted it in respect of the other goods and services.

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

14. By an application filed with the Registry of the Court of First Instance on 1 October 2003, the appellant requested that the decision of the Board of Appeal of 14 July 2003 be annulled, raising three pleas in law: first, infringement of Article 8(1)(b) and (2) of Regulation No 40/94; secondly, infringement of Article 8(5) of Regulation No 40/94; and, thirdly, infringement of Article 74 of Regulation No 40/94. It must be pointed out that at the hearing, the appellant requested in the alternative that the case be referred back to the Fourth Board of Appeal in order to afford it the opportunity to prove that its mark had a reputation within the meaning of Article 8(5) of Regulation No 40/94.

15. In its judgment, the Court of First Instance first examined the admissibility of the five documents appended to the application and produced for the first time by the appellant before the Court of First Instance in order to prove that the sign 'OBELIX' was well known. Having found that those documents had not been produced in the context of the procedure before OHIM, the Court of First Instance, referring to Article 63 of Regulation No 40/94, declared them inadmissible inasmuch as to admit them would be contrary to Article 135(4) of the Rules of Procedure of the Court of First Instance (paragraphs 15 and 16 of the judgment under appeal). In this context, the Court of First Instance referred to the characteristics of annulment proceedings, in which the legality of a measure before the court must be assessed on the basis of the elements of law and fact existing at the time when the measure was adopted.

16. The Court of First Instance then declared inadmissible the plea based on Article 8(5) of Regulation No 40/94, pointing out that at no time did the appellant request the Board of Appeal to apply that provision and that therefore the Board did not consider it. First of all, under Article 74 of Regulation No 40/94, in proceed-

ings relating to relative grounds for refusal to register, OHIM is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. Secondly, since the purpose of applications to the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94, such review must be conducted with regard to the issues of law raised before the Board of Appeal. Thirdly, Article 135(4) of the Rules of Procedure states expressly that '[t]he parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal' (paragraphs 19 to 25 of the judgment under appeal).

17. Lastly, the Court of First Instance declared the head of claim put forward for the first time at the hearing inadmissible under Article 44(1) of the Rules of Procedure of the Court of First Instance (paragraphs 28 and 29 of the judgment under appeal).

18. The Court of First Instance then went on to consider the merits of the substance of the pleas. With regard to the plea of infringement of Article 74 of Regulation No 40/94, according to which, in the absence of a challenge by the other party to the proceedings, the Board of Appeal ought to have assumed that the opponent's 'OBELIX' mark had a reputation, the Court of First Instance found in paragraphs 34 and 35 of the judgment under appeal that Article 74 of Regulation No 40/94 cannot be interpreted as meaning 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. In this case neither the Opposition Division nor the Board of Appeal considered that the appellant had substantiated conclusively on the facts or evidence adduced the legal assessment advocated by it, namely that the unregistered sign was well known and that the registered sign was highly distinctive. Accordingly, in paragraph 36 of the judgment under appeal, the Court of First Instance declared that plea unfounded.

19. With regard to the plea based on Article 8(1)(b) and (2) of Regulation No 40/94, the Court of First Instance first assessed the similarity of the goods and services at issue. The Court rejected the appellant's argument that the goods referred to in the Community trade mark application, included in Classes 9 and 16, were included in the extensively-worded list of goods and services at the time of the earlier registration; 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 other goods 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 continued as follows, in paragraphs 62 and 63 of the judgment under appeal:

'62. Furthermore, it is clear from the list of goods and services falling within Class 9 covered by the earlier registration that the sectors covered by that right are photography, cinema, optics, teaching and video

games. That list of goods and services is close to that which is claimed in the Community trade mark application, which shows that the sector in question is, almost exclusively, telecommunications of all forms. Telecommunications equipment falls within the category of “apparatus for recording, transmission or reproduction of sound and/or images”, which forms part of the official title of Class 9 ... However, that part of the class title (“telecommunications”) was not claimed in the earlier right, which implies that telecommunications equipment was not intended to be covered. The applicant registered its trade mark in respect of a large number of classes, but it did not refer to “telecommunications” in the specification and it even excluded the whole of Class 38 from the registration. Class 38 concerns precisely “telecommunications” services.

63. The Court shares the view of the Board of Appeal that the earlier registration protects “electrotechnical apparatus and instruments, electronics”, but that that wide formulation cannot be used by the applicant 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, when specific protection of telecommunications apparatus and instruments could have been easily obtained.’

20. After upholding the Board of Appeal’s finding that the services referred to in the trade mark application in Classes 37 and 42 and the services designated in the earlier registration and included in Class 42 were not similar (paragraph 67), the Court of First Instance held as follows:

‘68. Second, the Board of Appeal did not err when it asserted that the services listed in the Community trade mark application under Class 38 ... are sufficiently different from those covered by the earlier registration and included in Class 41 ..., given their technical nature, the skills required to offer them and the needs of the consumers which they are intended to satisfy. Consequently, the services appearing in the trade mark application included in Class 38 are at most slightly similar to the services falling within Class 41 protected by the earlier right.

69. Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to “computers” and “computer programs” (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. 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. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software. That exclusion is not in any event legitimate in the present case, since the

Community trade mark application is exclusively for telecommunications in their various forms, whereas the earlier registration makes no reference to any activity in that sector. Furthermore, as the Board of Appeal rightly pointed out, there is nothing to stop the applicant from also registering its trade mark in respect of telephony.’

21. Lastly, the Court of First Instance held, in paragraph 70 of the judgment under appeal, that ‘the goods and services in question are not similar’, with one exception: the ‘leasing of computers and computer programs’ which appeared in the Community trade mark application (Class 42) and the appellant’s ‘computers’ and ‘computer programs recorded on data carriers’ (Class 9) were similar by reason of their complementarity.

22. With regard to comparison of the signs, after noting that the Board of Appeal had found in the contested decision that the signs at issue were similar (paragraph 74 of the judgment under appeal), the Court of First Instance undertook a visual, aural and conceptual comparison (paragraphs 75 to 81 of the judgment under appeal).

23. The Court of First Instance found, *inter alia*, that, despite the letter combination ‘OB’ and the ‘LIX’ ending, common to both, they had a number of significant visual differences, such as the letters following ‘OB’ (‘E’ in the first case and ‘I’ in the second), the beginning of the words (the Community trade mark applied for began with ‘M’ and the earlier mark with ‘O’) and their length. Having observed that the consumer’s attention is usually directed to the beginning of the word, the Court of First Instance concluded that ‘the signs in question are not visually similar or that, at most, they are visually very slightly similar’ (paragraphs 75 and 76 of the judgment under appeal).

24. After carrying out an aural comparison of the signs, the Court of First Instance held that they had a certain aural similarity (paragraphs 77 and 78). As regards the conceptual comparison, the Court of First Instance found that, even if the term ‘OBELIX’ had been registered as a word mark, it would readily be identified by the average member of the public with the popular character from the comic strip, which makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar (paragraph 79 of the judgment under appeal). 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 between the signs were such as to counteract the aural similarities and any visual similarities (paragraphs 80 to 81 of the judgment under appeal).

25. With regard to the likelihood of confusion, referring to Case T-311/01 *Les Éditions Albert René v OHIM – Trucco (STARIX)* [2003] ECR II-4625, the Court of First Instance stated 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' (paragraph 82 of the judgment under appeal). It continued:

'83. In those circumstances, the Board of Appeal's assessment of the distinctiveness of the earlier trade mark and the appellant's claims as to the reputation of that trade mark have no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in the present case (see, to that effect, *Starix*, ..., paragraph 60).

84. A likelihood of confusion presupposes that the signs as well as the goods and services designated are identical or similar, and the reputation of a mark is one factor which must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a risk of confusion (see, to that effect and by analogy, *Canon*, ..., paragraphs 22 and 24). Since, however, in the present case, the signs in dispute cannot be regarded as identical or similar, the fact that the earlier mark is widely known or enjoys a reputation in the European Union cannot alter the overall assessment of the likelihood of confusion (see to that effect, *Starix*, ..., paragraph 61).

85. Lastly, the Court must reject the appellant's argument that, because of the "IX" suffix, it is 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". It suffices to note in that regard that the applicant cannot claim an exclusive right to the use of the "IX" suffix.

86. It is clear from the foregoing that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 has not been satisfied. It therefore follows that the Board of Appeal was right in finding that there is no likelihood of confusion between the mark claimed and the earlier mark.'

26. The Court of First Instance accordingly dismissed the action brought by the applicant in that case.

27. The applicant before the Court of First Instance brought an appeal against the judgment of that Court on 13 January 2006.

28. It must also be noted that this appeal, while admissible, does not comply with the recommendations set out in paragraph 44 of the Practice Directions relating to direct actions and appeals, owing to its length. (5)

29. At the hearing of 25 October 2007, the parties submitted observations and replied to the Court's questions.

V – Analysis of the appeal

30. The appellant puts forward six grounds in support of the appeal. By the first ground of appeal, it complains that the judgment under appeal infringed Article 63 of Regulation No 40/94 and ruled on the similarity of the trade marks even though this did not form part of the subject-matter of the proceedings before the Court of First Instance. It thus infringed the principle of the prohibition on *reformatio in pejus*. By the second ground of appeal, the appellant pleads infringement of Article 8(1)(b) of Regulation No 40/94

with regard to the similarity of the goods and services and the similarity of the marks. By the third ground of appeal, the appellant complains that the Court of First Instance infringed Article 74 of Regulation No 40/94. By the fourth ground of appeal, it claims infringement of Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance. By the fifth ground of appeal, it complains that the Court infringed Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the appellant's head of claim seeking to have case referred back to the Board of Appeal. The sixth ground relates to the infringement of Article 63 of Regulation No 40/94 owing to the refusal to admit certain documents.

A – First ground of appeal: alleged infringements of Article 63 of Regulation No 40/94 and of the general Community procedural law principle of prohibition on *reformatio in pejus*

1. Arguments of the parties

31. The appellant claims that the judgment of the Court of First Instance infringed Article 63 of Regulation No 40/94 as well as the general principles of Community administrative and procedural law in that it found, contrary to the contested decision of the Board of Appeal, that the conflicting marks, 'OBELIX' and 'MOBILIX', were not similar, thus ruling to the detriment of the appellant on a question which had not been raised in a formally correct manner, thus exceeding its jurisdiction in the review of decisions of the Boards of Appeal of OHIM in a case such as this one.

32. The appellant observes that the issue of the similarity of the trade marks in no way formed the subject-matter of the application to the Court of First Instance and ought therefore not to have formed part of the proceedings before the Court of First Instance. However, even though the question of the similarity of the marks was not raised by any party to the proceedings in accordance with the required conditions, the Court of First Instance none the less ruled on this point to the appellant's detriment and therefore in fact disregarded the prohibition on *reformatio in pejus*.

33. OHIM replies by referring to the judgment in Case C-39/97 *Canon* [1998] ECR I-5507 (paragraph 17 and operative part) that the first ground of appeal is manifestly without foundation. In fact the Court of First Instance was bound to re-examine the similarity of the signs in question. In its application the appellant challenged the findings of the Board of Appeal as to the likelihood of confusion. As the similarity of the signs was an aspect of those findings, it had necessarily to be examined by 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 and to ensure its correct application.

34. Furthermore, OHIM points out that the Court of First Instance did not make changes to the Board of Appeal's decision. However, the prohibition on *reformatio in pejus* prevents an appeal court from going beyond the appellant's submissions and placing it in a

position less favourable than that in which it would be if it had not brought the appeal. In this case the Court of First Instance did not alter the decision by which the Board of Appeal partially upheld the opposition. The appellant was therefore not placed in a situation more unfavourable than that in which it was before making its application to the Court of First Instance.

2. Assessment

35. Under the general principle of procedural law known as the prohibition on *reformatio in pejus*, a higher court competent to rule on a remedy, for example an appeal, cannot vary a contested decision of a lower court to the appellant's detriment, if the appellant is the only party to have sought that remedy. (6)

36. Also under the principle of the prohibition on *reformatio in pejus*, in general, the worst outcome of the remedy applied for by the appellant must be the dismissal of the application and the simple upholding of the contested decision. (7)

37. That applies in the appellant's case. The judgment under appeal places the appellant in the same position as before it brought its application before the Court of First Instance. From that point of view it is difficult to see how this can be regarded as a case of *reformatio in pejus*.

38. The prohibition on *reformatio in pejus* before the Community Courts is limited by the courts' duty to raise of their own motion pleas of public policy. (8) A plea of substantive legality can only be examined before the Community Courts at the appellant's request whereas a plea of public policy can, and indeed must, be raised by the Court of its own motion. (9)

39. It must be pointed out that the concept of public policy in the context of pleas before the Community courts (10) is 'reserved to matters which, owing to their importance to the public interest, are not left to the discretion of the parties or of the Court and must be examined as a preliminary issue even though they have not been raised by the parties'. (11)

40. The appellant complains that in the judgment under appeal the Court of First Instance examined of its own motion the legality of the decision of the Board of Appeal from the viewpoint of the issue of similarity even though it did not claim an infringement thereof. It considers that this amounts to *reformatio in pejus* because the Court of First Instance examined a plea which it did not raise in its appeal.

41. It must be pointed out that the appellant did not challenge the legality of the Board of Appeal's findings on the question of the similarity of the 'OBELIX' and 'MOBILIX' signs and the goods and services protected by the two marks. Yet it is none the less apparent from the application to the Court of First Instance, and in particular paragraph 2.3 et seq thereof, that the appellant referred to the matter of the similarity of the 'OBELIX' and 'MOBILIX' signs and the goods and services protected by the two marks, as well as the likelihood of confusion, in its action before the Court of First Instance. In fact, it raised the arguments on the question of the similarity of the abovementioned marks and signs in the context of the plea of substantive legal-

ity relating to the infringement of Article 8(1)(b) and (2) of Regulation No 40/94. In the context of that plea, it argued before the Court of First Instance in exploring the claim of infringement of the well-known and highly distinctive nature of the 'OBELIX' mark that there was strong conceptual and aural similarity between the 'OBELIX' and 'MOBILIX' signs. (12) It also argued that there was a likelihood of conceptual confusion as a result of the interdependence between the similarity of the goods, the similarity of the trade marks, and the distinctiveness of the 'OBELIX' trade mark. (13) It thus included the question of the similarity of the 'OBELIX' and 'MOBILIX' signs within the subject-matter of the proceedings.

42. The subject-matter of the proceedings as set out by the appellant under Article 63 of Regulation No 40/94 also included the issue of the similarity of the 'OBELIX' et 'MOBILIX' signs. Accordingly, the appellant cannot accuse the Court of First Instance of ruling on the question of the similarity of the 'OBELIX' and 'MOBILIX' signs in the context of an analysis of the interdependence of the factors involved.

43. The Court of First Instance did not infringe either Article 63 of Regulation No 40/94 or the general principle of procedural law of the prohibition on *reformatio in pejus*.

44. The ground of appeal cannot succeed.

B – Second ground of appeal: alleged infringement of Article 8(1)(b) of Regulation No 40/94 owing to the similarity of the goods and services and the similarity of the marks

1. Arguments of the parties

45. By this ground of appeal, which is of considerable length and divided into two limbs, the appellant alleges infringement of Article 8(1)(b) of Regulation No 40/94 owing to the similarity of the goods and services and the similarity of the trade marks.

46. By the first limb, 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. First of all, the appellant criticises the Court of First Instance for having applied an incorrect legal principle to determine whether the respective goods and services were similar. By the second limb of the second ground of appeal, the appellant alleges that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94 in taking the view that the contested marks were dissimilar.

47. With regard to the first limb, the appellant states that a comparison of similarity should have been made, assuming that the conflicting marks are identical and that the earlier 'OBELIX' mark is highly distinctive or has a reputation. The correct legal criterion is therefore as follows: the goods (and services) are similar where the public could believe that they come from the same undertakings or from undertakings that are economically connected and where they appear on the market under identical marks and the earlier mark is highly distinctive and very widely known.

48. Secondly, the appellant challenges the consistency and basis of the specific findings as to the

similarity of the goods made by the Court of First Instance, which manifestly misread the list of goods and distorted it. According to the appellant, the Court of First Instance's statement in paragraph 62 of the judgment under appeal that 'it is clear from the list of goods and services falling within Class 9 covered by the earlier registration that the sectors covered by that right are photography, cinema, optics, teaching and video games' is incorrect and contradicted by the list of those of those goods and by the Court's own statements in paragraph 63. The statement, in paragraph 62 of the judgment under appeal, that the field covered by the 'MOBILIX' trade mark is almost exclusively telecommunications in all its forms is also contradicted by the list of goods, which includes 'accumulators and batteries', 'transformers and converters', 'coders and decoders', 'coded cards' and 'cards for coding', and is not limited to telecommunications.

49. With regard to the comparison of the 'MOBILIX' services within Classes 35, 37, 38 and 42 and the goods covered by the 'OBELIX' trade mark, the appellant alleges a contradiction between the findings of the Court of First Instance in paragraph 68 of the judgment under appeal ('the services appearing in the trade mark application included in Class 38 are at most slightly similar to the services falling within Class 41 protected by the earlier right') and the conclusion in paragraph 70 of the judgment under appeal that the goods and services in question are not similar; it also challenges the finding of the Court of First Instance rejecting the appellant's argument that all the goods and services covered by the Community trade mark application are connected with 'computers' and 'computer programs' (Class 9) covered by the earlier trade mark (paragraph 69 of the judgment under appeal).

50. By the second limb of the second ground of appeal, the appellant alleges that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94, in holding that the contested trade marks were dissimilar. This limb is advanced by way of alternative to the appellant's first ground of appeal. According to the appellant, the Court of First Instance did not apply the correct legal tests for assessing the similarity of the marks. With regard to visual similarity, the Court of First Instance arbitrarily highlighted the differences between the marks, whereas under general trade mark law principles, points in common are usually more significant than points of difference. The appellant alleges that the assessment of aural similarity made by the Court of First Instance, like that of conceptual similarity, is not supported by any of the facts submitted to that Court. With regard to conceptual comparison, the appellant challenges the finding of the Court of First Instance in paragraph 79 of the judgment under appeal, which states that '[the] specific representation of a popular character makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar'. The Court of First Instance's reasoning is incorrect, since according to general principles accepted in trade mark law, the

more well-known or distinctive an earlier mark is, the greater the likelihood of confusion.

51. The appellant also complains that the Court of First Instance applied the doctrine of 'counteraction' in paragraphs 80 to 82 of the judgment under appeal. According to the appellant, this doctrine is applicable only at the final assessment stage of the likelihood of confusion, but not where the conflicting marks are visually or aurally, or visually and aurally, similar. Therefore the correct legal criterion would have been as follows: two marks are similar (and, having found that the goods or services are similar or identical, the decision-making authority must therefore examine the likelihood of confusion) if there is (some, or a high degree of, or total) visual similarity (which also implies a degree of aural similarity), or whether there is (some, or a high degree of, or total) aural similarity, irrespective of whether or not there is conceptual similarity. Likewise, two marks are similar even if there is no visual or aural similarity where they are conceptually identical or similar.

52. Lastly, the appellant states that the Court of First Instance misunderstood its argument in stating in paragraph 85 of the judgment under appeal that it relies on an exclusive right to the use of the suffix 'IX', whereas it stated that it was the proprietor of a family of trade marks created in a similar way to 'MOBILIX' using a descriptive part which represents a person's profession or activity and combining it with the suffix 'IX'. Therefore the allusion to 'mobile' does not distance it from the family of trade marks but even increases the likelihood of confusion, since the existence of a family of trade marks is generally considered to be a discreet cause of the likelihood of confusion, even in the absence of aural and visual similarity.

53. OHIM contends that among the many arguments advanced by the appellant the only question of law is whether the Court of First Instance was entitled in law to conclude, in paragraph 81 of the judgment under appeal, that the conceptual differences between the signs in question are such as to counteract the existing aural and visual similarities. The Court of First Instance correctly examined all the evidence which, according to established case-law, must be taken into account in order to make a global assessment of the likelihood of confusion. According to settled case-law, such a global assessment entails that the conceptual and visual differences between two signs may counteract aural similarities between them in as much as at least one of the signs, from the point of view of the relevant public, has a clear and specific meaning, so that that public is likely to grasp it immediately. Whether such 'counteraction' actually occurs in the mind of the relevant consumer is a question of assessing the relevant facts. The result of this assessment is a finding of fact which is not subject to review by the Court of Justice in the context of an appeal.

54. With regard to the argument that the Court of First Instance should have taken account of the reputation of the 'OBELIX' trade mark in its comparison of the goods and services and the signs in question, OHIM argues that the appellant is confusing two concepts,

namely the reputation of Obelix, the well-known comic strip character, and the potential reputation of the 'OBELIX' trade mark. There is neither a legal principle nor any precedent according to which a famous literary character must automatically be regarded as a well-known trade mark. It all depends on the circumstances of the case and the appellant has never adduced, in the context of the procedure before OHIM, any evidence showing that the progressive transformation of a famous character into a well-known trade mark had actually occurred. Therefore, by declining to take account of the reputation of the Obelix name, which designates a famous comic strip character, in order to define the scope of protection of the earlier mark, the Court of First Instance was correct to apply the rule that, in opposition proceedings relating to relative grounds for refusal to register, the competent authority is restricted to the facts, evidence and arguments provided by the parties and the relief sought.

55. OHIM states that, by adhering to the principles established by the Court of First Instance, but challenging its conclusions, the appellant is reopening the factual assessments made by the Court of First Instance, which it is not for the Court of Justice to review in the context of an appeal.

56. With regard to the assertions that the Court of First Instance distorted the facts or evidence, OHIM takes the view that the Court of First Instance correctly reproduced the list of goods and services and made a comparative analysis based on factors such as the type of manufacturer or the distribution method for the goods. OHIM considers that the second ground of appeal must be rejected as partly unfounded and partly inadmissible.

2. Assessment

57. It is clear from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal lies on points of law only. The Court of First Instance 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 does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice. (14)

58. For the purposes of the application of Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where a trade mark is identical to a mark the highly distinctive character of which is particularly marked, to adduce evidence of similarity between the goods and services covered. In fact, the provision states that a likelihood of confusion presupposes that the goods or services covered are identical or similar.

59. The likelihood of confusion presupposes that the goods or services covered are identical or similar. Accordingly, even where a trade mark is identical to a mark the highly distinctive character of which is particularly marked, it is still necessary to adduce evidence of similarity between the goods or services covered. (15)

60. In those circumstances the appellant's argument, to the effect that the Court of First Instance erred in law by applying an incorrect legal criterion or no legal criterion but merely a line of argument containing contradictory assertions, is unfounded.

61. It follows from the examination of paragraphs 60 to 71 of the judgment under appeal that, having made a detailed analysis of the various factors characterising the relationship between the goods and services in question, the Court of First Instance was justified in considering, without erring in law, that the goods and services covered by the 'MOBILIX' trade mark are not similar to the services designated by the 'OBELIX' sign.

62. With regard to the argument that there is a clear contradiction on the part of the Court of First Instance between paragraphs 62 and 63 of the judgment under appeal, and that there are inaccuracies in paragraph 63 of the judgment under appeal, it must be noted that that argument essentially challenges the findings of fact made by the Court of First Instance and amounts to asking the Court of Justice to substitute its own appraisal of the facts for the findings made by the Court of First Instance in paragraphs 62 and 63 of the judgment under appeal. That argument of the appellant must therefore be rejected as manifestly inadmissible.

63. For those same reasons, the appellant's argument that the Court of First Instance did not correctly analyse the goods in Classes 9 and 16 respectively must be dismissed. In the light of the analyses made by the Court of First Instance, the same conclusion must be reached in relation to the complaint that the Court of First Instance merely conducted a literal comparison of the goods and services, and failed to take account of their economic relationship, and in particular disregarded the question whether the relevant public would attribute the same commercial origin to them where the goods and services have been offered under an identical mark.

64. In that context, the complaint relating to the issue of whether the Court of First Instance was entitled to conclude, in paragraph 81 of its judgment, (16) that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above, must be rejected. First of all, it must be pointed out that the Court of First Instance correctly applied, in paragraphs 72 and 74 to 80, the criteria set out in the case-law. Secondly, it is also clear from paragraph 79 of the judgment under appeal relating to the words 'MOBILIX' and 'OBELIX' that the Court of First Instance made certain factual findings therein and that the appellant is seeking to challenge the assessment of the facts made by the Court of First Instance and is in reality requesting that the Court substitute its own assessment of the facts for the findings of the Court of First Instance.

65. It is therefore clear from all of the foregoing considerations that the ground of appeal must be rejected as unfounded.

C – Third ground of appeal: alleged infringement of Article 74 of Regulation No 40/94 by rejecting the

claim that the ‘OBELIX’ trade mark was well known and had a highly distinctive character

1. Arguments of the parties

66. The appellant complains that the Court of First Instance infringed Article 74 of Regulation No 40/94 by rejecting the claim that the ‘OBELIX’ trade mark was well known and highly distinctive. The appellant challenges the correctness of the finding made by the Court of First Instance that OHIM assessed the facts and evidence since it was obliged to do so under Article 74(1) of Regulation No 40/94, but found them to be insufficient to establish that the unregistered sign was well known and that the registered sign was highly distinctive. Since Orange did participate in the proceedings before the Board of Appeal but failed to contest or otherwise challenge the appellant’s allegations, it would be absurd to require it to provide all the evidence, since there is no rule or principle of Community law that requires a party to produce evidence to prove something that is common ground between the parties. Indeed, the Opposition Division and the Board of Appeal expressly recognised the fact that the ‘OBELIX’ sign was well known. The Board of Appeal should therefore have concluded that the ‘OBELIX’ mark is highly distinctive and well known. Furthermore, since well-known facts need not be proved, the same principle ought to apply to well-known trade marks.

67. OHIM considers that the third ground of appeal must be rejected as manifestly unfounded. The restrictions placed on which facts may be included in the Board of Appeal’s examination under Article 74 of Regulation No 40/94 does not preclude the Board of Appeal from taking into consideration well-known facts other than those pleaded by the parties to the opposition proceedings. However, what might be regarded as well known in the present case is that Obelix is the name of a comic strip character. Yet that finding cannot apply as such to the OBELIX trade mark, as there is no precedent for saying that famous literary characters must be regarded as well-known trade marks.

68. Even if the parties do not disagree on the question of the reputation of the ‘OBELIX’ trade mark, the Court of First Instance is not bound by such a finding but is required to consider whether, by finding in the contested decision that there was no similarity between the marks, the Board of Appeal perhaps 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.

2. Assessment

69. As a preliminary matter, it must be pointed out that the appellant challenges the legality and correctness of the assessment of reputation made by the Board of Appeal and the Court of First Instance in the judgment under appeal.

70. As pointed out in paragraph 57, an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and assess the relevant

facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice.

71. By contrast, provided that the 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. (17)

72. With regard to the merits of the third ground of appeal, it must be pointed out that under Article 74(1) of Regulation No 40/94, in the course of the procedure, OHIM is to examine the facts of its own motion; however, in proceedings relating to the relative grounds for refusal of registration, the examination is restricted to the facts, evidence and arguments provided by the parties and the relief sought. In that regard, an appellant who refers to well-known facts is in a position to challenge the accuracy of the Board of Appeal’s findings of fact relating to reputation before the Court of First Instance.

73. The finding by the Court of First Instance as to whether the facts on which the Board of Appeal of OHIM based its decision are well known, including also the issue of whether the ‘OBELIX’ sign is well known, is a factual assessment which, save where the facts or evidence are distorted, is not subject to review by the Court of Justice on appeal. (18) However, there is no evidence of distortion in this case.

74. Therefore, the Court of First Instance did not err in law by holding, in paragraphs 32 to 36 of the judgment under appeal, that the legal finding as to how well known and distinctive the OBELIX sign is was not sufficiently supported by facts or evidence.

75. The third ground of appeal must therefore be dismissed as unfounded.

D – Fourth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and of Article 135(4) of the Rules of Procedure of the Court of First Instance by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94

1. Arguments of the parties

76. According to the appellant, the Court of First Instance infringed Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the appellant’s application to the Court of First Instance for annulment of the contested decision on the ground that the Board of Appeal did not apply Article 8(5) of Regulation No 40/94. The Court of First Instance erred in law in relying on an incorrect interpretation of the subject-matter of the appeal procedure; nor did it take account of the fact that the Board of Appeal could not limit itself to examining the facts or evidence relied on before it but ought to have extended its examination to

the facts produced at first instance, even if that question was not expressly raised in the grounds of the appeal.

77. The appellant states that, while the arguments on which it relied before the Board of Appeal related to 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 maintained throughout that it was the proprietor of the 'OBELIX' trade mark, which is protected simultaneously as a registered Community trade mark, as a well-known mark pursuant to Article 8(2)(c) of Regulation No 40/94 and as a famous trade mark. The appellant has always maintained that a trade mark that is well known and that comes within Article 8(2)(c) of Regulation No 40/94 was also a mark with a reputation for the purposes of Article 8(5) of Regulation No 40/94.

78. 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 meaning today. The Court of First Instance did not examine that argument in substance in the judgment under appeal, and ruled that head of claim inadmissible.

79. OHIM replies that this ground of appeal is manifestly unfounded. In fact, in its notice of opposition, the appellant, by ticking the appropriate boxes, based its opposition on two grounds – likelihood of confusion with an earlier trade mark and the gain unduly realised from the distinctiveness or reputation of an earlier mark or the adverse effect on it – when it provided the evidence in support of its opposition. The appellant did not, however, rely on the latter ground of opposition, namely Article 8(5) of Regulation No 40/94. Notwithstanding this evidential deficiency, the Opposition Division of OHIM referred to that provision, stating that there was no need to examine the merits of the opposition in the light of Article 8(5) of Regulation No 40/94 since the signs were not similar. When it appealed against that decision, the appellant did not ask the Board of Appeal to apply Article 8(5) of Regulation No 40/94; nor, moreover, did it mention the provision in its statement of grounds of appeal. In the light of the foregoing, and of the fact that the appellant has never identified the earlier mark the distinctiveness or reputation of which was adversely affected by the Community trade mark application, the Board of Appeal found that the documents produced in the context of the opposition proceedings were, rather, intended to demonstrate the reputation of the unregistered mark which was presented as one of the two earlier rights, or possibly the greater distinctiveness of the registered mark, but not its reputation within the meaning of Article 8(5) of Regulation No 40/94. The Board of Appeal did not therefore rule on the applicability of Article 8(5) of Regulation No 40/94.

80. Yet, rather than stating that the Board of Appeal had infringed Article 74 of Regulation No 40/94 by failing to consider Article 8(5) of Regulation No 40/94, the appellant claimed in its later application to the Court of First Instance that the Board had 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 application to the Court of First Instance to determine the applicability of that provision was inadmissible.

2. Assessment

81. As a preliminary point it must be pointed out that the appellant did not, in its opposition or its appeal to the Board of Appeal, request a review of legality under Article 8(5) of Regulation No 40/94. Indeed it is clear from the contested decision of the Board of Appeal (19) and from the submissions of the parties in the context of the present appeal and from the judgment under appeal and the Court of First Instance's Report for the Hearing that the plea of infringement of Article 8(5) of Regulation No 40/94 was put forward for the first time before the Court of First Instance.

82. It must be observed that, as the appellant points out, (20) it is not easy to distinguish between well-known trade marks and those with a reputation. In fact, there is some similarity between Articles 8(1) and (2) of Regulation No 40/94, on the one hand, and Article 8(5) of the same regulation, on the other. However, the reference to reputation and being well known in Article 8(2)(c) of Regulation No 40/94 and the reference in Article 8(5) of that regulation, which relates to the situation where the goods and services of two trade marks of which one has a reputation in the Community, cannot be said to be similar. An interpretation to the effect that Article 8(5) of Regulation No 40/94 is but the continuation of Articles 8(1) and (2) and that they must be examined together even though Article 8(5) was not relied on before the OHIM departments fails to take account of the scope of application of Article 8(5). In fact, on a schematic interpretation, it is clear both from the internal system and the external system of Article 8 of Regulation No 40/94 that the criteria contained in subparagraphs (1), (2) and (5) of Article 8 are different. The external system, that is to say the structure of the provision, clearly shows that subparagraphs (1), (2) and (5) of Article 8 of the regulation are distinct. Under the internal system, that is to say the way in which the content of the provision is arranged, the aims of the paragraphs are different. (21)

83. From this viewpoint, the appellant, having failed to contest the legality of the decision of the Opposition Division and the Board of Appeal in the light of Article 8(5) of Regulation No 40/94, cannot make good its own failure by referring to similar provisions.

84. Furthermore, in the context of the annulment proceedings regarding the decision referred to the Community courts, the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure

was adopted. (22) The same is true of the proceedings under Article 63 of Regulation No 40/94. In fact it is settled case-law that an appeal under that article relates to the legality of the decisions of the Boards of Appeal of OHIM within the meaning of Article 63(3) of Regulation No 40/94. Indeed, whereas under Article 63(3) of Regulation No 40/94, the Court of First Instance ‘has jurisdiction to annul or to alter the contested decision’, that paragraph must also be read in the light of the previous paragraph under which ‘[t]he 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’, and in the context of Articles 229 EC and 230 EC. The Court’s review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal. (23) It is common ground that Article 8(5) of Regulation No 40/94 was not one of the issues of law raised before the Board of Appeal.

85. Therefore the appellant could not have required the Court of First Instance to rule on this ground of appeal, which is based on a possible infringement of Article 63 of Regulation No 40/94 and of the Rules of Procedure of the Court of First Instance, by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94, a plea which was not put forward during the administrative phase of the procedure before OHIM.

86. The Court of First Instance did not, by rejecting the plea based on Article 8(5) of Regulation No 40/94 as inadmissible, infringe Article 63 of Regulation No 40/94 or Article 135(4) of the Rules of Procedure of the Court of First Instance by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94. This ground of appeal is unfounded.

E – Fifth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the head of claim seeking referral of the case back to the Board of Appeal

1. Arguments of the parties

87. The appellant considers that the judgment of the Court of First Instance infringed Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance in that it declared inadmissible the head of claim, put forward in the alternative at the hearing, seeking referral of the case back to the Board of Appeal in order to enable the appellant to establish the reputation of the ‘OBELIX’ trade mark. At the hearing before the Court of First Instance, the appellant submitted that, if the Court of First Instance were to uphold the principal form of order sought, to the effect that the Board of Appeal had infringed Article 8(5) of Regulation No 40/94, or itself rule on the complaint based on Article 8(5) of Regulation No 40/94, it should in any event refer the case back

to the Board of Appeal in order to enable the appellant to establish that assertion before it.

88. The appellant claims first of all that the form of order seeking referral back to the Board of Appeal to enable the appellant to establish the claim based on Article 8(5) of Regulation No 40/94 is not a ‘new’ form of order sought, but a form of order sought in the alternative based on Article 8(5) of Regulation No 40/94. The form of order sought in the alternative necessarily falls outside the main form of order sought and does not therefore constitute a ‘new’ form of order sought within the meaning of the judgment under appeal. Secondly, the Court of First Instance seems to have viewed the notion of ‘subject-matter’ as used in Article 135(4) of its Rules of Procedure as something which is amended every time a ‘form of order sought’ is added to the initial form of order sought, irrespective of its nature or context. The subject-matter of the proceedings before the Board of Appeal was whether ‘MOBILIX’ could be registered as a Community trade mark for some or all of the goods for which it was filed, given the opposition filed by the appellant on the basis of its ‘OBELIX’ trade mark. In no way did the appellant change this subject-matter, and the principal form of order seeking annulment of the Board of Appeal’s contested decision necessarily encompasses all the forms of order sought in that connection.

89. The appellant claims that Article 44 of the Rules of Procedure of the Court of First Instance does not prohibit, either expressly or impliedly, the setting-out of forms of order sought in the alternative in the principal form of order sought at a stage of the proceedings subsequent to the filing of the originating application. Nor, similarly, does Article 48 of the Rules of Procedure of the Court of First Instance contain any such prohibition.

90. OHIM contends that this ground of appeal is manifestly unfounded. Furthermore, this head of claim submitted in the alternative 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 Regulation No 40/94, and was only raised by the appellant when it realised that its claim of infringement of Article 8(5) was inadmissible. Given that this 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 the Rules of Procedure of the Court of First Instance.

2. Assessment

91. As is also noted in paragraphs 57 and 70 with regard to possible procedural irregularities, under the first paragraph of Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice, an appeal lies on points of law only. According to the latter provision, an appeal may lie on grounds of lack of competence of the Court of First Instance, a breach of procedure before it which adversely affected the interests of the appellant, or the infringement of Community law by the Court of First Instance. (24) Thus, the Court of Justice has jurisdiction to verify

whether a breach of procedure adversely affecting the appellant's interests was committed before the Court of First Instance and must satisfy itself that the general principles of Community law and the Rules of Procedure applicable to the burden of proof and the taking of evidence have been complied with. (25)

92. The form of order sought, as referred to in Article 38(1) of the Rules of Procedure of the Court and Article 44(1)(d) of the Rules of Procedure of the Court of First Instance, specifies the subject-matter of the application (26) and contains the operative part of the decision which the applicant seeks to obtain from the Community courts. (27) Accordingly, it is part of the subject-matter of the proceedings and must be stated in the application.

93. Although the Community courts acknowledge the admissibility of forms of order sought which are put forward in the alternative (*eventualiter*) in the event of rejection of the main form of order sought (*principaliter*) in the originating application, (28) the situation seems to be different if alternative forms of order sought are formulated during the course of the proceedings or even at the hearing. In fact, such forms of order, although formulated in the alternative, are new forms of order sought which change the subject-matter of the proceedings, since they articulate a claim submitted after expiry of the mandatory period for bringing proceedings and one which is to be examined in the event of rejection of the main form of order sought as put forward *principaliter*.

94. According to settled case-law, the first subparagraph of Article 42(2) of the Rules of Procedure of the Court exceptionally allows an applicant to raise new pleas in support of a form of order sought put forward in the originating application. Conversely, that provision in no way seeks to afford to the applicant the possibility of putting forward new forms of order sought. (29) Likewise, the equivalent provisions of Article 48(2) of the Rules of Procedure of the Court of First Instance allow in certain circumstances for new pleas in law to be produced during the course of proceedings. However, those provisions may in no case be interpreted as authorising the applicants to bring new claims before the Community judicature and thereby modify the subject-matter of the proceedings. (30)

95. However, a reformulation of the initial form of order sought is admissible, subject to the condition that it merely gives further particulars of the form of order sought in the application or that the reformulated form of order sought is still only secondary compared to the initial form of order sought. (31)

96. It must therefore be examined whether the head of claim put forward by the appellant in the alternative at the hearing before the Court of First Instance represents a reformulation of the existing form of order sought or a fresh form of order sought.

97. By its form of order sought in the alternative, the appellant essentially requested that the Court of First Instance refer the case back to the Board of Appeal to afford the appellant an opportunity to prove that its trade mark enjoys a reputation within the meaning of

Article 8(5) of Regulation No 40/94, and to issue directions to OHIM to examine the merits of the appellant's claims. It must be observed that the alternative head of claim is not intended to elicit clarification of the consequences of annulment, as the appellant claims, but to secure the issuing of directions to OHIM. However, under Article 63(6) of Regulation No 40/94, OHIM is to take the measures necessary to comply with the judgment of the Community courts. Accordingly, the Court of First Instance is not entitled to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part of the judgment of the Court of First Instance and the grounds on which they are based. (32)

98. It is therefore plain that the appellant was submitting a new head of claim in the alternative, by which it was asking for directions to be issued to OHIM. It was therefore attempting to change the subject-matter of the proceedings.

99. The Court of First Instance was entitled, without erring in law, to reject as inadmissible the form of order sought in the alternative at the hearing on the ground that it was a new form of order.

100. This ground of appeal cannot therefore succeed.

F – Sixth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and of Article 135(4) of the Rules of Procedure of the Court of First Instance by refusing to admit certain documents

1. Arguments of the parties

101. The appellant claims that the judgment of the Court of First Instance infringes Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance, in that it declared inadmissible certain documents produced for the first time before the Court of First Instance. According to the appellant, the Rules of Procedure do not in fact contain any prohibition on the production of evidence before the Court of First Instance.

102. The appellant criticises the Court of First Instance's interpretation of the notion of subject-matter of the proceedings in Article 135(4) of the Rules of Procedure of the Court of First Instance. The facts on which the appellant relied in support of its argument do not form part of the 'subject-matter' but constitute evidence in the case. It is only because the Board of Appeal, the highest authority in the administrative procedure, held that evidence to be unsatisfactory for the purposes of proving the appellant's claims that the appellant adduced new evidence before the Court of First Instance.

103. According to the appellant, it is also incompatible with the role of the Court of First Instance, as first-instance authority with power to review the lawfulness of OHIM's decisions, to refuse to take into consideration evidence adduced before it.

104. OHIM observes that the role of the Court of First Instance is to review the legality of decisions of the Boards of Appeal and not, when ruling on an appeal against a decision of an OHIM Board of Appeal, to establish whether it may lawfully adopt a new decision

with the same operative part as the contested decision. It follows that OHIM cannot be accused of any illegality with regard to factual evidence which was not submitted to it. Factual evidence which was adduced before the Court of First Instance but not previously produced before the OHIM departments must be excluded.

2. Assessment

105. As noted in paragraphs 57, 70 and 91, an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice.

106. It must also be borne in mind that, in an appeal, the Court of Justice has no jurisdiction to establish the facts or, in principle, to examine the evidence which the Court of First Instance accepted in support of those facts. Provided that the evidence has been properly obtained and the general principles of law and the rules of procedure in relation to the burden of proof and the taking of evidence have been observed, it is for the Court of First Instance alone to assess the value which should be attached to the evidence produced to it. Save where the evidence adduced before the Court of First Instance has been distorted, the appraisal therefore does not constitute a point of law which is subject to review by the Court of Justice. (33)

107. Although the appellant discusses the question whether, by declaring inadmissible the evidence offered by way of five documents, the Court of First Instance breached its Rules of Procedure, this in fact amounts to a claim that the evidence was distorted.

108. In the present case, however, there does not appear to have been any distortion of the evidence nor any breach of the Rules of Procedure of the Court of First Instance.

109. Even if the five documents adduced by the appellant before the Court of First Instance did demonstrate the repute of the 'OBELIX' sign, they were not sent to OHIM in the context of the procedure which led to the contested decision and were not discussed in due time, that is, before the contested decision was adopted. Indeed, in the context of proceedings for annulment of the decision referred to the Community Court, the legality of the contested measure must be assessed on the basis of the elements of fact and law existing at the time when the measure was adopted. (34)

110. In referring, in paragraph 16 of its judgment, to Article 135(4) of its Rules of Procedure, the Court of First Instance was seeking to highlight the nature of annulment proceedings. It is common ground that the five documents were not submitted before OHIM. In order to be taken into consideration, they should have been submitted during the administrative procedure before OHIM.

111. The sixth ground of appeal cannot succeed.

112. The appellant's appeal must be dismissed in its entirety.

VI – Costs

113. Under Article 69(2) of the Rules of Procedure of the Court of Justice, which applies to appeals under Article 118 of those Rules of Procedure, the unsuccessful party is to pay the successful party's costs. Accordingly if, as I propose, all the appellant's grounds of appeal are rejected, the appellant must be ordered to pay the costs of the appeal.

VII – Conclusion

114. On the basis of the above considerations I propose that the Court:

1. dismiss the appeal; and
2. order Les Éditions Albert René SARL to pay the costs.

1 – Original language: French.

2 – OJ 1994 L 11, p. 1.

3 – OJ 1991 L 136, p. 1, corrigendum OJ 1991 L 317, p. 34.

4 – See paragraph 5 of the judgment under appeal.

5 – OJ 2004 L 361, p. 15.

6 – Fasching, W., *Zivilprozeßrecht*, 2nd edition, Vienna, 1990, p. 883; Rosenberg, L., Schwab, K.-H., Gottwald, P., *Zivilprozessrecht*, 16th edition, Munich, 2004, p. 983; Rechberger, W, Simotta, D.-A., *Zivilprozessrecht*, 6th edition, Vienna, 2003, pp. 454 and 455.

7 – Rechberger, W, Simotta, D.-A., *op. cit.*, p. 455. The authors point out that there may be a change to the defendant's advantage only if the defendant has also appealed against the same decision before the same court.

8 – Fasching, W., *Zivilprozeßrecht*, p. 884.

9 – On the definition of public policy pleas in Community law, see Lenaerts, K., Arts, D., Maselis, I., Bray R., *Procedural Law of the European Union*, 2nd edition, London 2006, pp. 288 and 289; Sladič, J., 'Die Begründung der Rechtsakte des Sekundärrechts der EG in der Rechtsprechung des EuGH und des EuG', *Zeitschrift für Rechtsvergleichung, internationales Privatrecht und Europarecht*, 46(2005), p. 127, and Castillo de la Torre, F, 'Le relevé d'office par la juridiction communautaire', *Cahiers de droit européen*, 3-4/2005, p. 395 (421).

10 – It must be noted that the concept of pleas that are typical of, for example, French and Belgian law corresponds fairly closely to the notion in Roman law of an *actio*. The application of this system before the Community courts and the division into public policy pleas and substantive legality pleas have rightly been criticised in the commentaries by former judges of the Court of Justice. Indeed the former German judge Ulrich Everling considers that parties not from countries with a civil law system based on French legal tradition encounter difficulties with this system owing to the division between matters which are indivisible before the courts (Everling, U., 'Das Verfahren der Gerichte der EG im Spiegel der verwaltungsgerichtlichen Verfahren der Mitgliedstaaten', *Die Ordnung der Freiheit: Festschrift für Christian Starck zum siebzigsten Geburtstag*, 2007, p. 542).

- 11 – Opinion of Advocate General Ruiz-Jarabo Colomer in Joined Cases C-204/00 P, C-205/00 P, C-211/00 P, C-213/00 P, C-217/00 P and C-219/00 P *Aalborg Portland and Others v Commission* [2004] ECR I-267, point 217.
- 12 – Report for the Hearing in Case T-336/03, paragraphs 31 to 33.
- 13 – Report for the Hearing in Case T-336/03, paragraphs 34 to 35.
- 14 – Case C-37/03 P *BioID v OHMI* [2005] ECR I-7975, paragraph 43.
- 15 – Case C-196/06 P *Alecansan v OHIM*, paragraph 37.
- 16 – The wording of that paragraph is as follows: ‘It follows that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above’.
- 17 – Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 48.
- 18 – Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 53.
- 19 – Decision of the Fourth Board of Appeal of 14 July 2003, Case R 559/2002 – 4, paragraph 7.
- 20 – Appeal, paragraph 143.
- 21 – On the concepts of internal and external systems, see Heck, P., ‘Das Problem der Rechtsgewinnung’, *Gesetzesauslegung und Interessenjurisprudenz, Begriffsbildung und Interessenjurisprudenz*, Berlin, Zürich, 1968, pp. 188-189.
- 22 – Joined Cases 15 and 16/76 *France v Commission* [1979] ECR 321, paragraph 7. In that case, the French Republic was contesting the legality of certain decisions relating to the clearance of accounts submitted by the French Republic as expenses for the financial years 1971 and 1972 financed by the European Agricultural Guidance and Guarantee Fund (EAGGF) by relying on regularisation after the adoption of the decisions on the anomalies that were found.
- 23 – Case T-373/03 *Solo Italia v OHIM – Nuova Sala (PARMITALIA)* [2005] ECR II-1881, paragraph 25.
- 24 – Case C-185/95 P *Baustahlgewebe v Commission* [1998] ECR I-8417, paragraph 18.
- 25 – Case C-13/99 P *TEAM v Commission* [2000] ECR I-4671, paragraph 36.
- 26 – Rideau J., Picod F., *Code des procédures juridictionnelles de l’Union européenne*, 2nd edition, Paris, 2002, p. 592.
- 27 – Lenaerts, K., Arts, D., Maselis, I., Bray R., op. cit., p. 553.
- 28 – Rideau, J., Picod, F., *Code des procédures juridictionnelles de l’Union européenne*, cited above, p. 592. For views on forms of order sought in the alternative, see Rosenberg, L., Schwab, K.-H., Gottwald, P., *Zivilprozessrecht*, 16th edition, Munich, 2004, p. 649.
- 29 – Case 125/78 *GEMA v Commission* [1979] ECR 3173, paragraph 26.
- 30 – Case T-28/90 *Asia Motor France and Others v Commission* [1992] ECR II-2285, paragraph 43.
- 31 – Case T-100/96 *Vicente-Nufiez v Commission* [1998] ECR-SC I-A-591 and II-1779, paragraph 51, and Case T-177/03 *Strohm v Commission* [2005] ECR-SC I-A-147 and II-651, paragraph 21.
- 32 – Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-34/00, *Eurocool Logistik v OHIM (EURO-COOL)*, [2002] ECR II-683, paragraph 12; Case T-129/01 *Alejandro v OHIM – Anheuser-Busch (BUD-MEN)* [2003] ECR II-2251, paragraph 22; and Case T-366/04 *Hensotherm v OHIM* [2006] ECR II-65, paragraph 17.
- 33 – Joined Cases C-403/04 P and C-405/04 P *Sumitomo Metal Industries and Nippon Steel v Commission* [2007] ECR I-729, paragraph 38.
- 34 – *France v Commission*, cited above in footnote 22.