

Court of Justice EU, 12 March 2009, Antartica v OHIM - Nasdaq



v



TRADEMARK LAW

Use of a mark: seeking to create or maintain an outlet for services

- It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.

30 As the Court of First Instance held in paragraph 45 of the judgment under appeal, the Nasdaq indices refer to the stock exchange price quotation and financial services provided by The Nasdaq Stock Market, covered by the earlier mark and in respect of which it was registered.

Taking unfair advantage of earlier mark

- Required that the relevant public establishes a link between the earlier and later mark; no confusion required

It should be noted that the types of injury referred to in Article 8(5) of Regulation No 40/94, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them

- Relevant public: average consumers of the goods or services for which the later mark is requested, who are reasonably well informed and reasonably observant and circumspect

In such a case, in so far as what is prohibited is the drawing of benefit from the earlier mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is requested, who are reasonably well informed and reasonably ob-

servant and circumspect ([Intel Corporation, paragraph 36](#)).

49 In that respect, the Court of First Instance held, in paragraph 58 of the judgment under appeal, that, having regard to its omnipresence in the press, not only in the specialist press but also the general press, and the interest of a large part of the general public in the developments in the financial markets, the reputation of the earlier mark reaches further than the professional public specialising in financial information.

50 It is implicitly, but clearly, apparent from that assessment that, when assessing the existence of injury, the Court of First Instance included in its examination, as the relevant public, the average customer of goods and services for which the later mark, that is to say Antartica's mark, was requested.

Source: curia.europa.eu

Court of Justice EU, 12 March 2009

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

JUDGMENT OF THE COURT (First Chamber)

12 March 2009 (*)

(Appeal – Community trade mark – Regulation (EC) No 40/94 – Article 8(5) – Refusal to register – Earlier trade mark of repute NASDAQ – Figurative sign ‘nasdaq’ – Use of the earlier mark for goods and services allegedly offered free of charge – Taking unfair advantage of the distinctive character or the repute of the earlier mark – Relevant public)

In Case C-320/07 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 10 July 2007,

Antartica Srl, established in Rome (Italy), represented by E. Racca and A. Fusillo, avvocati,

appellant,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Follard-Monguiral, acting as Agent,

defendant at first instance,

The Nasdaq Stock Market, Inc., established in Washington (United States of America), represented by J. van Manen and J. Hofhuis, advocaten,

intervener at first instance,

THE COURT (First Chamber),

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

Advocate General: P. Mengozzi,

Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 25 September 2008,

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

gives the following

Judgment

1 By its appeal, Antartica Srl ('Antartica') asks the Court to set aside the judgment of the Court of First Instance of the European Communities of 10 May 2007

in Case T-47/06 *Antartica v OHMI – Nasdaq Stock Market (nasdaq)* ('the judgment under appeal'), which dismissed its action for annulment of the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 7 December 2005 (Case R 752/2004-2) ('the contested decision') annulling the decision of the Opposition Division of OHIM of 28 June 2004 which had rejected the opposition of The Nasdaq Stock Market Inc. ('The Nasdaq Stock Market') to the registration of the figurative sign 'nasdaq' as a Community trade mark.

Legal context

2 Article 8(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) is worded as follows:

'For the purposes of paragraph 1, "Earlier trade mark" means:

(a) trade marks of the following kinds with a date of application 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;

...

3 Article 8(5) of that regulation provides:

'... 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.'

Background to the dispute and the judgment under appeal

4 On 1 April 1996, The Nasdaq Stock Market filed an application for the Community word mark NASDAQ ('the earlier mark'), which was registered on 5 January 1999 for the following goods and services in Classes 9, 16, 35, 36, 38 and 42 in accordance with the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement'), and are described as follows:

– Class 9: 'Computer programs amongst others in the field of the analysis of securities prices, stock exchange, finance; computer apparatus, in particular closed circuit apparatus for the generation and the dissemination of securities information as well as closed circuit CRT terminals for use therewith as well as computer programs for the access to securities information';

– Class 16: 'Documentation and manuals related to computer programs and computer apparatus';

– Class 35: 'Stock exchange price quotation services ; listings of securities for quotations for sale or information purposes';

– Class 36: 'Financial services, amongst others, providing and updating an index of security values, securities, fixed incomes (such as bonds) and derivative products (such as options, warrants and swaps); as well as classification, analysis and reporting thereof';

– Class 38: 'Telecommunication services, amongst others electronic transmission of messages and data related to securities'; and

– Class 42: 'Computerised securities information and retrieval services, being general computer services'.

5 On 30 March 2000, Antartica filed an application for the registration of the following figurative sign as a Community trade mark:



6 That application was published in the Community Trademarks Bulletin No 11/2001 of 29 January 2001.

7 The goods in respect of which registration was sought are in Classes 9, 12, 14, 25 and 28 of the Nice Agreement, and correspond to the following descriptions:

– Class 9: 'Protective helmets for sports, cycling, motorcycling, motor racing, skiing, protective goggles for sports and pads for protecting body and limbs against accidents for personal use, time recording apparatus';

– Class 12: 'Vehicles, in particular bicycles and mountain bikes';

– Class 14: 'Clocks, chronometers, sports chronometers';

– Class 25: 'Clothes, in particular sportswear, clothing for gymnastics, ski boots, and après-ski boots, sports shoes in general'; and

– Class 28: 'Skis, ski poles, anti-vibration plates for skis, snowboards, boards for surfing on snow and on water, ski bindings and ski wax, stationary exercise bicycles, gymnasium equipment and apparatus'.

8 On 27 April 2001, The Nasdaq Stock Market brought opposition proceedings against the application for registration filed by Antartica in respect of all the goods in the abovementioned classes.

9 The grounds relied on in support of the opposition were, in particular, those set out in Article 8(5) of Regulation No 40/94.

10 By decision of 28 June 2004, the Opposition Division of OHIM rejected the opposition on the ground, in particular, that the reputation of the earlier mark in the Community had not been properly substantiated.

11 On 24 August 2004, The Nasdaq Stock Market brought an appeal before the Second Board of Appeal of OHIM against the Opposition Division's decision.

12 By the contested decision, that Board annulled the Opposition Division's decision on the ground that the latter had wrongly rejected the opposition brought by The Nasdaq Stock Market by basing its decision on the fact that the conditions for the application of Article 8(5) of Regulation No 40/94 had not been fulfilled.

13 The Board of Appeal held, essentially, that the reputation of the earlier mark in the Community for the services in Classes 35 and 36, for which it had been registered, had been substantiated, and that Antartica's use of the figurative sign 'nasdaq' without due cause would take unfair advantage of or be detrimental to the distinctive character and repute of the earlier mark.

14 By application lodged at the Registry of the Court of First Instance on 16 February 2006, Antartica brought an action for annulment of the contested decision, based on a single plea alleging infringement of Article 8(5) of Regulation No 40/94.

15 In paragraph 39 of the judgment under appeal, the Court of First Instance observed that the earlier mark was a Community mark and that the similarity of the marks at issue was not disputed.

16 Taking the view, in paragraph 45 of the judgment under appeal, that the references to the Nasdaq indices refer to the stock exchange price quotation and financial services included in Classes 35 and 36 of the Nice Agreement and constitute, therefore, a use of the earlier mark and, in paragraph 47 of that judgment, that the relevant public is made up of professionals and consumers who consult financial information either in the course of their main activity or for their own information, the Court of First Instance considered that the reputation of the earlier mark had to be determined in relation to that European public.

17 With regard to that reputation, the Court of First Instance held, in essence, in paragraph 51 of the judgment under appeal, that it had been established in respect of financial services and stock exchange price quotation services not only among the professional public active on the financial markets, but also in an important sub-section of the general public interested in the financial indices on account of their current or future investments.

18 Next, in paragraph 58 of the judgment under appeal, the Court of First Instance ruled that the possibility of accepting the existence of a detriment to the earlier mark for the purposes of Article 8(5) of Regulation No 40/94 is supported by the inherently very distinctive nature of the earlier mark, its omnipresence not only in the specialist press but also the general press, as well as the interest shown by a large part of the general public in developments in the financial markets and, therefore, that the reputation of that mark reaches further than the professional public specialising in financial information.

19 In paragraph 60 of the judgment under appeal, the Court of First Instance held that the minutes of the ordinary general meeting of Antartica's shareholders of 12 April 1998 demonstrated, first, that those shareholders were aware that the term 'nasdaq' designated 'the American online stock market', and secondly that the

word had been chosen because it was regarded as being descriptive of the main activities of Antartica, which included the design, manufacture and sale of high-tech materials and sports equipment. Therefore, the Court of First Instance took the view, in that paragraph, that taking into consideration the fact that the financial and stock market listing services supplied by The Nasdaq Stock Market and, consequently, the earlier mark itself, undeniably present a certain image of modernity, that link enables the transfer of that image to sports equipment, and, in particular, to the high-tech composite materials which would be marketed by Antartica under the mark for which registration is sought, which Antartica appears to recognise implicitly by stating that the word 'nasdaq' is descriptive of its main activities.

20 The Court of First Instance held, in paragraph 61 of the judgment under appeal, that The Nasdaq Stock Market had *prima facie* established the existence of a future risk, which was not hypothetical, that Antartica would, by the use of the mark applied for, draw unfair advantage from the reputation of the earlier mark.

21 After holding, at paragraph 62 of the judgment under appeal, that it was for Antartica to demonstrate that it could rely on due cause for such use, the Court of First Instance held, at paragraph 63 of that judgment, that Antartica 'did not argue before the Court the existence of due cause for the use of the mark applied for. Furthermore, the only argument put forward to that effect before the Board of Appeal is that the word "nasdaq" was chosen because it is an acronym for "Nuovi Articoli Sportivi Di Alta Qualità"'.
22 Accordingly, the Court of First Instance held, at paragraph 64 of the judgment under appeal, that Antartica had not put forward any convincing reason to warrant the conclusion that its use of the figurative sign 'nasdaq' would be founded on due cause within the meaning of Article 8(5) of Regulation No 40/94, and therefore dismissed the action in its entirety.

The appeal

23 By its appeal, which is based on a single plea, divided into two parts, alleging breach of Article 8(5) of Regulation No 40/94, Antartica requests the Court to set aside the judgment under appeal and order OHIM to pay the costs.

24 OHIM and The Nasdaq Stock Market contend that the Court should dismiss the appeal and order Antartica to pay the costs.

The first part of the single plea, based on the lack of use of the earlier mark

Arguments of the parties

25 By this part of the plea, Antartica essentially claims that the use of a mark is established only if it is used in connection with the sale of goods or services. However, the Nasdaq indices are available free of charge in the press and on television, and no evidence has been adduced to the effect that those indices are for sale within the Community. Accordingly, the Court of First Instance was mistaken in holding, at paragraph 45 of the judgment under appeal, that proof of the use of the earlier mark in commerce had been satisfactorily adduced.

26 According to OHIM and The Nasdaq Stock Market, that part of the plea is directed against the Court of First Instance's findings of fact in paragraph 45 of the judgment under appeal. The Nasdaq Stock Market states that a charge is made for the services in question, whereas other services, such as those relating to information, are provided to the general public free of charge. Moreover, according to The Nasdaq Stock Market, advertising is always offered to the public free of charge.

27 OHIM adds that Antarctica simply reproduces the arguments and pleas already presented before the Court of First Instance, so that the Court of Justice has no jurisdiction to examine them. As a result, the first part of the plea should be declared inadmissible.

Findings of the Court

28 In support of the first part of the single plea, Antarctica calls into question the use of the earlier mark for the goods and services in Classes 35 and 36 within the meaning of the Nice Agreement by submitting that The Nasdaq Stock Market offers them in the Community on a non-profit-making basis, whereas the use of a trade mark is based on the premiss that the goods or services for which it is registered are paid for.

29 It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.

30 As the Court of First Instance held in paragraph 45 of the judgment under appeal, the Nasdaq indices refer to the stock exchange price quotation and financial services provided by The Nasdaq Stock Market, covered by the earlier mark and in respect of which it was registered.

31 Consequently, the first part of the single plea must be rejected as unfounded.

The second part of the single plea, based on the taking unfair advantage of the distinctive character or the reputation of the earlier mark

Arguments of the parties

32 By this part of the plea, Antarctica claims that the consumers of the goods covered by trade mark applied for are not aware of the earlier mark and, therefore, that contrary to the view of the Court of First Instance, any unfair advantage can be ruled out in the present case. Antarctica states, in that respect, that it would derive an unfair advantage from the earlier mark only if it were established that the earlier mark was also known to consumers of goods covered by the trade mark applied for, since the goods and services in question are very different, or if it were shown that it sold or intended to sell its goods or services to the same specific sector of the public, which is familiar with the earlier mark.

33 Antarctica also contends that the definitions of a trade mark with a reputation within the meaning of Article 8(5) of Regulation No 40/94, on the one hand, and of well-known marks within the meaning of Article 6

bis of the Convention for the Protection of Industrial Property, signed at Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaty Series, Vol 828, No 11851, p. 305) ('the Paris Convention'), on the other hand, differ. For the purposes of Article 8(5) of Regulation No 40/94, the 'reputation' of the earlier mark must be of an 'exceptional' kind, that is to say, it must extend to the general public and not only to the public constituted by the consumers of the goods designated by that trade mark.

34 As regards paragraphs 60 and 63 of the judgment under appeal, Antarctica claims that, contrary to what was held by the Court of First Instance, it is apparent from the evidence laid before that Court that Antarctica acted in good faith when it chose the figurative sign 'nasdaq' and that the acronym of the expression 'Nuovi Articoli Sportivi Di Alta Qualità' describes Antarctica's commercial activities.

35 Antarctica claims, in its reply, that in paragraphs 51, 58, 60 and 63 of the judgment under appeal, the Court of First Instance distorted the evidence adduced.

36 According to OHIM and The Nasdaq Stock Market, the second part of the single plea is inadmissible since it is directed against the determination of the facts by the Court of First Instance in paragraphs 51 and 58 of the judgment under appeal.

37 OHIM adds that, even if this part must be regarded as raising a question of law, it should be rejected as unfounded. Antarctica deliberately truncated paragraphs 51 and 58 of the judgment under appeal, where the Court of First Instance considered, in essence, that the earlier mark was also known to a large part of the general public, which is interested in financial indices on account of their present or future investments.

38 As regards the alleged difference between the drafting of Article 8(5) of Regulation No 40/94 and that of Article 6 bis of the Paris Convention, OHIM relies on Case T-150/04 Mülhens v OHIM – Minoronzoni (TOSCA BLU) [2007] ECR II-2353, paragraph 60, in which the Court of First Instance ruled that 'Regulation No 40/94 is consistent, on this point, with Article 16(3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights of 15 April 1994 (Annex 1C to the Agreement establishing the World Trade Organisation) (OJ 1994 L 336, p. 214), which extends the application of Article 6 bis of the Paris Convention to situations where the goods or services at issue are not similar, on the condition, however, that the earlier mark has been registered'. Consequently, Antarctica's argument is also unfounded in this respect.

39 The Nasdaq Stock Market claims that, to the extent that Antarctica's argument that a large part of the public interested in financial indices because of its present or future investments is not interested in Antarctica's goods, is admissible, it is unfounded, because it is clear, in the present case, that a large part of the public interested in financial indices is also interested in Antarctica's goods.

40 With regard to Antarctica's arguments concerning paragraphs 60 and 63 of the judgment under appeal, The Nasdaq Stock Market contends that they are inadmissible, because they address finding of facts undertaken by the Court of First Instance.

Findings of the Court

41 In support of the second part of the single plea, Antarctica calls in question, in particular, the criterion relating to the relevant public, which is one of the criteria to be taken into consideration in assessing the existence of injury, as regards any unfair advantage that may have been derived from the distinctive character or the reputation of the earlier mark within the meaning of Article 8(5) of Regulation No 40/94.

42 Contrary to what OHIM and The Nasdaq Stock Market contend, Antarctica's argument does not concern the finding of facts undertaken by the Court of First Instance, but bears on the question whether, in the definition of the relevant public, that Court applied the correct criterion (see, by analogy, [Case C-334/05 P OHIM v Shaker \[2007\] ECR I-4529, paragraph 29](#), and [Case C-47/07 P Masdar \(UK\) v Commission \[2008\] ECR I-0000, paragraph 77](#)).

43 It should be noted that the types of injury referred to in Article 8(5) of Regulation No 40/94, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, as regards Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which is essentially identical to Article 8(5) of Regulation No 40/94, [Case C-252/07 Intel Corporation \[2008\] I-0000, paragraph 30](#) and the case-law cited).

44 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark ([Intel Corporation, paragraph 31](#)).

45 However, the existence of such a link must be subject to an overall assessment, taking into account all factors relevant to the circumstances of the case and, in particular, the degree of similarity between the marks at issue; the nature of the goods or services for which the marks at issue were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use and the existence of the likelihood of confusion on the part of the public ([Intel Corporation](#), paragraphs 41 and 42 and the case-law cited).

46 As regards, more particularly, the relevant public to be taken into consideration, it should be pointed out that that public will vary according to the type of injury alleged by the proprietor of the earlier mark.

47 It is apparent from paragraphs 53 to 61 of the judgment under appeal that the injury at issue in the present case relates to the unfair advantage that has been taken of the distinctive character or the repute of the earlier mark.

48 In such a case, in so far as what is prohibited is the drawing of benefit from the earlier mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is requested, who are reasonably well informed and reasonably observant and circumspect ([Intel Corporation, paragraph 36](#)).

49 In that respect, the Court of First Instance held, in paragraph 58 of the judgment under appeal, that, having regard to its omnipresence in the press, not only in the specialist press but also the general press, and the interest of a large part of the general public in the developments in the financial markets, the reputation of the earlier mark reaches further than the professional public specialising in financial information.

50 It is implicitly, but clearly, apparent from that assessment that, when assessing the existence of injury, the Court of First Instance included in its examination, as the relevant public, the average customer of goods and services for which the later mark, that is to say Antarctica's mark, was requested.

51 With regard to Antarctica's argument that the reputation of the earlier mark should extend to the general public and not only to the public constituted by the consumers of the goods designated by that trade mark, it should be recalled, without it being necessary to examine the differences between the concepts of a trade mark of repute and a trade mark which is well known, that it was mentioned in paragraph 49 of this judgment that the Court of First Instance held, in paragraph 58 of the judgment under appeal, that the reputation of the earlier mark reaches further than the professional public specialising in financial information.

52 It follows that Antarctica's argument relating to the relevant public must be rejected as unfounded.

53 With regard to Antarctica's arguments concerning paragraphs 60 and 63 of the judgment under appeal, it is sufficient to point out that, in those paragraphs, the Court of First Instance made an assessment of a factual nature.

54 Finally, it should be noted that it was only at the stage of the reply that Antarctica raised arguments relating to the distortion of evidence by the Court of First Instance in paragraphs 51, 58, 60 and 63 of the judgment under appeal. Those arguments therefore constitute, by virtue of Articles 42(2) and 118 of the Rules of Procedure, a new plea which is inadmissible in so far as it is not based on questions of law or fact which were raised during the proceedings (see, by analogy, judgment of 20 September 2007 in [Case C-193/06 P Nestlé v OHIM](#) and the case-law cited). Consequently, those allegations must be rejected as inadmissible.

55 It follows that the second part of the single plea must be rejected, as being partly unfounded and partly inadmissible.

56 In view of the above, as none of the parts of the single plea is well founded, the appeal must be dismissed in its entirety.

Costs

57 Under Article 69(2) of the Rules of Procedure, which applies to appeal proceedings by virtue of Article 118 thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM and The Nasdaq Stock Market have applied for costs and Antarctica has been unsuccessful, the latter must be ordered to pay the costs.

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

1. Dismisses the appeal;
 2. Orders Antarctica Srl to pay the costs.
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