

Court of Justice EU, 20 november 2014, Intra-Press v BHIM



TRADEMARK LAW

The General Court should have determined whether the low degree of similarity was nevertheless sufficient, on account of the presence of other relevant assessment factors (such as the reputation or recognition enjoyed by the earlier mark), for the public to make a link between those two marks

- According to the same case-law, Article 8(5) of Regulation No 40/94, like Article 8(1)(b), is manifestly inapplicable where the General Court rules out any similarity between the marks at issue. It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out an overall assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public.

- 74 In the present cases, the General Court found in paragraph 72 of the judgments under appeal that, ‘having regard to the assessments made in paragraphs 41 to 51 [of those judgments]’, the signs at issue lacked the requisite similarity for the purposes of applying Article 8(5) of Regulation No 40/94.

- 75 However, although the General Court found in paragraphs 41 to 51 of the judgments under appeal that those signs were not at all visually or phonetically similar, it also found that there was a low degree of conceptual similarity between them. Thus, the General Court did not, in those judgments, rule out all possibility that the marks at issue were similar.

- 76 Consequently, in accordance with the case-law cited in paragraph 73 above, the General Court was wrong to rule out the application of Article 8(5) of Regulation No 40/94 without first undertaking an overall assessment of the marks at issue in order to ascertain whether that low degree of similarity was nevertheless sufficient, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, for the

relevant public to make a link between those marks.

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Court of Justice EU, 20 november 2014

(C. Toader, E. Jarašiūnas, C.G. Fernlund (rapporteur))
JUDGMENT OF THE COURT (Eighth Chamber)
20 November 2014 (*)

(Appeal — Community trade mark — Regulation (EC) No 40/94 — Article 8(1)(b) — Article 8(5) — Word mark GOLDEN BALLS — Opposition by the proprietor of the earlier Community word mark BALLON D’OR — Relevant public — Similarity of the signs — Likelihood of confusion)

In Joined Cases C-581/13 P and C-582/13 P,
TWO APPEALS under Article 56 of the Statute of the Court of Justice, lodged on 15 November 2013,
Intra-Press SAS, established in Boulogne-Billancourt (France), represented by P. Péters, advocaat, and T. de Haan, avocat,
applicant,

the other parties to the proceedings being:

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

Golden Balls Ltd, established in London (United Kingdom), represented by M. Edenborough QC,
applicant at first instance,

THE COURT (Eighth Chamber),

composed of C. Toader, Acting President of the Eighth Chamber, E. Jarašiūnas and C.G. Fernlund (Rapporteur), Judges,

Advocate General: M. Wathelet,

Registrar: A. Calot Escobar,

having regard to the written procedure,

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

Judgment

1 By its appeals, Intra-Press SAS seeks to have set aside the judgments of 16 September 2013 in Golden Balls v OHIM — Intra-Press (GOLDEN BALLS), T-448/11, EU:T:2013:456, and in Golden Balls v OHIM — Intra-Press (GOLDEN BALLS), T-437/11, EU:T:2013:441, (collectively, ‘the judgments under appeal’), by which the General Court of the European Union annulled the decisions of the First Board of Appeal of OHIM of 22 June 2011 (Case R 1432/2010-1) and of 26 May 2011 (Case R 1310/2010-1) relating to opposition proceedings between Intra-Press and Golden Balls Ltd (collectively, ‘the contested decisions’).

Legal context

2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Nevertheless, in the light of the date on which the registration applications at issue were filed,

the present disputes remain governed by Regulation No 40/94.

3 Article 8(1)(b) of Regulation No 40/94 was worded as follows:

‘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.’

4 Article 8(5) of that regulation provided:

‘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 disputes and the contested decisions

5 The facts of the disputes, as set out in paragraphs 1 to 10 of the judgments under appeal, may be summarised as follows.

6 On 25 June and 1 October 2007, Golden Balls Ltd filed applications with OHIM for registration of the word mark ‘GOLDEN BALLS’ as a Community trade mark.

7 The first of those applications, which gave rise to the judgment in Case T-448/11, concerned goods and services in Classes 9, 28 and 41 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 (‘the Nice Agreement’), which corresponded, for each of those classes, to the following description:

– Class 9: ‘Slot machines, for use in combination with a screen, video tapes, CDs, CD Roms, DVDs and other disc-shaped sound and image carriers, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; photographic, cinematographic and optical apparatus and

instruments, recording discs, data processing equipment and computers, computer hardware and software, compact discs, mouse-mats, mobile phone accessories, sunglasses’;

– Class 28: ‘Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees, electronic games’;

– Class 41: ‘Education; providing of training; entertainment; sporting and cultural activities, production of television and radio programmes and entertainment programmes, production of motion picture films, theatre production such as shows and theatrical performances, production of musicals, organization of music events/concerts, production of games, game services provided on-line (via internet)’.

8 The second of those applications, which gave rise to the judgment in Case T-437/11, concerned goods in Classes 16, 21 and 24 of the Nice Agreement, which corresponded, for each of those classes, to the following description:

– Class 16: ‘Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers’ type; printing blocks’;

– Class 21: ‘Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes, mugs, glasses’;

– Class 24: ‘Textiles and textile goods, not included in other classes; bed and table covers, towels, duvet covers’.

9 The Community trade mark applications were published in Community Trade Marks Bulletin No 64/2007 of 26 November 2007 and No 8/2008 of 18 February 2008, respectively.

10 On 26 February 2008 and on 16 May 2008, respectively, Intra-Press filed a notice of opposition under Article 42 of Regulation No 40/94 against registration of the mark applied for in both cases, in relation to the goods and services referred to in paragraphs 7 and 8 above, respectively.

11 The two oppositions were based, inter alia, on the earlier Community word mark BALLON D’OR, filed on 24 December 2004 and registered on 7 November 2006 under No 4226148, covering goods and services in Classes 9, 14, 16, 18, 25, 28, 38 and 41 of the Nice Agreement and corresponding, for each of those classes, to the following description:

– Class 9: ‘Scientific (other than for medical purposes), nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; teaching apparatus and

instruments; apparatus for recording, transmission or reproduction of sound or images; CDs, magnetic and optical data carriers, recording discs; video cassettes, audio cassettes, radios, television apparatus, telephone apparatus, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines; fire-extinguishing apparatus; data processing apparatus and equipment, computers, computer software (recorded), telecommunications apparatus and instruments, apparatus and instruments for the transmission and reception of images, sound and data, electronic organisers, divers' masks, optical goods, spectacles, sunglasses';

– Class 14: *'Precious metals and their alloys other than for dental purposes; jewellery, precious stones; horological and chronometric instruments, watches, clocks, alarm clocks, chronometers, brooches (jewellery), sundials, medals, figurines (statuettes) of precious metal, cigar cases, cigarettes cases and cigarette lighters of precious metal, ashtrays of precious metal, cigarette cases of precious metal, key rings (trinkets or fobs)*';

– Class 16: *'Paper and cardboard (unprocessed, semi-finished or for stationery); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); wrapping paper; sacks, bags and sheets for packaging in paper or plastics; printers' type; printing blocks, newspapers, books, magazines*';

– Class 18 — *'Leather and imitations of leather, and goods made from these materials and not included in other classes; trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery*';

– Class 25: *'Clothing (apparel), footwear (except orthopaedic footwear); headgear; motorists' clothing; swimwear and bathing caps; bathrobes; berets; smocks; bodies; caps (headwear); boots; braces; underpants; caps; belts; shawls; dressing gowns; sweaters; hats; socks; booties; football boots; ski boots; sports shoes; shirts; under shirts; tights; wet suits for water skiing; suits; cyclists' clothing; mufflers; esparto shoes or sandals; scarves; gabardines (clothing); waistcoats; gymnastics shoes; raincoats; slippers; swaddling clothes; coats; trousers; slippers; overcoats; parkas; bathrobes; pullovers; pyjamas; dresses; dressing gowns; wooden shoes; aprons (clothing); uniforms; jackets; gymnastic clothing; clothing of leather and imitations of leather; visors (hatmaking)*';

– Class 28: *'Games and playthings; gymnastic and sporting articles (other than clothing, footwear and mats); decorations for Christmas trees; hang gliders; bladders of balls for games; air pistols (toys); artificial fishing bait; percussion caps (toys); toys for pets; ring games; ornaments for Christmas trees (except illumination articles and confectionery); Christmas tree stands; Christmas trees of synthetic material;*

archery implements; bows for archery; novelties for parties, dances (party favours); swings; balls for games, play balloons; baseball gloves; swimming pools (play articles); stationary exercise bicycles; billiard balls, cues and tables; marbles for games; bob-sleighs; playing balls; boxing gloves; gut for rackets; fishing rods; golf balls; toy masks; kites; dolls' rooms; rocking horses; targets; toy building structures; machines for physical exercises; cricket bags; golf clubs; golf bags, with or without wheels; hockey sticks; appliances for gymnastics; draughts (games); dice; discuses for sports; dominoes; chess sets; arms; fencing gloves and masks; climbers' harnesses; exercisers (expanders); nets for sports; ski bindings; darts; foils for fencing; floats for fishing; indoor football tables; harpoon guns (sports articles); golf gloves; bar-bells; fish hooks; rattles; counters for games; automatic and electronic games, other than coin-operated and those adapted for use with television receivers only; mah-jong sets; puppets; scale-model vehicles; swim fins; teddy bears; paragliders; ice skates; roller-skates; fishing tackle; skateboards; sailboards; surf boards; dolls; protective paddings (part of sport suits); elbow, knee and shin guards (sports articles); ninepins; bats for games; skis; water skis; surf skis; parlour games; tables for table tennis; sledges; spinning tops (toys); sleighs (sports articles); spring boards (sporting articles); scooters (toys); toy vehicles; shuttlecocks; dolls' clothes; game cards';

– Class 38: *'Telecommunications; transmission of images, sound and data by telephone, by computer terminals, a global communications network (the Internet) or local communications network (an intranet), satellite and electronic mail; processing, monitoring, broadcasting and reception of data, signals, images and information processed by computers or by telecommunications apparatus and instruments; transmission of information contained in databanks and image banks; dissemination of information by electronic means, news agencies; communications by fibre optic networks; radio, telephone or telegraph communications services; broadcasting of television programmes; radio broadcasting; television broadcasting, sending of telegrams; radio broadcasting; satellite transmission; data transmission; cable television broadcasting*';

– Class 41: *'Education; providing of training; entertainment; sporting and cultural activities; timing of sports events, organisation of sports competitions and awarding of trophies, club services (entertainment), sports club services, radio and television entertainment, providing sports facilities, amusement parks, providing recreational facilities; publication of books, magazines and newspapers, production of radio and television programmes, rental of sports equipment (except vehicles); arranging and conducting of conferences, forums and colloquiums; gymnastic instruction, amusement parks, organisation of competitions (education or entertainment), production of shows, sports camp services, film production, rental of stadium facilities*'.

12 The grounds relied on in support of the oppositions were those set out in Article 8(1)(b) and Article 8(5) of Regulation No 40/94.

13 On 19 and 31 May 2010, the Opposition Division rejected both oppositions for the following reasons. It found that the goods and services covered by the signs at issue were partly identical and partly different. In its view, the signs were visually and phonetically different, and slightly similar conceptually for one section of the relevant public. Furthermore, the Opposition Division found that, as the signs were dissimilar overall, there was no likelihood of confusion between those signs for the purposes of Article 8(1)(b) of Regulation No 40/94. Lastly, as regards the ground relating to the reputation of the earlier mark, it found that, since the signs were dissimilar, Article 8(5) of Regulation No 40/94 is not applicable.

14 On 15 and 27 July 2010, Intra-Press filed a notice of appeal with OHIM in each case under Articles 57 to 62 of Regulation No 40/94 (to which Articles 58 to 64 of Regulation No 207/2009 correspond) against the decisions of the Opposition Division.

15 By the contested decisions, the First Board of Appeal of OHIM upheld the appeals in part, that is to say, in respect of certain goods in Class 9 of the Nice Agreement and the goods and services in Classes 16, 28 and 41 of that agreement, and in part dismissed them, that is to say, in respect of the ‘apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity’ in Class 9 of the Nice Agreement and the goods in Classes 21 and 24 of that agreement. In particular, it found as follows:

– the relevant public is composed of both professionals and average consumers in the European Union, who are reasonably well-informed and reasonably observant and circumspect. For the purposes of the assessment of the likelihood of confusion, the public to be taken into consideration is the public with a lower level of attention: in the circumstances, the average European consumer;

– with regard to the comparison of the goods and services, the Board of Appeal agreed with the assessment of the Opposition Division, which was uncontested by the parties. Accordingly, the Board of Appeal considered the Class 9 goods covered by the mark applied for to be partly identical to, partly similar to and partly dissimilar to the Class 9 goods covered by the earlier mark. The Class 16 and Class 28 goods covered by the mark applied for were identical to the Class 16 and Class 28 goods covered by the earlier mark, and the Class 21 and Class 24 goods were different from those covered by the earlier mark. The Class 41 services covered by the mark applied for were identical or highly similar to the Class 41 services covered by the earlier mark;

– as regards the comparison of the signs at issue, the Board of Appeal considered them to be visually and phonetically different, agreeing on that point with the assessment of the Opposition Division. By contrast, contrary to the Opposition Division, the Board of

Appeal concluded that, conceptually, the signs were identical or, ‘at the least’, extremely similar;

– in the light of those elements, the Board of Appeal concluded that there was a likelihood of confusion or of association between the signs at issue in respect of the identical goods and services in Classes 9, 16, 28 and 41 of the Nice Agreement, and that there was no likelihood of confusion in respect of the various goods in Classes 9, 21 and 24 of that agreement;

– the Board of Appeal deemed it unnecessary to consider matters in the light of Article 8(5) of Regulation No 40/94.

The proceedings before the General Court and the judgments under appeal

16 By two applications lodged at the Registry of the General Court on 5 August 2011, Golden Balls brought two actions for annulment of the contested decisions to the extent that they upheld the appeals in respect of certain goods and services in Classes 9, 16, 28 and 41 of the Nice Agreement.

17 Intra-Press also submitted applications under Article 134(3) of the Rules of Procedure of the General Court, seeking annulment of the contested decisions to the extent that they dismiss its oppositions in respect of the ‘apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity’ in Class 9 of the Nice Agreement and the goods covered by the mark applied for in Classes 21 and 24 of that agreement.

18 In support of its applications, framed in comparable terms, Golden Balls put forward a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94. In support of its applications for annulment, Intra-Press raised a single plea in law, alleging infringement of Article 8(5) of Regulation No 40/94 and Articles 62(1) and 74(1) of that regulation (now Articles 64(1) and 76(1) of Regulation No 207/2009).

19 By the judgments under appeal, the General Court upheld the actions brought by Golden Balls and dismissed Intra-Press’s claims. Consequently, it annulled point 1 of the operative part of both contested decisions.

20 As regards the assessment of the likelihood of confusion for the purposes of Article 8(1)(b) of Regulation No 40/94, the General Court held first, in paragraph 27 of the judgments under appeal, that the Board of Appeal had been correct in finding that, in the circumstances, the relevant public was composed of average consumers in the European Union, reasonably well-informed and reasonably observant and circumspect.

21 Secondly, the General Court upheld, in paragraph 31 of the judgments under appeal, the finding of the Board of Appeal concerning the comparison of the goods and services at issue, which, moreover, had not been contested by the parties.

22 Thirdly, in relation to the comparison of the signs at issue, the General Court stated in paragraphs 37 and 40 of the judgment under appeal that the Board of Appeal was correct to find that those signs were visually and phonetically different.

23 As regards the Board of Appeal's assessment that, conceptually, the signs at issue were identical or, at the least, extremely similar, the General Court observed in paragraph 41 of the judgments under appeal that those signs call to mind, from an objective point of view and apart from some differences in the details, in principle the same semantic content or the same idea, namely, 'a golden balloon or a golden ball or gold'. In paragraph 42 of those judgments, the General Court added that, for the purposes of assessing the conceptual similarity for the relevant public — in particular, for the average anglophone and francophone public — due account had to be taken of the fact that the earlier mark is in the French language whereas the mark applied for is in English, and the signs at issue accordingly differ as regards the language enabling their respective conceptual content to be understood.

24 While admitting, in paragraph 43 of the judgments under appeal, that such a linguistic difference is not sufficient to exclude the existence of a conceptual similarity from the point of view of the relevant consumers, the General Court found that, in so far as such a difference requires the consumer to make a translation, it is nevertheless capable — depending, *inter alia*, on the linguistic knowledge of the relevant public, the degree of relationship between the languages concerned and the actual words used by the signs at issue — of preventing the relevant public, at least to some degree, from making an immediate conceptual comparison.

25 In that respect, the General Court stated in paragraph 44 of the judgments under appeal that it was not established that the meaning of the mark applied for, comprising the words 'golden' and 'balls', will immediately be understood by the relevant public, namely the general public in the European Union, in particular the francophone public, which understands the French expression 'ballon d'or' constituting the earlier mark. In paragraph 45 of those judgments, the General Court specified that, even assuming that *'the words "golden" and "ball" are part of basic English-language vocabulary and that they are, therefore, as such, understandable for the average consumer, including the average francophone consumer, that does not mean that that consumer, who will generally — as the parties agree — have a weak understanding of the English language, will understand those words in their specific combination "golden balls" immediately as an English translation of the French expression "ballon d'or", which constitutes the earlier mark'*.

26 In paragraphs 47 and 48 of the judgments under appeal, the General Court pointed out differences between the signs at issue which militate against such an immediate conceptual comparison. It took the view that the fact that its use of the plural distinguishes the sign 'GOLDEN BALLS' from the earlier sign 'BALLON D'OR' would not go unnoticed by the relevant public, given that that is a fairly basic grammatical point which is also capable of being understood and perceived by the francophone public, especially as the plural of words is formed in the same

way in English as in French. It also stated that the difference in the respective positions of the words 'golden' and 'd'or' — in the one case, at the beginning of the sign and, in the other, at the end — as well as the clear difference between the origins of the two words are differences likely to render the immediate discovery of the similar hidden meaning of the signs at issue more difficult, both for the francophone consumer and for the anglophone consumer with an average level of attention.

27 The General Court added, in paragraph 49 of the judgments under appeal, that, in any event, it appeared improbable that the result of such an analysis of the translation would spontaneously enter the head of the average consumer concerned, contemplating a simple purchase of everyday consumer goods. This led the General Court to conclude in paragraph 50 of those judgments that the Board of Appeal was wrong to consider the signs at issue to be conceptually extremely similar or identical, since those signs have, at most, a weak — or even very weak — degree of conceptual similarity for the reasonably informed and observant relevant public, in particular the francophone public.

28 Fourthly, the General Court pointed out in paragraph 58 of the judgments under appeal, in the context of the overall assessment of the likelihood of confusion, that, even though the goods at issue were identical, the very weak conceptual similarity of the signs at issue, for which an act of translation was a prerequisite ('prior translation'), was not enough to offset their visual and phonetic dissimilarities. Furthermore, in paragraph 59 of those judgments, the General Court stated that the highly distinctive character of the mark BALLON D'OR had not been established as regards the goods concerned and that — even if that mark enjoys a highly distinctive character and account is taken of the fact that the goods and services in question are identical or similar — the very weak conceptual similarity, which depended on 'prior translation', could not, in the circumstances of the case, be sufficient in itself to create a likelihood of confusion on the part of the target public. Consequently, in paragraph 60 of the judgments under appeal, the General Court concluded that the Board of Appeal was wrong to find that there was a likelihood of confusion on the part of the relevant public in respect of the identical or similar goods and services covered by the signs at issue, given that the fact that the signs at issue are in different languages creates a manifest distinction between them so that the average consumer will not immediately associate them without undertaking an intellectual process of translation.

29 As regards the question whether the Board of Appeal had failed to comply with an essential procedural requirement by not examining the ground of opposition relating to breach of Article 8(5) of Regulation No 40/94, the General Court found in paragraph 68 of the judgments under appeal that the Board of Appeal had considered it unnecessary to examine that ground, notwithstanding the fact that the subject-matter of the dispute also covered various

goods that fell outside the purview of the Board of Appeal's assessment of the likelihood of confusion. In paragraphs 72 to 75 of those judgments, the General Court concluded, having regard to its assessments concerning the comparison of the signs at issue for the purposes of applying Article 8(1)(b) of that regulation, that those signs lacked the requisite similarity for the purposes of applying Article 8(5) of that regulation and that, therefore, the opposition had in any event to be rejected in its entirety. Consequently, the General Court held that the plea raised by Intra-Press had to be rejected as being of no effect.

Forms of order sought and procedure before the Court

30 By its appeals, Intra-Press claims that the Court of Justice should set aside the judgments under appeal, refer the cases back to the General Court for a decision on the actions brought under Article 8(5) of Regulation No 40/94, and reserve the costs.

31 OHIM claims that the Court should uphold the appeals and order Golden Balls to pay the costs incurred by OHIM.

32 Golden Balls contends that the Court should dismiss the appeals and order OHIM — or, alternatively, Intra-Press, or, in the further alternative, OHIM and Intra-Press, jointly and severally — to pay the costs incurred by Golden Balls.

33 By order of the President of the Court of 10 December 2013, Cases C-581/13 P and C-582/13 P were joined for the purposes of the written and oral procedure and the judgment.

The appeals

34 Intra-Press relies, in essence, on three grounds of appeal: (i) distortion of the facts in the assessment of the abilities of the relevant public; (ii) infringement of Article 8(1)(b) of Regulation No 40/94 (this ground of appeal is divided into two parts in Case C-582/13 P and into three parts in Case C-581/13 P); and (iii) infringement of Article 8(5) of Regulation No 40/94.

First ground of appeal: distortion of the facts

Arguments of the parties

35 By its first ground of appeal, Intra-Press claims that the General Court distorted the facts in concluding, in paragraph 45 of the judgments under appeal, that 'the parties agree[d]' that the average consumer, including the average francophone consumer, generally has a weak understanding of the English language.

36 OHIM contends that no such distortion is evident from the documents in the file and that the General Court's conclusion concerning the level of competence of the French general public in that language is based on well-known facts.

37 Golden Balls maintains that Intra-Press acknowledged, at least implicitly in its oral submissions, that the relevant public has a weak understanding of the English language and contends that the General Court could, in any event, arrive at its conclusion regardless of the opinions of the parties.

Findings of the Court

38 As regards the distortion of the facts alleged by Intra-Press, it should be borne in mind that, under

Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal is to be limited to points of law. The General Court 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 open, as such, to review by the Court of Justice on appeal (see, inter alia, the judgments in [DKV v OHIM, C-104/00 P, EU:C:2002:506, paragraph 22](#), and [Storck v OHIM, C-25/05 P, EU:C:2006:422, paragraph 40](#)).

39 It should also be recalled that such distortion must be obvious from the documents before the Court, without there being any need to carry out a new assessment of the facts and the evidence (see, inter alia, the judgments in [Les Éditions Albert René v OHIM, C-16/06 P, EU:C:2008:739, paragraph 69](#), and [Waterford Wedgwood v Assembled Investments \(Proprietary\) and OHIM, C-398/07 P, EU:C:2009:288, paragraph 41](#)).

40 In the present case, it is sufficient to note that it is not obvious from the documents before the Court of Justice that, by the assertion made in paragraph 45 of the judgments under appeal and disputed by Intra-Press, the General Court distorted that company's position concerning the average francophone consumer's level of knowledge of the English language.

41 The present ground of appeal must therefore be rejected.

Second ground of appeal: infringement of Article 8(1)(b) of Regulation No 40/94

42 The second ground of appeal is divided into several parts. By the first part, Intra-Press submits that the General Court made an incorrect assessment of the relevant public, in that it only took into account part of that public. The second part of this ground of appeal concerns the error of law allegedly made by the General Court in its assessment of 'conceptual similarity'. By the third part of this ground of appeal, which is raised only in Case C-581/13 P, Intra-Press submits that, in its assessment of the likelihood of confusion, the General Court omitted to take into account the high distinctiveness of the earlier mark in relation to the services concerned in that case.

First part of the second ground of appeal: incorrect assessment of the relevant public

– Arguments of the parties

43 Intra-Press submits that the relevant public is the general public in the European Union with a sufficient understanding of both French and English and that the General Court — when comparing the signs at issue conceptually — effectively reduced the relevant public to the average francophone consumer. As a result, the General Court incorrectly assessed the degree of conceptual similarity between the signs at issue.

44 OHIM agrees with Intra-Press's argument regarding the incorrect assessment of the relevant public, to the extent that it is directed at the failure to

take into account part of the relevant public when comparing the signs at issue. In that regard, OHIM points out that the General Court did not state the reasons for which the anglophone public cannot immediately link the signs on account of their meaning. OHIM argues that that failure to state reasons did not only constitute a breach of an essential procedural requirement, but also led to the infringement of Article 8(1)(b) of Regulation No 40/94 to the extent that no consideration was given to the way in which the signs were perceived by part of the relevant public.

45 Golden Balls contends that the General Court always considered the public at large but, for the sake of argument, it considered a sub-set of the general public — average francophone consumers — which ‘represented the most favourable scenario for Intra-Press’s case’. Golden Balls adds that there was no evidence before the General Court that any other sub-set of the general public would be better placed than the francophone part of that public, for the purposes of the conceptual understanding of the two signs.

– Findings of the Court

46 It should be observed that the arguments put forward by Intra-Press and OHIM in support of the first part of the second ground of appeal are based on a manifest misreading of the judgments under appeal.

47 It does not emerge from those judgments that a part of the relevant public was ignored by the General Court when assessing the conceptual similarity of the marks at issue. Contrary to the assertions made by Intra-Press and OHIM, the General Court’s conclusions regarding the degree of similarity between the signs at issue are based on its consideration of all the relevant public, including the anglophone public.

48 In that regard, it should be borne in mind that, under Article 8(1)(b) of Regulation No 40/94, where the earlier mark relied on in support of opposition proceedings is a Community trade mark, the trade mark in respect of which registration is sought is not to be registered if, because it is identical or similar to that earlier trade mark and the goods or services covered by those marks are identical or similar, there is a likelihood of confusion on the part of the public in the European Union (see to that effect, inter alia, the judgment in *Armacell v OHIM*, C-514/06 P, EU:C:2008:511, paragraph 55).

49 In the present cases, in order to assess whether there could be such a likelihood of confusion, the General Court’s first step was to make the finding, in paragraph 27 of the judgments under appeal, that ‘*the relevant public was composed of average consumers in the European Union, reasonably well informed and reasonably observant and circumspect*’.

50 Subsequently, for the purposes of assessing conceptual similarity, the General Court relied in paragraph 42 of those judgments on the point of view of that general public, ‘*in particular the average anglophone and francophone public*’.

51 Lastly, after pointing out in paragraph 43 of the judgments under appeal that a linguistic difference between the signs is capable of preventing the relevant

public, at least to some degree, from drawing an immediate conceptual comparison between the signs, the General Court held in paragraphs 47 and 48 of those judgments — without confining its findings to one single part of the relevant public — that, because of the differences between the signs at issue, such a comparison would not readily be made. Specifically, in paragraph 48 of those judgments, the General Court stated that some of those differences between the signs at issue ‘*are capable of impeding the immediate discovery of the similar hidden meaning of the signs at issue, both for the francophone and anglophone consumer with an average level of attention*’.

52 Accordingly, it must be held that, contrary to the assertions made by Intra-Press and OHIM, the General Court did not reduce the relevant public to the average francophone consumer. Their arguments in that respect must therefore be rejected as manifestly unfounded.

53 As regards the failure to state reasons alleged by OHIM in respect of the General Court’s finding concerning the perception of the relevant public — other than the francophone public — of the two signs at issue, it should be borne in mind that, according to the settled case-law of the Court, the duty incumbent upon the General Court under Article 36 and the first paragraph of Article 53 of the Statute of the Court of Justice to state reasons for its judgments does not require the General Court to provide an account that follows exhaustively and one by one all the arguments articulated by the parties to the case. The reasoning may therefore be implicit, on condition that it enables the persons concerned to know the grounds on which the General Court has based its findings and provides the Court of Justice with sufficient material for it to exercise its appellate jurisdiction (see, inter alia, the judgment in *Isdin v OHIM and Bial-Portela*, C-597/12 P, EU:C:2013:672, paragraph 21).

54 In the present cases, it is apparent from paragraphs 47 and 48 of the judgments under appeal, inter alia, that the General Court analysed the signs at issue and justified its assessment of their conceptual differences, such as might be perceived by the relevant public as a whole. It must therefore be concluded that the General Court did not fail in its duty to state reasons.

55 In the light of all the foregoing considerations, the first part of the second plea must be rejected as manifestly unfounded.

Second part of the second ground of appeal: incorrect assessment of the conceptual similarity

– Arguments of the parties

56 Intra-Press submits that, in paragraph 60 of the judgments under appeal, the General Court erred in law in its assessment of the conceptual similarity of the signs at issue. According to Intra-Press, the General Court was incorrect to add a condition, in order for those signs to be recognised as similar, relating to an intellectual process involving the translation of those signs by the relevant public. Intra-Press argues that the relevant public is capable of identifying the meaning of the words ‘golden balls’ and ‘ballon d’or’ and of forming the view that, conceptually, the signs are

identical or highly similar. According to Intra-Press, application of the criterion of an ‘intellectual process of translation’ or ‘prior translation’ is artificial for the purposes of assessing the conceptual similarity of the signs at issue.

57 Intra-Press adds that, when word marks are composed of basic words in various languages understood by the public, which is the case here, there is no ‘intellectual process of translation’; nor does the consumer engage in ‘prior translation’ or ‘begin by translating’. According to Intra-Press, the meaning of those words would be immediately understood by the relevant public, whatever its mother tongue.

58 OHIM submits that the General Court did not predicate the conceptual similarity of the signs at issue on the existence of an intellectual process, undertaken by the relevant public, consisting in the translation of those signs.

59 Nevertheless, OHIM shares Intra-Press’s view that the intellectual process of translation is not a relevant criterion for the purposes of assessing whether the signs at issue are conceptually similar. According to OHIM, that criterion is relevant only in the context of the overall assessment of the likelihood of confusion. The degree of conceptual similarity between such signs does not depend on the more or less immediate connection made by the public between the meanings of those signs, but only on their closeness in terms of the idea that they each evoke.

60 Golden Balls contends that the cognitive process of translation is an aspect of the conceptual comparison that comes into play when the words for which registration as marks is sought are not in the same language. Golden Balls also argues that, by the second part of the second ground of appeal, Intra-Press is attempting to portray an assessment of fact as a principle of law.

– Findings of the Court

61 As regards the argument put forward by Intra-Press and OHIM concerning the significance placed on prior translation, for the purposes of assessing the conceptual similarity of the word marks at issue, which are in different languages, it should be noted that by ‘conceptual similarity’, those parties mean the manner in which the relevant public understands the signs at issue. Intra-Press and OHIM are thus attempting to have the Court re-examine the appraisal of the facts made by the General Court in paragraphs 42 to 50 of the judgments under appeal, to the effect that: (i) the signs at issue differ as regards the language enabling their respective conceptual content to be understood and (ii) that linguistic difference is capable of preventing the relevant public, at least to some degree, from making an immediate conceptual comparison.

62 The Court has held that findings relating to the characteristics of the relevant public and to its degree of attention, perception or attitude represent appraisals of fact (see, inter alia, the order in *Shah v Three-N-Products Private*, C-14/12 P, EU:C:2013:349, paragraph 28 and the case-law cited) and that the same is true as regards the relevant public’s understanding of

the meanings of different languages (see the order in *adp Gauselmann v OHIM*, C-532/10 P, EU:C:2011:433, paragraph 51).

63 Accordingly, as such an assessment is not open to review by the Court of Justice on appeal, the argument of Intra-Press and OHIM in that regard must be rejected as manifestly inadmissible, as must, in consequence, the second part of the second plea.

Third part of the second ground of appeal: incorrect assessment of the distinctiveness of the earlier mark

64 Intra-Press submits that the General Court failed, in the judgment in Case T-448/11, to take into consideration, for the purposes of assessing the likelihood of confusion between the marks at issue, the distinctiveness of the earlier mark BALLON D’OR in relation to the services in Class 41 of the Nice Agreement and, in particular, in relation to ‘a sports competition’.

65 In that regard, it should be pointed out that Intra-Press’s argument is based on a manifestly incorrect reading of the judgment in Case T-448/11.

66 While it is true that, in paragraph 59 of the judgment in Case T-448/11, the General Court did not specifically hold that the mark BALLON D’OR was devoid of distinctive character as regards the services at issue, it nevertheless clearly stated in that paragraph that, in the circumstances, such distinctive character would not, in any event, affect the overall assessment of the likelihood of confusion on the part of the target public. It follows that, contrary to the assertions made by Intra-Press, the General Court considered the possible impact of the distinctive character of the mark BALLON D’OR on the likelihood of confusion, as regards the services at issue.

67 It is apparent from all the above considerations that none of the three parts of the second plea can be upheld. Consequently, that plea must be rejected as in part unfounded and in part manifestly inadmissible.

Third ground of appeal: infringement of Article 8(5) of Regulation No 40/94

68 By its third ground of appeal, which is divided into two parts, Intra-Press submits that the General Court infringed Article 8(5) of Regulation No 40/94. First, according to Intra-Press, the General Court wrongly inferred from the lack of similarity between the signs at issue for the purposes of Article 8(1)(b) that there was a lack of similarity for the purposes of Article 8(5). Secondly, according to Intra-Press, the General Court should also have evaluated the application of Article 8(5) in respect of the similar or identical goods in relation to which it had held that there was no likelihood of confusion.

69 It is appropriate first of all to examine the first part of that ground of appeal.

Arguments of the parties

70 Intra-Press submits, in essence, that the General Court did not correctly assess the conditions for the application of Article 8(5) of Regulation No 40/94. It wrongly omitted to assess the effect of the repute of the earlier mark, despite the supposedly low degree of similarity between the signs at issue, on the link that

the relevant public could make between those signs. According to Intra-Press, it is only where there is no similarity between the earlier mark and the mark for which registration is sought that such an examination is unnecessary.

71 OHIM submits that the General Court also infringed Article 8(5) of Regulation No 40/94, but only as a result of the error in law made in the conceptual and overall comparison of the signs at issue.

Findings of the Court

72 The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).

73 According to the same case-law, Article 8(5) of Regulation No 40/94, like Article 8(1)(b), is manifestly inapplicable where the General Court rules out any similarity between the marks at issue. It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out an overall assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public (*Ferrero v OHIM*, EU:C:2011:177, paragraph 66).

74 In the present cases, the General Court found in paragraph 72 of the judgments under appeal that, 'having regard to the assessments made in paragraphs 41 to 51 [of those judgments]', the signs at issue lacked the requisite similarity for the purposes of applying Article 8(5) of Regulation No 40/94.

75 However, although the General Court found in paragraphs 41 to 51 of the judgments under appeal that those signs were not at all visually or phonetically similar, it also found that there was a low degree of conceptual similarity between them. Thus, the General Court did not, in those judgments, rule out all possibility that the marks at issue were similar.

76 Consequently, in accordance with the case-law cited in paragraph 73 above, the General Court was wrong to rule out the application of Article 8(5) of Regulation No 40/94 without first undertaking an overall

assessment of the marks at issue in order to ascertain whether that low degree of similarity was nevertheless sufficient, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, for the relevant public to make a link between those marks.

77 In those circumstances, it must be held that the General Court erred in law in concluding in paragraph 72 of the judgments under appeal that the Board of Appeal had been under a duty — even if it had examined the plea raised by Intra-Press alleging infringement of Article 8(5) of Regulation No 40/94 — to reject the opposition concerning the 'apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity' in Class 9 of the Nice Agreement and the goods in Classes 21 and 24 of that agreement.

78 Accordingly, without it being necessary to examine the other arguments put forward by Intra-Press, the first part of the third ground of appeal must be upheld and the judgments under appeal set aside to the extent that they dismissed the two applications for annulment submitted by Intra-Press.

The action at first instance

79 Under the first paragraph of Article 61 of the Statute of the Court of Justice, if the Court quashes decisions of the General Court, it may itself give final judgment in those matters, where the state of the proceedings so permits. That is the position in the present cases.

80 In support of its applications, under Article 134(3) of the Rules of Procedure of the General Court, for annulment of the contested decisions to the extent that they reject its oppositions against registration of the sign 'GOLDEN BALLS' as a mark concerning 'apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity' in Class 9 of the Nice Agreement and the goods in Classes 21 and 24 of that agreement, Intra-Press raises a single plea in law, alleging infringement of Articles 8(5), 62(1) and 74(1) of Regulation No 40/94. According to Intra-Press, the Board of Appeal should have ruled on the plea alleging infringement of Article 8(5) of that regulation, in relation to the goods referred to above.

81 At the hearing before the General Court, OHIM essentially admitted that the fact that the Board of Appeal did not rule on the plea alleging infringement of Article 8(5) of Regulation No 40/94 constituted an infringement of an essential procedural requirement.

82 In the present cases, the Board of Appeal — unlike the Opposition Division — found that the signs at issue were similar overall. Accordingly, it concluded that there was a likelihood of confusion in relation to the identical or similar goods and services at issue, pursuant to Article 8(1)(b) of Regulation No 40/94. It therefore took the view that it was unnecessary to examine the pleas raised by Intra-Press on the basis of Article 8(5) of that regulation, despite the fact that the dispute also concerned different goods, not covered by the Board of Appeal's assessment relating to the likelihood of confusion.

83 In that respect, it should be noted that, under Article 62(1) of Regulation No 40/94, by virtue of the appeal brought before it, the Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition, in terms both of law and of fact (OHIM v Kaul, C-29/05 P, EU:C:2007:162, paragraph 57).

84 In the present cases, that obligation to examine the merits of the appeal must be understood as meaning that the Board of Appeal was obliged to decide on each of the heads of claim submitted for its consideration in order to give a decision on the oppositions by either rejecting them or declaring them to be founded, thereby either upholding or reversing the decisions of the Opposition Division contested before it (see, to that effect, OHIM v Kaul, EU:C:2007:162, paragraph 56).

85 In the light of the considerations set out in paragraphs 72 to 77 above, it should be noted that, in so far as it did not give a decision on Intra-Press's plea alleging infringement of Article 8(5) of Regulation No 40/94 in relation to the goods referred to in paragraph 80 above, the Board of Appeal failed to fulfil its obligation to carry out a new, full examination of the merits of the oppositions filed by that company.

86 It follows that the contested decisions must also be annulled to the extent that they dismissed the appeals against the rejections of the opposition to the registration of the mark GOLDEN BALLS in relation to the 'apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity' in Class 9 of the Nice Agreement and the goods in Classes 21 and 24 of that agreement.

Costs

87 Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court itself gives final judgment in the case, the Court is to make a decision as to costs.

88 Under Article 138(3) of the Rules of Procedure, applicable to appeal proceedings by virtue of Article 184(1) of those rules, where each party succeeds on some heads and fails on others, the parties are to bear their own costs.

89 In the present cases, it must first be observed that, although one of the grounds of appeal put forward by Intra-Press was upheld and the judgments under appeal have been aside on that ground, that is not the position as regards the other grounds of appeal, which were each in turn rejected by the Court.

90 Secondly, with regard to the action at first instance, it should be noted that, by annulling the contested decisions in part, the Court has also upheld the plea in law raised by Intra-Press. On the other hand, it is apparent from the judgments under appeal, which have not been overturned by the Court on these points, that Intra-Press and OHIM did not succeed in relation to the pleas in law raised by Golden Balls at first instance.

91 In those circumstances, and since each of the parties has been unsuccessful in part, both at first instance and on appeal, they must be ordered to bear their own costs. On those grounds, the Court (Eighth Chamber) hereby:

1. Sets aside the judgments of the General Court of the European Union in *Golden Balls v OHIM — Intra-Press (GOLDEN BALLS)* (T-448/11, EU:T:2013:456) and in *Golden Balls v OHIM — Intra-Press (GOLDEN BALLS)* (T-437/11, EU:T:2013:441) to the extent that they dismissed the two applications for annulment submitted by Intra-Press SAS;

2. Dismisses the appeals as to the remainder;

3. Annuls point 2 of the operative part of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 22 June 2011 (Case R 1432/2010-1) and point 2 of the operative part of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 26 May 2011 (Case R 1310/2010-1);

4. Orders Intra-Press SAS, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Golden Balls Ltd to bear their own costs at first instance and on appeal.

[Signatures]
