

Court of Justice EU, 10 December 2015, El Corte Inglés v OHIM

The English Cut

v



TRADEMARK LAW

RELATIVE GROUNDS FOR REFUSAL

Concept “similarity” has the same meaning when used for relative grounds for refusal in article 8(1)(b) (similarity with earlier trade mark for similar goods and services) and article 8(5) CTMR (similarity with earlier trade mark)

- Given that it is not apparent either from the wording of paragraphs 1(b) and 5 of Article 8 of Regulation No 207/2009 or from the case-law of the Court of Justice that the concept of similarity has a different meaning in each of those paragraphs, it follows, inter alia, that, if, in examining the conditions for the application of Article 8(1)(b) of that regulation, the General Court concludes that there is no similarity between the signs at issue, paragraph 5 of Article 8 also necessarily does not apply to the case in point. Conversely, if the General Court takes the view, in the context of that same examination, that there is some similarity between the signs at issue, such a finding is equally valid with regard to the application of both Article 8(1)(b) and Article 8(5) of that regulation.

Article 8(5) CTMR requires a lower similarity than article 8(1) under b CTMR

- Because only a possible link between marks and no confusion is required

The degree of similarity between the signs at issue required by each of the paragraphs of that provision is different. Whereas the application of Article 8(1)(b) of Regulation No 207/2009 is conditional on a finding of a degree of similarity between those signs which is capable of giving rise to a likelihood of confusion between them on the part of the relevant public, the existence of such a likelihood of confusion is not, by contrast, necessary as a condition for the application of paragraph 5 of that article.

42. Since Article 8(5) of Regulation No 207/2009 merely requires the similarity which exists to be capable of leading the relevant public to make a connection between the signs at issue, that is to say, to establish a link between them, but does not require that similarity to be capable of leading that public to confuse those signs, it must be held that the protection which that provision lays down in favour of marks with a reputation may apply even if there is a lower degree of similarity between the signs at issue (see, by analogy, judgment in Adidas-Salomon and Adidas Benelux, C-408/01, EU:C:2003:582, paragraphs 27, 29 and 31, and judgment in Intel Corporation, C-252/07, EU:C:2008:655, paragraphs 57, 58 and 66).

The General Court EU was right in saying that only a small conceptual similarity was required for likelihood of confusion as set out in 8(1)(b) CTMR

- In that regard, it must be pointed out that, when it examined the conditions for the application of Article 8(1)(b) of Regulation No 207/2009, the General Court held, in paragraph 29 of the judgment under appeal, that there was a low degree of conceptual similarity between the signs at issue. However, in paragraph 33 of that judgment, it took the view that, in the light of the absence of any visual and phonetic similarity, it had been rightly found in the contested decision that those signs were different overall. Consequently, the General Court held that, as one of the cumulative conditions for the application of Article 8(1)(b) was not satisfied, there was no need to carry out a global assessment of the likelihood of confusion.

Because of the small conceptual similarity the General Court EU should have examined whether the public is establishing a link with the renown or reputation of the earlier mark for the purpose of 8(5) CMTR

- However, as regards the assessment of the conditions for the application of Article 8(5) of Regulation No 207/2009, the General Court stated, in paragraph 39 of the judgment under appeal, that it was apparent from the comparison of the signs at issue, which was carried out in the context of paragraph 1(b) of that article, that those signs were not similar and therefore that the conditions for the application of paragraph 5 of that article were not satisfied.

- In ruling to that effect, the General Court erred in law. The Court could not disregard its own finding, in paragraph 29 of the judgment under appeal, that there was a conceptual similarity between the signs at issue.

- In those circumstances, the General Court should have examined whether that degree of similarity, albeit low, was not sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8(5) of Regulation No 207/2009.

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Court of Justice EU, 10 December 2015

(J. Malenovský (rapporteur), M. Safjan en K. Jürimaä)
JUDGMENT OF THE COURT (Ninth Chamber)
10 December 2015 (*)

(Appeal — Community trade mark — Application for the word mark The English Cut — Opposition by the proprietor of the national and Community word and figurative marks including the word elements ‘El Corte Inglés’ — Regulation (EC) No 207/2009 — Article 8(1)(b) — Likelihood of confusion — Article 8(5) — Risk that the relevant public will make a connection with a trade mark which has a reputation — Degree of similarity required)

In Case C-603/14 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 29 December 2014,

El Corte Inglés SA, established in Madrid (Spain), represented by J. Rivas Zurdo, abogado, appellant,

the other party to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by J. Crespo Carrillo, acting as Agent, defendant at first instance,

THE COURT (Ninth Chamber),

composed of J. Malenovský (Rapporteur), acting as President of the Chamber, M. Safjan and K. Jürimaä, Judges,

Advocate General: N. Wahl,

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 appeal, El Corte Inglés SA (‘El Corte Inglés’) seeks to have set aside the judgment of the General Court of the European Union of 15 October 2014 in *El Corte Inglés v OHIM — English Cut (The English Cut)* (T-515/12, EU:T:2014:882) (‘the judgment under appeal’), by which that Court dismissed its action seeking annulment of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 6 September 2012 (Case R 1673/2011-1) (‘the contested decision’) relating to opposition proceedings between that company and The English Cut SL (‘The English Cut’).

Legal context

2. Article 8 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1) provides:

‘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;

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;

...

...

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.’

Background to the dispute and the contested decision

3. On 9 February 2010, The English Cut filed with OHIM an application for registration of the word sign ‘The English Cut’ as a Community trade mark.

4. The goods in respect of which registration was sought are in Class 25 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 (‘the Nice Agreement’), and correspond to the following description:

‘Clothing, except suits, trousers and jackets; footwear, headgear’.

5. The application for registration of that Community trade mark was published in Community Trade Marks Bulletin No 2010/122 of 6 July 2010.

6. On 4 October 2010, El Corte Inglés filed a notice of opposition to the registration of that mark in respect of the goods referred to in paragraph 4 of the present judgment.

7. The opposition was based, inter alia, on the following earlier marks:

– the Spanish word mark El Corte Inglés, registered under the number 166450 in respect of in Class 25 of the Nice Agreement, and

– the Community figurative marks registered under the numbers 5428255 and 5428339 in respect of, inter alia, in Class 25 of the Nice Agreement and in respect of the following services: in Class 35 of the Nice Agreement. Those marks related to the figurative signs reproduced below:



8. The grounds relied on in support of the opposition were those set out in Article 8(1)(b) and (5) of Regulation No 207/2009.

9. On 12 July 2011, the Opposition Division of OHIM rejected the opposition.

10. On 16 August 2011, El Corte Inglés filed a notice of appeal against that decision. By the contested decision, the First Board of Appeal of OHIM dismissed that appeal.

11. In the first place, in so far as the opposition was based on Article 8(1)(b) of Regulation No 207/2009, the Board of Appeal found, as regards whether there was a similarity, within the meaning of that provision, between the signs at issue, that those signs were not visually or phonetically similar. In the same way, from a conceptual standpoint, it found that the word sign '*the English Cut*', taken as a whole, would be perceived as a fanciful name by the Spanish public, which does not have a good command of English. However, it admitted that, notwithstanding the average Spanish consumer's low level of knowledge of English, the term '*English*' would be understood by the majority of those consumers as expressing a concept similar to that expressed by the Spanish term '*Inglés*'.

12. Consequently, the Board of Appeal found that the signs at issue were conceptually similar as regards one of their word elements, even though those signs were not similar as a whole.

13. The Board of Appeal then went on to consider the global assessment of the likelihood of confusion and found that the words and were the dominant elements in the signs at issue and that the relevant public would not be able to establish any between them. It concluded that there was indeed a degree of conceptual similarity between those signs, which it expressly categorised, in paragraph 43 of the contested decision, as '*minimal*', but that they were, however, different overall, with the result that the opposition, in so far as it

was based on Article 8(1)(b) of Regulation No 207/2009, had to be rejected.

14. In the second place, in so far as the opposition was based on Article 8(5) of Regulation No 207/2009, the Board of Appeal found that, in spite of the substantial reputation which the earlier marks had in the department store sector, El Corte Inglés had not provided sufficient evidence that there was actually or potentially any detriment to the reputation of those marks or that there was actually any unfair advantage being taken of or risk that unfair advantage would be taken of the reputation of those marks. Consequently, it rejected the opposition which El Corte Inglés had brought on the basis of that provision.

The procedure before the General Court and the judgment under appeal

15. By application lodged at the Registry of the General Court on 22 November 2012, El Corte Inglés brought an action for annulment of the contested decision.

16. In support of its action, the appellant relied on two pleas in law, alleging, (i) infringement of Article 8(1)(b) of Regulation No 207/2009 and (ii) infringement of Article 8(5) of that regulation.

17. By the judgment under appeal, the General Court dismissed the action in its entirety.

18. As regards the first plea, the General Court, first of all, took the view that, since the findings of the Board of Appeal relating to the definition of the relevant public and the comparison of the goods and services concerned had not been disputed by the parties and were correct, they had to be upheld.

19. As regards, secondly, the similarity of the signs at issue, for the purposes of Article 8(1)(b) of Regulation No 207/2009, the General Court pointed out, first, that they were made up of words which consist of a different number of letters and come from different languages and, secondly, that their pronunciation and the number of syllables which they contain are different. The General Court concluded that the Board of Appeal was right in finding that those signs were neither visually nor phonetically similar. By contrast, as regards the conceptual aspect, the General Court pointed out that the literal meaning of the signs at issue was the same, namely '*the English cut*'. However, it took the view that Spanish consumers would be able to perceive that meaning as being identical only after translating the word sign '*The English Cut*' into their language, which precluded them from making an immediate conceptual connection between the signs at issue. Consequently, the General Court, in paragraph 29 of the judgment under appeal, categorised the degree of conceptual similarity between those signs as '*low*'.

20. Lastly, at the end of its analysis, the General Court held, in paragraph 33 of the judgment under appeal, that there was a low degree of conceptual similarity, but no visual or phonetic similarity between the signs at issue. Consequently, it held that the Board of Appeal was right to find that the signs were different overall. Since it took the view that one of the cumulative conditions for the application of Article 8(1)(b) of

Regulation No 207/2009 was not satisfied, the General Court decided that there was no need to carry out a global assessment of the likelihood of confusion. Consequently, it rejected the first plea as unfounded.

21. As regards the second plea, the General Court rejected it as unfounded on the ground that, although the earlier marks had a considerable reputation, it was apparent from the comparison of the signs at issue carried out in the context of the first plea that those signs were not similar, with the result that the condition as to their identity or similarity, which is necessary for the purposes of the application of Article 8(5) of Regulation No 207/2009, was not satisfied in the present case.

Forms of order sought before the Court

22. El Corte Inglés claims that the Court should:

- set aside the judgment under appeal in its entirety, and
- order the party or parties opposing the appeal to pay the costs.

23. OHIM contends that the Court should:

- dismiss the appeal as partially inadmissible and partially unfounded, and
- order El Corte Inglés to pay the costs.

The appeal

24. In support of its appeal, El Corte Inglés puts forward three grounds of appeal alleging, (i) that the General Court distorted the facts (ii) infringement of Article 8(1)(b) of Regulation No 207/2009 and (iii) infringement of Article 8(5) of that regulation.

The first ground of appeal, alleging that the General Court distorted the facts

25. According to El Corte Inglés, since it was found in the contested decision that there was a conceptual similarity between the signs at issue, the General Court could not, without distorting the facts in the present case, lower the degree of that similarity by categorising it, in paragraphs 29, 30 and 33 of the judgment under appeal as ‘*slight*’ or ‘*minimal*’.

26. It must be pointed out, in that regard, that such a claim is based on a misreading of the contested decision. Although, in many paragraphs of that decision, the Board of Appeal stated that there was a conceptual similarity between the signs at issue without stating the degree of that similarity, by contrast, in paragraph 43 of that decision, it expressly categorised the degree of similarity as ‘*minimal*’. Consequently, in pointing out, in paragraph 30 of the judgment under appeal, that the Board of Appeal had acknowledged that there was a ‘*minimal*’ degree of conceptual similarity between the signs at issue and in deciding, in paragraphs 29 and 33 of that judgment, to categorise that degree of similarity as ‘*low*’, the General Court did not distort the facts in the present case and did not, therefore, lower the degree of the similarity which had been found to exist in the contested decision.

27. In any event, it must be pointed out that whether a conceptual similarity is slight, low or minimal in degree is part of an assessment of the facts of the case. However, the General Court is not bound by such an assessment carried out by the Board of Appeal, as that

assessment forms part of the reasons for the decision the legality of which is being disputed before it (see, to that effect, judgment in [Editions Albert René v OHIM, C-16/06 P, EU:C:2008:739](#), paragraphs 47 and 48).

28. In those circumstances, 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 207/2009

29. El Corte Inglés maintains that, by ruling out, in paragraphs 26 to 33 of the judgment under appeal, the existence of any visual and phonetic similarity between the signs at issue and by acknowledging only a low degree of conceptual similarity between them, the General Court infringed the provisions of Article 8(1)(b) of Regulation No 207/2009.

30. Such a line of argument, however, seeks to call into question the General Court’s assessment of the facts.

31. It is apparent from Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union that an appeal lies on points of law only. As the appraisal of the facts and the assessment of the evidence do not constitute points of law subject, as such, to review by the Court of Justice on appeal, the General Court thus has exclusive jurisdiction to find and appraise those facts and to assess that evidence (see, to the effect, inter alia, judgment in [Les Éditions Albert René v OHIM, C-16/06 P, EU:C:2008:739](#), paragraph 68, and order in [Repsol YPF v OHIM, C-466/13 P, EU:C:2014:2331](#), paragraph 54).

32. Consequently, the second ground of appeal must be rejected as inadmissible.

The third ground of appeal, alleging infringement of Article 8(5) of Regulation No 207/2009

Arguments of the parties

33. El Corte Inglés submits that, according to the case-law of the Court of Justice, the degree of similarity between the signs at issue that is required for the application of Article 8(1)(b) and Article 8(5) respectively of Regulation No 207/2009 is different. In its view, it is apparent from the case-law of the Court of Justice, and in particular from paragraphs 72 to 78 of the judgment in [Intra-Press v OHIM \(C-581/13 P and C-582/13 P, EU:C:2014:2387\)](#), that, contrary to Article 8(1)(b) of Regulation No 207/2009, Article 8(5) of that regulation requires only a low degree of similarity between the signs at issue. It maintains that, consequently, since, in the present case, the General Court acknowledged that there was a conceptual similarity, albeit low in degree, between those signs, that Court erred in not examining whether, on account of the presence of other relevant factors, such as the renown or reputation of the earlier marks, that low degree of conceptual similarity was not, nevertheless, sufficient for the relevant public to establish a link between those signs.

34. OHIM submits that the judgment in [Intra-Press v OHIM \(C-581/13 P and C-582/13 P, EU:C:2014:2387\)](#) on which El Corte Inglés relies in

order to develop its arguments must be put into perspective with the judgments in [Calvin Klein Trademark Trust v OHIM \(C-254/09 P, EU:C:2010:488\)](#) and [Ferrero v OHIM \(C-552/09 P, EU:C:2011:177\)](#). It takes the view that, in the latter two judgments, the Court of Justice held that the General Court had been right to conclude that Article 8(5) of Regulation No 40/94, the provisions of which were identical to those of Article 8(5) of Regulation No 207/2009, was manifestly inapplicable, even though the General Court had pointed out that the signs at issue had a word or figurative element in common when it examined the conditions for the application of the protection currently provided for in Article 8(1)(b) of Regulation No 207/2009.

35. According to OHIM, that difference in outcome is explained by the fact that, in the cases which gave rise to the judgments in [Calvin Klein Trademark Trust v OHIM \(C-254/09 P, EU:C:2010:488\)](#) and [Ferrero v OHIM \(C-552/09 P, EU:C:2011:177\)](#), in contrast to the situation which obtained in the judgment in [Intra-Press v OHIM \(C-581/13 P and C-582/13 P, EU:C:2014:2387\)](#), the General Court took into account, at the stage of the visual, phonetic and conceptual comparison of the signs at issue, factors such as the distinctive and dominant elements of each of those signs which, in other situations, are examined only in the context of a global assessment of the likelihood of confusion. OHIM deduces from that that, if the General Court takes the distinctive and dominant elements of each of the signs at issue into account at the stage of the comparison of those signs, which is the case here, but reaches the conclusion, as a result of that examination, that there is no likelihood of confusion, in spite of the existence of a slight degree of conceptual similarity, that Court is entitled to deduce from this that the application of Article 8(5) of Regulation No 207/2009 is necessarily excluded.

36. In the alternative, OHIM submits that, even though, formally, the General Court did not expressly examine, in the context of the application of Article 8(5) of Regulation No 207/2009, whether the slight degree of conceptual similarity which was found to exist when it examined the conditions for the application of Article 8(1)(b) of that regulation was sufficient for the public to establish a link between the signs at issue, it must nevertheless be deduced from certain considerations of the General Court set out in the context of the latter examination that Article 8(5) of Regulation No 207/2009 also did not apply, on the ground that consumers are capable of perceiving, as the case may be, that the signs at issue have the same meaning only after they have translated the sign *'The English Cut'* into their native language, with the result that they do not make an immediate conceptual connection between those signs.

Findings of the Court

37. It must be pointed out, at the outset, that the provisions of Article 8(1)(b) and Article 8(5) of Regulation No 207/2009 reproduce identically those of

Article 8(1)(b) and Article 8(5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). Consequently, the case-law of the Court of Justice relating to Article 8(1)(b) and Article 8(5) of Regulation No 40/94 must be regarded as relevant with regard to the interpretation of Article 8(1)(b) and Article 8(5) of Regulation No 207/2009.

38. It is apparent from the wording of Article 8(5) of Regulation No 207/2009 that its application is subject to three conditions: first, that the signs at issue are identical or similar, secondly, that the earlier mark cited in opposition has a reputation and, thirdly, that there is a risk that the use by someone, without due cause, of the sign in respect of which registration as a trade mark is applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. Furthermore, it is apparent from that wording that the three conditions referred to previously must be regarded as cumulative. Lastly, it must be pointed out that the condition that the signs at issue must be identical or similar is common to Article 8(1)(b) and Article 8(5) of that regulation.

39. Given that it is not apparent either from the wording of paragraphs 1(b) and 5 of Article 8 of Regulation No 207/2009 or from the case-law of the Court of Justice that the concept of similarity has a different meaning in each of those paragraphs, it follows, inter alia, that, if, in examining the conditions for the application of Article 8(1)(b) of that regulation, the General Court concludes that there is no similarity between the signs at issue, paragraph 5 of Article 8 also necessarily does not apply to the case in point. Conversely, if the General Court takes the view, in the context of that same examination, that there is some similarity between the signs at issue, such a finding is equally valid with regard to the application of both Article 8(1)(b) and Article 8(5) of that regulation.

40. However, in a situation in which the degree of similarity in question does not prove to be sufficient to result in the application of Article 8(1)(b) of Regulation No 207/2009, it cannot be deduced from that that the application of paragraph 5 of that article is necessarily precluded.

41. The degree of similarity between the signs at issue required by each of the paragraphs of that provision is different. Whereas the application of Article 8(1)(b) of Regulation No 207/2009 is conditional on a finding of a degree of similarity between those signs which is capable of giving rise to a likelihood of confusion between them on the part of the relevant public, the existence of such a likelihood of confusion is not, by contrast, necessary as a condition for the application of paragraph 5 of that article.

42. Since Article 8(5) of Regulation No 207/2009 merely requires the similarity which exists to be capable of leading the relevant public to make a connection between the signs at issue, that is to say, to establish a link between them, but does not require that similarity to be capable of leading that public to confuse those signs, it must be held that the protection

which that provision lays down in favour of marks with a reputation may apply even if there is a lower degree of similarity between the signs at issue (see, by analogy, judgment in Adidas-Salomon and Adidas Benelux, C-408/01, EU:C:2003:582, paragraphs 27, 29 and 31, and judgment in Intel Corporation, C-252/07, EU:C:2008:655, paragraphs 57, 58 and 66).

43. It follows that, if the examination of the conditions for the application of Article 8(1)(b) of Regulation No 207/2009 has shown that there is some similarity between the signs at issue, the General Court must, in order to ascertain, this time, whether the conditions for the application of paragraph 5 of that article are satisfied, examine whether, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, the relevant public is capable of establishing a link between those signs (see, to that effect, judgment in Intra-Press v OHIM, C-581/13 P and C-582/13 P, EU:C:2014:2387, paragraph 73).

44. It is in the light of the foregoing considerations that it must be examined whether, in the present case, as El Corte Inglés submits, the General Court infringed Article 8(5) of Regulation No 207/2009.

45. In that regard, it must be pointed out that, when it examined the conditions for the application of Article 8(1)(b) of Regulation No 207/2009, the General Court held, in paragraph 29 of the judgment under appeal, that there was a low degree of conceptual similarity between the signs at issue. However, in paragraph 33 of that judgment, it took the view that, in the light of the absence of any visual and phonetic similarity, it had been rightly found in the contested decision that those signs were different overall. Consequently, the General Court held that, as one of the cumulative conditions for the application of Article 8(1)(b) was not satisfied, there was no need to carry out a global assessment of the likelihood of confusion.

46. However, as regards the assessment of the conditions for the application of Article 8(5) of Regulation No 207/2009, the General Court stated, in paragraph 39 of the judgment under appeal, that it was apparent from the comparison of the signs at issue, which was carried out in the context of paragraph 1(b) of that article, that those signs were not similar and therefore that the conditions for the application of paragraph 5 of that article were not satisfied.

47. In ruling to that effect, the General Court erred in law. That Court could not disregard its own finding, in paragraph 29 of the judgment under appeal, that there was a conceptual similarity between the signs at issue.

48. In those circumstances, the General Court should have examined whether that degree of similarity, albeit low, was not sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8(5) of Regulation No 207/2009.

49. That finding is not called into question by the case-law of the Court of Justice resulting from the judgments in Calvin Klein Trademark Trust v

OHIM (C-254/09 P, EU:C:2010:488) and Ferrero v OHIM (C-552/09 P, EU:C:2011:177) relied on by OHIM, since those judgments relate to different situations. In particular, although, in those cases, there was a word or element which was common to the signs at issue, the General Court had formally held, contrary to what is the case in the judgment under appeal, that there was no similarity between the signs at issue.

50. Lastly, even if, as OHIM maintains, it could be deduced from the judgment under appeal that the General Court, after carrying out the examination as to whether there was any link between the signs at issue, had reached the conclusion that, in the present case, the conditions for the application of Article 8(5) of Regulation No 207/2009 were not satisfied on the ground that it was apparent from the examination which it had carried out of the conditions for the application of paragraph 1(b) of that article, that the relevant consumers were not in a position to make an immediate conceptual connection between the signs at issue, it would have to be held that such a ground would be marred by an error in law. The types of injury referred to in Article 8(5) of that regulation do not require the connection which consumers are capable of making between the signs at issue to be immediate.

51. In those circumstances, the third ground of appeal must be upheld as well founded.

52. It follows that the judgment under appeal must be set aside in so far as it was held in that judgment that it was apparent from the fact that the degree of similarity between the signs at issue was not sufficient to result in the application of Article 8(1)(b) of Regulation No 207/2009 that the conditions for the application of paragraph 5 of that article were therefore also not satisfied in the present case. The appeal must be dismissed as to the remainder.

The action before the General Court

53. In accordance with the first paragraph of Article 61 of the Statute of the Court of Justice, where the Court of Justice sets aside a decision of the General Court, it may itself give final judgment in the matter, where the state of the proceedings so permits, or refer the case back to the General Court for judgment.

54. In the present case, the conditions in which the Court of Justice may give final judgment in the matter are not satisfied. As is apparent from paragraph 48 of the present judgment, it is for the General Court to examine, in fact, whether the degree of similarity, albeit low, between the signs at issue, which that Court held to exist, in paragraph 29 of the judgment under appeal, when it examined the conditions for the application of Article 8(1)(b) of Regulation No 207/2009, was not sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8(5) of that regulation.

55. Consequently, the case must be referred back to the General Court and the costs must be reserved.

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

1. Sets aside the judgment of the General Court of the European Union of 15 October 2014 in *El Corte Inglés v OHIM — English Cut (The English Cut)* (T-515/12, EU:T:2014:882) in so far as it was held in that judgment that it was apparent from the fact that the degree of similarity between the signs at issue was not sufficient to result in the application of Article 8(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark that the conditions for the application of Article 8(5) of that regulation were therefore also not satisfied in the present case;
2. Dismisses the appeal as to the remainder;
3. Refers the case back to the General Court of the European Union;
4. Reserves the costs.

[Signatures]

* Language of the case: Spanish.
