European Court of Justice, 26 April 2007, Travatan

TRADEMARK LAW

Public

- **Influence does not exclude all likelihood of confusion**.

Contrary to what the applicant claims, the fact that intermediaries such as healthcare professionals are liable to influence or even to determine the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue.

- **The relevant public must be deemed to be composed of the average consumer.**

In addition, the Court of Justice has already held that the average consumer only rarely has the chance to make a direct comparison between the different signs but must place his trust in the imperfect picture of them that he has kept in his mind (**Lloyd Schuhfabrik Meyer**, paragraph 26, and judgment of 23 September 2004 in Case C-107/03 P Procter & Gamble v OHIM, not pub-lished in the ECR, paragraph 44). Furthermore, since it is undisputed that the whole process of marketing the goods at issue is aimed at the end-user's acquisition of them, the Court of First In-stance was entitled to hold that the role played by intermediaries, even if they are healthcare professionals whose prior intervention is required in order to sell those goods to end-users, must be in part balanced against the high degree of attentiveness which may be shown by those users, in the light of the fact that the goods at issue are pharmaceutical products, when they are prescribed and, consequently, against those users' ability to make those professionals take into account their perception of the trade marks at issue and, in par-ticular, their requirements or preferences. In this connection, it should be recalled that the Court has already ruled that where the goods or ser-vices with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (**Joined Cases C-473/01 P and C-474/01 P Procter & Gamble v OHIM [2004] ECR I-5173**, paragraph 33, and **Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317**, paragraph 24). It follows that the Court of First Instance did not err in law by including end-users in the relevant public for the purposes of applying Article 8(1)(b) of Regula-tion No 40/94.

Similarity

- **Case-law shows that in the assessment of that similarity all the relevant factors should be taken into account. Those factors include, in particular, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary.**

As regards the argument according to which the Court of First Instance failed to take into account criteria which were relevant in assessing whether the goods at issue are similar, case-law shows that in the assessment of that similarity all the relevant factors characterising the relationship between those goods should be taken into account. Those factors include, in particular, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary (see, to that effect, Canon, paragraph 23). In the present case it must be held that, pursuant to that case-law, the Court of First Instance, in order to conclude in paragraph 61 of the judgment under appeal that the Board of Appeal did not err in finding that there was a high degree of similarity between the products in question, correctly examined, in paragraph 57 of the judgment under appeal, the nature of those products, their purpose, their end-users, the way in which they are sold and whether they are in competition with each other or are complementary. The applicant is therefore incorrect in criticising the Court of First Instance for failing to take into account relevant criteria in the assessment of the similarity of the products.

Likelihood of confusion

- **Assessment whether there was such a likelihood of confusion in the eyes of the healthcare professionals at issue necessary.**

Consequently, the Court of First Instance was entitled, in paragraphs 62 to 76 of the judgment under appeal, to assess whether there was a likelihood of confusion in the eyes of end-users. By contrast, it is not apparent to the requisite legal standard from the judgment under appeal whether the Court of First Instance systematically assessed whether there was such a likelihood of confusion in the eyes of the healthcare professionals at issue. (…). However, that failure to give adequate reasons is not such as to invalidate the judgment under appeal. Since, in the context of its definitive assessment of the facts in paragraphs 56 to 57 of the judgment under appeal, the Court of First Instance concluded that there was significant similarity between the goods concerned as well as visual and phonetic similarity of the signs at issue in the eyes of that part of the relevant public which consisted of end-users, it was entitled, without infringing the scope of Article 8(1)(b) of Regulation No 40/94, to deduce, in paragraphs 76 and 80 of that judg-ment, that there was a likelihood of confusion between those signs within the meaning of that provision.

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European Court of Justice, 26 April 2007
(A. Rosas, A. Tizzano, A. Borg Barthet, J. Malenovský and A. Ó Caoimh)
JUDGMENT OF THE COURT (Third Chamber)
26 April 2007 (*)
(Appeals – Community trade mark – Regulation (EC) No 40/94 – Article 8(1)(b) – Relative ground for refusal of registration – Likelihood of confusion – Article 43(2) and (3) – Genuine use – New plea – Word mark 'TRAVATAN' – Opposition by proprietor of earlier national trade mark 'TRIVASTAN')
In Case C-412/05 P,
APPEAL pursuant to Article 56 of the Statute of the Court of Justice, brought on 23 November 2005,
Alcon Inc., established in Hünenberg (Switzerland), represented by G. Breen, solicitor, and J. Gleeson SC, with an address for service in Luxembourg,
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,
Biofarma SA, established in Neuilly-sur-Seine (France), represented by V. Gil Vega and A. Ruiz López, abogados,
intervener at first instance,
THE COURT (Third Chamber),
composed of A. Rosas, President of the Chamber, A. Tizzano, A. Borg Barthet, J. Malenovský and A. Ó Caoimh (Rapporteur), Judges,
Advocate General: J. Kokott,
Registrar: J. Swedenborg, Administrator,
having regard to the written procedure and further to the hearing on 27 September 2006,
after hearing the **Opinion of the Advocate General at the sitting on 26 October 2006**,
gives the following
Judgment
1 By its appeal, Alcon Inc. seeks the annulment of the judgment of the Court of First Instance of the European Communities in Case T-130/03 Alcon v OHIM – Biofarma (TRAVATAN) [2005] II-3859 ('the judgment under appeal'), by which that court dismissed its appeal for annulment of the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 30 January 2003 (Case R 968/2001-3), refusing to register the word sign 'TRAVATAN' as a Community Trade Mark ('the contested decision').
Legal context
2 The first subparagraph of Article 48(2) of the Rules of Procedure of the Court of First Instance provides that 'no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure'.
3 Pursuant to Article 135(4) of those Rules, 'the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal'.
4 Article 8(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, 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.'
5 Article 8(2)(a)(ii) of that regulation is worded as follows:
'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:
…
(ii) trade marks registered in a Member State …'.
6 Article 43(2) and (3) of the same regulation provides:
'2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.
3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'
7 According to Article 44(1) of that Regulation, the applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein.
8 Article 63(1) to (3) of Regulation No 40/94 provides as follows:
'1. Actions may be brought before the Court of [First Instance] against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.
3. The Court of [First Instance] has jurisdiction to annul or to alter the contested decision.'

9 Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), lists, in Rule 13(1) thereof, the information that an application for amendment of the application under Article 44 of that latter Regulation must contain.

Background to the dispute

10 On 11 June 1998 the applicant filed an application at OHIM for the registration as a Community trade mark of the word mark 'TRAVATAN' in respect of 'ophthalmic pharmaceutical products'. The goods in respect of which registration was sought are in Class 5 for the purpose of the Nice Agreement concerning the International Classification of Goods and Services for Purposes of the Registration of Marks, of 15 June 1957, as revised and amended ('the Nice Agreement'), namely, 'pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides'.

11 On 22 June 1999, Biofarma SA ('Biofarma') filed a notice of opposition under Article 42 of Regulation No 40/94 against the registration of that Community trade mark. The opposition was based on the existence of the national word mark TRIVASTAN ('the earlier mark'), registered in Italy on 27 January 1986, and on all of the goods covered by that mark, namely 'pharmaceutical, veterinary and hygiene products; dietary products for infants or patients; plasters, materials for dressings; tooth fillings and dental impressions; disinfectants; herbicides and pesticides', included in Class 5. The opposition was directed against all the goods covered in the contested Community trade mark application.

12 Having been called on to furnish proof of the genuine use of the earlier mark in Italy, Biofarma sent some documents to OHIM for that purpose on 28 July 2000.

13 The opposition brought by Biofarma was accepted by a decision of OHIM's Opposition Division of 26 September 2001, which found that use of the earlier mark was proven in respect of a specific pharmaceutical product, namely a 'peripheral vasodilator intended to treat peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear'. Consequently, that opposition division refused the registration of the word sign 'TRAVATAN' as a Community trade mark on the ground that there was a likelihood of confusion, including the likelihood of association with the earlier mark, in Italy, given the fact that the marks were similar both visually and phonetically and that there was a degree of similarity between the goods concerned.

14 On 13 November 2001, the applicant lodged an appeal against that decision before the Third Board of Appeal of OHIM, which dismissed that appeal in the contested decision and so upheld the Opposition Division's decision, the grounds of which the Third Board of Appeal adopted in substance.

The judgment under appeal

15 By application lodged at the Registry of the Court of First Instance on 17 April 2003, the applicant brought an action for annulment of the contested decision. For that purpose it raised two pleas in law, relating to the infringement of Article 43(2) and (3) and of Article 8(1)(b) and (c), respectively, of Regulation No 40/94.

16 Before addressing those pleas, the Court of First Instance made the preliminary observations in paragraphs 17 to 22 of the judgment under appeal that the plea submitted by the applicant at the hearing in which it relied on Case T-334/01 MFE Marienfelde v OHIM–Vétoquinol(HIPOVITON) [2004] ECR II-2787 (in order to claim that the conditions required for the earlier mark to be regarded as having been subject to genuine use were not satisfied, in particular because of the small sales volume of the earlier trade mark) should be rejected as inadmissible. After reiterating the terms of the first subparagraph of Article 48(2) of its Rules of Procedure, the Court of First Instance found, first that, in its application, the applicant had alleged that the Board of Appeal had infringed Article 43(2) and (3) of Regulation No 40/94, not in so far as those conditions were not satisfied, but only in so far as the evidence of genuine use submitted by Biofarma did not establish that the earlier mark had actually been used in respect of ophthalmic products and, secondly, that that applicant had entirely failed to establish the existence of new matters of fact or law for the purpose of Article 48.

17 In paragraph 23 of the judgment under appeal, the Court of First Instance added that, 'in any event', even if that plea were to be interpreted as an argument related to the first plea put forward in the application, its review in the context of the examination of the legality of the contested decision could not go beyond the factual and legal context of the dispute as it was brought before the Board of Appeal. In paragraph 24 of that judgment the Court of First Instance found that, during the procedure before OHIM, the applicant had not disputed that the evidence supplied by Biofarma showed genuine use of the earlier mark in respect of a particular product. Before the Opposition Division, the applicant had even stated that it had 'noted the documents provided to prove use of the trade mark TRIVASTAN in Italy' and proposed 'not to dispute this issue'. The Court of First Instance therefore held, in paragraph 25 of that judgment, that the applicant's arguments could only be dismissed.

18 The Court of First Instance then rejected, in paragraphs 29 to 33 of the judgment under appeal, the first plea raised by the applicant on the ground that the Board of Appeal had rightly held that the proof fur-

nished by Bioforma showed that the earlier mark had been put to genuine use. In this respect the Court of First Instance stated, in essence, in paragraphs 30 and 31 of that judgment, that if one of the therapeutic indications of a medicinal product bearing the mark TRIVASTAN is to treat vascular disorders of the eye and it has been proved that that product was sold for several years, it is superfluous to require proof that the medicinal product was actually taken by patients suffering from vascular disorders of the eyes.

19 As regards the second plea, the Court of First Instance, after having reiterated the provisions applicable and the case-law about the likelihood of confusion with the earlier mark in paragraphs 45 to 47 of the judgment under appeal, observed, in paragraphs 48 and 49 of that judgment:

‘48 In the present case, the earlier mark TRIVASTAN is registered in Italy, which therefore constitutes the relevant territory for the purposes of applying Article 8(1)(b) of Regulation No 40/94.

49 It is common ground that the products in question are medicinal products requiring a doctor’s prescription prior to their sale to end users in pharmacies. Consequently, the relevant public is composed not only of end users, but also of professionals, that is doctors who prescribe the medicinal product and pharmacists who sell that prescribed product.’

20 The Court of First Instance then held in paragraph 50 of the judgment under appeal that in the light of those considerations it was necessary to compare, first, the goods concerned and, second, the conflicting signs.

21 Concerning, in the first place, the comparison of those goods, the Court of First Instance began by dismissing in paragraphs 51 to 53 of the judgment under appeal the restriction which the applicant claimed to have made to the list of goods specified in its trade mark application, stating, in paragraph 53 of the judgment, that the applicant had not submitted any request to amend the application to that effect pursuant to Article 44 of Regulation No 40/94 and to Rule 13 of Regulation No 2868/95.

22 The Court of First Instance held, in paragraph 55 of that judgment, that the goods to be compared were therefore ‘ophthalmic pharmaceutical products’ and a ‘peripheral vasodilator intended for the treatment of peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear’.

23 The Court of First Instance first observed, in paragraph 57 of the judgment under appeal, that those products have the same nature (pharmaceutical products), purpose (treatment of eye disorders whether or not provoked by vascular causes), consumers (professionals, including physicians and pharmacists, and also real end-users, that is patients who suffer from eye disorders) and distribution channels (typically pharmacies) and can be complementary. It inferred that they could undoubtedly be produced or sold by the same economic operators.

24 Next, in paragraph 58 of the judgment under appeal, the Court of First Instance rejected the applicant’s argument that the goods were not similar because Biofarma’s product is a tablet taken orally, whereas the applicant’s product takes the form of eye drops. It stated that that difference in the way in which the medicinal product is administered is of less significance, in the present case, than the fact that the two products have a common nature and purpose.

25 Lastly, in paragraphs 59 and 60 of the judgment under appeal, the Court of First Instance rejected as irrelevant the applicant’s argument that its medicinal product is prescribed by a medical eye specialist, whereas Biofarma’s medicinal product is prescribed by a medical specialist in the field of vascular disorders.

26 Concerning, in the second place, the comparison of the signs at issue, the Court of First Instance held, first, in paragraph 66 of the judgment under appeal, that the Board of Appeal had not erred in finding that the signs were similar visually. The Court of First Instance observed in that respect, in paragraph 65 of the judgment:

‘65 The Board of Appeal rightly found that, visually, the two signs were nearly the same length and shared seven letters, “t”, “r”, “v”, “a”, “t”, “a” and “n”, in the same order. It also stated pertinently that the signs began with the same letters “t” and “r” and had the same ending in “tan”. It must be observed that the fact that the first two letters do not entirely form the first syllable is not relevant, in the present case, when the signs are compared visually. It must therefore be concluded that the overall impression created by those visual resemblances is that the signs are similar. The Board of Appeal was right to find that the differences between the signs in question, caused by the fact that the third letter of each sign is different (the vowels “i” and “a”) and the presence of an additional letter in the earlier mark (the consonant “s”), were not capable of overriding that impression, since those elements were not very perceptible visually.’

27 Next, the Court of First Instance concluded, in paragraph 70 of the judgment under appeal, that the Board of Appeal had not erred in finding that there was phonetic similarity between the conflicting signs. The Court of First Instance ruled in this connection, in paragraph 69 of the judgment:

69 ‘... both signs consist of words having the same phonetic length, the same initial sound (“tr”), the same final sound (the syllable “tan”), fairly similar middle sounds (“va”/“vas”) and the same cadence, as the majority of the phonemes are identical and appear in the same order. It should be noted that the existence of such a large number of common elements prevents Italian consumers from clearly perceiving the small differences between those signs, which is liable to give rise to some confusion on their part’.

28 Lastly, the Court of First Instance held in paragraph 74 of the judgment under appeal that there was no conceptual similarity between the signs in question.

29 In those circumstances, the Court of First Instance held, in paragraphs 75, 76 and 80 of that judgment, that, given the significant similarity of the goods concerned and the visual and phonetic similarity

of the signs at issue, there was a likelihood of confusion between those signs in so far as the public might believe that the goods in question originated from the same undertaking or, as the case may be, from economically-linked undertakings. As a result, it dismissed the applicant's second plea and, therefore, the action in its entirety.

Forms of order sought

30 By its appeal, the applicant claims that the Court should:

– annul the judgment under appeal;

– if necessary, remit the case back to the Court of First Instance, and

– order OHIM and/or Biofarma to pay the costs.

31 OHIM contends that the Court should dismiss the appeal and order the applicant to pay the costs.

32 Biofarma, which has not lodged a reply but which made submissions at the hearing, concurs with the arguments submitted by OHIM.

The appeal

33 In support of its claims for annulment of the judgment under appeal, the applicant raises a plea concerning the admissibility of the plea alleging infringement of Article 43(2) and (3) of Regulation No 40/94 and a plea alleging infringement of Article 8(1)(b) of that regulation.

The first plea, concerning the admissibility of the plea alleging infringement of Article 43(2) and (3) of Regulation No 40/94

Arguments of the parties

34 The applicant claims that the Court of First Instance erred in ruling that, on account of being a new plea, the plea alleging infringement of Article 43(2) and (3) of Regulation No 40/94 as regards fulfilment of the conditions required for the earlier mark to be regarded as having been put to genuine use was inadmissible. Having disputed before OHIM the context in which the earlier mark had been used, namely whether that mark had actually been used in Italy to protect ophthalmic products, it submits that it should have been admissible to submit subsidiary claims under that head to the Court of First Instance.

35 In any event, the applicant takes the view that that plea is based on legal issues which came to light in the course of the proceedings, namely the judgment delivered in MFE Marienfelde v OHIM – Vétoquinol(HIPOVITON). It submits that in paragraph 35 of that judgment, which was delivered subsequent to the lodging of the action which gave rise to the judgment under appeal, the Court of First Instance, holding that in respect of the extent of the use made of the earlier mark account must be taken, in particular, of the sales volume of all the acts of use on the one hand and, on the other, the duration of the period in which those acts of use occurred and the frequency of those acts, reinterpreted the applicable law as it stemmed from Case C-40/01 Ansul [2003] ECR I-2439.

36 The applicant next claims that the Court of First Instance further erred in law in paragraphs 23 to 25 of the judgment under appeal by holding that even if the plea at issue were admissible, it should restrict itself to reviewing the legality of the Board of Appeal of OHIM's decision on the basis of the factual and legal position as it was before the Board of Appeal. Were this reasoning correct, a contested decision of the Board of Appeal could not be annulled even if it was clearly incorrect in the light of the latest interpretation of the law by the Court of First Instance or the Court of Justice.

37 According to OHIM, the applicant's contention that the mark was not put to genuine use is a new plea since, in the initial plea advanced before the Board of Appeal, the applicant merely claimed that it was not proven that the earlier mark had been used for products with specific therapeutic applications, namely ophthalmic applications, without calling into question the genuine nature of that use. That new contention amends, in breach of Article 135(4) of the Rules of Procedure of the Court of First Instance, the subject-matter of the proceedings as brought before the Board of Appeal, since it seeks a re-examination of the contested decision on issues which that decision did not deal with.

Findings of the Court

38 Inasmuch as, by the first part of the arguments raised under this plea, the applicant alleges that the Court of First Instance misconstrued the scope of the first subparagraph of Article 48(2) of the Rules of Procedure of that Court, it should be recalled that that provision provides that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure.

39 In the present case, paragraphs 17 to 22 of the judgment under appeal show that the Court of First Instance held that, in the absence of any new matters of fact or law, the plea submitted by the applicant at the hearing, according to which the conditions required for the earlier mark to be regarded as having been put to genuine use were not satisfied, in particular because of the low sales volume of that mark, should be rejected as inadmissible in so far as it was a new plea for the purpose of that provision in the Rules of Procedure of the Court of First Instance. In its application, the applicant had alleged that the Board of Appeal had infringed Article 43(2) and (3) of Regulation No 40/94 not in that those conditions were not satisfied, but only in that the evidence of genuine use submitted by Biofarma did not show that the earlier mark had actually been used in respect of ophthalmic products.

40 As the Advocate General observed in point 20 of her Opinion, the assessment made by the Court of First Instance is vitiated by an error in law. The line of argument which states that the conditions required for the earlier mark to be regarded as having been put to genuine use are not satisfied logically falls under the plea alleging that there is no evidence of such genuine use in respect of ophthalmic products. That line of argument, apart from being based on the infringement of the same provision of Regulation No 40/94 as that submitted in the plea in question, seeks, like that plea, to dispute that the earlier mark was actually used in the course of

trade. Consequently, it may be regarded as amplifying that plea and must be held to be admissible (Case 306/81 Verros v Parliament [1983] ECR 1755, paragraph 9, and Case C-66/02 Italy v Commission [2005] ECR I-10901, paragraph 86).

41 However, the error in law vitiating paragraphs 17 to 22 of the judgment under appeal is not such as to invalidate that judgment and, therefore, the arguments put forward by the applicant on this issue must be set aside as inoperative. The Court of First Instance's rejection of the line of argument relating to the conditions required for the earlier mark to be regarded as having been put to genuine use has adequate legal basis in other grounds set out in that judgment (see, to that effect, Case C-496/99 P Commission v CAS Succhi di Frutta [2004] ECR I-3801, paragraph 68, and Case C-447/02 P KWS Saat v OHIM [2004] ECR I-10107, paragraphs 46 to 51).

42 In this connection, it is apparent from paragraphs 23 to 25 of the judgment under appeal, introduced by the phrase 'in any event', which are the subject-matter of the second part of the arguments raised by the applicant under this plea, that the Court of First Instance held that, even if the line of argument relating to the conditions required for the earlier mark to be regarded as having been put to genuine use were to be interpreted as an argument relating to the plea put forward in the application, it should in any case be rejected on another ground to the effect that, since the purpose of the action before the Court of First Instance is to review the legality of the contested decision, in its review it cannot go beyond the factual and legal context of the dispute as it was brought before the Board of Appeal. In paragraph 24 of that judgment the Court of First Instance stated, in its definitive assessment of the facts (which is not to be called into question in this appeal) that, in the proceedings before OHIM, the applicant had expressly stated that it did not dispute the fact that the evidence supplied by the intervener showed genuine use of the earlier mark in respect of a particular product.

43 Contrary to the applicant's submission, the Court of First Instance was fully entitled to reject as inadmissible the disputed arguments on this second ground. The applicant does not have the power to alter before the Court of First Instance the terms of the dispute, as delimited in the respective claims and allegations it and the party opposing the trade mark application have submitted (see, to that effect, Case C-106/03 P Vedial v OHIM [2004] ECR I-9573, paragraph 26, and KWS Saat v OHIM, paragraph 58).

44 First, under Article 63 of Regulation No 40/94, a Board of Appeal's decision may be annulled or altered only on grounds of lack of competence, infringement of an essential procedural requirement, failure to comply with the EC Treaty, with Regulation No 40/94 or with any rule of law relating to their application, or misuse of power. Accordingly, the review of that decision by the Community Courts is confined to a review of the legality of that decision, and is thus not intended to re-examine the facts which were assessed within OHIM, requiring new factual submissions made to that body to be taken into consideration (see, to that effect, Case C-214/05 P Rossi v OHIM [2006] ECR I-7057, paragraph 50, and Case C-29/05 P OHIM v Kaul [2007] ECR I-0000, paragraph 54).

45 Secondly, it follows from Article 135(4) of the Rules of Procedure of the Court of First Instance that the parties to proceedings before that Court may not change the subject-matter of the proceedings before the Board of Appeal.

46 As a result, having independently reached the finding that the applicant had abstained from challenging before OHIM the fact that the earlier mark satisfied the conditions required in order to be regarded as having been put to genuine use, the Court of First Instance was entitled, without erring in law, to find that the disputed arguments at issue, expounded for the first time in the hearing before it, were inadmissible.

47 It follows that the first plea must be rejected as in part inoperative and in part unfounded.

The second plea, concerning infringement of Article 8(1)(b) of Regulation No 40/94

The first part, relating to the definition of the relevant public

– Arguments of the parties

48 By the first part of the second plea, the applicant claims that the Court of First Instance erred in law in paragraph 49 of the judgment under appeal in its interpretation of the term 'public', in so far as it failed to state that end-users do not make a choice when they buy goods issued on a doctor's prescription. That situation implies that, at the time of sale to the end-user, the trade mark affixed to the goods does not carry out the function of guaranteeing the identity of those goods by allowing the user to distinguish those goods from goods from another origin. Consequently, there is no likelihood of confusion for the end-user. That approach has been followed both by the Boards of Appeal and by the Community Courts (Case T-237/01 Alcon v OHIM–Dr. Robert Winzer Pharma (BSS) [2003] ECR II-411, paragraph 42, confirmed on that issue by the Court of Justice in the order in Case C-192/03 P Alcon v OHIM [2004] ECR I-8993, paragraph 30).

49 It follows, in the submission of the applicant, that the Court of First Instance should have restricted the definition of the public solely to healthcare professionals, that is, doctors and pharmacists, and that end-users should not have been taken into account for the purpose of assessing the likelihood of confusion.

50 OHIM contends that the likelihood of confusion is not limited to cases of direct confusion, in which goods bearing a certain trade mark are confused with different goods bearing a competitor's trade mark. Since the essential function of a Community trade mark is to serve to indicate the origin of the goods, it is enough for the relevant public to attribute the same origin to two sets of goods bearing identical or similar marks. Patients might attribute the same origin to the goods in question even if their choice is guided in the purchasing transaction and even if the contact with the two marks at issue occurs at different times during

separate purchasing transactions. The decisions to the contrary adopted by the Boards of Appeal are not binding on the Community Courts. As for the judgments cited by the applicant, they concern other provisions of Regulation No 40/94, namely Article 7(1)(d) and Article 50(1)(a).

– **Findings of the Court**

51 Under Article 8(1)(b) of Regulation No 40/94, the existence of a likelihood of confusion resulting from the similarity, on one hand, between the trade mark in the application for registration and an earlier trade mark and, on the other hand, between the goods or services covered by the trade marks, must be assessed on the part of the public in the territory in which the earlier trade mark is protected.

52 In the present case, after having stated in paragraph 48 of the judgment under appeal that since the earlier mark was registered in Italy, that Member State therefore constituted the relevant territory for the purposes of applying that provision of Article 8, the Court of First Instance found, in paragraph 49 of that judgment, that, since it is common ground that the products in question are medicinal products requiring a doctor's prescription prior to their sale to end-users in pharmacies, the relevant public is composed not only of end-users, but also of professionals, that is, doctors who prescribe the medicinal product and pharmacists who sell that prescribed product.

53 According to case-law, the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, **Case C-299/99 Philips [2002] ECR I-5475**, paragraph 30, and Case C-37/03 P BioID v OHIM [2005] ECR I-7975, paragraph 27).

54 For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, to that effect, **Case C-39/97 Canon [1998] ECR I-5507**, paragraph 28).

55 Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, to that effect, Canon, paragraph 29, and **Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819**, paragraph 17).

56 In the present case, having regard to that case-law, the Court of First Instance was fully entitled to hold, which indeed is not disputed by any party in these appeal proceedings, that the healthcare professional at issue must be included in the relevant public for the purposes of the application of Article 8(1)(b) of Regulation No 40/94, the function of the trade mark as an indication of origin being also relevant to intermediaries who deal with the goods commercially in so far as it will tend to influence their conduct in the market (see, to that effect, **Case C-371/02 Björnekulla Fruktindustrier [2004] ECR I-5791**, paragraphs 23 and 25).

57 However, contrary to what the applicant claims, the fact that intermediaries such as healthcare professionals are liable to influence or even to determine the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue.

58 In so far as it found in paragraph 49 of the judgment under appeal, in its definitive assessment of the facts, that the products at issue are sold in pharmacies to the end-users, the Court of First Instance was fully entitled to infer therefrom that, even though the choice of those products is influenced or determined by intermediaries, such a likelihood of confusion also exists for those consumers since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products, at various times.

59 It is settled case-law that the perception of the marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (Lloyd Schuhfabrik Meyer, paragraph 25, and Case C-361/04 P Ruiz-Picassoand Others v OHIM [2006] ECR I-643, paragraph 38).

60 In addition, the Court of Justice has already held that the average consumer only rarely has the chance to make a direct comparison between the different signs but must place his trust in the imperfect picture of them that he has kept in his mind (Lloyd Schuhfabrik Meyer, paragraph 26, and judgment of 23 September 2004 in Case C-107/03 P Procter & Gamble v OHIM, not published in the ECR, paragraph 44).

61 Furthermore, since it is undisputed that the whole process of marketing the goods at issue is aimed at the end-user's acquisition of them, the Court of First Instance was entitled to hold that the role played by intermediaries, even if they are healthcare professionals whose prior intervention is required in order to sell those goods to end-users, must be in part balanced against the high degree of attentiveness which may be shown by those users, in the light of the fact that the goods at issue are pharmaceutical products, when they are prescribed and, consequently, against those users' ability to make those professionals take into account their perception of the trade marks at issue and, in particular, their requirements or preferences.

62 In this connection, it should be recalled that the Court has already ruled that where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (**Joined Cases C-473/01 P and C-474/01 P Procter & Gamble v OHIM [2004] ECR I-5173**, paragraph 33, and **Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317**, paragraph 24).

63 It follows that the Court of First Instance did not err in law by including end-users in the relevant public for the purposes of applying Article 8(1)(b) of Regulation No 40/94.

64 That conclusion cannot be called into question by arguments which the applicant has derived from certain decisions of the Boards of Appeal or the Community Courts.

65 The decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal of OHIM are led to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of the Boards of Appeal must be assessed solely on the basis of that regulation as interpreted by the Community judicature and not on the basis of a previous decision-making practice (BioID v OHIM, paragraph 47, and **Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551**, paragraph 48).

66 As regards the case which gave rise to the judgment of the Court of First Instance in Alcon v OHIM–Dr. Robert Winzer Pharma (BSS), cited by the applicant in support of its arguments, that case concerned a trade mark application which related not to goods sold to end-users in pharmacies, but to 'ophthalmic pharmaceutical preparations; sterile solutions for ophthalmic surgery' in respect of which the Court of First Instance was entitled to hold without erring in law that the customary nature of the trade mark at issue should be assessed from the point of view of the medical specialists for whom it was intended, namely ophthalmologists and ophthalmic surgeons practising in the European Union.

67 Therefore, the first part of the second plea must be rejected as unfounded.

The second part, relating to the similarity of the goods

– Arguments of the parties

68 The applicant claims that the Court of First Instance erred in law by not requiring Biofarma to adduce evidence of the alleged similarity between the goods at issue. It submits that the Court of First Instance also failed to take into account or at least failed to give enough consideration to the relevant aspects of those goods, in particular the nature and form of the goods and the role of the healthcare professionals who prescribe and issue those goods.

69 OHIM makes the observation that the concept of similarity of goods is a legal issue which must be examined automatically by its own authorities. As regards the need to have regard to the form of the goods, OHIM considers that that information is irrelevant unless the designation of the goods in the trade mark application specifies that form of use, which is not true in this case. The form, it submits, is merely an aspect of marketing which is extraneous to the trade mark sought and which may change over time. The same finding applies to the fact that the goods are sold on prescription, since this fact also is an aspect which is extraneous to the goods on the list to which the Community trade mark application at issue refers.

– Findings of the Court

70 The Court rejects from the outset as inadmissible the argument by which the applicant, referring to the level of evidence which should have been required from Biofarma, effectively seeks to call into question the purely factual assessment made by the Court of First Instance in paragraphs 57 to 60 of the judgment under appeal, which led that Court to rule in paragraph 61 of that judgment that the Board of Appeal did not err in finding that there was a high degree of similarity between the goods in question.

71 The applicant cannot require the Court to substitute its own assessment for that of the Court of First Instance in that regard. It is settled case-law that the effect of Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice is that an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts and evidence are distorted, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (see Case C-206/04 P Mülhens v OHIM [2006] ECR I-2717, paragraph 41, and Rossi v OHIM, paragraph 26).

72 As regards the argument according to which the Court of First Instance failed to take into account criteria which were relevant in assessing whether the goods at issue are similar, case-law shows that in the assessment of that similarity all the relevant factors characterising the relationship between those goods should be taken into account. Those factors include, in particular, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary (see, to that effect, Canon, paragraph 23).

73 In the present case it must be held that, pursuant to that case-law, the Court of First Instance, in order to conclude in paragraph 61 of the judgment under appeal that the Board of Appeal did not err in finding that there was a high degree of similarity between the products in question, correctly examined, in paragraph 57 of the judgment under appeal, the nature of those products, their purpose, their end-users, the way in which they are sold and whether they are in competition with each other or are complementary. The applicant is therefore incorrect in criticising the Court of First Instance for failing to take into account relevant criteria in the assessment of the similarity of the products.

74 Furthermore, in so far as the applicant alleges the Court of First Instance failed correctly to take into account the criterion relating to the form of the products at issue, it should be stated that the Court of First Instance, in paragraph 58 of the judgment under appeal, did examine the application of that criterion for the purposes of assessing the similarity of the goods. It considered however, that the difference in the way in which the medicinal products at issue are administered is of less significance, in the present case, than the fact

that the two products have a common nature and the same end-users.

75 By criticising the Court of First Instance for failing correctly to take into account the form of the products at issue, the applicant is thereby effectively attempting to have the Court of Justice substitute its own assessment of the facts for that of the Court of First Instance in that latter regard. Accordingly, since the applicant has not alleged any distortion of the facts or evidence submitted to the Court of First Instance, the argument raised to that effect must, in accordance with the case-law cited in paragraph 71 of this judgment, be rejected as inadmissible.

76 Lastly, in so far as the applicant alleges that the Court of First Instance failed to take into account the fact that the goods at issue are issued by healthcare professionals solely on prescription, that argument must be rejected as unfounded on the same grounds as those set out in paragraphs 51 to 63 of this judgment, since it effectively challenges the definition of the relevant public accepted in the judgment under appeal.

77 Consequently, the second part of this plea must be rejected as in part inadmissible and in part unfounded.

The third part, relating to the similarity of the signs

– Arguments of the parties

78 The applicant alleges that the Court of First Instance erred in law by comparing the signs at issue without correctly identifying the relevant public in respect of which the likelihood of confusion should be examined.

79 Concerning visual similarity, the applicant claims that the Court of First Instance erred in holding that the general impression created by the visual similarities proved that the marks at issue were similar. In the context of an overall assessment, even though there are similarities, there are not enough of them to conclude that those marks are visually similar. The visual comparison should be carried out through the eyes of a member of the relevant public.

80 Concerning phonetic similarity, the applicant claims that the Court of First Instance incorrectly held that the marks at issue were similar from that standpoint. In fact, the dominant prefixes of each mark are clearly distinguishable and are pronounced quite differently. In addition, it submits that the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks is irrelevant in the present case, since the goods at issue are prescribed by specialist doctors. In any event, the effect of any similarities should not be overstated, particularly if the difference in the form of the two products and the specific healthcare context in which each of them is sold is taken into account.

81 OHIM contends that those various arguments are inadmissible since the applicant restricts itself to criticising the findings of fact made by the Court of First Instance.

– Findings of the Court

82 The argument according to which the Court of First Instance erred in law by comparing the signs at issue without correctly identifying the relevant public must be rejected from the outset as unfounded on the same grounds as those set out in paragraphs 51 to 63 of this judgment, since that argument effectively challenges the definition of the relevant public accepted in the judgment under appeal.

83 In so far as the applicant submits that the signs at issue are not likely to be confused on the visual and phonetic levels, in particular having regard to the form of the goods at issue and the specific healthcare context in which those goods are sold, it should be observed that the Court of First Instance, in paragraphs 64 to 70 of the judgment under appeal, carried out a purely factual appraisal in this connection to conclude, in paragraphs 75 and 76 of that judgment, that the signs at issue were visually and phonetically similar.

84 As a result, pursuant to the case-law cited in paragraph 71 of this judgment, since there is no allegation that the Court of First Instance distorted the facts or evidence submitted to it, the third part of the second plea must, in that regard, be rejected as inadmissible.

85 Furthermore, the arguments used by the applicant to criticise the Court of First Instance for failing to take into account, in its assessment of whether the signs at issue are visually or phonetically similar, the fact that the relevant public includes healthcare professionals in addition to end-users, are indissociable from the fourth part of this plea. They will therefore be considered within that context.

The fourth part, relating to the likelihood of confusion

– Arguments of the parties

86 The applicant submits that, although Court of First Instance observed that the relevant public includes, in addition to end-users, pharmacists and doctors, it did not actually take that into account and it assessed whether there was a likelihood of confusion only on the basis of what is perceived by the average consumer. As it is, in its decision the Opposition Division had considered that the likelihood of confusion between the goods at issue by doctors and pharmacists was weak.

87 OHIM contends that the arguments submitted in that regard are inadmissible in so far as they are not legal arguments in which the applicant is claiming that the Court of First Instance misinterpreted Article 8(1)(b) Regulation No 40/94 or distorted the facts.

– Findings of the Court

88 By this part of the second plea, the applicant is seeking to establish that the Court of First Instance erred in law in so far as it failed to examine the likelihood of confusion of the signs at issue, within the meaning of Article 8(1)(b) of Regulation No 40/94, in the eyes of the relevant public as accepted in the judgment under appeal.

89 Contrary to what is submitted by OHIM, by thereby casting doubt on the reasoning followed by the Court of First Instance in its application of that provision the applicant is thus raising a legal issue concerning the Court of First Instance's application of

Community law. Accordingly, this part of the second plea is admissible.

90 As regards the merits of that part, it should be recalled that in paragraph 48 of the judgment under appeal the Court of First Instance found that Italy constitutes the relevant territory in the present case. Furthermore, it follows from paragraphs 51 to 63 of this judgment that the Court of First Instance was entitled to hold, in paragraph 49 of the judgment under appeal, that the relevant public is composed not only of end-users, but also of certain healthcare professionals. Therefore, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, the existence of a likelihood of confusion between the goods at issue must be assessed, as the Court of First Instance held in paragraph 50 of the judgment under appeal, in relation to the perception of them in the eyes of the relevant public, as thus defined.

91 Consequently, the Court of First Instance was entitled, in paragraphs 62 to 76 of the judgment under appeal, to assess whether there was a likelihood of confusion in the eyes of end-users.

92 By contrast, it is not apparent to the requisite legal standard from the judgment under appeal whether the Court of First Instance systematically assessed whether there was such a likelihood of confusion in the eyes of the healthcare professionals at issue.

93 In paragraph 65 of the judgment under appeal, the Court of First Instance made a general assessment of the visual similarity between the signs at issue, without making clear the extent to which that assessment applied to end consumers and to healthcare professionals, if necessary by distinguishing or qualifying the analysis according to the part of the relevant public concerned.

94 Similarly, as regards the phonetic similarity between the signs at issue, whereas the Court of First Instance based its assessment in this respect, in paragraph 69 of the judgment under appeal, on the perception of them by 'Italian consumers', it did not state in that paragraph to what extent that assessment applies to both end-users and healthcare professionals. Admittedly, in paragraph 57 of that judgment, concerning the assessment of the similarity of the goods at issue, the Court of First Instance expressly refers to both end-users and healthcare professionals by the term 'consumers'. However, that term, used in another part of the same judgment merely to define the relevant nationality, is, in the absence of any other indication, more likely to refer to the former group than the latter, a fortiori since it is apparent from the file before the Court of Justice that the contested decision under judicial review in the judgment under appeal included solely end-users in the relevant public.

95 The issue of the perception of the signs at issue in the eyes of healthcare professionals was at the centre of the arguments on the scope of Article 8(1)(b) of Regulation No 40/94, developed by the applicant before the Court of First Instance, as it is before the Court of Justice at the appeal stage.

96 In those circumstances, this Court finds that the judgment under appeal is vitiated by a flaw in the reasoning on those issues, the Court not having sufficient information to be able to exercise its power of review in that regard.

97 Pursuant to case-law, the issue whether the grounds of a judgment of the Court of First Instance are contradictory or inadequate is a question of law which is amenable, as such, to judicial review on appeal (Case C-401/96 P Somaco v Commission [1998] ECR I-2587, paragraph 53, and Case C-446/00 P Cubero Vermurie v Commission [2001] ECR I-10315, paragraph 20).

98 Therefore, it must be stated that the Court of First Instance has, in paragraphs 65 and 69 of the judgment under appeal, given inadequate reasons for its assessment concerning whether the signs at issue are visually or phonetically similar in the eyes of the relevant public, which also includes certain healthcare professionals.

99 However, that failure to give adequate reasons is not such as to invalidate the judgment under appeal. Since, in the context of its definitive assessment of the facts in paragraphs 56 to 57 of the judgment under appeal, the Court of First Instance concluded that there was significant similarity between the goods concerned as well as visual and phonetic similarity of the signs at issue in the eyes of that part of the relevant public which consisted of end-users, it was entitled, without infringing the scope of Article 8(1)(b) of Regulation No 40/94, to deduce, in paragraphs 76 and 80 of that judgment, that there was a likelihood of confusion between those signs within the meaning of that provision.

100 In the light of those considerations, in spite of the failure to give adequate reasons which vitiates paragraphs 65 and 69 of the judgment under appeal, there is no cause for annulment of that judgment since, in any event, the grounds given are sufficient to provide a basis for the operative part, namely the Court of First Instance's dismissal of the appeal directed against the contested decision (see, to that effect, Commission v CAS Succhi di Frutta, paragraph 68, and KWS Saat v OHIM, paragraphs 46 to 51).

101 Consequently, the fourth part of the second plea must be rejected as inoperative.

The fifth part, concerning the limited nature of the Community trade mark application

– Arguments of the parties

102 According to the applicant, the Court of First Instance erred by considering that the Board of Appeal of OHIM could not be criticised for failing to hold that the applicant's statement in its pleading before that Board, in which it confirmed that it was willing to limit the specification of goods in the application to ophthalmic pharmaceuticals for the treatment of glaucoma, constituted an express proposal for amendment in the event of the Board being minded to uphold the opposition. In the absence of oral proceedings, the applicant had no opportunity to ascertain that board's likely view before the decision was adopted. The proposed amendment of the list of goods would have enabled the difference be-

tween the applicant's goods and those of Biofarma to be clarified further.

103 OHIM takes the view that the assessments made by the Board of Appeal cannot be challenged at this stage of the proceedings. In addition, it contends, the applicant is not putting forward any reason based on law or on distortion of the facts which would enable the conclusion of the Court of First Instance in paragraph 53 of the judgment under appeal, that the detailed rules for restricting the specification of goods had not been satisfied, to be overturned. The issue whether the restriction suggested by the applicant complied with Article 44 of Regulation No 40/94 and Rule 13 of Regulation No 2868/95 is a matter of fact which does not fall within the jurisdiction of the Court of Justice. OHIM maintains that the second plea is therefore inadmissible in that respect.

– Findings of the Court

104 So far as the admissibility of this part of the second plea is concerned, it should be noted that, by this part, the applicant is not claiming, in contrast to what OHIM submits, that the statement in its pleading before the Board of Appeal complied with the detailed rules laid down in Regulations No 40/94 and No 2868/95, but it criticises the Court of First Instance for failing to take that statement into account in spite of the fact that it did not comply with those detailed rules.

105 In doing so, the applicant is alleging that the Court of First Instance misinterpreted Community law and is therefore raising a point of law. Accordingly, this part of the second plea is admissible.

106 As regards the merits of this part, it should be recalled that, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, the assessment of the likelihood of confusion between the goods must concern all of the goods designated in the application for registration of a Community trade mark.

107 Under Article 44(1) of that regulation, the applicant may at any time restrict the list of goods or services contained in the application. A request to amend an application submitted under that provision must comply with the detailed rules established by Rule 13 of Regulation No 2868/95.

108 By this part of the second plea, the applicant is not disputing that it failed to lodge such a request. It maintains however that, in the absence of any oral proceedings before the Board of Appeal, an express proposal for restriction of the specification of goods, such as that set out in this instance in its pleading before that board, should have been taken into account where the Board intended to uphold the opposition.

109 However, no such obligation is laid down either in Regulation No 40/94 or in Regulation No 2868/95. As paragraph 107 of this judgment shows, any request for restriction of the specification of goods must be submitted, pursuant to those regulations, in the form of a request for amendment which complies with certain detailed rules. As the Court of First Instance rightly held in paragraph 51 of the judgment under appeal, such a request must be made expressly and unconditionally.

110 Consequently, since it is undisputed in this case that the proposal set out by the applicant in its pleading before the Board of Appeal did not comply with those requirements, the Court of First Instance was entitled to hold, in paragraphs 53 and 54 of the judgment under appeal, that the Board of Appeal cannot be criticised for failing to take that proposal into account.

111 As a result, the fifth part of the second plea must be rejected as unfounded.

112 Since the applicant has been unsuccessful in all of its pleas, the appeal must be dismissed.

Costs

113 Under Article 69(2) of the Rules of Procedure, which applies on an appeal by virtue of Article 118 of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has applied for costs and the applicant has been unsuccessful, it must be ordered to pay OHIM's costs. Since Biofarma has not applied for costs, it must be ordered to bear its own costs.

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

1. Dismisses the appeal;
2. Orders Alcon Inc. to pay, in addition to its own costs, the costs of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM);
3. Orders Biofarma SA to bear its own costs.

OPINION OF ADVOCATE GENERAL KOKOTT

delivered on 26 October 2006 1(1)
Case C-412/05 P
Alcon Inc.
v
Office for Harmonisation in the Internal Market,
other party to the proceedings:
Biofarma SA
(Appeal – Community trade mark – Word mark 'TRAVATAN' – Opposition of the proprietor of the mark 'TRIVASTAN' – Refusal of registration – New plea – Medicinal products)

I – Introduction

1. The present case concerns the question whether two trade marks in respect of medicinal products, the word mark TRAVATAN and the earlier Italian word mark TRIVASTAN, may be confused, which would mean that registration of TRAVATAN as a Community mark is not permissible. Such a likelihood of confusion has been found to exist at every instance to date, that is to say by the Opposition Division and the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM' or 'the Office') and by the Court of First Instance.

2. In the appeal, it must be examined, first, whether the Court of First Instance was right in dismissing submissions by the appellant because they were made too late and, second, whether it examined the likelihood of confusion correctly, in particular as regards the relevant public.

II – Legal context

3. Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (2) governs the relative ground for refusal constituted by a likelihood of confusion:

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

(a) …

(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. The seventh recital in the preamble explains the concept of 'likelihood of confusion' in the case of similarity between marks and between goods or services. The likelihood of confusion, 'the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for … protection'.

5. An earlier mark can prevent registration of a new mark, however, only if it is still being put to genuine use. Article 43(2) and (3) of Regulation No 40/94 therefore provides:

'2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

III – Background to the dispute and the judgment of the Court of First Instance

6. The Court of First Instance set out the background to the dispute as follows in paragraphs 1 to 11 of the contested judgment of 22 September 2005 in Case T-130/03: (3)

'1 On 11 June 1998, Alcon Inc. filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark in respect of which registration was sought is the word mark TRAVATAN.

3 The goods in respect of which registration of the trade mark was sought are in Class 5 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: "Ophthalmic pharmaceutical preparations".

4 The application was published in Community Trade Marks Bulletin No 23/99 of 22 March 1999.

5 On 22 June 1999, Biofarma SA filed an opposition under Article 42 of Regulation No 40/94 against the registration of that Community trade mark. The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of Regulation No 40/94. The opposition was based on the existence of the national word mark TRIVASTAN, registered in Italy on 27 January 1986 under No 394980.

6 The opposition was filed against all goods covered by the trade mark application. It was based on all the goods covered by the earlier mark, namely "Pharmaceutical, veterinary and hygiene products; dietary products for infants or patients; plasters; materials for dressings; tooth fillings and dental impressions; disinfectants; herbicides and pesticides", in Class 5.

7 By letter of 5 May 2000, the applicant requested that the intervener furnish proof, in accordance with Article 43(2) and (3) of Regulation No 40/94, that the earlier mark had, during the period of five years preceding the date of publication of the Community trade mark application, been put to genuine use in the Member State in which it is protected in connection with all the goods on which the opposition is based. By letter of 29 May 2000, the Opposition Division requested the intervener to furnish such proof within two months.

8 On 28 July 2000, the intervener sent documents to OHIM intended to demonstrate genuine use of the earlier mark in Italy. In particular, among these documents were invoices, the explanatory notice relating to the intervener's medicinal product, an extract from the Italian directory L'Informatore Farmaceutico and an extract from the Pharmaceutical Trade Mark Directory.

9 By decision of 26 September 2001, the Opposition Division found that the use of the earlier mark was proven in respect of a specific pharmaceutical product, namely a "peripheral vasodilator intended to treat peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear", and it allowed the opposition for all the goods claimed. It therefore refused registration of the mark applied for on the ground that there was a risk of confusion, including the risk of association, in Italy, given the fact that the marks were similar both visually and phonetically and that there was a degree of similarity between the goods.

10 On 13 November 2001, the applicant filed an appeal with OHIM against the decision of the Opposition

Division pursuant to Articles 57 to 62 of Regulation No 40/94.

11 By decision of 30 January 2003 ("the contested decision"), the Third Board of Appeal dismissed the appeal. It essentially held that, since the goods designated by the marks at issue displayed a high degree of similarity and there were considerable visual and phonetic similarities between the marks, there was a likelihood of confusion, including a likelihood of association, between the goods in question.'

7. The Court of First Instance dismissed the action brought by Alcon against the decision of the Board of Appeal.

8. It held that the plea that the conditions concerning genuine use in accordance with the judgment in MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)(4) were not satisfied was inadmissible because it had been put forward too late and, moreover, had not been advanced before the Board of Appeal (paragraph 19 et seq.).

9. Nor did Alcon refute the finding of the Board of Appeal that the evidence provided by the intervener demonstrated genuine use of the earlier mark in respect of a 'peripheral vasodilator intended to treat peripheral and cerebral vascular disturbance and vascular disorders of the eye and ear' (paragraph 29 et seq.).

10. Finally, according to the Court of First Instance, the Board of Appeal was also right in finding that there was a likelihood of confusion between the two marks. Both the respective goods (paragraph 55 et seq.) and the signs to be compared (paragraph 65 et seq.) were very similar. Italian consumers in particular could confuse the two signs (paragraph 72 et seq.).

IV – The appeal

11. Alcon challenges the dismissal by the Court of First Instance of its plea concerning the conditions for genuine use as inadmissible, and takes the view that the Court erred in its assessment of the likelihood of confusion, in particular by failing to have sufficient regard to the role of healthcare professionals.

12. Alcon accordingly claims that the Court should:

(1) set aside the decision challenged;

(2) if necessary, remit the case back to the Court of First Instance; and

(3) order OHIM and/or the intervener to pay the costs.

13. OHIM considers the appeal essentially to be unfounded, but in several respects also to be inadmissible, and therefore contends that the Court should:

(1) dismiss the appeal as partly inadmissible and partly unfounded; and

(2) order the appellant to pay the costs.

14. Biofarma did not take part in the proceedings until the oral procedure and endorses the form of order sought by OHIM.

V – Appraisal

A – First ground of appeal – admissibility of the plea concerning genuine use of the earlier mark

15. The Court of First Instance observed in paragraph 20 of the contested judgment 'that, in its application, the applicant did not complain that the Board of Appeal had infringed Article 43(2) and (3) of Regulation No 40/94 in so far as the conditions concerning genuine use of the earlier mark were not satisfied, but only in so far as the evidence of genuine use submitted by the intervener did not show that the earlier mark had actually been used in respect of ophthalmic products'. It concluded from this that Alcon's plea at the hearing in respect of the conditions concerning genuine use was a new plea in law and therefore inadmissible.

16. Alcon states in objection that its plea as to the conditions concerning genuine use is only a new argument to substantiate the actual plea in law, namely infringement of Article 43(2) and (3) of Regulation No 40/94.

17. Under Article 48(2) of the Rules of Procedure of the Court of First Instance, no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. A plea which may be regarded as amplifying a plea made previously, whether directly or by implication, in the original application must, however, be considered admissible. (5)

18. The application of this procedural provision can be illustrated by cases from areas of law other than trade mark law. Thus, in a case where the original complaint was that several requirements of Article 87(1) EC had been infringed, the Court of Justice held that a new plea that the measure in question benefited not only undertakings for the purposes of Article 87(1) EC but also other persons was a permissible amplification. (6) It likewise regarded the complaint that the Commission had failed to investigate the effect on trade adequately as an amplification of the plea that there was no effect on trade at all. (7) A complaint alleging a procedural error, namely a failure to give a hearing, has been found to be a permissible amplification, after it was initially argued only that compliance with the substantive conditions for the adoption of the safeguard measure at issue had not been sufficiently clarified. (8) Finally, the Court has also found a newly raised argument that in a selection procedure under the Staff Regulations an age-limit should have been made publicly known to be an amplification of the plea that there was no legal basis for applying the age-limit. (9)

19. The situation is similar in the present case. In its application Alcon had challenged the findings on genuine use in accordance with Article 42(2) and (3) of Regulation No 40/94. It submitted that Biofarma had not proved any use that would have been capable of giving the mark a sufficient reputation with the relevant Italian public. Nor had use of the medicinal product for ophthalmic purposes been proved. According to what is stated by the Court of First Instance in paragraph 17 of the contested judgment, at the hearing Alcon then 'referred to the judgment in Case T-334/01 MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON) [2001] ECR II-2787 in order to claim that the conditions concerning genuine use were not satisfied, in particular because of the low volume of sales of the earlier mark'.

20. This plea clearly amplifies the reasoning in support of the plea that Article 43(2) and (3) of Regulation No 40/94 had been infringed. It is therefore not an inadmissible new plea, but a permissible amplification of a plea put forward at the appropriate time. The finding that it was made too late in the judicial proceedings is therefore wrong in law.

21. However, in paragraph 23 of the contested judgment the Court of First Instance dismissed this plea additionally on the basis of a second reason, stating that its review could not go beyond the factual and legal context of the dispute as brought before the Board of Appeal. The Court further correctly found that according to the case-file Alcon did not in fact call into question before the Board of Appeal or the Opposition Division the fact that the earlier mark had been put to genuine use, and indeed expressly waived any challenge to the evidence of its genuine use. (10) The arguments contested only that the mark had been used for a comparable product. (11) The Court therefore came to the conclusion that the arguments contesting genuine use of the earlier mark were also inadmissible because the proceedings before the Board of Appeal had not concerned them.

22. This alternative basis for dismissing the arguments contesting genuine use corresponds to Article 135(4) of the Rules of Procedure of the Court of First Instance. Under this provision, the parties before the Court may not change the subject-matter of the proceedings before the Board of Appeal. Since Alcon waived its right to dispute the relevant evidence, the subject-matter of the proceedings before the Board of Appeal did not include whether there was genuine use. Therefore, the Court of First Instance rightly dismissed this plea as inadmissible.

23. It is true that Alcon puts forward the view that to restrict in this way the subject-matter of proceedings before the Court of First Instance to the subject-matter of the proceedings before the Board of Appeal would preserve decisions which, in the light of subsequent case-law, are clearly contrary to the law. However, this view is misconceived. If a party contests throughout a certain aspect of the Office's application of the law, he can of course successfully challenge that application if the Court of First Instance has in the meantime decided this legal question in a manner favourable to him. However, if a party – like Alcon in the present case – chooses not to raise arguments on a particular issue, even subsequent case-law will not enable him to put forward for the first time before the Court of First Instance a plea to that effect.

24. The first ground of appeal should therefore be dismissed.

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

25. By the second ground of appeal, Alcon puts forward arguments, divided into six limbs, challenging the application of Article 8(1)(b) of Regulation No 40/94.

1. The sixth limb – restriction of the list of goods

26. In the sixth limb, which is to be dealt with first, Alcon objects to the products compared by the Board of Appeal and the Court of First Instance. It submits that before the Board of Appeal it deliberately confined the specification of its product to 'ophthalmic pharmaceuticals for the treatment of glaucoma', thus diminishing further any similarity between the goods .

27. In paragraphs 51 to 55 of the contested judgment, the Court of First Instance stated that this restriction had not been made in accordance with the requirements of Article 44 of Regulation No 40/94 and Rule 13 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94. (12) Also, a restriction of goods contained in an application for a Community trade mark had to be made expressly and unconditionally. The Court found that Alcon had not submitted a request that the specification of the products be restricted, but merely expressed its willingness to restrict it. Therefore, in accordance with the trade mark application, regard had to be had to all ophthalmic pharmaceutical products.

28. It must be stated that in principle Alcon was entitled to restrict the specification of the product before the Board of Appeal since Article 44(1) of Regulation No 40/94 allows the list of goods or services contained in the trade mark application to be restricted at any time. It is only in judicial proceedings that Article 135(4) of the Rules of Procedure precludes a restriction since it would change the subject-matter of the proceedings. (13)

29. However, the Court of First Instance rightly requires in settled case-law that a restriction of goods contained in an application for a trade mark be made expressly and unconditionally. (14) The restriction may be of considerable significance for the scope of protection under the trade mark and – as is clear in the present case – for the mark's registrability.

30. Since Alcon did not declare a restriction, but merely stated that it was willing so to do, the Court of First Instance was able, without distorting Alcon's statement, to come to the conclusion that the goods contained in the application had not been restricted.

31. Nor can the Board of Appeal be regarded as having made a procedural error by not calling on Alcon to clarify its statement. Such a clarification would, it is true, probably have been useful from the point of view of procedural economy, but there is no provision that would oblige the Board of Appeal to bring about such clarification. Rather, Rule 13(3) of Regulation No 2868/95 relates to some other (formal) deficiencies of which the Office must notify the applicant, specifying a period for their remedy, if the requirements governing amendment of the application are not fulfilled. This obligation arises, however, only once the applicant has made a request for amendment.

32. In the present case, there is no reason to burden OHIM with further notification obligations that are not expressly laid down. Like most parties to proceedings before OHIM, Alcon is a large undertaking operating internationally which must have sufficient expertise to participate on its own responsibility in trade mark pro-

ceedings or – as here – to instruct qualified representatives. Alcon should therefore have realised itself that a statement of willingness to restrict the goods contained in the application is not equivalent to their restriction.

33. The Court of First Instance therefore did not err in law when, like the Board of Appeal, it used for the comparison of the products the goods contained in the application for a trade mark, namely ophthalmic pharmaceutical preparations. This limb is therefore unfounded.

2. The second limb – comparison of the products

34. It likewise follows from the findings on the sixth limb that the second limb too – in so far as it is not inadmissible from the outset – is in any event unfounded.

35. In this limb, Alcon complains that the Court of First Instance failed to require Biofarma to produce evidence of the similarity of both products. It submits that Travatan is administered in the form of eye drops, while Trivastan is a tablet. For that reason alone the products are not similar.

36. This limb is inadmissible in so far as it ostensibly concerns the actual comparison of the products. It is clear from Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice that an appeal lies on points of law only. The Court of First Instance 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 they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal. (15) Distortion of evidence is not apparent here, nor is it pleaded by Alcon.

37. However, in this limb Alcon also objects to the determination of the products compared. The question whether the comparison must be limited to two specific medicinal products in the respective forms in which they are administered is a point of law to be examined on appeal.

38. Alcon is wrong though in its submission that it is in eye-drop form that the medicinal product Travatan is to be considered. As already explained, for the trade mark applied for here the group of goods constituted by ophthalmic pharmaceutical preparations must be used as the basis for comparison. This group encompasses medicinal products which are sold for administration in various forms, hence also products which, like the product to be compared, are offered in tablet form.

39. This limb too should therefore be dismissed.

3. The first limb – the relevant public

40. In the first limb, Alcon submits that OHIM defined the relevant public incorrectly.

41. In paragraph 49 of the contested judgment the Court of First Instance found:

‘It is common ground that the products in question are medicinal products requiring a doctor’s prescription prior to their sale to end users in pharmacies. Consequently, the relevant public is composed not only of end users, but also of professionals, that is doctors who prescribe the medicinal product and pharmacists who sell that prescribed product.’ (16)

42. In its statements on the likelihood of confusion in paragraphs 68, 69 and 72 et seq., the Court confirms the analysis of the Board of Appeal on the basis of the perception of consumers. Only in paragraph 73 are professionals mentioned as a possible component of the relevant public, but the findings are again based on the perception of consumers.

43. Alcon contests the inclusion of end users in the relevant public. Since the products require a prescription, solely the doctor makes the decision as to their acquisition. Therefore only the perception of healthcare professionals is relevant. Another OHIM Board of Appeal, (17) the Court of First Instance (18) and the Court of Justice (19) have already so decided.

44. The Office and Biofarma, on the other hand, take the view that the perception of patients matters too. The Office stresses that when patients are confronted by a mark, they are not to be misled as to the origin of the goods designated. Their perception is irrelevant only if their being confronted with the mark can be ruled out. (20) Biofarma supplements this with the practical example of confusing two medicinal products in the medicine cabinet at home.

45. This limb relates, first, to a factual element, namely the determination as to the public addressed by the goods in question, and is inadmissible to that extent. (21)

46. Second, at the same time it contests the interpretation of Article 8(1)(b) of Regulation No 40/94 with regard to the definition of the relevant public. In addition, it implies that the reasoning for the findings of the Court of First Instance is insufficient, since reasons are not stated for the inclusion of end users despite submissions to the contrary. Both aspects concern points of law, and the limb is therefore admissible to this extent.

47. The Court of Justice focuses on the perception of the mark in the mind of the average consumer of the type of goods or services in question. (22) In general, the perception of consumers or end users will play a decisive role as the aim of the whole commercialisation process is the purchase of the product by those persons. (23) However, this is true only where the end user makes the decision on the purchase.

48. In the case of medicinal products available only on prescription, the choice between various products is made not upon acquisition but earlier, during the medical consultation. Medicinal products available only on prescription are, because of the risks attaching to them, subject to special control by doctors, and also by pharmacists. This justifies even restrictions on intra-Community trade (24) and finds expression in the relevant secondary legislation. Under the first indent of Article 88(1) of Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 on the Community code relating to medicinal products for human use, (25) Member States are to prohibit the advertising to the general public of medicinal products which are available on prescription only. In principle, therefore, the acquisition of medicinal products available only on prescription is to be decided upon by health professionals and not end consumers.

49. Even if regard is nevertheless in principle had to patients too, because – as submitted in particular by the Office at the hearing – they can influence a doctor's prescription, in the case of medicinal products available only on prescription their influence has very little significance when compared with the doctor's responsibility for the decision. (26)

50. In particular, the possible influence exerted by patients cannot mean that the patient is regarded as the reasonably well informed and reasonably observant and circumspect consumer of those products. The average consumer must rather be determined by reference to the group that largely determines decisions on the acquisition of medicinal products available only on prescription, that is to say by reference to prescribing doctors.

51. The risk, pointed out by OHIM and Biofarma, of confusion on the part of a patient who, independently of prescription, is confronted with the mark, is also of little significance, under trade mark law at any rate. In the Picasso judgment, the Court of Justice regarded the moment when the choice between the goods and marks is made as crucial for assessing the likelihood of confusion. (27) Other points in time, at which confusion on the part of consumers might be more likely because they display a lesser level of attention, are by contrast of secondary importance. (28)

52. Therefore, Alcon is correct in its argument that the relevant public for medicinal products available only on prescription is to be determined by reference to healthcare professionals, and not patients. Despite this submission, the Court of First Instance does not deal with the legal question of how the public under Article 8(1)(b) of Regulation No 40/94 is to be defined, nor does it explain why, contrary to Alcon's submission, it includes end users in the relevant public.

53. Consequently, at the very least the reasoning in the contested judgment is insufficient, both so far as the interpretation of Article 8(1)(b) of Regulation No 40/94 is concerned and with regard to the specific inclusion of end users. If the Court of First Instance were in fact to be proceeding on the basis that, irrespective of the product at issue, it is always the average end user that matters, that would involve, in addition to the defective reasoning, an incorrect interpretation of Article 8(1)(b) of Regulation No 40/94.

54. In the present case, however, inclusion of the end user can be upheld at least on other grounds. Here it is not two medicinal products available only on prescription that are to be compared but, on the one hand, the group of goods – ophthalmic pharmaceutical preparations – specified in the application and, on the other, the medicinal product available only on prescription that has been marketed under the trade mark TRIVASTAN. As Alcon acknowledged in response to a question put in the course of the oral procedure, on the Italian market not all ophthalmic pharmaceutical preparations are available only on prescription.

55. In the case of trade marks for medicinal products sold without a prescription, the perception of the end user is of very much greater importance. While it is true that these products may be acquired at the instigation of doctors, in many cases the end users decide by themselves on their purchase. Therefore they are also advertised to end users. (29)

56. The perception of the end user is also of importance in particular for an examination, as must be conducted here, of the likelihood of confusion between, on the one hand, a group of goods including both medicinal products sold without a prescription and medicinal products available only on prescription and, on the other hand, a medicinal product available only on prescription. If the end user wants to purchase the product sold without a prescription but, as the result of confusion, asks for the product requiring a prescription, the pharmacy will refuse to sell the latter. If, on the other hand, because of confusion, he asks for the product sold without a prescription although he actually wanted the product available only on prescription for his ailment, it is possible that he will obtain a product that does not help him.

57. The reduction of the relevant public to doctors which Alcon seeks would therefore be permissible in the present case only if the likelihood of confusion in respect of ophthalmic pharmaceutical preparations available only on prescription could be examined separately. That would presuppose that the list of goods can be split.

58. In principle it is possible to limit the grant or refusal of a trade mark application to certain constituents of the list of goods. Under the first sentence of Article 43(5) of Regulation No 40/94, an application for a trade mark is to be refused only in respect of those goods or services which, on the basis of the opposition, may not be registered.

59. In the present case, however, this is irrelevant since Alcon did not subdivide the comprehensive generic term 'ophthalmic pharmaceutical preparations' and neither the Office nor the courts can correct the list of goods accordingly of their own motion. It is admittedly possible to refuse registration for individual, expressly named goods or groups of goods, but the further subdivision into groups of goods would encroach upon the applicant's powers over his application. Furthermore, the formal requirements for restricting the list of goods would be circumvented and – should the subdivision be made in judicial proceedings – the facts upon which the Office has ruled would be altered. (30)

60. Consequently, the Court of First Instance was able to determine whether there was a likelihood of confusion solely on the basis of the perception of the end user. Hence, notwithstanding the legal errors in the contested judgment, it is not to be set aside as a result of the first limb of the second ground of appeal.

4. The third and fourth limbs – comparison of the signs

61. In the third and fourth limbs, Alcon contests the visual and phonetic comparison of the signs. However, Alcon thereby challenges exclusively the findings of fact made by the Court of First Instance. The appeal is therefore inadmissible in this regard. (31)

5. The fifth limb – likelihood of confusion

62. In so far as Alcon challenges the assessment of the likelihood of confusion, it essentially relies on the fact that insufficient account was taken of doctors and pharmacists. As already explained, a likelihood of confusion on the part of end users is, however, sufficient, since the list of goods for the mark TRAVATAN also included medicinal products sold without a prescription. (32) The appeal is therefore unfounded in this regard.

VI – Costs

63. Under Article 122 of the Rules of Procedure of the Court of Justice, in conjunction with Articles 118 and 69(2) 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 Alcon is unsuccessful with its appeal, it has to bear the costs.

VII – Conclusion

64. I accordingly propose that the Court should:

(1) dismiss the appeal;

(2) order Alcon Inc. to pay the costs of the proceedings.

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1 – Original language: German.

2 – OJ 1994 L 11, p. 1.

3 – Alcon v OHIM [2005] ECR II-0000.

4 – Case T-334/01 [2004] ECR II-2787.

5 – See, on the Rules of Procedure of the Court of Justice which are couched in identical terms, Case 306/81 Verros v Parliament [1983] ECR 1755, paragraph 9; Case C-301/97 Netherlands v Council [2001] ECR I-8853, paragraphs 166 and 169; and Case C-66/02 Italy v Commission [2005] ECR I-10901, paragraphs 85 and 86.

6 – Italy v Commission, cited in footnote 5, paragraphs 87 and 88.

7 – Italy v Commission, cited in footnote 5, paragraphs 103 and 108.

8 – Netherlands v Council, cited in footnote 5, paragraphs 157 et seq. and 169.

9 – Verros v Parliament, cited in footnote 5, paragraphs 7 and 10.

10 – See the second set of observations before the Opposition Division, Annex 7 to the application at first instance (p. 73 of the annexes).

11 – See the grounds in support of the appeal before the Board of Appeal, Annex 3 to the application at first instance (p. 38 of the annexes).

12 – OJ 1995 L 303, p. 1.

13 – Case C-447/02 P KWS Saat v OHIM [2004] ECR I-10107, paragraph 58.

14 – See the references in paragraph 51 of the contested judgment.

15 – See specifically in respect of trade mark law, Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 39, and Case C-37/03 P BioID v OHIM [2005] ECR I-7975, paragraph 43; see to this effect also Case C-104/00 P DKV v OHIM [2002] ECR I-7561, paragraph 22, and, more generally, Case C-390/95 P Antillean Rice Mills and Others v Commission [1999] ECR I-769, paragraph 29, Case C-237/98 P Dorsch Consult v Council andCommission [2000] ECR I-4549, paragraphs 35 and 36, and Joined Cases C-204/00 P, C-205/00 P, C-211/00 P, C-213/00 P, C-217/00 P and C-219/00 P Aalborg Portland and Others v Commission [2004] ECR I-123, paragraph 49.

16 – Similarly, Case T-154/03 Biofarma v OHIM – Bausch & Lomb Pharmaceuticals (ALREX) [2005] ECR I-0000, paragraph 45; the appeal (Case C-95/06 P) against this judgment has in the meantime been withdrawn.

17 – Alcon relies on the decision of the First Board of Appeal of 12 May 2004 in Case R 304/2003-1 Pierre Fabre Medicament, SA v Fujisawa Deutschland GmbH (RIBOMUSTIN/RIBOMUNYL).

18 – Alcon relies on Case T-237/01 Alcon v OHIM – Dr. Robert Winzer Pharma (BSS) [2003] ECR II-411, paragraph 42.

19 – Alcon relies on the order in Case C-192/03 P Alcon v OHIM – Dr. Robert Winzer Pharma(BSS) [2004] ECR I-8993, paragraph 30.

20 – This seems to be so in the case of the mark BSS, which is used for a product for ophthalmic surgery and the distinctive character of which is determined by the perception of medical professionals (see the order in BSS, cited in footnote 19, paragraph 30).

21 – See above, point 36.

22 – Case C-251/95 SABEL [1997] ECR I-6191, paragraph 23, and Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 25, which concern Article 4(1)(b) 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), a provision corresponding to Article 8(1)(b) of Regulation No 40/94.

23 – Case C-371/02 Björnekulla Fruktindustrier [2004] ECR I-5791, paragraph 24.

24 – Case C-322/01 Deutscher Apothekerverband [2003] ECR I-14887, paragraph 119.

25 – OJ 2001 L 311, p. 67.

26 – See the judgments of the Bundesgerichtshof (Federal Court of Justice, Germany) of 15 October 1992 in Case I ZR 259/90 (CORVATON/CORVASAL, Gewerblicher Rechtsschutz und Urheberrecht 1993, 118, 119), of 2 February 1989 in Case I ZR 150/86 (Herzsymbol, Gewerblicher Rechtsschutz und Urheberrecht 1989, 425, 428) and of 25 January 1990 in Case I ZR 83/88 (L-THYROXIN, Gewerblicher Rechtsschutz und Urheberrecht 1990, 453, 455). See, to similar effect, the decision of the Hearing Officer of the UK Patent Office, S.J. Probert, of 29 January 1998 (Application No 1582474 filed by Dallas Burston Ashbourne Limited and Opposition No 42375 filed by Warner-Lambert Company (DICLOTARD), http://www.patent.gov.uk/tm/legal/decisions/inter1998/o01198.pdf, p. 13, line 12 et seq.).

27 – Case C-361/04 P Ruiz-Picasso and Others v OHIM [2006] ECR I-643, paragraph 40.

28 – The Picasso judgment, cited in footnote 27, paragraph 41 et seq.

29 – See Article 88(2) of Directive 2001/83.

30 – A similar result was reached in the judgments of the Bundespatentgericht (Federal Patents Court, Germany) of 20 November 1997 in Case 30 W (pat) 123/97 (‘Plantapret’, Gewerblicher Rechtsschutz und Urheberrecht 1998, 725 (727)) and of the Bundesgerichtshof of 12 February 1998 in Case I ZB 32/95 (‘salvent/Salventerol’, BGH Gewerblicher Rechtsschutz und Urheberrecht 1998, p. 924 (925)).
31 – See above, point 36.
32 – See above, point 54.