

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

17 June 2008*

In Case T-420/03,

El Corte Inglés, SA, established in Madrid (Spain), represented by J. Rivas Zurdo and E. López Leiva, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by I. de Medrano Caballero, acting as Agent,

defendant,

the other parties to the proceedings before the Board of Appeal of OHIM, interveners before the Court of First Instance, being

José Matías Abril Sánchez and **Pedro Ricote Saugar**, residing in Madrid, represented by J.M. Iglesias Monravá, lawyer,

* Language of the case: Spanish.

ACTION brought against the decision of the Second Board of Appeal of OHIM of 1 October 2003 (Case R 88/2003-2), relating to opposition proceedings between El Corte Inglés, SA, and J.M. Abril Sánchez and P. Ricote Saugar,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fourth Chamber),

composed of I. Wiszniewska-Bialecka (Rapporteur), acting for the President, E. Moavero Milanesi and N. Wahl, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Registry of the Court on 17 December 2003,

having regard to OHIM's response lodged at the Registry of the Court on 23 April 2004,

having regard to the interveners' response lodged at the Registry of the Court on 13 April 2004,

having regard to the request for production of documents made by the Court to the interveners on 30 September 2004,

having regard to the observations of the applicant and OHIM lodged at the Registry of the Court on 1 December 2004 and 25 November 2004 respectively,

having regard to the Court's written question to the parties of 4 July 2005,

having regard to the observations lodged by the parties at the Registry of the Court on 19 July 2005, 3 August 2005 and 16 September 2005,

having regard to the order of 13 October 2005 staying the proceedings,

having regard to the Court's written question of 13 March 2007 to the parties,

having regard to the observations lodged by the parties at the Registry of the Court on 22 March 2007, 28 March 2007 and 12 April 2007,

further to the hearing on 19 September 2007,

gives the following

Judgment

Background to the dispute

- 1 On 3 May 1999, the interveners, José Matías Abril Sánchez and Pedro Ricote Saugar, submitted an application for registration of 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. That application was worded in Spanish.
- 2 The mark in respect of which registration is sought is the following figurative sign:



- 3 The services in respect of which registration was sought are in Classes 38 and 41 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended ('the Nice classification') and correspond, for each of those classes, to the following description:

— Class 38: ‘Telecommunications; services of radio and television programmes; radio and television broadcasting and diffusion’;

— Class 41: ‘Educational, formative and entertainment services; cinema and recording studies, rent of videos, concourse (scattering), installation of televisions and radiophones, production of films’.

⁴ The application for the Community trade mark was published in *Community Trade Marks Bulletin* No 95/99 of 29 November 1999.

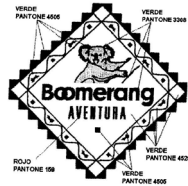
⁵ On 18 February 2000, the applicant, the Spanish company El Corte Inglés, filed an opposition against the registration of the trade mark applied for in respect of all the services covered by the application for registration.

⁶ The language of the opposition proceedings was English.

⁷ The opposition was based on the following earlier rights:

— the figurative marks which were the subject of Spanish registrations Nos 2 163 613 (in respect of ‘telecommunications’ services in Class 38) and 2 163 616 (in respect of ‘education and entertainment’ services in Class 41), applied for on 22 May 1998, and Spanish registrations Nos 2 035 514 (in respect of the goods ‘clothing, footwear and hats’ in Class 25), 2 035 507 (in respect of the goods ‘installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes’ in Class 11), 2 035 505 (in respect of the goods ‘hand tools and instruments; cutlery, forks and spoons; side arms; safety razor’ in

Class 8) and 2 035 508 to 2 035 513, applied for on 19 June 1996, represented below:



- the figurative marks which are the subject of Spanish registrations Nos 1 236 024 (in respect of the goods ‘articles of clothing for men, women and children; footwear’ in Class 25) and 1 236 025 (in respect of the goods ‘gymnastic and sporting articles (except for clothing and footwear); games and toys’ in Class 28) applied for on 23 February 1988, and Spanish registration No 1 282 250 (in respect of the goods ‘leather and imitations of leather, and products made of these materials and not included in other classes; animals’ skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery’ in Class 18), applied for on 3 November 1988, represented below:



- the word mark BOOMERANG, which is the subject of Spanish registration No 456 466 (in respect of the goods ‘all kinds of clothing for gentlemen, ladies and children, handkerchiefs, towels, lingerie, drapery, bed and table covers’ in Classes 24 and 25), applied for on 25 September 1964;
- the figurative marks which are the subject of Spanish registration No 2 227 732, applied for on 16 April 1999, and the Spanish applications for registration

Nos 2 227 731 (in respect of the goods ‘paper, cardboard, paper and cardboard articles, not included in other classes; printed matter, newspapers and periodicals, books; bookbinding material, photographs; stationery, adhesive materials (stationery); artists’ materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers’ type and clichés (stereotype)’ in Class 16) and 2 227 734, filed on 16 April 1999, represented below:



- the figurative mark which the the subject of United Kingdom registration No 1 494 568 (in respect of the goods ‘suits, coats, tailcoats, trousers, skirts, shorts, T-shirts, sweaters, jumpers, jackets, sweatshirts; socks, scarves, gloves, headbands, wristbands; shoes, slippers, boots, sportshoes; all included in Class 25’ in Class 25), applied for on 18 March 1992, represented below:



- the figurative marks which are the subject of Irish registration No 153 228 (in respect of the goods ‘articles of clothing, headgear and footwear, all included in Class 25’ in Class 25), filed on 13 March 1992, and Greek registration No 109 387

(in respect of the goods ‘clothing, including boots and slippers’, in Class 25), filed on 16 March 1992, represented below:



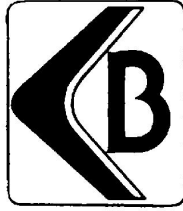
- the figurative mark which is the subject of Community trade mark application No 448 514 filed on 3 February 1997 for a range of goods in Classes 3, 18 and 25, represented below:



BOOMERANG

- the figurative marks, well known in the sense of Article 6bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised and amended (‘the Paris Convention’), in Spain, Ireland, Greece and the United Kingdom, and covering all the goods and services in Classes 18, 25, 38 and 41, represented below:





- 8 The grounds put forward in support of the opposition were those referred to in Article 8(1)(a) and (b) and Article 8(5) of Regulation No 40/94.
- 9 By fax of 20 March 2000, OHIM informed the applicant that it had not correctly identified all of the goods and services protected by its earlier rights. It granted it a period of two months to remedy those deficiencies.
- 10 By letter of 21 March 2000 addressed to OHIM, the applicant specified, in English, the goods and services covered by Spanish registrations Nos 2 035 505, 2 035 507, 2 035 514, 456 466, 1 236 024, 1 236 025, 1 282 250, 2 227 731, 2 163 613 and 2 163 616, Greek registration No 109 387, United Kingdom registration No 1 494 568 and Irish registration No 153 228.

- 11 The applicant also attached with that letter copies of the registration or renewal certificates of the Spanish trade marks Nos 2 035 505, 2 035 507, 2 035 514, 1 236 024, 1 236 025, 1 282 250 in Spanish, and their translations into English; a copy of Spanish trade mark application No 456 466 and a document transferring to it that right, with the translations into English thereof; a copy of Spanish registration application form No 2 227 731, with a translation into English; copies of United Kingdom registration certificate No 1 494 568 and Irish registration certificate No 153 228, in English; a copy of the second page of Greek registration certificate No 109 387, together with a translation into English of the whole of the certificate; copies of Spanish registration application forms Nos 2 163 613 and 2 163 616, referring to the relevant services in Spanish, and copies of the relevant Spanish registration decisions — which referred to Classes 38 and 41 respectively but did not refer to the services covered by those registrations — and the translation into English of those decisions.
- 12 By fax of 7 August 2000, OHIM informed the applicant, first, that Spanish registrations Nos 2 035 508 to 2 035 513, 2 227 732 and 2 227 734 would not be taken into consideration, since the goods and services which they covered had not been specified in the language of the opposition proceedings and, secondly, that the applicant had until 17 December 2000 to submit facts, evidence and observations in support of its opposition. OHIM also stated in that fax that all documents had to be provided in the language of the opposition proceedings or accompanied by a translation, a translation also being required for any document already included in the file which was not in the language of the opposition proceedings. It stated finally that it would not take into account the documents which had not been translated into the language of the proceedings, or translations provided without a copy of the original.
- 13 That fax was accompanied by an information sheet entitled ‘Information about evidence’, which stated, *inter alia*, that all the formal and substantive particulars relating to the earlier rights had to be provided, in particular the issuing authority, the goods and services covered, the date of registration and the proprietor of the right. That note also stated that even the standard wording of the documents submitted should be translated.
- 14 On 3 October 2000, the interveners lodged their observations in reply to the opposition and restricted the services for which they were seeking registration of the

mark Boomerang^{TV} to those in Class 41 corresponding to the following description: ‘cinema and recording studios, rent of videos, concourse (scattering), installation of television and radiophones, production of films’.

- 15 By fax of 20 November 2000, OHIM informed the applicant of that restriction, asking it if it still wished to maintain its opposition, and extended until 20 January 2001 the period mentioned in its fax of 7 August 2000.
- 16 By fax of 19 January 2001, the applicant informed OHIM that the opposition was being maintained, inter alia on the ground that the restriction of the services for which registration was sought would still not rule out a likelihood of confusion with its trade mark No 2 163 616. It also provided a number of documents seeking to prove the reputation of its earlier marks. The same day, the interveners lodged new observations, claiming inter alia that the applicant had failed to provide evidence of the use of its earlier rights.
- 17 By decision of 29 November 2002, the Opposition Division rejected the opposition. It found, inter alia, that the applicant had failed to submit the list of goods and services covered by Spanish marks Nos 2 035 508 to 2 035 513, 2 227 732 and 2 227 734, despite being requested to do so, and therefore it held that the opposition was inadmissible to the extent to which it was based upon those marks. Furthermore, it held that the opposition was unfounded inasmuch as it was based on earlier rights Nos 2 163 613, 2 163 616, 456 466 and, 109 387, since no evidence of the existence of those marks had been adduced. The Opposition Division thus observed that the applicant had provided neither the translation into English of Spanish registration application forms Nos 2 163 613 and 2 163 616 — and that the information concerning the issuing authorities, the proprietor of those registrations, the date and number of those applications and the specification of the services referred to by those registrations had not therefore been translated into the language of the opposition proceedings — nor an official document indicating the date of Spanish registration No 456 466 or the date from which it was valid, nor an official document containing information on the proprietor of Greek registration No 109 387, the dates of the application for registration and registration of that right, the goods covered by that registration and the representation of the sign in question.

- 18 The Opposition Division also held that the applicant had not adduced sufficient evidence to prove the existence of its marks which were well known within the meaning of Article 6bis of the Paris Convention in Spain, Ireland, Greece and the United Kingdom and that, to that extent, the opposition was also unfounded.
- 19 Lastly, it took the view that the conditions for the application of Article 8(1)(a) and (b) and Article 8(5) of Regulation No 40/94 had not been met, inter alia on the grounds that the earlier rights of which the applicant had provided proof (Spanish registrations Nos 2 035 505, 2 035 507, 2 035 514, 1 236 024, 1 236 025, 1 282 250 and 2 227 731, United Kingdom registration No 1 494 568, Irish registration No 153 228 and the Community trade mark application No 448 514) covered goods and services which were not similar to those in respect of which registration of the mark Boomerang^{TV} was sought and that the evidence provided was not sufficient to prove that the earlier marks had a reputation.
- 20 On 24 January 2003 the applicant filed a notice of appeal at OHIM against the Opposition Division's decision. Inter alia, it attached to the statement of the grounds of appeal extracts from the Sitadex database of the Oficina Española de Patentes y Marcas (Spanish Patent and Trade Marks Office; 'OEPM'), concerning its Spanish registrations Nos 2 163 613, 2 163 616 and 456 666, and the interveners' Spanish registration No 2 184 868, accompanied by translations in English thereof, and a press article relating to the scale and diversity of its commercial activities in Spain.
- 21 By decision of 1 October 2003 ('the contested decision'), the Second Board of Appeal of OHIM dismissed the appeal. First, it disregarded as inadmissible, in the light of its decision-making practice and the Court's case-law, the documents submitted for the first time as an annex to the statement of the grounds of appeal. Secondly, it confirmed the Opposition Division's finding that the opposition was inadmissible in so far as it was based on Spanish registrations Nos 2 035 508 to 2 035 513, 2 227 732 and 2 227 734, the applicant not having put forward any argument to refute the fact that it had not specified the goods and services which were the subject of those registrations. Thirdly, it held, inter alia, that Rule 16(1) to (3), Rule 17(2) and Rule 20(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing

Regulation No 40/94 (OJ 1995 L 303, p. 1), as applicable to the facts, entitled the Opposition Division to reject the opposition on the grounds that the applicant had not submitted, in the language of the opposition proceedings, the documents necessary to prove the existence of earlier rights Nos 2 163 613 and 2 163 616. Fourthly, it approved the findings of the Opposition Division according to which, first, the existence of Greek registration No 109 387 and Spanish registration No 456 466 had not been proved, the applicant not having put forward any argument proving otherwise and, secondly, the evidence provided by the applicant was not sufficient to establish that the requirements set for the protection of well-known marks within the meaning of Article 6bis of the Paris Convention had been fulfilled, the applicant not having put forward any argument proving otherwise.

- 22 The Board of Appeal therefore examined the opposition solely on the basis of Spanish registrations Nos 2 035 505, 2 035 507, 2 035 514, 1 236 024, 1 236 025, 1 282 250 and 2 227 731, United Kingdom registration No 1 494 568, Irish registration No 153 228 and the Community trade mark application No 448 514. After having found that Article 8(1)(a) of Regulation No 40/94 was not applicable on the ground that none of the earlier marks was identical to the mark in respect of which registration was sought, it found that there was no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94, since there was no similarity between the goods protected by those earlier rights and the services covered by the application for registration. Lastly, it endorsed the Opposition Division's finding that Article 8(5) of Regulation No 40/94 was not applicable inasmuch as the applicant had failed to establish to the requisite legal standard the reputation of its marks containing the word element 'boomerang'.

Forms of order sought by the parties

- 23 The applicant claims that the Court should:

— annul the contested decision;

— refuse registration of the trade mark Boomerang^{TV};

— Order OHIM and the interveners to pay the costs.

24 In addition, the applicant requests the Court to take into account new evidence.

25 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

26 The interveners claim that the Court should:

— dismiss the action;

— uphold the contested decision;

- allow registration of the trade mark Boomerang^{TV} in respect of the services in Class 41;
- order the applicant to pay the costs.

²⁷ In their reply of 22 March 2007 to the Court's written question requesting the parties to submit observations on the consequences which the Court of Justice's judgment in Case C-29/05 P *OHIM v Kaul* [2007] ECR I-2213 might have for the present case, the interveners stated that the services covered by their application for registration could be restricted to 'cinema and recording studios; televised competitions, production of films'. In reply to a question asked by the Court at the hearing, the interveners stated that that restriction was proposed only as an alternative, which has been noted by the Court.

²⁸ In addition, the interveners suggest that the Court should adopt a measure of inquiry, seeking production of the file of the proceedings before OHIM and an attestation from the Madrid Central Mercantile Register as to the objects of the applicant company.

Law

²⁹ In support of its action, the applicant essentially puts forward four pleas, alleging: (i) infringement by the Board of Appeal of the obligation to examine the evidence submitted to it; (ii) errors committed by OHIM in assessing the evidence of the existence of some of the applicant's earlier rights; (iii) infringement of Article 8(1) (b) of Regulation No 40/94; and (iv) infringement of Article 8(5) of Regulation No 40/94. However, the Court must first rule on the admissibility of some of the forms of order sought and on that of the new evidence put forward by the applicant.

Admissibility of some of the forms of order sought

30 In its second head of claim, the applicant essentially requests the Court to instruct OHIM to refuse registration of the trade mark Boomerang^{TV}. In their third head of claim, the interveners essentially ask the Court to instruct OHIM to allow registration of the trade mark Boomerang^{TV} in respect of the services in Class 41 of the Nice classification.

31 Pursuant to Article 63(6) of Regulation No 40/94, OHIM is required to take the measures necessary to comply with a judgment of the Community judicature. Therefore, it is not for the Court to issue directions to OHIM. It is for the latter to draw the conclusions from the operative part of the judgment given by the Court and the grounds on which it is based (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-192/04 *Flex Equipos de Descanso v OHIM — Leggett & Platt (LURA-FLEX)* [2007] ECR II-2411, paragraph 33). Therefore, the applicant's second head of claim and the interveners' third head of claim are inadmissible.

*The production of new evidence before the Court**Arguments of the parties*

32 The applicant has included with its application a number of documents intended in particular to demonstrate that it and its earlier marks are well known and of repute. It also offers to produce certain additional evidence.

33 OHIM contends that the new evidence produced by the applicant for the first time before the Court and its offer to adduce additional new evidence are both inadmissible.

Findings of the Court

34 It is evident from the case-file that the applicant produced for the first time before the Court: (i) the judgment of the Tribunal Superior de Justicia de Madrid (Madrid High Court of Justice, Spain) of 11 September 2003 in Case No 1118/2000 between the interveners and OEPM concerning that office's refusal to register the figurative mark Boomerang^{TV} to designate services in Class 41 for the purpose of the Nice classification (annex 4 to the application); (ii) various documents intended to prove that it and its earlier marks were well known and of repute (annexes 5 to 8 and 14 to the application) and; (iii) an extract from the Sitadex database corresponding to the application for registration No 2 184 869 of the trade mark Boomerang^{TV} in respect of services in Class 41 for the purpose of the Nice classification, submitted by the interveners before OEPM (last three pages of annex 13 to the application).

35 Actions before the Court seek a review of the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94. Therefore, it is not the Court's function to review the facts in the light of documents adduced for the first time before it. To allow such evidence would be contrary to Article 135(4) of the Rules of Procedure, according to which the parties' submissions may not alter the subject-matter of the proceedings before the Board of Appeal. Accordingly, such evidence is inadmissible and must be excluded, without any need to assess its probative value (Case T-128/01 *DaimlerChrysler v OHIM (Calandre)* [2003] ECR II-701, paragraph 18, and judgment of 23 May 2007 in Case T-342/05 *Henkel v OHIM — SERCA (COR)*, not published in the ECR, paragraph 31). For the same reason, an offer of new evidence submitted by a party must also be disregarded (see, to that effect, Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 97).

36 It follows that in the present case annexes 5 to 8, annex 14 and the last three pages of annex 13 to the application are inadmissible, in so far as they constitute new evidence which was not produced during the proceedings before OHIM, and that the applicant's offer to produce additional evidence cannot be accepted.

37 Nevertheless, neither the parties nor the Court can be precluded from drawing on Community, national or international case-law for the purposes of interpreting Community law. That possibility of referring to national judgments is not covered by the case-law referred to in paragraph 35 above, since it is not alleged that the Board of Appeal failed to take the factual aspects of a specific national judgment into account but that it infringed a provision of Regulation No 40/94 and the case-law is cited in support of that plea (Case T-277/04 *Vitakraft-Werke Wührmann v OHIM — Johnson's Veterinary Products (VITACOAT)* [2006] ECR II-2211, paragraph 71). Any account to be taken by the Court of the judgment of the Tribunal Superior de Justicia de Madrid reproduced in annex 4 to the application therefore depends on the reason for which the applicant invokes that judgment. Consequently, whether the Court is able to take that judgment into account will be examined during the detailed analysis of the plea in connection with which that judgment is invoked.

The first plea: infringement of the obligation to examine the evidence submitted for the first time before the Board of Appeal

Arguments of the parties

38 The applicant points out that the evidence produced for the first time before the Board of Appeal was admissible and that the judgment in *OHIM v Kaul*, cited in paragraph 27 above, confirms that it is possible to submit facts and evidence for the first time at the stage of the appeal before OHIM. In addition, according to that judgment, the dismissal of an action cannot be founded solely on the ground that the

facts and evidence could no longer be submitted before the Board of Appeal. The application to the present case of the approach upheld in that judgment should lead to the annulment of the contested decision.

39 OHIM and the interveners contend that the Board of Appeal correctly concluded that the evidence produced by the applicant for the first time with its statement of the grounds of appeal was inadmissible. They also submit that *OHIM v Kaul*, cited in paragraph 27 above, is irrelevant to the present case, since the nature of the evidence at issue is different.

Findings of the Court

40 By its first plea, the applicant alleges, essentially, that the Board of Appeal infringed Article 74(2) of Regulation No 40/94. Under that provision, OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

41 It follows that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the passing of the time-limits to which such submission is subject under the provisions of Regulation No 40/94 and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late. However, a party has no unconditional right to have such facts and evidence submitted out of time taken into consideration by OHIM. In stating that the latter ‘may’, in such a case, decide to disregard those facts and that evidence, Article 74(2) of Regulation No 40/94 grants OHIM a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (*OHIM v Kaul*, cited in paragraph 27 above, paragraphs 42 and 43).

42 Where OHIM is called upon to give judgment in the context of opposition proceedings, taking facts or evidence submitted out of time into account is particularly likely to be justified where OHIM considers, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (*OHIM v Kaul*, cited in paragraph 27 above, paragraph 44).

43 It follows that, contrary to what the applicant submits, the Board of Appeal was not required to take into consideration the evidence produced for the first time before it. It is, however, necessary to determine whether, in refusing to take that evidence into consideration, the Board of Appeal did not infringe Article 74(2) of Regulation No 40/94 by considering itself to have no discretion in that regard. Contrary to what OHIM and the interveners maintain, there is no need, in principle, to restrict the application of the principles set out in paragraphs 40 to 42 above on the basis of the nature of the facts and evidence in question, since no such restriction is provided for in Article 74(2) of Regulation No 40/94. The nature of the facts and evidence at issue is, nevertheless, a factor which OHIM may take into account when exercising the discretion granted to it under that article.

44 In the present case, the Board of Appeal stated in paragraph 27 of the contested decision that it was in accordance with the practice of the Boards of Appeal to consider as inadmissible documents included for the first time with the statement of the grounds of appeal. It added that such documents should have been submitted to the Opposition Division within the relevant deadline and that a party could not validly avail itself of the appeal in order to introduce, *inter alia*, new evidence not submitted in due time. It referred, in this connection, to two earlier decisions of Boards of Appeal of OHIM and to Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301.

45 Thus, in order to conclude that the documents produced for the first time before it were inadmissible, the Board of Appeal relied on the fact that the applicant had already been granted the opportunity to produce all of the documents at issue before

the Opposition Division. It thus implicitly took the view that the circumstances in which the documents at issue had been produced precluded their being taken into account. Furthermore, it is evident from the case-file that the period given to the applicant to produce the documents at issue before the Opposition Division had been extended and that the applicant had not in any way contended that it had not been in a position to produce the relevant documents before the Opposition Division when it granted the applicant additional time for that purpose.

⁴⁶ The contested decision therefore shows that the Board of Appeal did not hold on principle that the documents produced by the applicant for the first time before it were inadmissible, but that it took into account the facts of the case and gave grounds for its decision on that issue. Admittedly, the list of those grounds is brief and the factors referred to by the Board of Appeal do not expressly correspond to those referred to by the Court of Justice in *OHIM v Kaul*, cited in paragraph 27 above. However, that does not justify the conclusion that the Board of Appeal infringed Article 74(2) of Regulation No 40/94.

⁴⁷ According to *OHIM v Kaul*, cited in paragraph 27 above (see, in this connection, paragraphs 42 and 43), it is an essential requirement that the Board of Appeal should not consider itself to be unable to take into account facts and evidence which are submitted for the first time before it. However, as shown in paragraphs 44 and 45 above, that was not the case here. The factors which the Court of Justice identified as those which may justify taking into account facts or evidence submitted out of time are given only by way of example, as the term 'particularly' (see paragraph 42 above) indicates. The reference in the present case to factors which are not identical to those referred to by the Court of Justice in that judgment cannot therefore be regarded as constituting a failure to state reasons within the terms of that judgment. That applies all the more so since the Court of Justice expressly ruled only as to factors which might warrant taking account of facts and evidence submitted out of time, even though, as noted in paragraph 41 above, Article 74(2) of Regulation No 40/94 also allows such facts and evidence to be rejected, depending on the circumstances.

⁴⁸ It follows that the Board of Appeal did not dismiss the action brought before it by the applicant solely on the ground that that party had submitted facts and evidence out of time and that it did not take the view that it had no discretion to take account of

the documents produced by the applicant for the first time before it. On the contrary, it exercised the broad discretion conferred upon it by Article 74(2) of Regulation No 40/94, in so far as it was only after having analysed the facts of the case and the position in law that it decided to reject as inadmissible the documents at issue.

- 49 In the absence of any manifest error of assessment by the Board of Appeal in this respect, it has not been established that Article 74(2) of Regulation No 40/94 was infringed. Consequently, the first plea must be rejected as unfounded.

The second plea, relating to errors committed by OHIM as regards the assessment of the evidence of the existence of some of the earlier rights

Arguments of the parties

- 50 First, the applicant submits that, by letter of 21 March 2000, it submitted in good time the required translations relating to Spanish registrations Nos 2 163 613 and 2 163 616 and the essential information relating to Spanish registration No 456 466. The Opposition Division and the Board of Appeal furthermore recognised that fact regarding registrations Nos 2 163 613 and 2 163 616, accepting that the opposition was admissible in so far as it was filed on the basis of those rights. The Opposition Division and the Board of Appeal, by then ignoring those rights as the basis of the opposition, are therefore following a contradictory line of reasoning.
- 51 Secondly, it points out that, in contravention of Rule 20(2) of the version of Regulation No 2868/95 applicable to the facts, OHIM did not call upon it to produce the missing translations relating to registrations Nos 2 163 613 and 2 163 616. OHIM's

fax of 7 August 2000 implies that the translations of the registrations which were not mentioned in it were regarded as admissible.

52 Lastly, the applicant maintains that the interveners themselves, by comparing Spanish registration No 2 163 616 to the trade mark for which registration was sought, recognised the validity of that registration. The latter should therefore be allowed.

53 It follows that the Board of Appeal, like the Opposition Division, incorrectly failed to take into account certain earlier rights, including Spanish registration No 2 163 616, which led it to undermine the rights which the applicant derives from Article 8(1) and (2) of Regulation No 40/94.

54 The same is true regarding the applicant's well-known marks. The evidence furnished to the Opposition Division, supplemented by that submitted to the Board of Appeal, was sufficient to prove the existence of well-known marks for the purpose of Article 8(2)(c) of Regulation No 40/94.

55 In any event, the applicant attaches, in annexes 10 to 12 to its application, extracts from the Sitadex database relating to Spanish registrations Nos 2 163 613, 2 163 616 and 456 466 and emphasises, in particular, that those first two registrations have to be taken into account as the basis of its opposition and that, as regards registration No 456 466, the relevant extract from the Sitadex database has already been produced before the Board of Appeal. It emphasises, moreover, that it itself is a well-known company, a claim proved before the Board of Appeal.

56 OHIM submits, first of all, that the applicant's first argument, according to which the required translations were submitted by letter of 21 March 2000, was not raised before the Board of Appeal and is therefore contrary to Article 135(4) of the Rules of

Procedure. As regards the substance of the plea, OHIM and the interveners dispute the arguments put forward by the applicant.

Findings of the Court

57 Since the applicant's arguments concern only trade marks Nos 2 163 613, 2 163 616 and 456 466 and its well-known marks, the finding of the Board of Appeal that the existence of Greek registration No 109 387 has not been proved must be considered to be definitive.

58 As regards the earlier rights in respect of which the applicant is disputing the Board of Appeal's findings, it must be observed that the applicant's line of argument seeks, essentially, to demonstrate that the Board of Appeal erred in law by holding, first, in general, that the Opposition Division was justified in concluding that the existence of those earlier rights had not been proved and, secondly, specifically, that the applicant had not established the existence of its well-known marks within the meaning of Article 6bis of the Paris Convention.

— The evidence of the existence of the earlier rights

59 Article 42(3) of Regulation No 40/94 provides that opposition must be expressed in writing and must specify the grounds on which it is made. It is not to be treated as duly entered until the opposition fee has been paid and, within a period fixed by the OHIM, the opponent may submit in support of his case facts, evidence and arguments. Under Rule 18(1) of Regulation No 2868/95, as applicable to the facts, if OHIM finds that the notice of opposition does not comply with the provisions of that article, or where the notice of opposition does not, *inter alia*, clearly identify the earlier mark or the earlier right on the basis of which the opposition is being entered,

it shall reject the notice of opposition as inadmissible unless those deficiencies have been remedied before expiry of the opposition period.

60 Under Rule 15(2)(b)(vii) of Regulation No 2868/95, as applicable to the facts, the notice of opposition must contain, so far as the earlier mark or the earlier right on which the opposition is based is concerned, the goods and services in respect of which the earlier mark has been registered or applied for or in respect of which it is well known or has a reputation. Under Rule 18(2) thereof, in the same version, if the notice of opposition does not comply with other provisions of Regulation No 40/94 or the provisions of Regulation No 2868/95 other than those referred to in Rule 18(1), and therefore, inter alia, if the notice of opposition does not comply with Rule 15(2)(b)(vii) of Regulation No 2868/95, OHIM is to inform the opposing party and call upon him to remedy those deficiencies within a period of two months. Failing this, OHIM is to reject the notice of opposition as inadmissible.

61 In addition, under Rule 16(2) and (3) of Regulation No 2868/95, as applicable to the facts, the notice of opposition is preferably to be accompanied by evidence of the existence of the earlier marks and, if such evidence has not been provided with the notice of opposition, it can be submitted within such period after commencement of the opposition proceedings as OHIM may specify pursuant to Rule 20(2) of that regulation.

62 Under Rule 17(2) of Regulation No 2868/95, as applicable to the facts, where the evidence in support of the opposition as provided for in Rule 16(2) is not filed in the language of the opposition proceedings, the opposing party must file a translation of that evidence into that language within a period of one month from the expiry of the opposition period or, where applicable, within the period specified by OHIM pursuant to Rule 16(3) thereof.

63 Finally, under Rule 20(2) of Regulation No 2868/95, as applicable to the facts, where the notice of opposition does not contain particulars of, inter alia, the evidence as

referred to in Rule 16(2), OHIM is required to call upon the opposing party to submit such particulars within a period specified by OHIM.

64 It thus follows from Article 42 of Regulation No 40/94, read in conjunction with Rules 16, 17, 18 and 20 of Regulation No 2868/95, as applicable to the facts, that the legislature makes a distinction between, on one hand, the conditions which the notice of opposition must satisfy, which are laid down as conditions of admissibility of the opposition, and, on the other hand, the submission of the facts, evidence and arguments and of the documents supporting the opposition, which are matters falling within the scope of the examination of the opposition (judgments in Case T-232/00 *Chef Revival USA v OHIM — Massagué Marín (Chef)* [2002] ECR II-2749, paragraph 31, and of 15 May 2007 in Joined Cases T-239/05, T-240/05, T-245/05 to T-247/05, T-255/05 and T-274/05 to T-280/05 *Black & Decker v OHIM — Atlas Copco (Three-dimensional representation of a yellow and black electrical power tool et al.)*, not published in the ECR, paragraph 84).

65 As regards the conditions which, if not complied with in the notice of opposition, lead to rejection of the opposition as inadmissible, Rule 18 of Regulation No 2868/95, as applicable to the facts, distinguishes between the conditions for admissibility in paragraph 1 thereof and those in paragraph 2 thereof. As is evident from paragraph 60 above, it is only in cases in which the notice of opposition does not comply with one or more conditions of admissibility of the opposition other than those expressly referred to in Rule 18(1) of Regulation No 2868/95, as applicable to the facts, that OHIM is required, by virtue of Rule 18(2), to inform the opponent of this and to call upon him to remedy the deficiency within a period of two months before it rejects the opposition as inadmissible (*Chef*, cited in paragraph 64 above, paragraphs 33 and 36).

66 By contrast, the legal requirements concerning the presentation of the facts, evidence and observations and of the documents submitted in support of the opposition, including their translations into the language of the opposition proceedings, are not conditions of admissibility of the opposition but conditions relating to the examination of its substance. Therefore, the Opposition Division is not required to point out to the opponent the deficiency constituted by its failure to produce such evidence in support of the opposition or a translation of that evidence into the language of the opposition proceedings (see, to that effect, *Chef*, cited in paragraph 64 above, paragraphs 37, 52 and 53, and *LURA-FLEX*, cited in paragraph 31 above, paragraphs 55 and 56).

67 If the opponent does not present the evidence and documents in support of the opposition and their translation into the language of the opposition proceedings before the expiry of the period initially laid down for that purpose by OHIM or before the expiry of any extension of that period under Rule 71(1) of Regulation No 2868/95, as applicable to the facts, OHIM may lawfully reject the opposition as unfounded unless, in accordance with Rule 20(3) of Regulation No 2868/95, as applicable to the facts, it can give a ruling on it on the basis of the evidence which it may already have before it. The rejection of the opposition in such a case is the consequence of a failure to comply with a substantive condition of the opposition, since the opponent, by failing to present within the prescribed period the relevant evidence and supporting documents, fails to prove the existence of the facts or the rights on which his opposition is founded (*Chef*, cited in paragraph 64 above, paragraph 44, and order in Case T-235/02 *Strongline v OHIM — Scala (SCALA)* [2003] ECR II-4903, paragraph 39).

68 In the present case it is common ground that, by fax of 20 March 2000, OHIM informed the applicant that, inter alia, it had not correctly identified all the goods and services protected by its earlier rights and granted it a period of two months, which expired on 20 May 2000, to remedy those deficiencies.

69 It is also common ground that, by letter of 21 March 2000 addressed to OHIM, the applicant, first, specified in English the goods and services covered by inter alia Spanish registrations Nos 2 163 613, 2 163 616, and 456 466. Secondly, it sent to OHIM, as regards Spanish registration No 456 466, a copy of the trade mark application published in the Spanish Official Bulletin of Intellectual Property in 1964 and of the official transfer of that right to it, with their translations into English, and, as regards Spanish registrations Nos 2 163 613 and 2 163 616, copies of the Spanish registration application forms, referring to the relevant services, and copies of the Spanish registration decisions, which referred to Classes 38 and 41 respectively but did not refer to the list of services specifically covered by those registrations, and the translation into English of the decisions alone.

70 Lastly, it is common ground that, by fax of 7 August 2000, the Opposition Division informed the applicant that Spanish registrations Nos 2 035 508 to 2 035 513, 2 227 732 and 2 227 734 would not be taken into consideration on the ground that the goods and services which they covered had not been specified in the language

of the opposition proceedings. It granted the applicant a period of four months, expiring on 17 December 2000, to submit facts, evidence and observations in support of its opposition, stating that all documents had to be in the language of the opposition proceedings or accompanied by a translation. By fax of 20 November 2000, that period was extended up to 20 January 2001. The file shows that, by way of reply to that fax, the applicant, on 19 January 2001, provided only documents designed to prove the reputation of its earlier marks. The applicant submitted those documents merely in order to prove the reputation of its trade marks, but the Opposition Division also took them into account as possible evidence that the earlier marks were well known.

71 It follows that, first, contrary to what the applicant asserts, it did not submit to the Opposition Division the evidence necessary to prove the existence of its Spanish trade marks Nos 2 163 613, 2 163 616 and 456 466. Although, by letter of 21 March 2001, it specified, in the language of the opposition proceedings, the list of goods and services covered by those marks, by doing so it merely ensured its opposition complied with the other provisions of Regulation No 40/94 or Regulation No 2868/95 referred to by Rule 18(2) of Regulation No 2868/95, as applicable to the facts.

72 In fact, as it has been shown in paragraphs 10 and 11 above, in that letter the applicant did not produce either the Spanish registration certificate for trade mark No 456 466 or any other official document, together with its translation into English if necessary, referring to all the substantive and procedural evidence relating to that right and which would have enabled the Opposition Division to consider its existence established, even though the Opposition Division had expressly stated that that evidence and any translations of it had to be provided in order to prove the existence of the earlier marks at issue (see paragraphs 12 and 13 above). Likewise, the applicant did not produce any official document, together with its translation into English if necessary, providing evidence of, *inter alia*, the goods and services for which trade marks Nos 2 162 613 and 2 163 616 had been registered or provide any document to prove that the relevant earlier marks were well known. Moreover, the documents furnished by the applicant on 19 January 2001 could not remedy the deficiencies in the evidence of the existence of marks Nos 2 163 613, 2 163 616 and 456 466, since they were intended only to prove that the earlier marks had a reputation, and no other official document relating to trade marks Nos 2 163 613, 2 163 616 and 456 466 was produced before the Opposition Division.

- 73 The specification in the language of the opposition proceedings of the goods and services covered by the earlier marks does not constitute, and cannot be treated as equivalent to, a translation of the evidence of the existence of the earlier marks at issue (see, to that effect, *Chef*, cited in paragraph 64 above, paragraph 64) and, in the absence of any translation into the language of the opposition proceedings of evidence of the existence of those earlier rights, the Opposition Division was justified in holding that the opposition was unfounded in so far as it relied on rights the existence of which had not been proved (see paragraph 67 above and, in support of this, *Chef*, cited in paragraph 64 above, paragraphs 44 and 57).
- 74 Furthermore, since the evidence of the existence of the earlier rights related to the substance of the opposition, the fact that the Opposition Division held that the opposition was admissible even though it was founded on earlier rights the existence of which it subsequently held not to be established does not reveal any conflict in the reasoning of the Opposition Division.
- 75 Secondly, it is apparent from the accepted facts, reiterated in paragraphs 68 to 70 above, that, by sending the fax of 20 March 2000 requesting the applicant to remedy the deficiencies in its opposition, the Opposition Division correctly applied Rule 18(2) of Regulation No 2868/95, as applicable to the facts. Furthermore, by sending the fax of 7 August 2000 calling on the applicant to provide, within a period of four months — which was subsequently extended by one month — the facts, evidence and observations in support of its opposition, the Opposition Division correctly applied Rule 20(2) of Regulation No 2868/95, as applicable to the facts.
- 76 In addition, contrary to what the applicant claims, the Opposition Division was under no obligation to ask it to submit the missing translations or to inform it that the evidence submitted was clearly inadequate for the purposes of proving the existence of the rights at issue and to set it a period within which to remedy those omissions. In fact, that duty is imposed on OHIM only with regard to the conditions for the admissibility of the opposition in Rule 18(2) of Regulation No 2868/95, as applicable to the facts. Infringement of Rule 20(2) of Regulation No 2868/95, as applicable to the facts, has therefore not been established.

77 Thirdly, even on the assumption that the interveners had actually recognised the ‘validity’ of Spanish registration No 2 163 616, or indeed that of the other earlier rights at issue, which they did not do, that fact did not place the Opposition Division and the Board of Appeal under an obligation to hold that the existence of those rights had been proved. Article 8 of Regulation No 40/94 provides, essentially, that a relative ground for refusal of registration of a Community trade mark exists only if there is a conflict between the Community trade mark for which registration is sought and another earlier mark. Under the case-law, it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition (see, to that effect, Case T-269/02 *PepsiCo v OHIM — Intersnack Knabber-Gebäck (RUFFLES)* [2005] ECR II-1341, paragraph 26). The issue of the existence of an earlier mark is thus not a factor which can be left to the free assessment of the parties. Consequently, the argument that the applicant derives from the interveners’ alleged agreement as regards the existence of one or even several of its earlier rights must be rejected.

78 It follows from all of the foregoing that the Board of Appeal did not err in endorsing the Opposition Division, which concluded that the existence of earlier marks Nos 2 163 613, 2 163 616 and 456 466 had not been proved and that the opposition was unfounded in so far as it was based on those rights. Consequently, the first branch of the second plea must be rejected, without it being necessary to rule on the admissibility of the first argument put forward by the applicant (see, to that effect, Case C-233/02 *France v Commission* [2004] ECR I-2759, paragraph 26).

— The evidence of the existence of the earlier well-known marks

79 Since Article 8(2)(c) of Regulation No 40/94 refers to trade marks which are ‘well-known in a Member State, in the sense in which the words “well-known” are used in Article 6 *bis* of the Paris Convention’ it is necessary, in order to ascertain how the existence of a well-known mark can be proved, to refer to the guidelines for the interpretation of Article 6bis.

80 Under Article 2 of the joint recommendation concerning the provisions on the protection of well-known trademarks, adopted by the Assembly of the Paris Union and the General Assembly of the World Intellectual Property Organisation (WIPO) at the 34th series of meetings of assemblies of the Member States of the WIPO (of 20 to 29 September 1999), in determining whether a mark is a well-known mark within the meaning of the Paris Convention, the competent authority can take into account any circumstances from which it may be inferred that the mark is well known, including: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark; the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent to which they reflect use or recognition of the mark; the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognised as well known by competent authorities; the value associated with the mark.

81 In the present case, it is apparent from the case-file that, in order to establish the existence of its earlier well-known marks in Spain, Ireland, Greece and the United Kingdom, the applicant produced before the Opposition Division, first, extracts from catalogues of its goods, showing that the trade name 'Boomerang' is used for a variety of sports clothing, accessories and equipment, secondly, a photograph of two zeppelin-shaped balloons which bear the word 'Boomerang' taken at a sporting event and, thirdly, various articles from Spanish newspapers relating to an indoor-soccer club called 'Boomerang Interviu' and, later, 'Boomerang', sponsored by the applicant.

82 It must therefore be held, as the Opposition Division rightly stated and the Board of Appeal confirmed in paragraph 41 of the contested decision, in which it adopted the grounds set out by the Opposition Division, that those documents do not prove that the trade marks at issue were used or even known or recognised in Ireland, Greece and/or the United Kingdom. Moreover, although those documents prove that at least some of the marks at issue were used by the applicant in Spain, they contain no information as to the duration and the extent of that use, the degree of knowledge or recognition of the trade marks at issue in Spain or any other information from which it might be inferred that the marks at issue are well known in Spain or in a substantial part of Spanish territory.

83 It follows that the Board of Appeal did not err in holding that the Opposition Division had rightly concluded that the applicant had not proved that the conditions set out in Article 8(2)(c) of Regulation No 40/94 were satisfied.

84 Indeed, as has been established in connection with the analysis of the first plea and as it stems from paragraph 76 above, the Board of Appeal was well founded in disregarding the documents produced for the first time before it by the applicant and in holding that the Opposition Division was not required to inform the applicant of the inadequacy of the evidence provided for the purpose of establishing the existence of its well-known marks within the meaning of Article 6bis of the Paris Convention.

85 The second limb of the second plea must therefore be rejected, as must the second plea in its entirety. It is not necessary, in the light of the foregoing, for the Court to rule in connection with this plea on the documents in annexes 10 to 12 to the application.

The third plea: infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

86 The applicant submits, first, that it is repeating its arguments set out during the proceedings before OHIM. It considers them to be ‘repeated in their entirety’ and, on the basis of them, requests that the application for registration submitted by the interveners be rejected.

87 Next, it points out that the word ‘boomerang’ is the dominant element in its family of earlier marks and that its dominant character is not affected by the presence of the word ‘aventura’ in some of those marks. Since consumers generally refer to trade marks orally, the figurative elements are also irrelevant. In addition, the ‘tv’ element of the mark applied for, being generic and descriptive, should not be taken into consideration in the comparison of the conflicting marks. The trade mark applied for therefore consists of the dominant element of the earlier marks. The Board of Appeal did not give sufficient consideration to that factor.

88 Moreover, the services referred to by the trade mark applied for and those covered by trade mark No 2 163 616 are identical or similar, even though the list of services for which registration of the trade mark Boomerang^{TV} was applied for was restricted in the course of the proceedings before OHIM. It is thus established that there is a likelihood of confusion as regards those two marks. So far as concerns the goods covered by the other earlier marks, a number of them, such as bags or clothing, might be used to support the promotion of activities in Class 41 in respect of which registration of the trade mark Boomerang^{TV} has been sought. The sector which the earlier marks cover, that is to say, the sports sector, is also linked to that of televised events and television productions. On account of that connection, and the fact that the word ‘boomerang’ is shared by the conflicting marks, it submits that a likelihood of confusion is established also with regard to those other earlier marks.

89 The highly distinctive character of the earlier marks, which are well known and have a reputation in the clothing and fashion sector in Spain, at least as the trade marks of an undertaking which itself has a reputation in Spain, further increases the likelihood of confusion in the present case.

90 Lastly, the applicant adds that the interveners have attempted without success to obtain registration of the trade mark Boomerang^{TV} in Spain in respect of services in Classes 38 and 41 — the extracts from the Sitadex database relating to those refusal decisions being included in annex 13 to the application — and that the OEPM rejected their application for registration because of a likelihood of confusion with the applicant’s earlier Spanish marks. OHIM should have taken that refusal into

consideration. The existence of conflicting decisions also undermines the harmonisation of the internal market. A judgment of the Tribunal Superior de Justicia de Madrid of 11 September 2003, included in annex 4 to the application, between the same parties and concerning the same trade marks, but limited to Class 41, also established the likelihood of confusion.

- 91 OHIM and the interveners dispute that there is a likelihood of confusion in the present case.

Findings of the Court

- 92 It should first be recalled that it is settled case-law that, under Article 44(1) of the Rules of Procedure of the Court of First Instance, which applies to intellectual property matters by virtue of Articles 130(1) and 132(1) of those rules, although specific points in the text of the application can be supported and completed by references to specific passages in the documents attached, a general reference to other documents cannot compensate for the failure to set out the essential elements of the legal argument, which must, under those provisions, appear in the application itself (Case T-270/02 *MLP Finanzdienstleistungen v OHIM (bestpartner)* [2004] ECR II-2837, paragraph 16, and Case T-256/04 *Mundipharma v OHIM — Altana Pharma (RESPICUR)* [2007] ECR II-449, paragraph 14).

- 93 Moreover, it is not for the Court to find in the file of the proceedings before OHIM the arguments to which the applicant might be referring or to examine them, since those arguments are inadmissible (see, to that effect, Case T-127/02 *Concept v OHMI (ECA)* [2004] ECR II-1113, paragraph 21, and Case T-209/01 *Honeywell v Commission* [2005] ECR II-5527, paragraph 57). Therefore, the application, in so far as it refers to the documents lodged by the applicant before OHIM, is inadmissible and it is only in the light of the arguments submitted in the application that the merits of this plea will be assessed.

94 It must also be borne in mind that the applicant does not dispute that the existence of Greek registration No 109 387 had not been established. Also, as is apparent from the analysis of the first and second pleas, the Board of Appeal was justified, first, in holding that the existence of trade marks Nos 2 163 613, 2 163 616 and 456 466 and the earlier well-known marks had not been proved before the Opposition Division and, secondly, to disregard the documents which had been produced for the first time before it. In addition, the documents produced for the first time before the Court are inadmissible (see paragraph 36 above). Lastly, although the documents in annexes 10 to 12 to the application (see paragraph 55 above) had already been produced by the applicant before the Board of Appeal, they must also be disregarded. Since the Board of Appeal was well founded in declaring those documents inadmissible (see paragraph 49 above), to admit that they are admissible before the Court would change the subject-matter of the proceedings as they have been assessed by the Board of Appeal, something which would be contrary to Article 135(4) of the Rules of Procedure (see paragraph 35 above).

95 Consequently, it is in the light only of those earlier registrations the existence of which was established to the requisite legal standard during the proceedings before the Opposition Division, namely Spanish registrations Nos 2 035 505, 2 035 507, 2 035 514, 1 236 024, 1 236 025, 1 282 250 and 2 227 731, United Kingdom registration No 1 494 568 and Irish registration No 153 228 and the Community trade mark application No 448 514, that the Court will assess the merits of this plea.

96 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered 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. Furthermore, under Article 8(2)(a)(i) and (ii) and (b) of Regulation No 40/94, 'earlier trade marks' means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark and applications for registrations of Community trade marks, subject to their registration.

97 The existence of a likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark was registered. Those conditions are cumulative (Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 51). Thus, where one of those essential conditions for the application of Article 8(1)(b) of Regulation No 40/94 is not satisfied, there can be no likelihood of confusion.

98 In the present case, it is common ground that the Board of Appeal relied solely on the lack of similarity between the conflicting goods and services in order to conclude that there was no likelihood of confusion. It is settled case-law that, in assessing the similarity of the goods and services in question, all the relevant factors relating to the way in which those goods and services are connected should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 23, and Case T-150/04 *Mühlens v OHIM — Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraph 29). Goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM — Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM — Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35).

99 However, the descriptions of the goods and services at issue in paragraphs 7 and 14 above show that the goods covered by the earlier rights differ by their nature, their intended purpose and their method of use from the services in respect of which registration of the mark Boomerang^{TV} has been applied for. In addition, those goods and those services are not in any way in competition with each other or complementary for the purposes of the case-law cited in the preceding paragraph. Consequently, the Board of Appeal acted correctly in law in concluding that the conflicting goods and services were not similar and, therefore, that there was no likelihood of confusion.

100 The fact that some of the goods covered by the earlier rights might be — which is not to concede that they are — used for the purposes of promoting the services in respect of which registration of the trade mark Boomerang^{TV} has been applied for, or that the sports sector, under which several earlier rights might fall, might be linked to that of television productions, in which the trade mark applied for falls, cannot undermine that finding. Such connections are too imprecise and coincidental to allow the conclusion that the goods and services in question are complementary within the meaning of the case-law cited in paragraph 98 above.

101 It stems from this that the applicant's arguments relating to the comparison of the conflicting marks and the highly distinctive character of its earlier marks are immaterial and must be rejected. As regards the decisions of the OEPM relating to the refusal to register the trade mark Boomerang^{TV} in Spain, these must be disregarded for the same reasons as those already set out in paragraph 94 above. As regards the judgment of the Tribunal Superior de Justicia de Madrid refusing registration of the trade mark Boomerang^{TV} in Spain, in annex 4 to the application, it need only be stated that the Community trade mark regime is an autonomous system which applies independently of any national system (Case T-32/00 *Messe München v OHIM (Electronica)* [2000] ECR II-3829, paragraph 47, and *TOSCA BLU*, cited in paragraph 98 above, paragraph 40). That judgment is therefore irrelevant and must be disregarded, without it being necessary to rule upon whether it is admissible (see, to that effect, *France v Commission*, cited in paragraph 78 above, paragraph 26).

102 In the light of all the foregoing, this plea must be rejected, without there being any need to rule on the alternative application by the interveners to restrict the list of services in respect of which they are applying for registration of the trade mark Boomerang^{TV}.

The fourth plea: infringement of Article 8(5) of Regulation No 40/94

Arguments of the parties

103 The applicant submits that its earlier marks, registered in particular for goods linked to the clothing, sports-fashion and sports sector, falling primarily within Classes 18, 24, 25 and 28, possess a reputation. It submits that the reputation of its marks, like its own reputation, has already been established during the proceedings before OHIM. The applicant also refers to its Internet site and to annexes 5 to 8 and 14 to the application, and offers to produce additional evidence.

104 The applicant claims that Article 8(5) of Regulation No 40/94 is applicable in the present case. The use without due cause of the trade mark applied for by the interveners would allow them to take unfair advantage of, or would be detrimental to the distinctive character or repute of, the applicant's earlier trade marks. Specifically, the distinctive character of those earlier marks would be weakened and their prestige might be lessened if the services designated by the trade mark Boomerang^{TV} are of poor quality and the proprietors of the Boomerang^{TV} mark would be able to save on certain advertising investments. In addition, it is possible that the applicant will diversify its activities into the field in which the mark applied for falls.

105 OHIM and the interveners contend in reply that, since the repute of the earlier marks has not been established, the Board of Appeal was right to conclude that the conditions for application of Article 8(5) of Regulation No 40/94 had not been satisfied.

Findings of the Court

106 Under Article 8(5) of Regulation No 40/94, ‘upon opposition by the proprietor of an earlier trade mark..., the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

107 According to the case-law, in order to satisfy the requirement of reputation, an earlier mark must be known to a significant part of the public concerned by the goods or services covered by that trade mark, that is to say, depending on the goods or services being marketed, either by the general public or by a more specialised public, such as a given professional circle. In examining that condition, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by the earlier mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. There is, however, no requirement for that mark to be known by a given percentage of the relevant public or for its reputation to cover all the territory concerned, so long as that reputation exists in a substantial part of that territory (Case T-8/03 *El Corte Inglés v OHIM — Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 67).

108 In the present case, for the same reasons as those set out in paragraph 94 above, only the evidence produced by the applicant before the Opposition Division and only the earlier rights referred to in paragraph 95 above will be taken into consideration by the Court for the purposes of analysing this plea.

109 In this regard, it is clear from the case-file that the documents produced by the applicant before the Opposition Division in order to establish the reputation of its earlier marks are those to which the Opposition Division referred as intending to prove the existence of the applicant's well-known marks. However, it is evident from paragraph 81 above, in which the documents in question are described, that the applicant has not provided any information relating to the intensity, geographical extent and duration of the use of its earlier rights, and the size of the investment made by the undertaking to promote them, or any other evidence demonstrating that its earlier rights are known by a significant part of their relevant public.

110 It follows that, although the degree of recognition to be proved regarding marks possessing a reputation within the meaning of Article 8(5) of Regulation No 40/94 is not as high as that in the case of well-known marks within the meaning of Article 6bis of the Paris Convention, the Board of Appeal did not err in law when it confirmed the finding of the Opposition Division that the reputation of the earlier marks had not been established and when it held, consequently, that Article 8(5) of Regulation No 40/94 was not applicable in the present case. Accordingly, the fourth plea must be rejected, as must the action in its entirety, without it being necessary for the Court to rule on the application for a measure of inquiry submitted by the interveners.

Costs

111 Under Article 87(2) 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 the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by OHIM and the interveners.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders El Corte Inglés SA to pay the costs.**

Wiszniewska-Białeczka

Moavero Milanesi

Wahl

Delivered in open court in Luxembourg on 17 June 2008.

E. Coulon

I. Wiszniewska-Białeczka

Registrar

for the President