

OPINION OF ADVOCATE GENERAL

TRSTENJAK

delivered on 29 November 2007¹

I — Introduction

1. The appellant — Les Éditions Albert René SARL — is requesting the Court to set aside the judgment of the Court of First Instance of the European Communities (Third Chamber) ('the Court of First Instance') in Case T-336/03 *Les Éditions Albert René v OHIM — Orange (MOBILUX)* [2005] ECR II-4667 ('the judgment under appeal'), by which the Court of First Instance dismissed its appeal against the decision of the Fourth Board of Appeal of the Office for Harmonization in the Internal Market (Trade marks and designs) (OHIM) of 14 July 2003 (Case R 0559/2002-4) relating to opposition proceedings between the appellant and Orange A/S ('Orange') concerning the opposition by the appellant, proprietor of the earlier trade mark 'OBELIX', to registration as a Community trade mark of the sign 'MOBILIX'. The Opposition Division dismissed the appellant's opposition; the fourth Board of Appeal upheld its appeal in part.

2. The appellant considers principally that, in that judgment, the Court of First Instance

failed to take account of the principle of the prohibition on *reformatio in pejus* and mechanically applied the doctrine of 'counteraction' when assessing the likelihood of confusion between the goods and services covered by two similar marks.

II — Legal framework

3. Article 8 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark,² as amended, governs relative grounds for refusal and provides as follows:

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

1 — Original language: French.

2 — OJ 1994 L 11, p. 1.

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;
- (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.
- (iii) trade marks registered under international arrangements which have effect in a Member State;
- (b) applications for the trade marks referred to in subparagraph (a), subject to their registration;

2. For the purposes of paragraph 1, “Earlier trade marks” means:

- (a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:
 - (c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, 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.
- ...

(i) Community trade marks;

5. Furthermore, upon opposition by the proprietor of an earlier trade mark within

the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

4. Article 74 of that regulation governs examination of the facts by the Office of its own motion and provides as follows:

‘1. In proceedings before it [OHIM] shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. [OHIM] may disregard facts or evidence which are not submitted in due time by the parties concerned.’

5. Article 44 of the Rules of Procedure of the Court of First Instance³ provides as follows:

‘1. An application of the kind referred to in Article 21 of the Statute of the Court of Justice shall state:

- (a) the name and address of the applicant;
- (b) the designation of the party against whom the application is made;
- (c) the subject-matter of the proceedings and a summary of the pleas in law on which the application is based;
- (d) the form of order sought by the applicant;
- (e) where appropriate, the nature of any evidence offered in support.

3 — OJ 1991 L 136, p. 1, corrigendum OJ 1991 L 317, p. 34.

2. For the purposes of the proceedings, the application shall state an address for service in the place where the Court of First Instance has its seat and the name of the person who is authorised and has expressed willingness to accept service.

In addition to or instead of specifying an address for service as referred to in the first subparagraph, the application may state that the lawyer or agent agrees that service is to be effected on him by telefax or other technical means of communication.

If the application does not comply with the requirements referred to in the first and second subparagraphs, all service on the party concerned for the purposes of the proceedings shall be effected, for so long as the defect has not been cured, by registered letter addressed to the agent or lawyer of that party. By way of derogation from the first paragraph of Article 100, service shall then be deemed to have been duly effected by the lodging of the registered letter at the post office of the place where the Court of First Instance has its seat.

3. The lawyer acting for a party must lodge at the Registry a certificate that he is authorised to practise before a Court of a Member State or of another State which is a party to the EEA Agreement.

4. The application shall be accompanied, where appropriate, by the documents specified in the second paragraph of Article 21 of the Statute of the Court of Justice.

5. An application made by a legal person governed by private law shall be accompanied by:

- (a) the instrument or instruments constituting and regulating that legal person or a recent extract from the register of companies, firms or associations or any other proof of its existence in law;
- (b) proof that the authority granted to the applicant's lawyer has been properly conferred on him by someone authorised for the purpose.

5a. An application submitted under Article 238 of the EC Treaty, Article 42 of the ECSC Treaty or Article 153 of the EAEC Treaty pursuant to an arbitration clause contained in a contract governed by public or private law, entered into by the Community or on its behalf, shall be accompanied by a copy of the contract which contains that clause.

6. If an application does not comply with the requirements set out in paragraphs 3 to 5 of this Article, the Registrar shall prescribe a reasonable period within which the applicant is to comply with them whether by putting the application itself in order or by producing any of the abovementioned documents. If the applicant fails to put the application in order or to produce the required documents within the time prescribed, the Court of First Instance shall decide whether the noncompliance with these conditions renders the application formally inadmissible.'

after hearing the Advocate General, allow the other party time to answer on that plea.

Consideration of the admissibility of the plea shall be reserved for the final judgment.'

6. Article 48 of the Rules of Procedure of the Court of First Instance provides as follows:

7. Article 135(4) of the Rules of Procedure of the Court of First Instance provides that the submissions of the parties may not change the subject-matter of the proceedings before the Board of Appeal.

'1. In reply or rejoinder a party may offer further evidence. The party must, however, give reasons for the delay in offering it.

III — Facts

2. 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.

8. On 7 November 1997, Orange filed an application with OHIM for registration of the word sign 'MOBILIX' as a Community trade mark under Regulation No 40/94.

If in the course of the procedure one of the parties puts forward a new plea in law which is so based, the President may, even after the expiry of the normal procedural time-limits, acting on a report of the Judge Rapporteur and

9. The goods and services in respect of which registration was sought are in Classes 9, 16, 35, 37, 38 and 42 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:

- ‘apparatus, instruments and installation for telecommunication, including for telephony, telephones and cellular telephones, including antennae, aerials and parabolic reflectors, accumulators and batteries, transformers and convertors, coders and decoders, coded cards and card for coding, telephone calling cards, signalling and teaching apparatus and instruments, electronic telephone books, parts and accessories (not included in other classes) for the aforementioned goods’ within Class 9;
 - ‘telephone calling cards’, within Class 16;
 - ‘telephone-answering service (for temporarily absent subscribers), business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties’, within Class 35;
 - ‘telephone installation and repairs, construction, repairs, installation’, within Class 37;
 - ‘telecommunications, including telecommunications information, telephone and telegraph communications, communications through computer screens and cellular telephones, facsimile transmission, radio and television broadcasting, including through cable television and the Internet, message sending, leasing of message sending apparatus, leasing of telecommunications apparatus, including of telephony apparatus’, within Class 38;
 - ‘scientific and industrial research, engineering, including projecting facilities and telecommunications installations, particularly for telephony, and computer programming, design, maintenance and updating of software, leasing of computers and computer programs’, within Class 42.
10. The Community trade mark application was the subject of an opposition brought by

the appellant based on the following earlier rights relating to the term ‘OBELIX’:

- the earlier registered trade mark, protected by registration of Community trade mark No 16 154 of 1 April 1996 in respect of certain goods and services in Classes 9, 16, 28, 35, 41 and 42 of the Nice agreement for the following goods and services in so far as they are relevant to the present proceedings:
 - ‘electrical and electronic photographic, cinematographic and optical teaching apparatus and instruments (except projection apparatus) so far as included in Class 9, electronic apparatus for games, with and without screens, computers, program modules and computer programs recorded on data carriers, especially video games’, within Class 9;
 - ‘paper, cardboard; goods made from paper and cardboard, printed goods (so far as included in Class 16) newspapers and magazines, books, book binding material, namely book-binding cords, cloth and other materials for bookbinding; photographs; stationery; adhesives (for paper and stationery); artists’ materials, namely goods for drawing, painting and modelling; paint brushes; typewriters and office requisites, (except furniture) and machines for office use (so far as included in Class 16); instructional and teaching material (except apparatus); plastic materials for packaging not included in other classes; playing cards; printers’ type; printing blocks’, within Class 16;
 - ‘games and playthings; gymnastic and sporting articles (so far as included in Class 28); decorations for Christmas trees’, within Class 28;
 - ‘marketing and publicity’, within Class 35;
 - ‘film presentation, film production, film rental; publication of books and magazines; education and entertainment; organisation and presentation of displays and exhibitions; public entertainment, amusement parks, production of live orchestral and spoken-word performances; presentation of reconstructions of historical-cultural and ethnological characters’, within Class 41;

- ‘accommodation and catering; photography; translations; copyright management and exploitation; exploitation of industrial property rights’, within Class 42.

the trade marks and, more particularly, by the very different concepts which they express: mobile phones in the case of ‘MOBILIX’ and obelisks in the case of ‘OBELIX’.

- the earlier well-known mark in all the Member States.⁴

11. In support of its opposition, the appellant argued that there was a likelihood of confusion within the meaning of Article 8(1)(b) and (2) of Regulation No 40/94.

12. By decision of 30 May 2002, the Opposition Division rejected the opposition and authorised the continuation of the procedure for registration of the application for a Community trade mark. The Opposition Division considered that it had not been conclusively demonstrated that the earlier trade mark was well known, and found that, overall, the trade marks were not similar. There was a certain aural similarity but that was counteracted by the visual appearance of

13. Following an appeal filed by the appellant on 1 July 2002, the Fourth Board of Appeal delivered its decision on 14 July 2003. It annulled in part the decision of the Opposition Division. The Board of Appeal stated, first of all, that the opposition should be regarded as being based exclusively on the likelihood of confusion. It then stated that it was possible to detect a certain similarity between the trade marks. In comparing the goods and services, the Board found that ‘signalling and teaching apparatus and instruments’ in the Community trade mark application and ‘optical and teaching apparatus and instruments’ in the earlier registration in Class 9 were similar. It reached the same conclusion in respect of the Class 35 services referred to as ‘business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties’ in the Community trade mark application and ‘marketing and publicity’ in the earlier registration. The Board found that, given the degree of similarity between the signs in question and between these particular goods and services, there was a likelihood of confusion in the mind of the relevant public. It therefore refused the application for a Community trade mark in respect of ‘signalling and teaching apparatus and instruments’, and services described as ‘business management and organisation consulting and assistance, consulting and assistance in connection with attending to business duties’, and granted it in respect of the other goods and services.

⁴ — See paragraph 5 of the judgment under appeal.

IV — Procedure before the Court of First Instance and the judgment under appeal

14. By an application filed with the Registry of the Court of First Instance on 1 October 2003, the appellant requested that the decision of the Board of Appeal of 14 July 2003 be annulled, raising three pleas in law: first, infringement of Article 8(1)(b) and (2) of Regulation No 40/94; secondly, infringement of Article 8(5) of Regulation No 40/94; and, thirdly, infringement of Article 74 of Regulation No 40/94. It must be pointed out that at the hearing, the appellant requested in the alternative that the case be referred back to the Fourth Board of Appeal in order to afford it the opportunity to prove that its mark had a reputation within the meaning of Article 8(5) of Regulation No 40/94.

15. In its judgment, the Court of First Instance first examined the admissibility of the five documents appended to the application and produced for the first time by the appellant before the Court of First Instance in order to prove that the sign 'OBELIX' was well known. Having found that those documents had not been produced in the context of the procedure before OHIM, the Court of First Instance, referring to Article 63 of Regulation No 40/94, declared them inadmissible inasmuch as to admit them would be contrary to Article 135(4) of the Rules of Procedure of the Court of First Instance (paragraphs 15 and 16 of the judgment under appeal). In this context,

the Court of First Instance referred to the characteristics of annulment proceedings, in which the legality of a measure before the court must be assessed on the basis of the elements of law and fact existing at the time when the measure was adopted.

16. The Court of First Instance then declared inadmissible the plea based on Article 8(5) of Regulation No 40/94, pointing out that at no time did the appellant request the Board of Appeal to apply that provision and that therefore the Board did not consider it. First of all, under Article 74 of Regulation No 40/94, in proceedings relating to relative grounds for refusal to register, OHIM is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. Secondly, since the purpose of applications to the Court of First Instance is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94, such review must be conducted with regard to the issues of law raised before the Board of Appeal. Thirdly, Article 135(4) of the Rules of Procedure states expressly that '[t]he parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal' (paragraphs 19 to 25 of the judgment under appeal).

17. Lastly, the Court of First Instance declared the head of claim put forward for the first time at the hearing inadmissible

under Article 44(1) of the Rules of Procedure of the Court of First Instance (paragraphs 28 and 29 of the judgment under appeal).

18. The Court of First Instance then went on to consider the merits of the substance of the pleas. With regard to the plea of infringement of Article 74 of Regulation No 40/94, according to which, in the absence of a challenge by the other party to the proceedings, the Board of Appeal ought to have assumed that the opponent's 'OBELIX' mark had a reputation, the Court of First Instance found in paragraphs 34 and 35 of the judgment under appeal that Article 74 of Regulation No 40/94 cannot be interpreted as meaning that OHIM is required to accept that points put forward by one party and not challenged by the other party to the proceedings are established. In this case neither the Opposition Division nor the Board of Appeal considered that the appellant had substantiated conclusively on the facts or evidence adduced the legal assessment advocated by it, namely that the unregistered sign was well known and that the registered sign was highly distinctive. Accordingly, in paragraph 36 of the judgment under appeal, the Court of First Instance declared that plea unfounded.

19. With regard to the plea based on Article 8(1)(b) and (2) of Regulation No 40/94, the Court of First Instance first assessed the similarity of the goods and services at issue. The Court rejected the

appellant's argument that the goods referred to in the Community trade mark application, included in Classes 9 and 16, were included in the extensively-worded list of goods and services at the time of the earlier registration; it stated in paragraph 61 of the judgment under appeal that the mere fact that a particular good is used as a part, element or component of other goods does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different. The Court of First Instance continued as follows, in paragraphs 62 and 63 of the judgment under appeal:

'62. Furthermore, it is clear from the list of goods and services falling within Class 9 covered by the earlier registration that the sectors covered by that right are photography, cinema, optics, teaching and video games. That list of goods and services is close to that which is claimed in the Community trade mark application, which shows that the sector in question is, almost exclusively, telecommunications of all forms. Telecommunications equipment falls within the category of "apparatus for recording, transmission or reproduction of sound and/or images", which forms part of the official title of Class 9 However, that part of the class title ("telecommunications") was not claimed in the earlier right, which implies that telecommunications equipment was not intended to be covered. The applicant registered its trade mark in respect of a large number

of classes, but it did not refer to “telecommunications” in the specification and it even excluded the whole of Class 38 from the registration. Class 38 concerns precisely “telecommunications” services.

63. The Court shares the view of the Board of Appeal that the earlier registration protects “electrotechnical apparatus and instruments, electronics”, but that that wide formulation cannot be used by the applicant as an argument for finding that the goods are very similar, still less that they are identical to the goods referred to in the application, when specific protection of telecommunications apparatus and instruments could have been easily obtained.’

20. After upholding the Board of Appeal’s finding that the services referred to in the trade mark application in Classes 37 and 42 and the services designated in the earlier registration and included in Class 42 were not similar (paragraph 67), the Court of First Instance held as follows:

- ‘68. Second, the Board of Appeal did not err when it asserted that the services listed in

the Community trade mark application under Class 38 ... are sufficiently different from those covered by the earlier registration and included in Class 41 ..., given their technical nature, the skills required to offer them and the needs of the consumers which they are intended to satisfy. Consequently, the services appearing in the trade mark application included in Class 38 are at most slightly similar to the services falling within Class 41 protected by the earlier right.

69. Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to “computers” and “computer programs” (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software. That exclusion is not in any event

legitimate in the present case, since the Community trade mark application is exclusively for telecommunications in their various forms, whereas the earlier registration makes no reference to any activity in that sector. Furthermore, as the Board of Appeal rightly pointed out, there is nothing to stop the applicant from also registering its trade mark in respect of telephony.'

21. Lastly, the Court of First Instance held, in paragraph 70 of the judgment under appeal, that 'the goods and services in question are not similar', with one exception: the 'leasing of computers and computer programs' which appeared in the Community trade mark application (Class 42) and the appellant's 'computers' and 'computer programs recorded on data carriers' (Class 9) were similar by reason of their complementarity.

22. With regard to comparison of the signs, after noting that the Board of Appeal had found in the contested decision that the signs at issue were similar (paragraph 74 of the judgment under appeal), the Court of First Instance undertook a visual, aural and conceptual comparison (paragraphs 75 to 81 of the judgment under appeal).

23. The Court of First Instance found, *inter alia*, that, despite the letter combination 'OB' and the 'LIX' ending, common to both, they had a number of significant visual differences, such as the letters following 'OB' ('E' in the first case and 'I' in the second), the beginning of the words (the Community trade mark applied for began with 'M' and the earlier mark with 'O') and their length. Having observed that the consumer's attention is usually directed to the beginning of the word, the Court of First Instance concluded that 'the signs in question are not visually similar or that, at most, they are visually very slightly similar' (paragraphs 75 and 76 of the judgment under appeal).

24. After carrying out an aural comparison of the signs, the Court of First Instance held that they had a certain aural similarity (paragraphs 77 and 78). As regards the conceptual comparison, the Court of First Instance found that, even if the term 'OBELIX' had been registered as a word mark, it would readily be identified by the average member of the public with the popular character from the comic strip, which makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar (paragraph 79 of the judgment under appeal). Since the word sign 'OBELIX' had, from the point of view of the relevant public, a clear and specific meaning so that the public was capable of grasping it immediately, the conceptual differences between the signs were such as to counteract the aural similarities and any visual similarities (paragraphs 80 to 81 of the judgment under appeal).

25. With regard to the likelihood of confusion, referring to Case T-311/01 *Les Éditions Albert René v OHIM — Trucco (STARIX)* [2003] ECR II-4625, the Court of First Instance stated that ‘the differences between the signs in question are sufficient to rule out any likelihood of confusion in the perception of the target public. Such a likelihood would presuppose that both the degree of similarity of the trade marks in question and that of the goods or services designated by those marks were sufficiently high’ (paragraph 82 of the judgment under appeal). It continued:

present case, the signs in dispute cannot be regarded as identical or similar, the fact that the earlier mark is widely known or enjoys a reputation in the European Union cannot alter the overall assessment of the likelihood of confusion (see to that effect, *Starix*, ..., paragraph 61).

‘83. In those circumstances, the Board of Appeal’s assessment of the distinctiveness of the earlier trade mark and the appellant’s claims as to the reputation of that trade mark have no bearing on the application of Article 8(1)(b) of Regulation No 40/94 in the present case (see, to that effect, *Starix*, ..., paragraph 60).

85. Lastly, the Court must reject the appellant’s argument that, because of the “IX” suffix, it is entirely conceivable that the term “MOBILIX” would insinuate itself into the family of trade marks made up of the characters from the “Asterix” series and that it would be understood as a derivation of the term “OBELIX”. It suffices to note in that regard that the applicant cannot claim an exclusive right to the use of the “IX” suffix.

84. A likelihood of confusion presupposes that the signs as well as the goods and services designated are identical or similar, and the reputation of a mark is one factor which must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a risk of confusion (see, to that effect and by analogy, *Canon*, ..., paragraphs 22 and 24). Since, however, in the

86. It is clear from the foregoing that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 has not been satisfied. It therefore follows that the Board of Appeal was right in finding that there is no likelihood of confusion between the mark claimed and the earlier mark.’

26. The Court of First Instance accordingly dismissed the action brought by the applicant in that case.

27. The applicant before the Court of First Instance brought an appeal against the judgment of that Court on 13 January 2006.

28. It must also be noted that this appeal, while admissible, does not comply with the recommendations set out in paragraph 44 of the Practice Directions relating to direct actions and appeals, owing to its length.⁵

29. At the hearing of 25 October 2007, the parties submitted observations and replied to the Court's questions.

V — Analysis of the appeal

30. The appellant puts forward six grounds in support of the appeal. By the first ground of appeal, it complains that the judgment under appeal infringed Article 63 of Regulation No 40/94 and ruled on the similarity of the

trade marks even though this did not form part of the subject-matter of the proceedings before the Court of First Instance. It thus infringed the principle of the prohibition on *reformatio in pejus*. By the second ground of appeal, the appellant pleads infringement of Article 8(1)(b) of Regulation No 40/94 with regard to the similarity of the goods and services and the similarity of the marks. By the third ground of appeal, the appellant complains that the Court of First Instance infringed Article 74 of Regulation No 40/94. By the fourth ground of appeal, it claims infringement of Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance. By the fifth ground of appeal, it complains that the Court infringed Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the appellant's head of claim seeking to have case referred back to the Board of Appeal. The sixth ground relates to the infringement of Article 63 of Regulation No 40/94 owing to the refusal to admit certain documents.

A — *First ground of appeal: alleged infringements of Article 63 of Regulation No 40/94 and of the general Community procedural law principle of prohibition on reformatio in pejus*

1. Arguments of the parties

31. The appellant claims that the judgment of the Court of First Instance infringed Article 63 of Regulation No 40/94 as well as the general principles of Community administrative and

⁵ — OJ 2004 L 361, p. 15.

procedural law in that it found, contrary to the contested decision of the Board of Appeal, that the conflicting marks, 'OBELIX' and 'MOBILIX', were not similar, thus ruling to the detriment of the appellant on a question which had not been raised in a formally correct manner, thus exceeding its jurisdiction in the review of decisions of the Boards of Appeal of OHIM in a case such as this one.

32. The appellant observes that the issue of the similarity of the trade marks in no way formed the subject-matter of the application to the Court of First Instance and ought therefore not to have formed part of the proceedings before the Court of First Instance. However, even though the question of the similarity of the marks was not raised by any party to the proceedings in accordance with the required conditions, the Court of First Instance none the less ruled on this point to the appellant's detriment and therefore in fact disregarded the prohibition on *reformatio in pejus*.

33. OHIM replies by referring to the judgment in Case C-39/97 *Canon* [1998] ECR I-5507 (paragraph 17 and operative part) that the first ground of appeal is manifestly without foundation. In fact the Court of First Instance was bound to re-examine the similarity of the signs in question. In its application the appellant challenged the findings of the Board of Appeal as to the likelihood of confusion. As the similarity of the signs was an aspect of those findings, it had necessarily to be examined by the Court

of First Instance in order to review the legality of the findings of the Board of Appeal in the light of Article 8(1)(b) of Regulation No 40/94 and to ensure its correct application.

34. Furthermore, OHIM points out that the Court of First Instance did not make changes to the Board of Appeal's decision. However, the prohibition on *reformatio in pejus* prevents an appeal court from going beyond the appellant's submissions and placing it in a position less favourable than that in which it would be if it had not brought the appeal. In this case the Court of First Instance did not alter the decision by which the Board of Appeal partially upheld the opposition. The appellant was therefore not placed in a situation more unfavourable than that in which it was before making its application to the Court of First Instance.

2. Assessment

35. Under the general principle of procedural law known as the prohibition on *reformatio in pejus*, a higher court competent to rule on a remedy, for example an appeal, cannot vary a contested decision of a lower court to the appellant's detriment, if the appellant is the only party to have sought that remedy.⁶

⁶ — Fasching, W., *Zivilprozessrecht*, 2nd edition, Vienna, 1990, p. 883; Rosenberg, L., Schwab, K.-H., Gottwald, P., *Zivilprozessrecht*, 16th edition, Munich, 2004, p. 983; Rechberger, W., Simotta, D.-A., *Zivilprozessrecht*, 6th edition, Vienna, 2003, pp. 454 and 455.

36. Also under the principle of the prohibition on *reformatio in pejus*, in general, the worst outcome of the remedy applied for by the appellant must be the dismissal of the application and the simple upholding of the contested decision.⁷

37. That applies in the appellant's case. The judgment under appeal places the appellant in the same position as before it brought its application before the Court of First Instance. From that point of view it is difficult to see how this can be regarded as a case of *reformatio in pejus*.

38. The prohibition on *reformatio in pejus* before the Community Courts is limited by the courts' duty to raise of their own motion pleas of public policy.⁸ A plea of substantive legality can only be examined before the Community Courts at the appellant's request whereas a plea of public policy can, and indeed must, be raised by the Court of its own motion.⁹

7 — Rechberger, W, Simotta, D.-A., op. cit., p. 455. The authors point out that there may be a change to the defendant's advantage only if the defendant has also appealed against the same decision before the same court.

8 — Fasching, W., *Zivilprozessrecht*, p. 884.

9 — On the definition of public policy pleas in Community law, see Lenaerts, K., Arts, D., Maselis, I., Bray R., *Procedural Law of the European Union*, 2nd edition, London 2006, pp. 288 and 289; Sladić, J., 'Die Begründung der Rechtsakte des Sekundärrechts der EG in der Rechtsprechung des EuGH und des EuG', *Zeitschrift für Rechtsvergleichung, internationales Privatrecht und Europarecht*, 46(2005), p. 127, and Castillo de la Torre, F., 'Le relevé d'office par la juridiction communautaire', *Cahiers de droit européen*, 3-4/2005, p. 395 (421).

39. It must be pointed out that the concept of public policy in the context of pleas before the Community courts¹⁰ is 'reserved to matters which, owing to their importance to the public interest, are not left to the discretion of the parties or of the Court and must be examined as a preliminary issue even though they have not been raised by the parties'.¹¹

40. The appellant complains that in the judgment under appeal the Court of First Instance examined of its own motion the legality of the decision of the Board of Appeal from the viewpoint of the issue of similarity even though it did not claim an infringement thereof. It considers that this amounts to *reformatio in pejus* because the Court of First Instance examined a plea which it did not raise in its appeal.

41. It must be pointed out that the appellant did not challenge the legality of the Board of

10 — It must be noted that the concept of pleas that are typical of, for example, French and Belgian law corresponds fairly closely to the notion in Roman law of an *actio*. The application of this system before the Community courts and the division into public policy pleas and substantive legality pleas have rightly been criticised in the commentaries by former judges of the Court of Justice. Indeed the former German judge Ulrich Everling considers that parties not from countries with a civil law system based on French legal tradition encounter difficulties with this system owing to the division between matters which are indivisible before the courts (Everling, U., 'Das Verfahren der Gerichte der EG im Spiegel der verwaltungsgerichtlichen Verfahren der Mitgliedstaaten', *Die Ordnung der Freiheit: Festschrift für Christian Starck zum siebzigsten Geburtstag*, 2007, p. 542).

11 — Opinion of Advocate General Ruiz-Jarabo Colomer in 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-267, point 217.

Appeal's findings on the question of the similarity of the 'OBELIX' and 'MOBILIX' signs and the goods and services protected by the two marks. Yet it is none the less apparent from the application to the Court of First Instance, and in particular paragraph 2.3 et seq. thereof, that the appellant referred to the matter of the similarity of the 'OBELIX' and 'MOBILIX' signs and the goods and services protected by the two marks, as well as the likelihood of confusion, in its action before the Court of First Instance. In fact, it raised the arguments on the question of the similarity of the abovementioned marks and signs in the context of the plea of substantive legality relating to the infringement of Article 8(1)(b) and (2) of Regulation No 40/94. In the context of that plea, it argued before the Court of First Instance in exploring the claim of infringement of the well-known and highly distinctive nature of the 'OBELIX' mark that there was strong conceptual and aural similarity between the 'OBELIX' and 'MOBILIX' signs.¹² It also argued that there was a likelihood of conceptual confusion as a result of the interdependence between the similarity of the goods, the similarity of the trade marks, and the distinctiveness of the 'OBELIX' trade mark.¹³ It thus included the question of the similarity of the 'OBELIX' and 'MOBILIX' signs within the subject-matter of the proceedings.

42. The subject-matter of the proceedings as set out by the appellant under Article 63 of Regulation No 40/94 also included the issue of the similarity of the 'OBELIX' et 'MOBILIX' signs. Accordingly, the appellant cannot accuse the Court of First Instance of ruling on the question of the similarity of the

'OBELIX' and 'MOBILIX' signs in the context of an analysis of the interdependence of the factors involved.

43. The Court of First Instance did not infringe either Article 63 of Regulation No 40/94 or the general principle of procedural law of the prohibition on *reformatio in pejus*.

44. The ground of appeal cannot succeed.

B — Second ground of appeal: alleged infringement of Article 8(1)(b) of Regulation No 40/94 owing to the similarity of the goods and services and the similarity of the marks

1. Arguments of the parties

45. By this ground of appeal, which is of considerable length and divided into two limbs, the appellant alleges infringement of

¹² — Report for the Hearing in Case T-336/03, paragraphs 31 to 33.

¹³ — Report for the Hearing in Case T-336/03, paragraphs 34 to 35.

Article 8(1)(b) of Regulation No 40/94 owing to the similarity of the goods and services and the similarity of the trade marks.

connected and where they appear on the market under identical marks and the earlier mark is highly distinctive and very widely known.

46. By the first limb, the appellant alleges that, when assessing the similarity of the goods and services, the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94. First of all, the appellant criticises the Court of First Instance for having applied an incorrect legal principle to determine whether the respective goods and services were similar. By the second limb of the second ground of appeal, the appellant alleges that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94 in taking the view that the contested marks were dissimilar.

48. Secondly, the appellant challenges the consistency and basis of the specific findings as to the similarity of the goods made by the Court of First Instance, which manifestly misread the list of goods and distorted it. According to the appellant, the Court of First Instance's statement in paragraph 62 of the judgment under appeal that 'it is clear from the list of goods and services falling within Class 9 covered by the earlier registration that the sectors covered by that right are photography, cinema, optics, teaching and video games' is incorrect and contradicted by the list of those of those goods and by the Court's own statements in paragraph 63. The statement, in paragraph 62 of the judgment under appeal, that the field covered by the 'MOBILIX' trade mark is almost exclusively telecommunications in all its forms is also contradicted by the list of goods, which includes 'accumulators and batteries', 'transformers and converters', 'coders and decoders', 'coded cards' and 'cards for coding', and is not limited to telecommunications.

47. With regard to the first limb, the appellant states that a comparison of similarity should have been made, assuming that the conflicting marks are identical and that the earlier 'OBELIX' mark is highly distinctive or has a reputation. The correct legal criterion is therefore as follows: the goods (and services) are similar where the public could believe that they come from the same undertakings or from undertakings that are economically

49. With regard to the comparison of the 'MOBILIX' services within Classes 35, 37, 38 and 42 and the goods covered by the 'OBELIX' trade mark, the appellant alleges a contradiction between the findings of the Court of

First Instance in paragraph 68 of the judgment under appeal ('the services appearing in the trade mark application included in Class 38 are at most slightly similar to the services falling within Class 41 protected by the earlier right') and the conclusion in paragraph 70 of the judgment under appeal that the goods and services in question are not similar; it also challenges the finding of the Court of First Instance rejecting the appellant's argument that all the goods and services covered by the Community trade mark application are connected with 'computers' and 'computer programs' (Class 9) covered by the earlier trade mark (paragraph 69 of the judgment under appeal).

similarity, is not supported by any of the facts submitted to that Court. With regard to conceptual comparison, the appellant challenges the finding of the Court of First Instance in paragraph 79 of the judgment under appeal, which states that '[the] specific representation of a popular character makes it extremely unlikely that there could be any confusion in the public mind between words which are more or less similar'. The Court of First Instance's reasoning is incorrect, since according to general principles accepted in trade mark law, the more well-known or distinctive an earlier mark is, the greater the likelihood of confusion.

50. By the second limb of the second ground of appeal, the appellant alleges that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94, in holding that the contested trade marks were dissimilar. This limb is advanced by way of alternative to the appellant's first ground of appeal. According to the appellant, the Court of First Instance did not apply the correct legal tests for assessing the similarity of the marks. With regard to visual similarity, the Court of First Instance arbitrarily highlighted the differences between the marks, whereas under general trade mark law principles, points in common are usually more significant than points of difference. The appellant alleges that the assessment of aural similarity made by the Court of First Instance, like that of conceptual

51. The appellant also complains that the Court of First Instance applied the doctrine of 'counteraction' in paragraphs 80 to 82 of the judgment under appeal. According to the appellant, this doctrine is applicable only at the final assessment stage of the likelihood of confusion, but not where the conflicting marks are visually or aurally, or visually and aurally, similar. Therefore the correct legal criterion would have been as follows: two marks are similar (and, having found that the goods or services are similar or identical, the decision-making authority must therefore examine the likelihood of confusion) if there is (some, or a high degree of, or total) visual similarity (which also implies a degree of aural similarity), or whether there is (some, or a

high degree of, or total) aural similarity, irrespective of whether or not there is conceptual similarity. Likewise, two marks are similar even if there is no visual or aural similarity where they are conceptually identical or similar.

52. Lastly, the appellant states that the Court of First Instance misunderstood its argument in stating in paragraph 85 of the judgment under appeal that it relies on an exclusive right to the use of the suffix 'IX', whereas it stated that it was the proprietor of a family of trade marks created in a similar way to 'MOBILIX' using a descriptive part which represents a person's profession or activity and combining it with the suffix 'IX'. Therefore the allusion to 'mobile' does not distance it from the family of trade marks but even increases the likelihood of confusion, since the existence of a family of trade marks is generally considered to be a discreet cause of the likelihood of confusion, even in the absence of aural and visual similarity.

53. OHIM contends that among the many arguments advanced by the appellant the only question of law is whether the Court of First

Instance was entitled in law to conclude, in paragraph 81 of the judgment under appeal, that the conceptual differences between the signs in question are such as to counteract the existing aural and visual similarities. The Court of First Instance correctly examined all the evidence which, according to established case-law, must be taken into account in order to make a global assessment of the likelihood of confusion. According to settled case-law, such a global assessment entails that the conceptual and visual differences between two signs may counteract aural similarities between them in as much as at least one of the signs, from the point of view of the relevant public, has a clear and specific meaning, so that that public is likely to grasp it immediately. Whether such 'counteraction' actually occurs in the mind of the relevant consumer is a question of assessing the relevant facts. The result of this assessment is a finding of fact which is not subject to review by the Court of Justice in the context of an appeal.

54. With regard to the argument that the Court of First Instance should have taken account of the reputation of the 'OBELIX' trade mark in its comparison of the goods and services and the signs in question, OHIM argues that the appellant is confusing two concepts, namely the reputation of Obelix, the well-known comic strip character, and the potential reputation of the 'OBELIX' trade mark. There is neither a legal principle nor any precedent according to which a famous literary character must automatically be

regarded as a well-known trade mark. It all depends on the circumstances of the case and the appellant has never adduced, in the context of the procedure before OHIM, any evidence showing that the progressive transformation of a famous character into a well-known trade mark had actually occurred. Therefore, by declining to take account of the reputation of the Obelix name, which designates a famous comic strip character, in order to define the scope of protection of the earlier mark, the Court of First Instance was correct to apply the rule that, in opposition proceedings relating to relative grounds for refusal to register, the competent authority is restricted to the facts, evidence and arguments provided by the parties and the relief sought.

55. OHIM states that, by adhering to the principles established by the Court of First Instance, but challenging its conclusions, the appellant is reopening the factual assessments made by the Court of First Instance, which it is not for the Court of Justice to review in the context of an appeal.

56. With regard to the assertions that the Court of First Instance distorted the facts or evidence, OHIM takes the view that the Court of First Instance correctly reproduced the list of goods and services and made a comparative analysis based on factors such as the type of manufacturer or the distribution method for the goods. OHIM considers that the second ground of appeal must be rejected as partly unfounded and partly inadmissible.

2. Assessment

57. 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 thus 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 does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice.¹⁴

58. For the purposes of the application of Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where a trade mark is identical to a mark the highly distinctive character of which is particularly marked, to adduce evidence of similarity between the goods and services covered. In fact, the provision states that a likelihood of confusion presupposes that the goods or services covered are identical or similar.

59. The likelihood of confusion presupposes that the goods or services covered are identical or similar. Accordingly, even where

¹⁴ — Case C-37/03 P *BioID v OHMI* [2005] ECR I-7975, paragraph 43.

a trade mark is identical to a mark the highly distinctive character of which is particularly marked, it is still necessary to adduce evidence of similarity between the goods or services covered.¹⁵

60. In those circumstances the appellant's argument, to the effect that the Court of First Instance erred in law by applying an incorrect legal criterion or no legal criterion but merely a line of argument containing contradictory assertions, is unfounded.

61. It follows from the examination of paragraphs 60 to 71 of the judgment under appeal that, having made a detailed analysis of the various factors characterising the relationship between the goods and services in question, the Court of First Instance was justified in considering, without erring in law, that the goods and services covered by the 'MOBILIX' trade mark are not similar to the services designated by the 'OBELIX' sign.

62. With regard to the argument that there is a clear contradiction on the part of the Court of First Instance between paragraphs 62 and 63 of the judgment under appeal, and that there are inaccuracies in paragraph 63 of the judgment under appeal, it must be noted that that argument essentially challenges the findings of fact made by the Court of First Instance

and amounts to asking the Court of Justice to substitute its own appraisal of the facts for the findings made by the Court of First Instance in paragraphs 62 and 63 of the judgment under appeal. That argument of the appellant must therefore be rejected as manifestly inadmissible.

63. For those same reasons, the appellant's argument that the Court of First Instance did not correctly analyse the goods in Classes 9 and 16 respectively must be dismissed. In the light of the analyses made by the Court of First Instance, the same conclusion must be reached in relation to the complaint that the Court of First Instance merely conducted a literal comparison of the goods and services, and failed to take account of their economic relationship, and in particular disregarded the question whether the relevant public would attribute the same commercial origin to them where the goods and services have been offered under an identical mark.

64. In that context, the complaint relating to the issue of whether the Court of First Instance was entitled to conclude, in paragraph 81 of its judgment,¹⁶ that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above, must be rejected. First of all, it must be pointed out that the Court of First Instance correctly applied, in paragraphs 72 and 74 to 80, the criteria set out in the case-

16 — The wording of that paragraph is as follows: 'It follows that the conceptual differences separating the signs at issue are, in the present case, such as to counteract the aural similarities and any visual similarities noted above'.

15 — Case C-196/06 P *Alecansan v OHIM*, paragraph 37.

law. Secondly, it is also clear from paragraph 79 of the judgment under appeal relating to the words ‘MOBILIX’ and ‘OBELIX’ that the Court of First Instance made certain factual findings therein and that the appellant is seeking to challenge the assessment of the facts made by the Court of First Instance and is in reality requesting that the Court substitute its own assessment of the facts for the findings of the Court of First Instance.

65. It is therefore clear from all of the foregoing considerations that the ground of appeal must be rejected as unfounded.

C — Third ground of appeal: alleged infringement of Article 74 of Regulation No 40/94 by rejecting the claim that the ‘OBELIX’ trade mark was well known and had a highly distinctive character

1. Arguments of the parties

66. The appellant complains that the Court of First Instance infringed Article 74 of Regulation No 40/94 by rejecting the claim that the

‘OBELIX’ trade mark was well known and highly distinctive. The appellant challenges the correctness of the finding made by the Court of First Instance that OHIM assessed the facts and evidence since it was obliged to do so under Article 74(1) of Regulation No 40/94, but found them to be insufficient to establish that the unregistered sign was well known and that the registered sign was highly distinctive. Since Orange did participate in the proceedings before the Board of Appeal but failed to contest or otherwise challenge the appellant’s allegations, it would be absurd to require it to provide all the evidence, since there is no rule or principle of Community law that requires a party to produce evidence to prove something that is common ground between the parties. Indeed, the Opposition Division and the Board of Appeal expressly recognised the fact that the ‘OBELIX’ sign was well known. The Board of Appeal should therefore have concluded that the ‘OBELIX’ mark is highly distinctive and well known. Furthermore, since well-known facts need not be proved, the same principle ought to apply to well-known trade marks.

67. OHIM considers that the third ground of appeal must be rejected as manifestly unfounded. The restrictions placed on which facts may be included in the Board of Appeal’s examination under Article 74 of Regulation No 40/94 does not preclude the Board of Appeal from taking into consideration well-known facts other than those pleaded by the parties to the opposition proceedings. However, what might be regarded as well

known in the present case is that Obelix is the name of a comic strip character. Yet that finding cannot apply as such to the OBELIX trade mark, as there is no precedent for saying that famous literary characters must be regarded as well-known trade marks.

68. Even if the parties do not disagree on the question of the reputation of the 'OBELIX' trade mark, the Court of First Instance is not bound by such a finding but is required to consider whether, by finding in the contested decision that there was no similarity between the marks, the Board of Appeal perhaps infringed Regulation No 40/94. In the context of inter partes proceedings before OHIM, there is no principle that requires that facts not contested by the other party should be regarded as established.

2. Assessment

69. As a preliminary matter, it must be pointed out that the appellant challenges the legality and correctness of the assessment of reputation made by the Board of Appeal and the Court of First Instance in the judgment under appeal.

70. As pointed out in paragraph 57, an appeal lies on points of law only. The Court of First Instance thus has exclusive jurisdiction to find and assess the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice.

71. By contrast, provided that the appellant challenges the interpretation or application of Community law by the Court of First Instance, the points of law examined at first instance may be discussed again in the course of an appeal. Indeed, if an appellant could not thus base his appeal on pleas in law and arguments already relied on before the Court of First Instance, an appeal would be deprived of part of its purpose.¹⁷

72. With regard to the merits of the third ground of appeal, it must be pointed out that under Article 74(1) of Regulation No 40/94, in the course of the procedure, OHIM is to examine the facts of its own motion; however, in proceedings relating to the relative grounds for refusal of registration, the examination is restricted to the facts, evidence and arguments provided by the parties and the relief

¹⁷ — Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 48.

sought. In that regard, an appellant who refers to well-known facts is in a position to challenge the accuracy of the Board of Appeal's findings of fact relating to reputation before the Court of First Instance.

D — Fourth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and of Article 135(4) of the Rules of Procedure of the Court of First Instance by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94

73. The finding by the Court of First Instance as to whether the facts on which the Board of Appeal of OHIM based its decision are well known, including also the issue of whether the 'OBELIX' sign is well known, is a factual assessment which, save where the facts or evidence are distorted, is not subject to review by the Court of Justice on appeal.¹⁸ However, there is no evidence of distortion in this case.

1. Arguments of the parties

74. Therefore, the Court of First Instance did not err in law by holding, in paragraphs 32 to 36 of the judgment under appeal, that the legal finding as to how well known and distinctive the OBELIX sign is was not sufficiently supported by facts or evidence.

76. According to the appellant, the Court of First Instance infringed Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the appellant's application to the Court of First Instance for annulment of the contested decision on the ground that the Board of Appeal did not apply Article 8(5) of Regulation No 40/94. The Court of First Instance erred in law in relying on an incorrect interpretation of the subject-matter of the appeal procedure; nor did it take account of the fact that the Board of Appeal could not limit itself to examining the facts or evidence relied on before it but ought to have extended its examination to the facts produced at first instance, even if that question was not expressly raised in the grounds of the appeal.

75. The third ground of appeal must therefore be dismissed as unfounded.

¹⁸ — Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 53.

77. The appellant states that, while the arguments on which it relied before the Board of Appeal related to Article 8(1)(b) of Regulation No 40/94, a reasonable reading of the documents adduced in the context of the opposition proceedings and the appeal make it clear that the appellant maintained throughout that it was the proprietor of the 'OBELIX' trade mark, which is protected simultaneously as a registered Community trade mark, as a well-known mark pursuant to Article 8(2)(c) of Regulation No 40/94 and as a famous trade mark. The appellant has always maintained that a trade mark that is well known and that comes within Article 8(2)(c) of Regulation No 40/94 was also a mark with a reputation for the purposes of Article 8(5) of Regulation No 40/94.

78. The Board of Appeal's finding that the appellant expressly limited its appeal to matters pertaining to Article 8(1) of Regulation No 40/94 is incorrect and was challenged by the appellant before the Court of First Instance. The appellant also debated before the Court of First Instance the relationship between Articles 8(2) and 8(5) of Regulation No 40/94 to establish that the marks protected by those provisions have the same meaning today. The Court of First Instance did not examine that argument in

substance in the judgment under appeal, and ruled that head of claim inadmissible.

79. OHIM replies that this ground of appeal is manifestly unfounded. In fact, in its notice of opposition, the appellant, by ticking the appropriate boxes, based its opposition on two grounds — likelihood of confusion with an earlier trade mark and the gain unduly realised from the distinctiveness or reputation of an earlier mark or the adverse effect on it — when it provided the evidence in support of its opposition. The appellant did not, however, rely on the latter ground of opposition, namely Article 8(5) of Regulation No 40/94. Notwithstanding this evidential deficiency, the Opposition Division of OHIM referred to that provision, stating that there was no need to examine the merits of the opposition in the light of Article 8(5) of Regulation No 40/94 since the signs were not similar. When it appealed against that decision, the appellant did not ask the Board of Appeal to apply Article 8(5) of Regulation No 40/94; nor, moreover, did it mention the provision in its statement of grounds of appeal. In the light of the foregoing, and of the fact that the appellant has never identified the earlier mark the distinctiveness or reputation of which was adversely affected by the Community trade mark application, the Board of Appeal found that the documents produced in the context of the opposition proceedings were, rather, intended to demonstrate the reputation of the unregistered mark which was presented as one of the two earlier rights, or possibly the greater distinctiveness of the

registered mark, but not its reputation within the meaning of Article 8(5) of Regulation No 40/94. The Board of Appeal did not therefore rule on the applicability of Article 8(5) of Regulation No 40/94.

the contested decision of the Board of Appeal¹⁹ and from the submissions of the parties in the context of the present appeal and from the judgment under appeal and the Court of First Instance's Report for the Hearing that the plea of infringement of Article 8(5) of Regulation No 40/94 was put forward for the first time before the Court of First Instance.

80. Yet, rather than stating that the Board of Appeal had infringed Article 74 of Regulation No 40/94 by failing to consider Article 8(5) of Regulation No 40/94, the appellant claimed in its later application to the Court of First Instance that the Board had infringed Article 8(5) of Regulation No 40/94. Since the Board of Appeal had not considered Article 8(5) of Regulation No 40/94, the Court of First Instance concluded correctly, in the light of Article 135(4) of its Rules of Procedure, that the appellant's application to the Court of First Instance to determine the applicability of that provision was inadmissible.

82. It must be observed that, as the appellant points out,²⁰ it is not easy to distinguish between well-known trade marks and those with a reputation. In fact, there is some similarity between Articles 8(1) and (2) of Regulation No 40/94, on the one hand, and Article 8(5) of the same regulation, on the other. However, the reference to reputation and being well known in Article 8(2)(c) of Regulation No 40/94 and the reference in Article 8(5) of that regulation, which relates to the situation where the goods and services of two trade marks of which one has a reputation in the Community, cannot be said to be similar. An interpretation to the effect that Article 8(5) of Regulation No 40/94 is but the continuation of Articles 8(1) and (2) and that they must be examined together even though Article 8(5) was not relied on before the OHIM departments fails to take account of the scope of application of Article 8(5). In fact, on a schematic interpretation, it is clear both from the internal system and the external system of Article 8 of Regulation No 40/94 that the criteria contained in subparagraphs (1), (2) and (5) of Article 8 are different. The external system, that is to say the structure of the provision, clearly shows that subparagraphs (1), (2) and (5) of Article 8 of the

2. Assessment

81. As a preliminary point it must be pointed out that the appellant did not, in its opposition or its appeal to the Board of Appeal, request a review of legality under Article 8(5) of Regulation No 40/94. Indeed it is clear from

¹⁹ — Decision of the Fourth Board of Appeal of 14 July 2003, Case R 559/2002 — 4, paragraph 7.

²⁰ — Appeal, paragraph 143.

regulation are distinct. Under the internal system, that is to say the way in which the content of the provision is arranged, the aims of the paragraphs are different.²¹

83. From this viewpoint, the appellant, having failed to contest the legality of the decision of the Opposition Division and the Board of Appeal in the light of Article 8(5) of Regulation No 40/94, cannot make good its own failure by referring to similar provisions.

84. Furthermore, in the context of the annulment proceedings regarding the decision referred to the Community courts, the legality of the contested measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted.²² The same is true of the proceedings under Article 63 of Regulation No 40/94. In fact it is settled case-law that an appeal under that article relates to the legality of the decisions of the Boards of Appeal of OHIM within the meaning of Article 63(3) of Regulation No 40/94. Indeed, whereas under Article 63(3) of Regulation No 40/94, the Court of First Instance ‘has jurisdiction to annul or to alter the contested decision’, that paragraph must also be read in the light of the previous

paragraph under which ‘[t]he 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’, and in the context of Articles 229 EC and 230 EC. The Court’s review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal.²³ It is common ground that Article 8(5) of Regulation No 40/94 was not one of the issues of law raised before the Board of Appeal.

85. Therefore the appellant could not have required the Court of First Instance to rule on this ground of appeal, which is based on a possible infringement of Article 63 of Regulation No 40/94 and of the Rules of Procedure of the Court of First Instance, by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94, a plea which was not put forward during the administrative phase of the procedure before OHIM.

86. The Court of First Instance did not, by rejecting the plea based on Article 8(5) of Regulation No 40/94 as inadmissible, infringe Article 63 of Regulation No 40/94 or Article 135(4) of the Rules of Procedure of

21 — On the concepts of internal and external systems, see Heck, P., ‘Das Problem der Rechtsgewinnung’, *Gesetzesauslegung und Interessenjurisprudenz, Begriffsbildung und Interessenjurisprudenz*, Berlin, Zürich, 1968, pp. 188-189.

22 — Joined Cases 15 and 16/76 *France v Commission* [1979] ECR 321, paragraph 7. In that case, the French Republic was contesting the legality of certain decisions relating to the clearance of accounts submitted by the French Republic as expenses for the financial years 1971 and 1972 financed by the European Agricultural Guidance and Guarantee Fund (EAGGF) by relying on regularisation after the adoption of the decisions on the anomalies that were found.

23 — Case T-373/03 *Solo Italia v OHIM — Nuova Sala (PARMI-TALIA)* [2005] ECR II-1881, paragraph 25.

the Court of First Instance by rejecting the form of order seeking annulment of the contested decision for failure to apply Article 8(5) of Regulation No 40/94. This ground of appeal is unfounded.

Article 8(5) of Regulation No 40/94, or itself rule on the complaint based on Article 8(5) of Regulation No 40/94, it should in any event refer the case back to the Board of Appeal in order to enable the appellant to establish that assertion before it.

E — Fifth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance by declaring inadmissible the head of claim seeking referral of the case back to the Board of Appeal

1. Arguments of the parties

87. The appellant considers that the judgment of the Court of First Instance infringed Article 63 of Regulation No 40/94 and Articles 44, 48 and 135(4) of the Rules of Procedure of the Court of First Instance in that it declared inadmissible the head of claim, put forward in the alternative at the hearing, seeking referral of the case back to the Board of Appeal in order to enable the appellant to establish the reputation of the 'OBELIX' trade mark. At the hearing before the Court of First Instance, the appellant submitted that, if the Court of First Instance were to uphold the principal form of order sought, to the effect that the Board of Appeal had infringed

88. The appellant claims first of all that the form of order seeking referral back to the Board of Appeal to enable the appellant to establish the claim based on Article 8(5) of Regulation No 40/94 is not a 'new' form of order sought, but a form of order sought in the alternative based on Article 8(5) of Regulation No 40/94. The form of order sought in the alternative necessarily falls outside the main form of order sought and does not therefore constitute a 'new' form of order sought within the meaning of the judgment under appeal. Secondly, the Court of First Instance seems to have viewed the notion of 'subject-matter' as used in Article 135(4) of its Rules of Procedure as something which is amended every time a 'form of order sought' is added to the initial form of order sought, irrespective of its nature or context. The subject-matter of the proceedings before the Board of Appeal was whether 'MOBILIX' could be registered as a Community trade mark for some or all of the goods for which it was filed, given the opposition filed by the appellant on the basis of its 'OBELIX' trade mark. In no way did the appellant change this subject-matter, and the principal form of order seeking annulment of the Board of Appeal's contested decision necessarily encompasses all the forms of order sought in that connection.

89. The appellant claims that Article 44 of the Rules of Procedure of the Court of First Instance does not prohibit, either expressly or impliedly, the setting-out of forms of order sought in the alternative in the principal form of order sought at a stage of the proceedings subsequent to the filing of the originating application. Nor, similarly, does Article 48 of the Rules of Procedure of the Court of First Instance contain any such prohibition.

90. OHIM contends that this ground of appeal is manifestly unfounded. Furthermore, this head of claim submitted in the alternative is based on a new plea in law claiming that the Board of Appeal infringed Article 74(1) of Regulation No 40/94 by failing to rule on the applicability of Article 8(5) of Regulation No 40/94, and was only raised by the appellant when it realised that its claim of infringement of Article 8(5) was inadmissible. Given that this head of claim put forward in the alternative was only submitted at the hearing stage, the Court of First Instance was correct in declaring it inadmissible, relying on Articles 44 and 48 of the Rules of Procedure of the Court of First Instance.

2. Assessment

91. As is also noted in paragraphs 57 and 70 with regard to possible procedural irregu-

larities, under the first paragraph of Article 225 EC and the first paragraph of Article 58 of the Statute of the Court of Justice, an appeal lies on points of law only. According to the latter provision, an appeal may lie on grounds of lack of competence of the Court of First Instance, a breach of procedure before it which adversely affected the interests of the appellant, or the infringement of Community law by the Court of First Instance.²⁴ Thus, the Court of Justice has jurisdiction to verify whether a breach of procedure adversely affecting the appellant's interests was committed before the Court of First Instance and must satisfy itself that the general principles of Community law and the Rules of Procedure applicable to the burden of proof and the taking of evidence have been complied with.²⁵

92. The form of order sought, as referred to in Article 38(1) of the Rules of Procedure of the Court and Article 44(1)(d) of the Rules of Procedure of the Court of First Instance, specifies the subject-matter of the application²⁶ and contains the operative part of the decision which the applicant seeks to obtain from the Community courts.²⁷ Accordingly, it is part of the subject-matter of the proceedings and must be stated in the application.

24 — Case C-185/95 P *Baustahlgewebe v Commission* [1998] ECR I-8417, paragraph 18.

25 — Case C-13/99 P *TEAM v Commission* [2000] ECR I-4671, paragraph 36.

26 — Rideau J., Picod F., *Code des procédures juridictionnelles de l'Union européenne*, 2nd edition, Paris, 2002, p. 592.

27 — Lenaerts, K., Arts, D., Maselis, I., Bray R., op. cit., p. 553.

93. Although the Community courts acknowledge the admissibility of forms of order sought which are put forward in the alternative (*eventualiter*) in the event of rejection of the main form of order sought (*principaliter*) in the originating application,²⁸ the situation seems to be different if alternative forms of order sought are formulated during the course of the proceedings or even at the hearing. In fact, such forms of order, although formulated in the alternative, are new forms of order sought which change the subject-matter of the proceedings, since they articulate a claim submitted after expiry of the mandatory period for bringing proceedings and one which is to be examined in the event of rejection of the main form of order sought as put forward *principaliter*.

94. According to settled case-law, the first subparagraph of Article 42(2) of the Rules of Procedure of the Court exceptionally allows an applicant to raise new pleas in support of a form of order sought put forward in the originating application. Conversely, that provision in no way seeks to afford to the applicant the possibility of putting forward new forms of order sought.²⁹ Likewise, the equivalent provisions of Article 48(2) of the Rules of Procedure of the Court of First Instance allow in certain circumstances for new pleas in law to be produced during the course of proceedings. However, those provisions may in no case be interpreted as authorising the applicants to bring new claims before the Community judicature and

thereby modify the subject-matter of the proceedings.³⁰

95. However, a reformulation of the initial form of order sought is admissible, subject to the condition that it merely gives further particulars of the form of order sought in the application or that the reformulated form of order sought is still only secondary compared to the initial form of order sought.³¹

96. It must therefore be examined whether the head of claim put forward by the appellant in the alternative at the hearing before the Court of First Instance represents a reformulation of the existing form of order sought or a fresh form of order sought.

97. By its form of order sought in the alternative, the appellant essentially requested that the Court of First Instance refer the case back to the Board of Appeal to afford the appellant an opportunity to prove that its trade mark enjoys a reputation within the meaning of Article 8(5) of Regulation No 40/94, and to issue directions to OHIM to examine the merits of the appellant's claims. It must be observed that the alternative head of claim is not intended to elicit

28 — Rideau, J., Picod, F., *Code des procédures juridictionnelles de l'Union européenne*, cited above, p. 592. For views on forms of order sought in the alternative, see Rosenberg, L., Schwab, K.-H., Gottwald, P., *Zivilprozessrecht*, 16th edition, Munich, 2004, p. 649.

29 — Case 125/78 *GEMA v Commission* [1979] ECR 3173, paragraph 26.

30 — Case T-28/90 *Asia Motor France and Others v Commission* [1992] ECR II-2285, paragraph 43.

31 — Case T-100/96 *Vicente-Nufiez v Commission* [1998] ECR-SC I-A-591 and II-1779, paragraph 51, and Case T-177/03 *Strohm v Commission* [2005] ECR-SC I-A-147 and II-651, paragraph 21.

clarification of the consequences of annulment, as the appellant claims, but to secure the issuing of directions to OHIM. However, under Article 63(6) of Regulation No 40/94, OHIM is to take the measures necessary to comply with the judgment of the Community courts. Accordingly, the Court of First Instance is not entitled to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part of the judgment of the Court of First Instance and the grounds on which they are based.³²

98. It is therefore plain that the appellant was submitting a new head of claim in the alternative, by which it was asking for directions to be issued to OHIM. It was therefore attempting to change the subject-matter of the proceedings.

99. The Court of First Instance was entitled, without erring in law, to reject as inadmissible the form of order sought in the alternative at the hearing on the ground that it was a new form of order.

32 — Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-34/00, *Eurocool Logistik v OHIM (EUROCOOL)*, [2002] ECR II-683, paragraph 12; Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BLUDMEN)* [2003] ECR II-2251, paragraph 22; and Case T-366/04 *Hensotherm v OHIM* [2006] ECR II-65, paragraph 17.

100. This ground of appeal cannot therefore succeed.

F — Sixth ground of appeal: alleged infringement of Article 63 of Regulation No 40/94 and of Article 135(4) of the Rules of Procedure of the Court of First Instance by refusing to admit certain documents

1. Arguments of the parties

101. The appellant claims that the judgment of the Court of First Instance infringes Article 63 of Regulation No 40/94 and Article 135(4) of the Rules of Procedure of the Court of First Instance, in that it declared inadmissible certain documents produced for the first time before the Court of First Instance. According to the appellant, the Rules of Procedure do not in fact contain any prohibition on the production of evidence before the Court of First Instance.

102. The appellant criticises the Court of First Instance's interpretation of the notion of subject-matter of the proceedings in Article 135(4) of the Rules of Procedure of the Court of First Instance. The facts on which the appellant relied in support of its argument

do not form part of the 'subject-matter' but constitute evidence in the case. It is only because the Board of Appeal, the highest authority in the administrative procedure, held that evidence to be unsatisfactory for the purposes of proving the appellant's claims that the appellant adduced new evidence before the Court of First Instance.

103. According to the appellant, it is also incompatible with the role of the Court of First Instance, as first-instance authority with power to review the lawfulness of OHIM's decisions, to refuse to take into consideration evidence adduced before it.

104. OHIM observes that the role of the Court of First Instance is to review the legality of decisions of the Boards of Appeal and not, when ruling on an appeal against a decision of an OHIM Board of Appeal, to establish whether it may lawfully adopt a new decision with the same operative part as the contested decision. It follows that OHIM cannot be accused of any illegality with regard to factual evidence which was not submitted to it. Factual evidence which was adduced before the Court of First Instance but not previously produced before the OHIM departments must be excluded.

2. Assessment

105. As noted in paragraphs 57, 70 and 91, 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 to assess the evidence. The appraisal of those facts and the assessment of that evidence does not therefore, save where they distort the evidence, constitute a point of law which is subject, as such, to review on appeal by the Court of Justice.

106. It must also be borne in mind that, in an appeal, the Court of Justice has no jurisdiction to establish the facts or, in principle, to examine the evidence which the Court of First Instance accepted in support of those facts. Provided that the evidence has been properly obtained and the general principles of law and the rules of procedure in relation to the burden of proof and the taking of evidence have been observed, it is for the Court of First Instance alone to assess the value which should be attached to the evidence produced to it. Save where the evidence adduced before the Court of First Instance has been distorted, the appraisal therefore does not constitute a point of law which is subject to review by the Court of Justice.³³

³³ — Joined Cases C-403/04 P and C-405/04 P *Sumitomo Metal Industries and Nippon Steel v Commission* [2007] ECR I-729, paragraph 38.

107. Although the appellant discusses the question whether, by declaring inadmissible the evidence offered by way of five documents, the Court of First Instance breached its Rules of Procedure, this in fact amounts to a claim that the evidence was distorted.

108. In the present case, however, there does not appear to have been any distortion of the evidence nor any breach of the Rules of Procedure of the Court of First Instance.

109. Even if the five documents adduced by the appellant before the Court of First Instance did demonstrate the repute of the 'OBELIX' sign, they were not sent to OHIM in the context of the procedure which led to the contested decision and were not discussed in due time, that is, before the contested decision was adopted. Indeed, in the context of proceedings for annulment of the decision referred to the Community Court, the legality of the contested measure must be assessed on the basis of the elements of fact and law existing at the time when the measure was adopted.³⁴

110. In referring, in paragraph 16 of its judgment, to Article 135(4) of its Rules of Procedure, the Court of First Instance was seeking to highlight the nature of annulment proceedings. It is common ground that the

five documents were not submitted before OHIM. In order to be taken into consideration, they should have been submitted during the administrative procedure before OHIM.

111. The sixth ground of appeal cannot succeed.

112. The appellant's appeal must be dismissed in its entirety.

VI — Costs

113. Under Article 69(2) of the Rules of Procedure of the Court of Justice, which applies to appeals under Article 118 of those Rules of Procedure, the unsuccessful party is to pay the successful party's costs. Accordingly if, as I propose, all the appellant's grounds of appeal are rejected, the appellant must be ordered to pay the costs of the appeal.

³⁴ — *France v Commission*, cited above in footnote 22.

VII — Conclusion

114. On the basis of the above considerations I propose that the Court:

1. dismiss the appeal; and

2. order Les Éditions Albert René SARL to pay the costs.