



Reports of Cases

JUDGMENT OF THE GENERAL COURT (First Chamber)

16 September 2013*

(Community trade mark — Opposition proceedings — Application for Community word mark GOLDEN BALLS — Earlier Community word mark BALLON D'OR — Similarity of the signs — Likelihood of confusion — Article 8(1)(b) of Regulation No 207/2009 — Application for annulment filed by the intervener — Article 134(3) of the Rules of Procedure of the General Court — Scope of the examination to be carried out by the Board of Appeal — Obligation to rule on the entirety of the action — Articles 8(5), 64(1) and 76(1) of Regulation No 207/2009)

In Case T-437/11,

Golden Balls Ltd, established in London (United Kingdom), represented by M. Edenborough QC, and S. Smith, Solicitor,

applicant,

v

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

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Intra-Press, established in Boulogne-Billancourt (France), represented by P. Péters, T. de Haan and M. Laborde, lawyers,

APPLICATION for annulment of the decision of the First Board of Appeal of OHIM of 26 May 2011 (Case R 1310/2010-1) relating to opposition proceedings between Intra-Press and Golden Balls Ltd,

THE GENERAL COURT (First Chamber),

composed of J. Azizi (Rapporteur), S. Frimodt Nielsen and M. Kancheva, Judges,

Registrar: T. Weiler, Administrator,

having regard to the application lodged at the Court Registry on 5 August 2011,

having regard to the response of OHIM lodged at the Court Registry on 19 December 2011,

having regard to the response of the intervener lodged at the Court Registry on 12 December 2011,

* Language of the case: English.

having regard to the reply lodged at the Court Registry on 26 March 2012,

further to the hearing on 30 April 2013,

gives the following

Judgment

Background to the dispute

- 1 On 1 October 2007, the applicant, Golden Balls Ltd, filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).
- 2 The mark in respect of which registration was sought is the word sign GOLDEN BALLS.
- 3 The goods for which registration was sought come within Classes 16, 21 and 24 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, for each of those classes, to the following description:
 - Class 16: ‘Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers’ type; printing blocks’;
 - Class 21: ‘Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes’;
 - Class 24: ‘Textiles and textile goods, not included in other classes; bed and table covers, towels, duvet covers’.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 8/2008 of 18 February 2008.
- 5 On 16 May 2008, the intervener, Intra-Press, filed a notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) against registration of the mark applied for in respect of the goods referred to in paragraph 3 above.
- 6 The opposition was based in particular on the earlier Community word mark BALLON D’OR, which was filed on 24 December 2004 and registered on 7 November 2006 under number 4226148 in respect of goods and services in Classes 9, 14, 16, 18, 25, 28, 38 and 41 corresponding, for each of those classes, to the following description:
 - Class 9: ‘Scientific (other than for medical purposes), nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; teaching apparatus and instruments; apparatus for recording,

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

- Class 14: 'Precious metals and their alloys other than for dental purposes; jewellery, precious stones; horological and chronometric instruments, watches, clocks, alarm clocks, chronometers, brooches (jewellery), sundials, medals, figurines (statuettes) of precious metal, cigar cases, cigarette cases and cigarette lighters of precious metal, ashtrays of precious metal, cigarette cases of precious metal, key rings (trinkets or fobs)';
- Class 16: 'Paper and cardboard (unprocessed, semi-finished or for stationery); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); wrapping paper; sacks, bags and sheets for packaging in paper or plastics; printers' type; printing blocks, newspapers, books, magazines';
- Class 18: 'Leather and imitations of leather, and goods made from these materials and not included in other classes; trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery';
- Class 25: 'Clothing (apparel), footwear (except orthopaedic footwear); headgear; motorists' clothing; swimwear and bathing caps; bathrobes; berets; smocks; bodies; caps (headwear); boots; braces; underpants; caps; belts; shawls; dressing gowns; sweaters; hats; socks; booties; football boots; ski boots; sports shoes; shirts; under shirts; tights; wet suits for water skiing; suits; cyclists' clothing; mufflers; esparto shoes or sandals; scarves; gabardines (clothing); waistcoats; gymnastics shoes; raincoats; slippers; swaddling clothes; coats; trousers; slippers; overcoats; parkas; bathrobes; pullovers; pyjamas; dresses; dressing gowns; wooden shoes; aprons (clothing); uniforms; jackets; gymnastic clothing; clothing of leather and imitations of leather; visors (hatmaking)';
- Class 28: 'Games and playthings; gymnastic and sporting articles (other than clothing, footwear and mats); decorations for Christmas trees; hang gliders; bladders of balls for games; air pistols (toys); artificial fishing bait; percussion caps (toys); toys for pets; ring games; ornaments for Christmas trees (except illumination articles and confectionery); Christmas tree stands; Christmas trees of synthetic material; archery implements; bows for archery; novelties for parties, dances (party favours); swings; balls for games, play balloons; baseball gloves; swimming pools (play articles); stationary exercise bicycles; billiard balls, cues and tables; marbles for games; bobsleighs; playing balls; boxing gloves; gut for rackets; fishing rods; golf balls; toy masks; kites; dolls' rooms; rocking horses; targets; toy building structures; machines for physical exercises; cricket bags; golf clubs; golf bags, with or without wheels; hockey sticks; appliances for gymnastics; draughts (games); dice; discuses for sports; dominoes; chess sets; arms; fencing gloves and masks; climbers' harnesses; exercisers (expanders); nets for sports; ski bindings; darts; foils for fencing; floats for fishing; indoor football tables; harpoon guns (sports articles); golf gloves; bar-bells; fish hooks; rattles; counters for games; automatic and electronic games, other than coin-operated and those adapted for use with television receivers only; mahjong sets; puppets; scale-model vehicles; swim fins; teddy bears; paragliders; ice skates; roller-skates; fishing tackle; skateboards; sailboards; surf boards; dolls; protective paddings (part of sport suits); elbow, knee and shin guards (sports articles); ninepins; bats for games; skis; water skis; surf skis; parlour games; tables for table tennis; sledges; spinning tops (toys); sleighs (sports articles); spring boards (sporting articles); scooters (toys); toy vehicles; shuttlecocks; dolls' clothes; game cards';

- Class 38: ‘Telecommunications; transmission of images, sound and data by telephone, by computer terminals, a global communications network (the Internet) or local communications network (an intranet), satellite and electronic mail; processing, monitoring, broadcasting and reception of data, signals, images and information processed by computers or by telecommunications apparatus and instruments; transmission of information contained in databanks and image banks; dissemination of information by electronic means, news agencies; communications by fibre optic networks; radio, telephone or telegraph communications services; broadcasting of television programmes; radio broadcasting; television broadcasting, sending of telegrams; radio broadcasting; satellite transmission; data transmission; cable television broadcasting’;
 - Class 41: ‘Education; providing of training; entertainment; sporting and cultural activities; timing of sports events, organisation of sports competitions and awarding of trophies, club services (entertainment), sports club services, radio and television entertainment, providing sports facilities, amusement parks, providing recreational facilities; publication of books, magazines and newspapers, production of radio and television programmes, rental of sports equipment (except vehicles); arranging and conducting of conferences, forums and colloquiums; gymnastic instruction, amusement parks, organisation of competitions (education or entertainment), production of shows, sports camp services, film production, rental of stadium facilities’.
- 7 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and Article 8(5) of Regulation No 40/94 (now Article 8(1)(b) and Article 8(5) of Regulation No 207/2009).
- 8 On 19 May 2010, the Opposition Division rejected the opposition in its entirety. The goods and services covered by the signs at issue were partially identical and partially different. The signs were visually and phonetically different and were slightly similar conceptually for a section of the relevant public. As the signs were globally dissimilar, there was no likelihood of confusion between the signs under Article 8(1)(b) of Regulation No 207/2009. Regarding the ground concerning the reputation of the earlier mark, as the signs were different, Article 8(5) of Regulation No 207/2009 was not applicable.
- 9 On 15 July 2010, the intervener filed a notice of appeal at OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.
- 10 By decision of 26 May 2011 (‘the contested decision’), the First Board of Appeal of OHIM partially upheld the appeal, namely for goods in Class 16, and partially dismissed it, namely for goods in Classes 21 and 24. In particular, it considered as follows:
- the relevant public is made up of the general public in the European Union (paragraph 12 of the contested decision);
 - with regard to the comparison of the goods, the Board of Appeal agreed with the assessment of the Opposition Division, which was uncontested by the parties. Thus, the Board of Appeal considered that the goods covered by the mark applied for in Class 16 were identical to those covered by the earlier mark in the same class, and that the goods in Classes 21 and 24 were different from those covered by the earlier mark (paragraphs 13 to 16 of the contested decision);
 - regarding the comparison of the signs, as regards their visual and phonetic comparison, the Board of Appeal agreed with the Opposition Division’s reasoning that the signs were visually and phonetically different (paragraph 18 of the contested decision). With regard to the conceptual comparison, unlike the Opposition Division, the Board of Appeal concluded that the marks at issue were identical, or, ‘at the least’, were conceptually extremely similar (paragraph 22 of the contested decision);

- in the light of the foregoing, the Board of Appeal concluded that there was a likelihood of confusion or of association between the signs at issue in respect of the identical goods, namely the goods in Class 16, and that there was no likelihood of confusion for the different goods in Classes 21 and 24 (paragraphs 23 to 32 of the contested decision);
- the Board of Appeal deemed it unnecessary to consider Article 8(5) of Regulation No 207/2009 (paragraph 33 of the contested decision).

Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision in relation to the goods in Class 16;
- order OHIM or, in the alternative, the intervener to pay the costs.

12 In its reply, lodged in accordance with Article 135(3) of the Rules of Procedure of the Court, the applicant additionally claims that the Court should ‘dismiss’ the intervener’s ‘application’ lodged in accordance with Article 134(3) of those rules.

13 OHIM contends that the Court should:

- dismiss the action in its entirety;
- order the applicant to pay the costs.

14 The intervener claims that the Court should:

- dismiss the action in its entirety;
- annul the contested decision in so far as it rejects the intervener’s opposition directed against the goods covered by the mark applied for in Classes 21 and 24;
- order the applicant to pay the costs, including the costs necessarily incurred by the intervener for the purpose of the proceedings before the Board of Appeal of OHIM.

Law

Introductory points

15 In support of the action, the applicant relies on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009. In addition, in support of the action for annulment brought under Article 134(3) of the Rules of Procedure, the intervener relies on a single plea in law alleging infringement of Article 8(5), Article 64(1) and Article 76(1) of Regulation No 207/2009.

The plea alleging infringement of Article 8(1)(b) of Regulation No 207/2009 relied on by the applicant

16 In support of its action, the applicant pleads infringement of Article 8(1)(b) of Regulation No 207/2009.

- 17 In essence, the applicant contests the conclusion of the Board of Appeal that there is a likelihood of confusion between the signs at issue in respect of the goods in Class 16. In particular, it contests the conceptual and global similarity between the signs at issue found by the Board of Appeal in the contested decision.
- 18 OHIM and the intervener dispute the merits of the plea raised by the applicant and claim that there is a likelihood of confusion between the signs at issue in respect of the identical goods in Class 16.
- 19 The Court points out that under Article 8(1)(b) of Regulation No 207/2009, 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 an 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.
- 20 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion within the meaning of the abovementioned provision. The likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and goods or services concerned and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM - Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33 and the case-law cited).
- 21 For the purposes of applying Article 8(1)(b) of Regulation No 207/2009, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see Case T-316/07 *Commercy v OHIM - easyGroup IP Licensing (easyHotel)* [2009] ECR II-43, paragraph 42 and the case-law cited).
- 22 The assessment of the likelihood of confusion on the part of the relevant public depends on various factors and must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global assessment must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression which they create, bearing in mind, in particular, their distinctive and dominant components (see Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraphs 34 and 35, and Case C-498/07 P *Aceites del Sur-Coosur v Koipe* [2009] ECR I-7371, paragraphs 59 and 60 and the case-law cited). In addition, it implies some interdependence between the relevant factors, so that a low degree of similarity between the goods or services covered may be offset by a high degree of similarity between the marks, and vice versa (see judgment of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraphs 44 and 45, and *easyHotel*, cited in paragraph 21 above, paragraph 41).

The relevant public

- 23 According to settled case-law, in the context of the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods or services concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see Case T-256/04 *Mundipharma v OHIM - Altana Pharma (RESPICUR)* [2007] ECR II-449, paragraph 42 and the case-law cited).
- 24 In that regard, the applicant complains that the Board of Appeal defined the level of attention of the relevant public as being lower than normal whereas it ought to have found a normal level of attention.

- 25 It must be stated, as OHIM and the intervener submit, that that complaint is based on a misinterpretation of the contested decision by the applicant.
- 26 The Board of Appeal noted, in paragraph 12 of the contested decision, that the relevant public for the goods in Classes 16, 21 and 24 was composed of average consumers, who are reasonably well-informed and reasonably observant and circumspect and that certain goods, namely ‘artists’ materials’ in Class 16 and ‘paint brushes’ and ‘unworked or semi-worked glass’ in Class 21 are also directed at professionals. Next, it stated that, where the relevant public was composed of both average consumers and professionals, the likelihood of confusion must be assessed in relation to the part of the public whose level of attention is lower, namely average consumers in the European Union and not professionals, as has also been recognised in the case-law (judgment of 15 February 2011 in Case T-213/09 *Yorma’s v OHIM – Norma Lebensmittelfilialbetrieb (YORMA’S)*, not published in the ECR, paragraph 25).
- 27 Accordingly, the Board of Appeal in fact, and correctly, found that the relevant public was composed of average consumers in the European Union, reasonably well informed and reasonably observant and circumspect. Therefore, contrary to what the applicant claims, it relied on a public having a normal level of attention.
- 28 Therefore, it must be stated that the assessment of the Board of Appeal as regards the relevant public and its level of attention is not incorrect.

Comparison of the goods

- 29 As has been recognised by settled case-law, in assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, such as the distribution channels of the goods concerned (see Case T-443/05 *El Corte Inglés v OHIM - Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-2579, paragraph 37 and the case-law cited).
- 30 In the contested decision, the Board of Appeal endorsed the assessment of the Opposition Division with regard to the comparison of the goods covered by the signs at issue, which, in addition, had not been disputed by the parties. Accordingly, it found that the goods designated by the signs at issue in Class 16 are identical whereas those in Classes 21 and 24 are different (paragraphs 13 to 16 of the contested decision).
- 31 In the present case, the findings of the Board of Appeal concerning the comparison of the goods, in particular as regards the goods in Class 16 at issue, are not disputed by the parties. Moreover, since there is no evidence before the Court which casts doubt on that assessment, it should be upheld.

Comparison of the signs

- 32 According to the case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (Case T-6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30, confirmed by order of the Court of Justice in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657). As has been established by the case-law, the visual, phonetic and conceptual aspects are relevant (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).

- 33 The global assessment of the likelihood of confusion, in relation to the visual, phonetic or conceptual similarity of the signs at issue, must be based on the overall impression given by the signs, their distinctive and dominant components, in particular, being borne in mind. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of such a likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *OHIM v Shaker*, cited in paragraph 22 above, paragraph 35 and the case-law cited).
- 34 In the present case, the Board of Appeal held the signs at issue to be different visually and phonetically, and shared the reasoning of the Opposition Division (paragraph 18 of the contested decision). However, conceptually, the signs at issue are identical, or at the least, extremely similar (paragraph 22 of the contested decision). The words ‘golden’ and ‘balls’ are part of basic English language vocabulary known by a large part of the relevant public and are understood as referring to a ‘golden ball’ or a ‘ball of gold’ or ‘golden’ (paragraph 21 of the contested decision).
- 35 The applicant confirms the lack of visual or phonetic similarity between the signs at issue, but disputes their conceptual similarity found by the Board of Appeal in the contested decision. According to the applicant, even the most unobservant or ill-informed person would perceive the mark applied for as being in the English language and the earlier mark as being in the French language. That fundamental difference ensures that one mark could never be mistaken for the other in any circumstance. In addition, the signs at issue do not constitute a transliteration of each other or an exact translation of each other. Thus, first, the English word ‘balls’ is in the plural and conveys the idea of several balls, whereas the French word ‘ballon’ is in the singular and conveys the idea of a single ball. Next, the French term ‘ballon’, which could also mean ‘balloon’, is not exactly equivalent to the English word ‘ball’ and the signs are not identical. Finally, the earlier mark BALLON D’OR is translated into English by ‘balloon of gold’ or ‘ball of gold’ and not by ‘golden ball’.
- 36 OHIM and the intervener do not dispute the visual and phonetic differences between the signs at issue, but invoke, contrary to the applicant, a conceptual identity or near identity between the signs at issue and an overall similarity between those signs.
- 37 The Court finds that the assessment of the Board of Appeal as to the visual and phonetic comparison of the signs at issue, which is not, moreover, disputed by the parties, is correct.
- 38 Visually, the signs at issue share only the group of letters ‘ball’, which is placed at the beginning of the sign in the earlier mark and at the end of the sign in the mark applied for. For the rest, those signs are visually different. In addition to the group of letters ‘ball’, the earlier mark contains the group of letters ‘on’ and the element ‘d’or’ at the end of the sign and the mark applied for starts with the element ‘golden’ and finishes with the letter ‘s’. Consequently, the signs at issue are, overall, visually different.
- 39 Phonetically, the signs at issue are pronounced completely distinctly, in their different languages, and, therefore, are also different.
- 40 The Board of Appeal’s finding that the signs at issue are visually and phonetically different must therefore be confirmed.
- 41 Next, as regards the Board of Appeal’s assessment that the signs at issue are conceptually identical or, at the least, extremely similar, the Court notes, first, that those signs call to mind – admittedly, from an objective point of view and apart from some differences of a detailed nature (see paragraph 47 below) – in principle, the same semantic content or the same idea, namely a golden balloon or a golden ball or gold. In that context, it should be noted, that the applicant could not, in response to a question from the Court during the hearing, refer to any example of a translation in the English press of the expression ‘ballon d’or’ other than the expression ‘golden ball’.

- 42 However, for the assessment of the conceptual similarity on the part of the relevant public, in particular the average anglophone and francophone public, due account has to be taken of the fact that the earlier mark is in the French language whereas the mark applied for is in the English language, and that the signs at issue accordingly differ as regards the language enabling access to the respective conceptual understanding of them.
- 43 In that regard a linguistic difference between the signs cannot, contrary to what the applicant appears to suggest, automatically suffice to exclude the existence of a conceptual similarity from the point of view of the relevant consumers. However, such a difference – in so far as it requires a translation on the part of the consumer – is capable, depending on, inter alia, the linguistic knowledge of the relevant public, the degree of relationship between the languages concerned and the actual words used by the signs at issue, of preventing, at least to some degree, an immediate conceptual comparison by the relevant public (see, to that effect, judgment of 28 June 2011 in Case T-471/09 *Oetker Nahrungsmittel v OHIM – Bonfait (Buonfatti)*, not published in the ECR, paragraph 82, and judgment of 26 September 2012 in Case T-265/09 *Serrano Aranda v OHIM – Burg Groep (LE LANCIER)*, not published in the ECR, paragraph 66).
- 44 In those circumstances, it is clear that it has not been established in the present case that the meaning of the mark applied for comprising the words ‘golden’ and ‘balls’ will immediately be understood by the relevant public, namely the general public in the European Union, in particular the francophone public, which understands the French expression ‘ballon d’or’ constituting the earlier mark.
- 45 Even assuming, like the Board of Appeal, that the words ‘golden’ and ‘ball’ are part of basic English-language vocabulary and that they are, therefore, as such, understandable for the average consumer, including the average francophone consumer, that does not mean that that consumer, who will generally – as the parties agree – have a weak understanding of the English language, will understand those words in their specific combination ‘golden balls’ immediately as an English translation of the French expression ‘ballon d’or’ which constitutes the earlier mark.
- 46 In that regard, it must be held that the differences between the signs at issue argue against such an immediate conceptual comparison.
- 47 In the first place, in so far as the applicant claims that the sign GOLDEN BALLS does not constitute an exact translation of the sign BALLON D’OR, since the French word ‘ballon’ is not exactly the equivalent of the English word ‘ball’ and since the French expression ‘ballon d’or’ is correctly translated by the English expression ‘gold ball’ or ‘ball of gold’ rather than the English expression ‘golden ball’, it must be held, as OHIM and the intervener submit, that those inaccuracies of translation, even if they were to exist, are irrelevant, since such linguistic subtleties would fail to be perceived by the relevant public, in particular by the francophone consumer, having a limited knowledge of English. However, the Court considers, contrary to what was held by the Board of Appeal, that the position is different as regards the fact that the sign GOLDEN BALLS is distinct from the sign BALLON D’OR by the use of the plural. It concerns a fairly basic grammatical point which is also capable of being understood and perceived by the francophone public, particularly because, as the applicant correctly noted, the plural of words is formed in the same way in English and in French. Accordingly, an average consumer, in particular, a francophone one, who, as OHIM and the intervener submit, will have a limited knowledge of English but one which is sufficient to understand the words ‘golden’ and ‘balls’ would also notice the use of the plural.
- 48 In the second place, it is necessary to note the different position of the elements ‘golden’ and ‘d’or’ respectively, at the beginning of the sign in one case and at the end of the sign in the other, as well as the clearly different origins of the English word ‘gold’ to which the first element refers and the French word ‘or’ to which the second element refers. Although it is true that those differences render translation of the English word to French and of the French word to English only slightly more

difficult, nevertheless those differences are capable of impeding the immediate discovery of the similar hidden meaning of the signs at issue, both for the francophone and anglophone consumer with an average level of attention.

- 49 Accordingly, even if it is accepted that francophone consumers will have, in principle, sufficient knowledge of English to understand the meaning of the expression ‘golden balls’ and will begin, despite the fact that it concerns a simple purchase of everyday consumer goods, by translating that sign to bring it closer to the underlying meaning of the mark BALLON D’OR, it appears improbable that the result of such an analysis would spontaneously come into the mind of the average consumer concerned (see, to that effect, *Buonfatti*, cited in paragraph 43 above, paragraph 82).
- 50 Therefore, it must be found that the Board of Appeal was wrong to consider that the signs at issue are conceptually extremely similar or identical. Those signs have, at most, a weak – or even very weak – degree of conceptual similarity for the reasonably informed and observant relevant public, in particular the francophone public.
- 51 In the light of the foregoing, it must be held that in the present case there is no visual or phonetic similarity between the signs at issue and, at most, a weak conceptual similarity, requiring prior translation.
- 52 Therefore, it is necessary to assess overall, whether, in the present case, that conceptual similarity is sufficient to create a likelihood of confusion as the Board of Appeal found (see, to that effect, Case T-33/03 *Osotspa v OHIM - Distribution & Marketing (Hai)* [2005] ECR II-763, paragraph 62, and Case T-534/10 *Organismos Kypriakis Galaktokomikis Viomichanias v OHIM – Garmo (HELLIM)* [2012] ECR, paragraph 43).

The overall assessment of the likelihood of confusion between the signs at issue

- 53 It should be borne in mind that, first, as is recognised by settled case-law, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because it is well known on the market (*SABEL*, cited in paragraph 32 above, paragraph 24; Case T-10/03 *Koubi v OHIM - Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraph 50; and *Hai*, cited in paragraph 52 above, paragraph 56 and the case-law cited).
- 54 Second, according to that same line of case-law, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar will not be sufficient to give rise to a likelihood of confusion (*SABEL*, cited in paragraph 32 above, paragraph 25, and *Hai*, cited in paragraph 52 above, paragraph 55).
- 55 The Board of Appeal held, in paragraphs 31 and 32 of the contested decision, that the identical nature of the goods in question, combined with an identical or very strong conceptual similarity, was capable of compensating for any lack of visual and phonetic similarity, and that, consequently, there was a likelihood of confusion or association, for the purposes of Article 8(1)(b) of Regulation No 207/2009, between the signs at issue for the identical goods in Class 16 covered by the mark applied for. In that regard, whilst noting that the intervener had produced an impressive amount of documents designed to prove the reputation of the mark BALLON D’OR with regard to a ‘sports competition’, the Board of Appeal found that, in the context of the analysis of the likelihood of confusion within the meaning of that provision, the reputation and moreover the distinctive character of the mark were to be taken into account only when that reputation was established with regard to the goods at issue (paragraphs 27 and 28 of the contested decision).

- 56 The applicant disputes that there is a likelihood of confusion between the signs at issue. In particular, it claims that the earlier mark for the goods in Class 16 has a normal distinctive character and disputes that the signs at issue are identical or strongly conceptually similar.
- 57 OHIM and the intervener dispute the applicant's arguments. In addition, the intervener claims that the earlier mark has enhanced distinctiveness and reputation.
- 58 As regards the overall assessment of the likelihood of confusion, the Court notes, first, as held in paragraphs 50 and 51 above, that the signs at issue are not identical or extremely similar conceptually, but at most slightly similar. Accordingly, contrary to what the Board of Appeal found in paragraph 31 of the contested decision, it must be held that, even if the goods at issue are identical, that weak, or very weak, conceptual similarity which requires a prior translation cannot suffice to make up for the visual and phonetic dissimilarities which exist.
- 59 In that context, it is apparent from settled case-law, as noted in paragraphs 53 and 54 above, that the possibility cannot be ruled out that a mere conceptual similarity between two marks can create a likelihood of confusion where the goods are similar, provided, however, that the earlier mark has a high distinctive character. It is sufficient to note that such a specific distinctive character of the mark BALLON D'OR has not been established in the present case as regards the goods concerned. Moreover, even if that mark enjoys a high distinctive character, and whilst taking account of the identical character of the goods in question, the very weak conceptual similarity, requiring prior translation, cannot, in the circumstances of the case, be sufficient to create, in itself, a likelihood of confusion on the part of the target public (*Hai*, cited in paragraph 52 above, paragraphs 61, 64 and 65).
- 60 Therefore, it must be held that the Board of Appeal was wrong to find the existence of a likelihood of confusion on the part of the relevant public for the identical goods covered by the signs at issue in Class 16. Due to the fact that the signs at issue are in different languages, a manifest distinction is created between them so that, as noted in paragraphs 44 to 48 above, the average consumer will not immediately associate them without undergoing an intellectual process of translation (see, to that effect, *Buonfatti*, cited in paragraph 43 above, paragraph 87).
- 61 It must therefore be held that the contested decision must be annulled to the extent of point 1 of its operative part, in so far as it annulled the decision of the Opposition Division and upheld the opposition for the goods covered by the mark applied for in Class 16, on the basis of breach of Article 8(1)(b) of Regulation No 207/2009.

The plea in law alleging infringement of Article 8(5), of Article 64(1) and of Article 76(1) of Regulation No 207/2009 relied on by the intervener

- 62 The intervener has filed an application under Article 134(3) of the Rules of Procedure.
- 63 In essence, the intervener raises a separate plea in law in support of its application for annulment of the contested decision, alleging infringement of Article 8(5), Article 64(1) and Article 76(1) of Regulation No 207/2009, inasmuch as that decision rejected the opposition as regards the goods covered by the mark applied for in Classes 21 and 24 in point 2 of its operative part. In the intervener's view, the Board of Appeal ought to have addressed the plea alleging infringement of Article 8(5) of that regulation, concerning the goods in Classes 21 and 24. There was an infringement of an essential procedural requirement and an error of law.
- 64 The applicant disputes the intervener's arguments. The Board of Appeal was correct to find that it was not necessary to rule on the argument put forward by the applicant relating to Article 8(5) of Regulation No 207/2009, that argument being manifestly unfounded.

- 65 OHIM, which failed to avail itself of the opportunity to submit a statement in response in order to respond to the heads of claim and pleas presented, on the basis of Article 134(3) of the Rules of Procedure, for the first time in the intervener's response, in essence accepted during the hearing that the failure of the Board of Appeal to have ruled on the plea alleging infringement of Article 8(5) of Regulation No 207/2009 constituted an infringement of an essential procedural requirement.
- 66 The Court notes that, by its application to dismiss the applicant's application and to annul the contested decision in so far as it rejected the intervener's opposition directed against the registration of the mark applied for with regard to the goods in Classes 21 and 24, the intervener is making use of the opportunity afforded to it by Article 134(3) of the Rules of Procedure to seek, in its response, a form of order annulling the contested decision on a point not raised in the application (see, to that effect, Case T-214/04 *Royal County of Berkshire Polo Club v OHIM - Polo/Lauren (ROYAL COUNTY OF BERKSHIRE POLO CLUB)* [2006] ECR II-239, paragraph 50).
- 67 To the extent that the intervener claims, in the context of the present plea, infringement of Article 8(5), of Article 64(1) and of Article 76(1) of Regulation No 207/2009, it disputes the lawfulness of the contested decision in that the Board of Appeal did not examine the ground for opposition alleging infringement of Article 8(5) of Regulation No 207/2009.
- 68 In the present case, the Board of Appeal considered, in contrast to the Opposition Division, that the signs at issue were similar overall and found a likelihood of confusion for the identical goods in Class 16 pursuant to Article 8(1)(b) of Regulation No 207/2009. In the light of that finding, the Board of Appeal considered that it was not necessary to examine the grounds raised by the intervener on the basis of Article 8(5) of Regulation No 207/2009 (paragraph 33 of the contested decision), notwithstanding the fact that the subject-matter of the dispute also included different goods in Classes 21 and 24 covered by the mark applied for, which were not covered by the assessment of the likelihood of confusion as regards the goods judged to be identical in Class 16.
- 69 In that regard, it must be borne in mind that, under the first sentence of Article 64(1) of Regulation No 207/2009, '[f]ollowing the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal'. The Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (Case C-29/05 P *OHIM v Kaul* [2007] ECR I-2213, paragraph 57, and Case T-215/03 *Sigla v OHIM - Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 96). It is settled case-law that that obligation to examine the allowability of the appeal must be understood to mean that the Board of Appeal is obliged to rule on each of the heads of claim submitted for its consideration in its entirety, either by upholding it, rejecting it as inadmissible or rejecting it on substantive grounds. Since disregard of that obligation can affect the content of the Board of Appeal's decision, it will amount to an infringement of an essential procedural requirement (see, to that effect, judgment of 9 September 2011 in Case T-382/09 *Ergo Versicherungsgruppe v OHIM – DeguDent (ERGO)*, not published in the ECR, paragraph 15 and the case-law cited).
- 70 However, it must be noted in the present case that it is apparent from the wording of Article 8(5) of Regulation No 207/2009 that the identity or similarity of the signs at issue also constitutes one of the three cumulative conditions for the application of that article (see, to that effect, Case T-67/04 *Spa Monopole v OHIM - Spa-Finders Travel Arrangements (SPA-FINDERS)* [2005] ECR II-1825, paragraph 30).
- 71 It should also be pointed out that, according to the case-law, the types of damage referred to in Article 8(5) of Regulation No 207/2009, where they occur, are the consequence of a certain degree of similarity between the marks at issue, by virtue of which the relevant section of the public makes a connection between the marks, that is to say, it establishes a link between them (see, to that effect, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 30 and the case-law cited).

- 72 Having regard to the assessments made in paragraphs 41 to 51 above, it must be noted that the signs at issue lack the similarity required for the purposes of applying Article 8(5) of Regulation No 207/2009. The Board of Appeal was therefore, in any event, under a duty to reject the opposition concerning the goods in Classes 21 and 24, even if it had examined the plea raised by the intervener alleging infringement of that provision.
- 73 It follows that the opposition had, in any event, to be rejected in its entirety since both a likelihood of confusion within the meaning of Article 8(1)(b) and a likelihood of a link for the purposes of Article 8(5) of Regulation No 207/2009 were lacking.
- 74 In those circumstances, even taking account of the fact that the Board of Appeal wrongly omitted to rule on the plea alleging infringement of Article 8(5) of Regulation No 207/2009 in so far as it concerned the goods covered by the mark applied for in Classes 21 and 24, it is not necessary to annul point 2 of the operative part of the contested decision since that error could not, in the particular circumstances of the present case, affect that part of the operative part of the contested decision (see, to that effect, Case T-301/01 *Alitalia v Commission* [2008] ECR II-1753, paragraph 307 and the case-law cited).
- 75 Consequently, the intervener's plea alleging infringement of Article 8(5), of Article 64(1) and of Article 76(1) of Regulation No 207/2009 raised in support of the application for partial annulment of the contested decision concerning the goods covered by the mark applied for in Classes 21 and 24 must be rejected as being of no effect. Accordingly, the application for annulment submitted by the intervener must be rejected.
- 76 It follows from all of the foregoing that it is necessary to annul only the point 1 of the operative part of the contested decision.

Costs

- 77 Under Article 87(2) of the Rules of Procedure of the Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- 78 First, since OHIM has been unsuccessful, it must be ordered to bear its own costs and to pay those of the applicant in accordance with the latter's pleadings. Second, the intervener, who has failed in its application for annulment based on Article 134(3) of the Rules of Procedure, must be ordered to bear its own costs and those incurred relating that application by the applicant, as applied for in that party's pleadings.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Annuls point 1 of the operative part of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 26 May 2011 (Case R 1310/2010-1);**
- 2. Rejects the application for annulment submitted by Intra-Pressse;**
- 3. Orders OHIM to bear, in addition to its own costs, those incurred by Golden Balls Ltd, with the exception of the latter's costs concerning the application for annulment based on Article 134(3) of the Rules of Procedure;**

4. Orders Intra-Pressé to bear, in addition to its own costs, those incurred by Golden Balls Ltd concerning the application for annulment based on Article 134(3) of the Rules of Procedure.

Azizi

Frimodt Nielsen

Kancheva

Delivered in open court in Luxembourg on 16 September 2013.

[Signatures]