



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

12 February 2015*

(Community trade mark — Opposition proceedings — Application for the Community figurative mark B — Earlier international figurative mark representing two extended wings — Relative grounds for refusal — No likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 207/2009 — No damage to reputation — Article 8(5) of Regulation No 207/2009)

In Case T-505/12,

Compagnie des montres Longines, Francillon SA, established in Saint-Imier (Switzerland), represented by P. González-Bueno Catalán de Ocón, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by F. Mattina, and subsequently by P. Bullock, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM being

Xiuxiu Cheng, residing in Budapest (Hungary),

ACTION brought against the decision of the Fifth Board of Appeal of OHIM of 14 September 2012 (Case R 193/2012-5), relating to opposition proceedings between Compagnie des montres Longines, Francillon SA and Xiuxiu Cheng,

THE GENERAL COURT (Fifth Chamber),

composed of A. Dittrich, President, J. Schwarcz (Rapporteur) and V. Tomljenović, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 19 November 2012,

having regard to the response of OHIM lodged at the Court Registry on 12 February 2013,

having regard to the decision of 25 March 2013 not to allow the lodging of a reply,

having regard to the change in the composition of the Chambers of the Court,

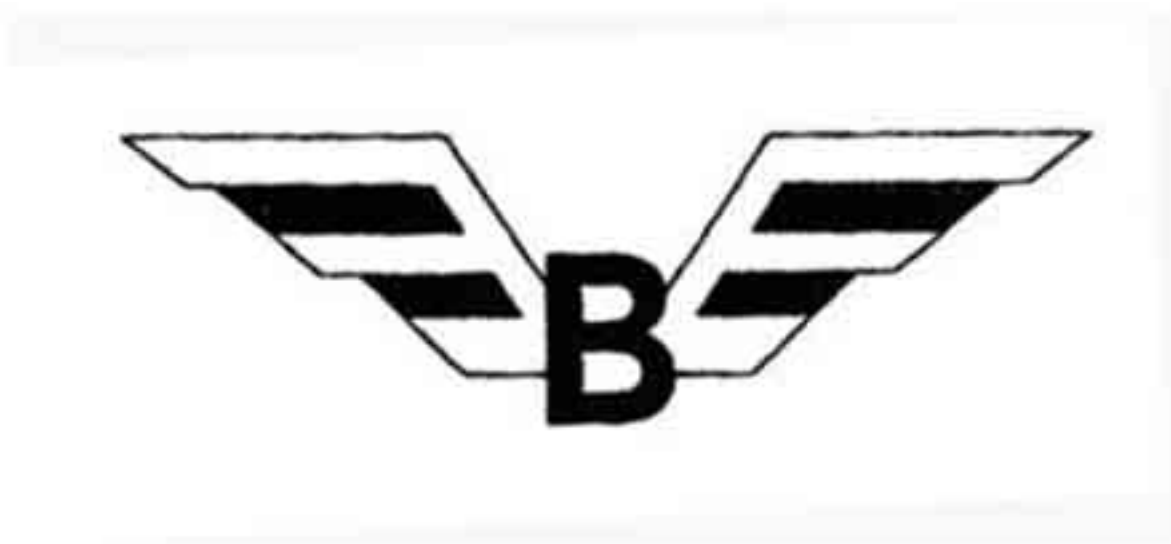
* Language of the case: English.

further to the hearing on 27 March 2014,
gives the following

Judgment

Background to the dispute

- 1 On 20 July 2009, Xiuxiu Cheng filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).
- 2 Registration as a mark was sought for the following figurative sign in black and white:



- 3 The goods in respect of which registration was sought are in Classes 9 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:
 - Class 9: 'Optical sunglasses';
 - Class 25: 'Clothing and footwear'.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 84/2010 of 10 May 2010.
- 5 On 30 July 2010, the applicant, Compagnie des montres Longines, Francillon SA, filed a notice of opposition pursuant to 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 on the earlier international figurative mark No 401319, which is reproduced below, has effect, inter alia, in Germany, Austria, Benelux, Bulgaria, Spain, Estonia, France, Greece, Hungary, Italy, Latvia, Lithuania, Portugal, the Czech Republic, Romania, Slovakia and Slovenia and

covers, inter alia, goods in Class 14 corresponding to the following description: ‘Watches, watch movements, cases, faces and bands, watchmaking materials; chronometers; chronographs; apparatus for timing sports events; pendulum clocks, pendulettes and alarm clocks; all chronometric instruments, jewellery watches, jewellery; timing installations, time display devices and panels’.



- 7 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) and (5) of Regulation No 207/2009.
- 8 By decision of 25 November 2011, the Opposition Division rejected the opposition in its entirety on the ground that the goods covered by the marks at issue were dissimilar, with the result that one of the necessary conditions for the application of Article 8(1)(b) of Regulation No 207/2009 was not satisfied. With regard to the ground of opposition relating to the application of Article 8(5) of Regulation No 207/2009, the Opposition Division found that the applicant had failed to prove, in relation to all the relevant Member States, that the earlier international mark had a reputation with respect to the goods in the category ‘horological and chronometric instruments’ in Class 14, the only category in respect of which a reputation had been claimed.
- 9 On 25 January 2012, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.
- 10 By decision of 14 September 2012 (‘the contested decision’), the Fifth Board of Appeal of OHIM dismissed the appeal, confirming the Opposition Division’s decision in its entirety.
- 11 First, the Board of Appeal found, in essence, that the relevant public at which the goods protected by the marks at issue were aimed consisted of both the general public and of specialist watch-making professionals and that, in both cases, that public had to be deemed to be reasonably well-informed and reasonably observant and circumspect.
- 12 Secondly, the Board of Appeal stated that the goods at issue were dissimilar, both in nature and in terms of their distribution channels. According to the Board of Appeal, they were not in competition and were also not complementary. It found that, in the absence of any similarity between the goods, one of the conditions necessary for the application of Article 8(1)(b) of Regulation No 207/2009 had not been satisfied and that there could therefore be no likelihood of confusion within the meaning of that provision.
- 13 Thirdly, as regards the application of Article 8(5) of Regulation No 207/2009, first, the Board of Appeal stated that it would also take into account the additional evidence relating to the reputation of the goods in the category ‘horological and chronometric instruments’ in Class 14, which the applicant had provided for the first time before the Board of Appeal and which was in addition to the evidence already submitted, in that regard, before the Opposition Division.
- 14 Next, the Board of Appeal found that, even though that evidence put forward by the applicant showed clearly that its goods were very popular and that they had been on the relevant market for well over a century, it also showed that those goods were generally not, or rarely ever, designated by the sign at issue in the present case on its own. On the contrary, the mark which was affixed to them consisted of a combination of the figurative mark on which the opposition was based and the stylised word ‘longines’.

15 Lastly, the Board of Appeal found that it had not been proved that the international figurative mark on which the opposition was based would, in the absence of the word ‘longines’, in itself be recognised in the context of ‘horological and chronometric instruments’, by ‘a significant part of the relevant public in a substantial part of the territories’ of Bulgaria, Benelux, the Czech Republic, Denmark, Estonia, Spain, France, Greece, Hungary, Italy, Lithuania, Latvia, Portugal, Romania, Slovakia and Slovenia. According to the Board of Appeal, the applicant had not proved that the relevant public would manage, without any particular effort, to associate the figurative mark at issue with its goods in the aforementioned category.

Forms of order sought

16 The applicant claims that the Court should:

- annul the contested decision;
- order OHIM and the other party to the proceedings before the Board of Appeal of OHIM to pay the costs.

17 OHIM contends that the Court should:

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

Law

18 The applicant puts forward two pleas in law in support of the action. The first plea alleges infringement of Article 8(1)(b) of Regulation No 207/2009. The second plea alleges infringement of Article 8(5) of that regulation.

The first plea, alleging infringement of Article 8(1)(b) of Regulation No 207/2009

19 The applicant submits, in essence, that the Board of Appeal was mistaken in its view that there was no similarity between the goods covered by the marks at issue and that it failed to take into account their visual and conceptual similarities. Consequently, the Board of Appeal erroneously found that Article 8(1)(b) of Council Regulation No 207/2009 was not applicable.

20 OHIM disputes the applicant’s arguments.

21 Article 8(1)(b) of Regulation No 207/2009 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not 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.

22 According to settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. According to the same case-law, the likelihood of confusion must be assessed globally, according to the relevant public’s perception of the signs and goods or services in question 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 covered (see judgment of 9 July 2003 in *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, ECR, EU:T:2003:199, paragraphs 30 to 33 and the case-law cited).

- 23 For the purposes of that global assessment, the average consumer of the category of goods or services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. Account should, however, be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must rely on an imperfect recollection of them. 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 judgment in *GIORGIO BEVERLY HILLS*, cited in paragraph 22 above, EU:T:2003:199, paragraph 33 and the case-law cited).
- 24 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 judgment of 22 January 2009 in *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, ECR, EU:T:2009:14, paragraph 42 and the case-law cited).
- 25 In addition, the more distinctive the earlier mark, the greater will be the likelihood of confusion. Thus, marks with a highly distinctive character, either per se or because of their recognition on the market, enjoy broader protection than marks with a less distinctive character. The distinctive character of the earlier trade mark and, in particular, its reputation, must therefore be taken into account when assessing whether a likelihood of confusion exists (see judgment of 17 April 2008 in *Ferrero Deutschland v OHIM*, C-108/07 P, EU:C:2008:234, paragraphs 32 and 33 and the case-law cited; judgment of 28 October 2010 in *Farmeco v OHIM — Allergan (BOTUMAX)*, T-131/09, EU:T:2010:458, paragraph 67).
- 26 Lastly, it must be borne in mind that for a Community trade mark not to be registered, it suffices that a relative ground for refusal for the purposes of Article 8(1)(b) of Regulation No 207/2009 exists in part of the European Union (see, to that effect, judgment of 14 December 2006 in *Mast-Jägermeister v OHIM — Licorera Zacapaneca (VENADO with frame and others)*, T-81/03, T-82/03 and T-103/03, ECR, EU:T:2006:397, paragraph 76 and the case-law cited).
- 27 It is in the light of the principles set out in paragraphs 21 to 26 above that the applicant's first plea in law in the present case must be examined.

The relevant public and its level of attention

- 28 It must be stated at the outset that the earlier mark is an international mark with effect, inter alia, in certain Member States of the European Union, as referred to in paragraph 6 above. Consequently, in order to establish the existence of any likelihood of confusion between the marks at issue the point of view of the relevant public in those Member States must be taken into account.
- 29 Next, it must be borne in mind that, according to the case-law, the relevant public consists of consumers who are likely to use both the goods protected by the earlier mark and the goods referred to in the trade mark application (see judgment of 30 September 2010 in *PVS v OHIM — MeDiTA Medizinische Kurierdienst (medidata)*, T-270/09, EU:T:2010:419, paragraph 28 and the case-law cited). Furthermore, it should also be borne in mind that it follows from the case-law that an examination of the grounds for refusal must be carried out in relation to each of the goods in respect of which the registration of the trade mark is sought (see, to that effect, judgment of 15 February 2007 in *BVBA Management, Training en Consultancy*, C-239/05, ECR, EU:C:2007:99, paragraph 34).

- 30 The Board of Appeal stated, in paragraph 15 of the contested decision, that the goods at issue were aimed both at the general public and at specialist watch-making professionals, both of which groups were deemed to be reasonably well informed and reasonably observant and circumspect.
- 31 The applicant does not dispute the definition of the relevant public or of its level of attention, but states solely that the ‘real clients’ and the potential customers of the goods at issue constitute categories which overlap. According to the applicant, a consumer who purchases some of the goods at issue may also buy others. The applicant states, in particular, that those who purchase highly-priced items and luxury goods may also purchase inexpensive goods. Consequently, in the applicant’s view, the consumers of the goods in question are the same.
- 32 The Court takes the view that all of the goods at issue are aimed at the general public and, as regards the goods protected by the earlier mark, also at specialist watch-making professionals. Consequently, the Board of Appeal was right to take a public with that make-up into account.
- 33 As regards the relevant public’s level of attention, it must be held that the categories of goods at issue are worded in a manner which is sufficiently broad for them to include some goods which may be purchased by anyone, that is to say even by consumers whose level of attention at the time of purchase is not high.
- 34 Even though the goods covered by the earlier mark, as well as the optical sunglasses in Class 9 covered by the trade mark application, are, for the most part, not purchased regularly and are bought through a salesperson, that is to say in circumstances in which the average consumer’s level of attention must be taken to be higher than usual, and therefore fairly high (see, to that effect, judgment of 12 January 2006 in *Devinlec v OHIM — TIME ART (QUANTUM)*, T-147/03, ECR, EU:T:2006:10, paragraph 63), the fact remains that that is not true of all of those goods, inasmuch as certain watches, watch bands, alarm clocks, items of costume jewellery or even optical sunglasses may be purchased without consumers even paying particular attention to them, in particular when they are ‘inexpensive’ goods.
- 35 As regards the level of attention of the public which buys the clothing and footwear in Class 25 covered by the mark applied for, first, it must be pointed out that, as those goods are mass consumption goods, which are frequently purchased and used by the average consumer, the level of attention at the time of purchase of those goods will not be higher than average. Secondly, it must be observed that the level of attention of the public is not lower than average because the goods at issue are fashion items and the consumer therefore pays some attention in choosing them (see, to that effect, judgment of 10 November 2011 in *Esprit International v OHIM — Marc O’Polo International (Representation of a letter on a pocket)*, T-22/10, EU:T:2011:651, paragraphs 45 to 47).

The comparison of the goods

- 36 According to settled case-law, in assessing the similarity between the goods at issue, all the relevant factors relating to those goods should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see judgment of 11 July 2007 in *El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, T-443/05, ECR, EU:T:2007:219, paragraph 37 and the case-law cited).
- 37 In the present case, the Board of Appeal endorsed the Opposition Division’s finding in respect of the dissimilarity between the goods at issue. It stated that both the nature and the distribution channels of those goods differed and that they were not in competition with one another. It concluded that there was ‘an absolute absence of similarity between the goods’.

- 38 More specifically, as regards the ‘optical sunglasses’ covered by the mark applied for, the Board of Appeal found that their purpose was entirely different from that of the time-measuring instruments and jewellery covered by the earlier mark. In the Board of Appeal’s opinion, that conclusion was not altered by the fact that both could be worn as a fashion accessory. The Board of Appeal found that the aesthetic purpose of ‘optical sunglasses’ remained secondary to their primary purpose, which was, in its view, that of correcting defects in vision and protecting the eyes from intense light.
- 39 As regards the ‘clothing and footwear’ covered by the trade mark application, the Board of Appeal noted that once again the main aim of those goods is to clothe the human body and feet. In the Board of Appeal’s view, the applicant’s ‘jewellery’ is also worn on the body, but solely for aesthetic reasons. Consequently, according to the Board of Appeal, the link between those two categories of goods is too weak.
- 40 The Board of Appeal also disputed the applicant’s claim that the goods at issue are complementary because they are fashion accessories. On the contrary, according to the Board of Appeal, the connection between those goods is too vague. It took the view that sunglasses are chosen mainly on account of their technical characteristics and not because they necessarily have to match the watch or earrings that a person is wearing. It stated that the same applies to clothing and footwear, which are not usually purchased in strict accordance with the style of the watch and jewellery that a person is wearing. Although, depending on how concerned a consumer is with fashion, goods such as watches and sunglasses may or may not be perceived as fashion accessories, the fact remains, according to the Board of Appeal, that their primary purpose is different.
- 41 Lastly, the Board of Appeal referred to the judgment of 7 December 2010 in *Nute Partecipazioni and La Perla v OHIM — Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, T-59/08, EU:T:2010:500, paragraph 36, and stated that it was apparent from that judgment that jewellery and women’s clothing belonged to adjacent market segments and that therefore a certain degree of similarity between the marks was required for the application of Article 8(5) of Regulation No 207/2009. However, according to the Board of Appeal, the Court had not established or affirmed that there was a similarity between the aforementioned goods. The Board of Appeal stated that, on the contrary, in another case, which gave rise to the judgment of 24 March 2010 in *2nine v OHIM — Pacific Sunwear of California (nollie)*, T-363/08, EU:T:2010:114, paragraphs 33 to 41, the Court had upheld the Second Board of Appeal’s finding that the goods in Class 25 and those in Class 14 of the Nice Agreement were dissimilar and that neither their similarity nor their alleged complementary character could be established on the basis of mere aesthetic considerations.
- 42 The applicant submits that the goods covered by the trade mark application and the goods protected by the earlier mark are similar. According to the applicant, their nature, purpose and intended use are the same, they are complementary, interchangeable and therefore in competition with each other, they satisfy a similar demand, share the same distribution channels and they are often sold in the same establishments. Lastly, it submits, first, that it has become commonplace for producers to extend their activities to a number of related markets, ranging from clothing to cosmetics to jewellery and, secondly, that the consumers of those goods are the same.
- 43 OHIM disputes the applicant’s arguments.
- 44 It should be noted at the outset that the Board of Appeal found that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned. However, even a slight similarity between the goods concerned would have required the Board of Appeal to ascertain whether a high degree of similarity between the signs could have given rise, in the mind of a consumer, to a likelihood of confusion as to the origin of the goods (see, to that effect, judgment in *PiraÑAM diseño original Juan Bolaños*, cited in paragraph 36 above, EU:T:2007:219, paragraph 40).

- 45 It is in that context that it must be determined whether the Board of Appeal's assessment that the goods at issue are not similar is well founded.
- 46 In that regard, it must be stated at the outset that the goods which have to be compared in the present case, namely, on the one hand, the 'optical sunglasses' and 'clothing and footwear' in, respectively, Classes 9 and 25 of the Nice Agreement and, secondly, the various horological and jewellery goods, listed in paragraph 6 above, in Class 14 of that agreement, belong to adjacent market segments.
- 47 It may also be stated, by analogy with what the Court held in the context of an assessment relating to Article 8(5) of Regulation No 207/2009 in the case which gave rise to the judgment of 27 September 2012 in *El Corte Inglés v OHIM — Pucci International (Emidio Tucci)*, T-373/09, EU:T:2012:500, paragraph 66, that, even though those categories of goods are different, each of them includes goods which are often sold as luxury goods under the famous trade marks of renowned designers and manufacturers. That fact shows that there is a certain proximity between the goods at issue, in particular in the luxury goods sector.
- 48 Likewise, the Court held, still in the context of an assessment relating to the provision referred to in paragraph 47 above, in paragraph 79 of its judgment of 27 September 2012 in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, EU:T:2012:499, that, in the luxury items sector, goods like glasses, jewellery and watches are also sold under the famous trade marks of renowned designers and manufacturers and that clothing manufacturers are therefore turning towards the market for those goods. The Court deduced from that there was a certain proximity between the goods at issue.
- 49 However, notwithstanding the fact that the goods covered by the trade mark application and those protected by the earlier mark, which are referred to in paragraph 46 above, belong to adjacent market segments, it must, in the first place, be held that the Board of Appeal did not err in stating that they differed in their nature, their intended purpose and their method of use.
- 50 First, the raw materials from which they are manufactured are different, except for some similarities between certain materials which may be used both in the manufacture of optical sunglasses and for certain horological goods or jewellery, such as glass.
- 51 Secondly, clothing and footwear in Class 25 are manufactured to cover, conceal, protect and adorn the human body. Optical sunglasses are above all produced to make it easier to see, to provide users with a feeling of comfort in certain meteorological conditions and, in particular, to protect their eyes from rays of sunlight. Watches and other horological goods are designed, inter alia, to measure and indicate the time. Lastly, jewellery has a purely ornamental function (see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 33 and the case-law cited).
- 52 In the second place, it must be pointed out that as the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable.
- 53 The applicant has not shown that it is typical, notwithstanding the abovementioned differences, for a consumer who, for example, intends to buy himself a new watch or some jewellery, to decide, suddenly, to buy himself, on the contrary, clothing, footwear or optical sunglasses, and vice versa.
- 54 In that regard, in particular, it must also be stated that the applicant has not proved its claim that, in the luxury and fashion sector, it is generally the trade mark and its prestige among consumers that motivate the consumer's decision to purchase a specific item and not the actual necessity to purchase that item, inter alia for its functionalities and to fulfil a very specific need. Likewise, it is necessary to reject as not proved the applicant's claim that, as the appearance and value of the goods prevail over

other factors relating to their nature, consumers in the sector concerned are principally in search not of specific goods, but of satisfaction for their 'hedonistic needs' or that they seek the instant gratification generated by an impulse purchase.

- 55 Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation between goods which belong to the luxury sector and are protected by the respective marks, since the applicant's theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as irrelevant the applicant's claim that the goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.
- 56 What is more, it must be stated that the relevant market within which the abovementioned goods fall cannot be limited to the 'luxury' or 'haute couture' market segment alone and that specific significance cannot, in addition, be attributed to that market segment in the present case, since the categories of goods protected by the marks at issue are defined in a manner which is sufficiently broad to include both 'consumer' goods falling within a generally affordable price range and certain 'inexpensive' goods. The applicant has not claimed, in relation to the 'basic' goods falling within those market segments, that they are also purchased by consumers acting in an impulsive and hedonistic manner, with the result that those consumers may indiscriminately replace some goods with others.
- 57 In the third place, it must be pointed out that, by its other arguments, the applicant attempts, in essence, to establish a complementary connection between the goods at issue.
- 58 It must be borne in mind that, in accordance with the case-law, complementary goods or services are those which are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods intended for different publics cannot be complementary (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 50 and the case-law cited).
- 59 Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).
- 60 However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited).

- 61 In the present case, the Court considers it appropriate to continue the assessment of the similarity of the goods at issue in two parts, on account of the fact that there may be complementarity between them. The first part relates to the comparison between the ‘clothing and footwear’ covered by the trade mark application and the various horological goods, the chronometers and the jewellery protected by the earlier mark and listed in paragraph 6 above. The second part relates to the comparison between those goods and the ‘optical sunglasses’ covered by the trade mark application.
- 62 As regards the first part, it must be held that the applicant’s arguments are not sufficient to establish that the goods in question are complementary from an aesthetic standpoint.
- 63 In that regard, first, the applicant submits that the goods at issue all fall within the fashion sector, or indeed even within the ‘luxury’ sector, and that the relevant consumers are in search of a specific style and an image which they wish to convey and thus choose all the items of clothing and accessories which they acquire to match their taste, ensuring that those goods complement each other. Secondly, it claims that those goods are often purchased concomitantly and in combination.
- 64 First, it must be pointed out that it has already been held by the Court, *inter alia* in the judgment of 13 December 2004 in *El Corte Inglés v OHIM — Pucci (EMILIO PUCCI)*, T-8/03, EU:T:2004:358, paragraph 42, that even if it were established that the disputed goods related to beauty, personal hygiene, physical appearance or personal image, it would be insufficient for the goods to be regarded as similar if they were markedly different in the light of all the other relevant factors characterising their relationship.
- 65 Next, it must be borne in mind that, although the search for a certain aesthetic harmony in clothing is a common feature of the entire fashion and clothing sector, it is, nevertheless, too general a factor to justify, by itself, a finding that goods such as jewellery and watches, on the one hand, and items of clothing, on the other, are complementary (see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 36 and the case-law cited).
- 66 In the circumstances of the present case, taking into account the differences between the goods analysed (see paragraphs 49 to 56 above), it was for the applicant, as the case may be, to show the existence of sufficiently strong connections linking the goods at issue aesthetically, *inter alia* by providing specific evidence from which the Court could have deduced that the relevant public was seeking, by buying them, genuinely to coordinate its outward appearance.
- 67 In the first place, the applicant has neither shown, nor is it generally accepted, that a consumer who buys watches or other horological goods makes his choice by taking as his main criterion that of whether those goods are well matched with one or other of his items of clothing or with his shoes and vice versa, and not, principally, by assessing the inherent characteristics of those goods, their quality in relation to their main function (see paragraph 51 above), and by taking into consideration, independently, their design and their general appearance.
- 68 The claim which the applicant put forward at the hearing, to the effect that consumers in Europe are already accustomed to the goods at issue being of a certain technical quality, with the result that it can be regarded as ‘established’, does not invalidate the abovementioned findings, inasmuch as, in fact, even if that claim were regarded as true, consumers will always consider it expedient to compare the various goods in order to obtain those with a level of quality which surpasses that of competing goods and in order to choose those with characteristics and a design which most closely correspond to their expectations. Those considerations may, in addition, justify even significant differences in the prices of the goods, contrary to what the applicant submits. This applies, by analogy, to ‘jewellery’. Although the question of a certain unity of style between clothing and footwear which is normally worn, on the one hand, and clothing accessories, jewellery and watches, on the other hand, may be raised by certain consumers who are more concerned with fashion, the fact remains that that is not a sufficient connection between the goods analysed, as required by the case-law referred to in paragraphs 59

and 60 above. Furthermore, contrary to the applicant's claims, those same considerations apply even if a particular consumer purchases another watch or a second pair of sunglasses although he already owns one. In particular, it has not been shown that, as the applicant submits, a 'majority' of the relevant consumers always match their watches and their sunglasses with their outfits on the basis of the activities which they intend to engage in.

- 69 Accordingly, the Court considers that it has not been shown that the watches, other horological goods and jewellery were 'indispensable or important' for the use of clothing and footwear and vice versa in such a way that it may be held that there is aesthetic complementarity between those goods.
- 70 In the second place, it has also not been shown that consumers consider it usual that those goods are sold under the same mark, inter alia on account of the fact that a large number of the producers or distributors of the goods are the same.
- 71 First, the example given by the applicant relating to the fact that certain commercially successful fashion designers, some of whose names it cites and to whose websites it also refers, now manufacture not only clothing and footwear, but also accessories including watches and jewellery constitutes, at the very most, an indication of a recent phenomenon which must, to date and in the absence of evidence to the contrary, be held to be somewhat marginal in the overall assessment of the market sector under consideration.
- 72 In this connection, it must be stated out that there are significant differences in the nature of the goods under comparison, in their manufacturing processes and as regards the know-how necessary for the creation of a quality product in each of the branches in question. By way of example, it must be pointed out that the manufacture of a wristwatch requires either traditional know-how or a particularly specialised automated or semi-automated production line, and each of those modes of production is thus manifestly different from the manufacturing processes for clothing or footwear, and it is not, moreover, possible to take the view that the experience which an undertaking has in manufacturing one of the products under comparison will increase its abilities or skills in the production of the others.
- 73 Accordingly, even if the references to certain websites of commercially successful fashion designers (see paragraph 71 above) make it possible to regard it as established that, in the luxury sector, the same producer may manufacture both the goods covered by the trade mark application and those protected by the earlier mark, thus extending, inter alia, certain marks with a reputation from one sector to another, it must be held that it has not been established that the consumers were necessarily informed of such a practice on the market, which was not restricted to the luxury market, and that they normally expected that the same undertaking could be responsible for the manufacture of the different goods at issue, which are not at first sight related and do not, in addition, fall within the same family of goods. Furthermore, that finding is not invalidated by the applicant's enumeration, in the course of the hearing, of a multitude of other renowned producers which manufacture all the goods at issue, as this is general in nature and is not supported by any evidence. In any event, even on the assumption that those manufacturers attempt, as a general rule, to exploit their success by affixing their trade marks to a wide range of goods, it cannot be concluded that this influences the expectations of consumers outside of the luxury sector.
- 74 Consequently, it has not been established that those consumers would deduce that there is any link between the goods under comparison or that those goods constitute an extended range of goods which come from the same source.
- 75 Secondly, contrary to the applicant's claims, it cannot be shown that the goods at issue are similar by taking into account the outlets in which they are sold and their distributors.

- 76 In that regard, first, it must be borne in mind that it is apparent from the case-law that, only the ‘objective’ circumstances in which the goods covered by the marks at issue are marketed, that is to say, those which it is usual to expect for the category of goods covered by those marks, must be taken into consideration (see, by analogy, judgment of 23 September 2009 in *Phildar v OHIM — Comercial Jacinto Parera (FILDOR)*, T-99/06, EU:T:2009:346, paragraphs 68 and 73 and the case-law cited).
- 77 Next, in the present case, it must be stated that, although it is true that it cannot be ruled out, in particular as regards those of the goods at issue which fall within the luxury sector, that they may be sold in the same premises, such as on the entrance floors of ‘multi-brand’ luxury shops, in shops which are well known and brand ‘flag’ shops, in ‘duty free’ shops and also in some sections of department stores, the fact remains that it has not been established, nor is it generally accepted, that that is the case for the majority of the goods at issue, in particular for those inexpensive goods which everyone can afford. In any event, it cannot be held that, notwithstanding the differences in the nature of the products under comparison, their intended uses and their purposes, the relevant consumers will take the view that they are closely connected and that the same undertaking is responsible for manufacturing them for the sole reason that they may, in certain circumstances, be sold in the same commercial premises (see also paragraph 79 below).
- 78 As regards the second part referred to in paragraph 61 above, relating to the possible existence of aesthetic complementarity between the optical sunglasses covered by the trade mark application, on the one hand, and the watches, horological goods and jewellery protected by the earlier mark, on the other hand, it must be stated, by analogy with the foregoing considerations, that that aesthetic complementarity has also not been established by the applicant. In particular, it must be stated that, inasmuch as optical sunglasses are intended to make it easier to see and to provide users with a feeling of comfort in certain meteorological conditions, in particular by protecting their eyes from rays of sunlight (see paragraph 51 above), the Board of Appeal was right to find that consumers will focus their attention particularly on the optical characteristics and the protective capabilities of those glasses, rather than on their design in aesthetic relation to watches and jewellery, in other words, their aesthetic purpose. Accordingly, and notwithstanding the evidence provided by the applicant relating to the manufacture of sunglasses by its own undertaking, the abovementioned goods are not indispensable or important in relation to the use of optical sunglasses and vice versa.
- 79 Furthermore, as regards the applicant’s claims relating to the sales outlets which those goods have in common, it must be pointed out that the Court has already held, in paragraph 40 of the judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114 and the case-law cited, that the fact that the goods under comparison may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin.
- 80 In the light of all of the foregoing, neither the fact that there may be an overlap between the consumers of the goods at issue nor the fact that, in the luxury sector, there are examples of producers which manufacture both the goods covered by the trade mark application and the goods protected by the earlier mark is sufficient, even taken together with the applicant’s other claims, for it to be possible to hold that there is any similarity, even if only low in degree, between the goods at issue.

The likelihood of confusion

- 81 As has already been stated in paragraph 44 above, the Board of Appeal found, solely on the basis of a comparison of the goods concerned, that there was no likelihood of confusion on the part of the relevant public.

- 82 The applicant submits that the Board of Appeal did not correctly apply Article 8(1)(b) of Regulation No 207/2009 and that the similarity of the marks at issue, coupled with the similarity of the goods covered by those marks, will give rise to a likelihood of confusion.
- 83 In that regard, inasmuch as it has already been held, in paragraph 80 above, that the Board of Appeal did not err in finding that there was not even a low degree of similarity between the goods at issue, and taking into account the case-law in *easyHotel* (cited in paragraph 24 above, EU:T:2009:14, paragraph 42), according to which a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009 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 being cumulative, the Court holds that, in the present case, the Board of Appeal also did not err in excluding any likelihood of confusion on the sole basis of a comparison of the goods at issue.
- 84 In the absence of any similarity between the disputed goods, and without prejudice to the assessment of the applicant's second plea in law, relating to the provision in Article 8(5) of Regulation No 207/2009, it must be added that that finding cannot be invalidated by the various claims of the applicant relating to the alleged reputation of the earlier mark and to the unfair advantage which the trade mark applicant will obtain from it, those claims being irrelevant as one of the cumulative conditions set out in Article 8(1)(b) of the regulation in question is not satisfied. The lack of similarity of the goods at issue cannot be offset, in the context of the global assessment of the likelihood of confusion, by the fact that the disputed marks are similar or even identical, whatever the level of recognition of those marks by the relevant consumers may be.
- 85 Lastly, in the light of the circumstances of the present case, the Court holds that it is not necessary to rule on the admissibility of the applicant's references to two decisions by Spanish courts in a case which the applicant regards as analogous to that at issue in the present case, namely, first, a decision of the Tribunal Superior de Justicia de Madrid (High Court of Justice, Madrid, Spain), dated 13 March 2013, and, secondly, a decision of the Tribunal Supremo (Supreme Court, Spain) of 9 January 2014, by which the Tribunal Supremo dismissed as inadmissible an appeal on a point of law against the aforementioned decision of the Tribunal Superior de Justicia de Madrid, which, first, had annulled a decision of the Oficina Española de Patentes y Marcas (Spanish Patents and Trade Marks Office) relating to the registration of a trade mark identical to that applied for in the present case and, secondly, had revoked that registration, holding it to be without effect.
- 86 In that regard, even if those references were held to be admissible, it must be borne in mind that it is apparent from settled case-law that national decisions on registrations in the Member States and, by analogy those cancelling or refusing registration, are only factors which may be taken into consideration, without being given decisive weight, in the registration of a Community trade mark. The same considerations apply to the case-law of the courts of the Member States (see, to that effect, judgment of 16 February 2000 in *Procter & Gamble v OHIM (Shape of a soap)*, T-122/99, ECR, EU:T:2000:39, paragraph 61, and judgment of 19 September 2001 in *Henkel v OHIM (Round red and white tablet)*, T-337/99, ECR, EU:T:2001:221, paragraph 58). That case-law, which was established in the context of the absolute grounds for refusal, is applicable, by analogy, in respect of the relative grounds for refusal of registration.
- 87 It must be pointed out that, unlike the present case, that dealt with by the Tribunal Superior de Justicia de Madrid and, thereafter, by the Tribunal Supremo, related to a specific case in which the various goods in Class 9 of the Nice Agreement protected by the marks at issue had been held to be 'identical'. It was in such factual circumstances, from which it is not possible to draw inferences in relation to the present case, that the Tribunal Superior de Justicia de Madrid carried out the assessment of the similarities between the marks and held, in the context of a global assessment, that there were similarities and that there was, therefore, a likelihood of confusion. The Tribunal Supremo dismissed the appeal on a point of law, in essence, for procedural reasons which also cannot have any effect on the present proceedings.

88 Consequently, the applicant's first plea must be rejected.

The second plea, alleging infringement of Article 8(5) of Regulation No 207/2009

89 The applicant submits that the Board of Appeal erred in its assessment that the earlier mark did not have a reputation when considered in the form in which it was registered, that is to say without the word element 'longines'. On the contrary, the applicant maintains that the conditions for the application of Article 8(5) of Regulation No 207/2009 were satisfied.

90 OHIM disputes the applicant's arguments.

91 Article 8(5) of Regulation No 207/2009 provides that, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for must 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 European Union 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 (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 47 above, EU:T:2012:500, paragraph 55).

92 According to the case-law, the purpose of Article 8(5) of Regulation No 207/2009 is not to prevent registration of any mark which is identical with a mark with a reputation or similar to it. The objective of that provision is, notably, to enable the proprietor of an earlier national mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark, or to take unfair advantage of that repute or distinctive character (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 47 above, EU:T:2012:500, paragraph 56 and the case-law cited). Those same considerations apply, by analogy, pursuant to Article 8(2)(a)(iii) of the abovementioned regulation, read in conjunction with Article 8(5) thereof, to earlier trade marks with a reputation that are registered under international arrangements which have effect in a Member State of the European Union.

93 In the present case, as has already been stated in paragraphs 13 to 15 above, the Board of Appeal found, in essence, that even though the evidence put forward by the applicant showed clearly that its goods were very popular and that they had been on the relevant market for well over a century, it also showed that those goods were generally not designated by the sign at issue in the present case on its own, but by a composite mark which also included the stylised word 'longines'. According to the Board of Appeal, the use which was made of the sign at issue was not sufficient to prove that a significant part of the relevant public in a substantial part of the territories of the countries listed in paragraph 15 above, would know that sign, on its own and without the word element, in the context of horological and chronometric instruments. It took the view that it is not possible to determine the reputation of a trade mark abstractly. According to the Board of Appeal, the applicant had failed to prove that the relevant public would effortlessly associate the figurative sign consisting of a 'winged hourglass' with the horological and chronometric instruments that the applicant produced.

94 The applicant puts forward, in essence, claims which may be classified into two parts. The first part relates to the fact that, according to the applicant, the earlier figurative mark has a reputation throughout the world as regards horological and chronometric instruments and jewellery in Class 14, as is apparent from the documentation submitted to OHIM.

95 By the second part of its claims, the applicant seeks, in principle, to establish that the registration of the mark applied for would be detrimental to the idea of exclusivity and the image of luxury and high quality that the earlier trade mark conveys and, therefore, to its reputation and distinctive character.

The applicant states that the registration of the mark applied for would dilute the ability of the earlier mark, which is a ‘winged hourglass’, to distinguish well-defined goods and to stimulate the desire of consumers. It also refers to the ‘parasitic’ nature of the mark applied for, which will obtain an unfair advantage, which it considers to be quite probable and foreseeable, from the fact that the earlier mark is highly reputed.

- 96 In that regard, since, as the Board of Appeal rightly stated in paragraph 24 of the contested decision, the application of Article 8(5) of Regulation No 207/2009 is subject to certain cumulative conditions (see also paragraph 91 above), including that of establishing that the earlier mark on which the opposition is founded has a reputation, the Court considers that it is appropriate to assess, first of all, the first part of the applicant’s claims. Accordingly, it must be assessed whether the Board of Appeal was right to find that such a reputation had not been proved in the present case and to therefore find, on that basis alone, that the applicant could not rely on the aforementioned provision for the purposes of opposing the registration of the mark applied for.
- 97 First, in the context of its claims relating to the aforementioned first part, the applicant submits that, contrary to the opinion of the Board of Appeal, the earlier mark is commonly used even without the word ‘longines’, for example on certain ‘buckles’ used in jewellery and horology and on the winding buttons of watches. Moreover, according to the applicant, all the evidence that was sufficient for the Board of Appeal to consider the word ‘longines’ in combination with the earlier mark to be a reputed trade mark should also serve as proof of the reputation of the earlier figurative mark on its own. In the applicant’s view, that mark may be used with or without the word ‘longines’.
- 98 Secondly, the applicant points out that the earlier mark has been used to designate its goods since 1874, that its first use even dates back to 1867 and that it is ‘extremely well-known’, not only to watch professionals, but also to the average consumer. According to the applicant, the imprint of that trade mark on metals and on goods enables consumers or professionals to verify whether or not the goods are originals.
- 99 Thirdly, the applicant states that the earlier mark, which transmits to the consumer various positive messages relating to the goods, has an autonomous and distinct value that goes beyond the goods it covers in Class 14 and thus extends to those in Classes 9 and 25.
- 100 The Court points out that, according to the case-law, in order to satisfy the requirement of reputation, a mark must be known to a significant part of the public concerned by the goods or services covered by that trade mark. In examining that condition, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by the earlier mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. There is, however, no requirement for that mark to be known by a given percentage of the relevant public or for its reputation to cover all the territory concerned, so long as that reputation exists in a substantial part of that territory (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 47 above, EU:T:2012:500, paragraph 58 and the case-law cited).
- 101 In the present case, it is apparent from the evidence provided by the applicant before OHIM that its goods do indeed have a significant, long-term presence, at least in some of the Member States of the European Union, in which the earlier mark is protected. The Board of Appeal, moreover, expressly confirmed that fact in the contested decision, but stated that those goods were generally not, or rarely ever, marketed with the earlier mark on its own, but that they were designated by a composite mark which includes, inter alia, the figurative sign of which the earlier mark consists.
- 102 As is apparent from paragraph 35 of the contested decision, the Board of Appeal attached particular importance to the fact that, ‘in the used combination of the winged hourglass device and the word “longines”, the latter is the visually dominant element’. It also stated, in the same paragraph of the contested decision, that the finding might have been different if, for instance, the earlier mark ‘had

consistently been represented in a different manner, as a combination of a large figure and a small verbal element, or if the appellant had provided any proof that the consumers were indeed accustomed to focusing on the winged hourglass device rather than on the “longines” component’. According to the Board of Appeal, the latter considerations had, however, to be set aside in view of the facts of the present case.

- 103 In that regard, first of all, the Court holds that, in view of the items of evidence submitted by the applicant, the Board of Appeal rightly stated, that it was not apparent from that evidence that consumers were accustomed to focusing on the ‘winged hourglass’ element in the composite mark used. By way of example, it must be pointed out that that evidence does not contain any opinion polls of the relevant public relating, *inter alia*, to its perception of the composite mark used or the question of which elements were memorised or, at the very least, recognised by that public, when faced with various marks in the course of its shopping, as referring to the applicant’s goods. In particular, the applicant has not, in addition, submitted opinion polls in which target persons who were shown only the figurative sign representing a ‘winged hourglass’ had to state whether they knew that sign and, if so, what they associated it with.
- 104 Next, contrary to the applicant’s claims, the Court holds that the evidence which the applicant put forward before OHIM regarding the use of the earlier mark consisting of a ‘winged hourglass’ is not sufficient for it to be held that it has been proved to have a reputation.
- 105 First, it is apparent from that evidence, as OHIM, moreover, rightly states that, when the earlier mark is used alone on watches it is not located in a visually significant position. On the contrary, it is sometimes situated in locations in which it may not be noticed on account of its size and position. Those considerations apply, in particular, to the references which the applicant has made to the use of the earlier mark on buckles, bands and the winding buttons of watches.
- 106 Secondly, it is not, in addition, apparent from the evidence which the applicant submitted before OHIM that the earlier mark, on its own, was used in promotional material, on invoices or in magazines in a way which is sufficiently significant, whether assessed from a quantitative or qualitative point of view, and consistent over a period of time for it to be capable of having an effect on the assessment of its reputation. As the Board of Appeal rightly found, it is apparent from the evidence that, apart from certain exceptions, it is the composite mark, consisting of the earlier mark and the word ‘longines’, that is regularly used.
- 107 Accordingly, the main question which still has to be settled by the Court is that of whether the relevant public, which has on numerous occasions been faced with advertisements, documents or even goods in which or on which the composite mark consisting of the earlier mark and the word ‘longines’ appears, has also noticed and memorised that earlier mark on its own in a sufficiently consistent way for it to be possible to deduce from that that the earlier mark has a reputation in accordance with the criteria set out in paragraph 100 above.
- 108 First, in that regard, the Court must take into account the fact that the evidence submitted by the applicant shows, *inter alia*, that the abovementioned advertisements appeared in all kinds of magazines or newspapers, which are written in various languages and marketed, *inter alia*, in the Member States of the European Union which are relevant in the present case. Furthermore, the Board of Appeal stated, in that regard, in the sixth indent of paragraph 25 of the contested decision, that 31 of those cuttings come from magazines and newspapers from Member States of the European Union.
- 109 Secondly, it is necessary to take into account the fact that the great majority of the magazines are not aimed at a public which consists solely of professionals, but that the target consumers are members of the general public, whether they are consumers who are interested in fashion, in news about people or those who are seeking information about their hobbies, including various sports. Some advertisements

were published in magazines for collectors and others were published in general-interest magazines. The Court also notes that, on a number of occasions, those advertisements took up a whole page or half a page in those magazines or newspapers.

- 110 Thirdly, it is apparent from the evidence which the applicant submitted to OHIM that the advertisements for the composite mark at issue, or the goods covered by that mark, were often presented in a context or in connection with celebrities from the world of culture or sport. To that effect, it is apparent from various documents provided by the applicant that its advertisements benefit from cooperation with personalities who are known throughout the world, including actors, poets, tennis players, sportspersons from the field of equestrian sports, skiers, cyclists, archers, gymnasts and even certain models. The goods at issue have thus been worn, for advertising purposes, by sportspersons or actors with a reputation throughout the world such as André Agassi, Audrey Hepburn and Humphrey Bogart.
- 111 Fourthly, the Court also takes into consideration the fact, which is apparent from the evidence, that, on numerous occasions, advertisements for the composite mark at issue, which consists of the graphic element of a 'winged hourglass' and the word 'longines', were displayed in the course of various sports competitions, some of which at least were broadcast on television.
- 112 Fifthly, it is also apparent from the tables and other items of evidence which the applicant submitted to OHIM that, for many years, and in particular from 2002 to 2010, it spent large sums on advertising in various countries such as France, Spain or Italy, which are relevant in the present case. The applicant also provided examples of invoices relating to the sale of the goods in question, in particular watches. Those invoices always bear the composite mark and show that the applicant has a significant presence on the European market, in particular in France, Germany, Italy and Spain. Lastly, the applicant also submitted certain market surveys concerning the penetration of the market by the composite mark in some of the Member States of the European Union, including France, Germany, Italy and the United Kingdom.
- 113 Accordingly, consistent items of evidence show the long-term use of the composite mark, not only in Switzerland, but also in certain Member States of the European Union which are relevant in the present case.
- 114 The Court holds that the abovementioned facts, taken as a whole, do not invalidate the findings of the Board of Appeal referred to in paragraph 93 above.
- 115 In the absence of specific evidence showing that consumers were accustomed to focusing, in particular, on the 'winged hourglass' element in the composite mark as used (see paragraph 103 above), it is necessary to assess, by carrying out a global analysis of that mark and its various components, what perception the relevant public has of it.
- 116 In that regard, it must be held, as was found by the Board of Appeal, that it is apparent from the evidence which the applicant submitted to OHIM relating to the use of the composite mark that it was clearly its word element, which consists of the word 'longines', which was dominant in the overall impression created by that sign, in particular from a visual point of view.
- 117 First, that is so on account of the position of that word within the composite mark, namely, in the upper half of that mark, and on account of the fact that it is both longer and broader than the graphic element, which consists of a 'winged hourglass' and is considerably smaller in size.
- 118 Next, the word 'longines' is easily legible as it is written in capital letters and in a font the graphic form of which does not deviate particularly from those of generally used fonts. The only graphic element which is somewhat specific to the word 'longines' is a certain extension, through the addition of a small stroke, to the ends of the capital letters of which it consists.

- 119 It must also be stated that the graphic element consisting, according to the applicant, of a ‘winged hourglass’, although it cannot be held to be negligible in the composite mark as used, nevertheless remains clearly ancillary and in the background in the overall impression which consumers perceiving that mark will have, not only on account of its size, which is smaller than that of the word ‘longines’, but also on account of its rather complicated nature, in the sense that it consists of a representation of outstretched wings containing in their middle a kind of rectangle, which rests on its short side and is divided by two diagonals. Those diagonals are themselves linked together by two horizontal lines and the whole is not easily memorisable. That same analysis holds good in respect of the few variations on that graphic device which are used by the applicant.
- 120 In addition, the Court holds that it is by no means established that the relevant public, which, moreover, does not focus its attention on the details of the composite mark used, perceives the part situated in the middle of the graphic device as constituting a kind of stylised ‘hourglass’. Although such an evocation may, as the case may be, occur more readily to consumers who are aware of the fact that a figurative mark consisting of a ‘winged hourglass’, albeit with different graphic design, had already been used by the applicant in the nineteenth century and was subsequently one of the first international registrations with the World Intellectual Property Organisation (WIPO), a point to which the applicant refers, it must be stated, as the Board of Appeal rightly pointed out in paragraph 34 of the contested decision, that that is not something which may be regarded as well-known to the public concerned, which, it must be borne in mind, does not consist solely of professionals from the horological sector (see also paragraph 125 below). Consequently, there are also no reasons linked to the conceptual content of the graphic element in question which would lead a substantial part of the relevant public to memorise that element in particular.
- 121 In the light of all of the foregoing, the Court holds that the Board of Appeal did not err in finding that it had not been proved that the earlier mark, taken as registered, has a reputation. In spite of the continuous quantitatively and qualitatively significant use of the composite mark consisting of the earlier mark and the word ‘longines’ over a period of time, it is the latter word which will attract the attention of consumers and will probably be retained by them and it has not been shown that a substantial part of the relevant public, in one or more of the Member States of the European Union in respect of which a reputation has been claimed, is also aware of the earlier mark in itself and associates it, without effort, with the applicant’s horological and chronometric goods, which are the only goods to which the claim in respect of reputation relates.
- 122 None of the applicant’s other claims can invalidate that finding.
- 123 In the first place, it is true, as the applicant submits, that it is not inconceivable, in theory, that the use of an earlier mark in a composite mark may be sufficient for it to be held that that earlier mark has a reputation, notwithstanding the fact that it has not, or not much, been used on its own, independently of the composite mark.
- 124 Such a possibility is apparent from the application, by analogy, of the case-law according to which a mark can acquire a particular distinctive character on account of its prolonged use and of its renown as part of another registered trade mark, provided that the target public perceives the mark as indicating that the goods come from a specific undertaking (see, to that effect, judgment of 7 September 2006 in *L & D v OHIM — Sämann (Aire Limpio)*, T-168/04, ECR, EU:T:2006:245, paragraph 74). However, in the present case, as the Board of Appeal rightly stated in paragraph 35 of the contested decision, for the possible conclusion to be reached that the earlier mark has a reputation, it would have been necessary to represent it differently in the composite mark used, so that it was memorised by the relevant public.
- 125 In the second place, the applicant’s various claims highlighting the long history and the consistent use of the earlier mark are not, in the absence of sufficiently specific evidence that a substantial part of the relevant public was aware of that mark, conclusive for the purpose of proving that it has a reputation.

In particular, although it is true that the applicant also submitted among the items of evidence some articles relating to the long-standing nature of the use and registration of a sign consisting of a 'winged hourglass', it must, first, be stated that some of them are articles aimed more at a public which consists of professionals and others are articles aimed at Swiss readers, and it has not been shown that they actually reached a significant part of the relevant public in the present case. In any event, it must be pointed out that the graphic device of the 'winged hourglass' which was used historically and was executed in a particularly detailed manner, differs notably from the graphic device which is currently used in the earlier mark.

- 126 In the third place, for reasons analogous to those stated in paragraph 125 above, it is necessary to reject as unproved the applicant's claim that not only professionals but also the general public were aware of the fact that it was through the graphic device of a 'winged hourglass' that the original goods of the applicant were recognisable and could be distinguished from counterfeit goods. In particular, the Court holds that, for a significant part of the relevant public, it is the actual use of the word 'longines' on the goods in question that fulfils that function.
- 127 Consequently, in view of all those circumstances, the applicant cannot maintain that it is through the 'reputed' earlier mark that it transmits to consumers various positive messages relating to the goods and that that mark has an autonomous and distinct value that goes beyond the goods it covers in Class 14 and thus extends to those in Classes 9 and 25. Even though it cannot be ruled out that the composite sign used has such a reputation on account of the presence of the word 'longines', the same cannot be true of the earlier mark on its own.
- 128 Accordingly, and in so far as the Board of Appeal confined itself, in its analysis of Article 8(5) of Regulation No 207/2009, to finding that the reputation of the earlier mark had not been proved (see paragraph 96 above), it is not for the Court to assess, for the first time, the applicant's claims relating to whether the other conditions for the application of that provision (see paragraphs 91 and 92 above) are satisfied or not, those claims being irrelevant to the outcome of the present case.
- 129 It follows that the applicant's second plea must also be rejected and the action must be dismissed in its entirety.

Costs

- 130 Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- 131 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Compagnie des montres Longines, Francillon SA, to pay the costs.**

Dittrich

Szwarcz

Tomljenović

Delivered in open court in Luxembourg on 12 February 2015.

[Signatures]