



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

6 April 2017¹

(EU trade mark — Opposition proceedings — International registration designating the European Union — Figurative mark NANA FINK — Earlier EU word mark NANA — No similarity between the goods — Article 8(1)(b) of Regulation (EC) No 207/2009 — Extent of the examination to be carried out by the Board of Appeal — Duty to rule on the entirety of the action)

In Case T-39/16,

Nanu-Nana Joachim Hoepf GmbH & Co. KG, established in Bremen (Germany), represented by T. Boddien, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by A. Schifko, acting as Agent,

defendant,

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

Nadine Fink, residing in Basel (Switzerland),

ACTION brought against the decision of the First Board of Appeal of EUIPO of 12 November 2015 (Case R 679/2014-1), relating to opposition proceedings between Nanu-Nana Joachim Hoepf and Ms Fink,

THE GENERAL COURT (Fifth Chamber),

composed of D. Gratsias, President, A. Dittrich and P.G. Xuereb (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 25 January 2016,

having regard to the response lodged at the Court Registry on 25 April 2016,

having regard to the written questions put by the Court to the parties and their answers to those questions lodged at the Court Registry on 30 November 2016,

¹ — Language of the case: German.

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

- 1 On 29 March 2012, the company of which Ms Nadine Fink is the successor obtained from the International Bureau of the World Intellectual Property Organisation (WIPO) international registration No 1111651 designating the European Union for the following figurative mark:



NANA FINK

- 2 The goods in respect of which that international registration was obtained are in Classes 14, 18 and 26 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 14: 'Precious metals and their alloys and goods in precious metals or coated therewith (included in this class); jewellery, precious stones; horological and chronometric instruments; key rings; cases for watches (presentation), fittings and ornaments for zip fasteners of precious metals';
 - Class 18: 'Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, satchel bags, pocket wallets';
 - Class 26: 'Belt clasps, fittings and ornaments for zip fasteners of precious metals'.
- 3 That international registration was notified to the European Union Intellectual Property Office (EUIPO), pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1). It was published in *Community Trade Marks Bulletin* No 71/2012 of 13 April 2012. On 24 August 2012, that international registration was transferred to Ms Fink.
- 4 On 9 January 2013, the applicant, Nanu-Nana Joachim Hoepf GmbH & Co. KG, filed a notice of opposition, pursuant to Articles 41 and 156 of Regulation No 207/2009, to the international registration, in so far as it designated the European Union, in respect of all the goods referred to in paragraph 2 above.

- 5 The opposition was based on the earlier EU word mark NANA, registered on 19 April 2011 under No 6218945 covering inter alia goods in Classes 14, 18 and 26 and corresponding, for each of those classes, to the following description:
- Class 14: ‘Horological and chronometric instruments of all kinds; costume jewellery; key fobs; jewellery; decorative articles of precious metal’;
 - Class 18: ‘Leather and imitations of leather, and goods made of these materials (included in Class 18); bags of all kinds (included in Class 18); pocket wallets, purses; cases of all kinds (included in Class 18); umbrellas, parasols and walking sticks; travel requisites and parts therefor (included in Class 18)’;
 - Class 26: ‘Artificial flowers’.
- 6 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009.
- 7 By decision of 21 January 2014, the Opposition Division upheld the opposition in part. The opposition was rejected, due to the lack of similarity of the goods, so far as concerns the following goods:
- Class 14: ‘Fittings and ornaments for zip fasteners of precious metals; precious metals and their alloys’;
 - Class 18: ‘Leather and imitations of leather, not included in other classes; animal skins’;
 - Class 26: ‘Belt clasps, fittings and ornaments for zip fasteners of precious metals’.
- 8 The Opposition Division upheld the opposition, because of a likelihood of confusion, as regards the other goods covered by the international registration at issue.
- 9 On 7 March 2014, the applicant filed an appeal with EUIPO against the decision of the Opposition Division pursuant to Articles 58 to 64 of Regulation No 207/2009.
- 10 By decision of 12 November 2015 (‘the contested decision’), the First Board of Appeal of EUIPO dismissed the appeal. It took the view, inter alia, that the Opposition Division had rejected the opposition for the following goods:
- Class 14: ‘Fittings and ornaments for zip fasteners of precious metals’;
 - Class 18: ‘Leather and imitations of leather, not included in other classes; animal skins’;
 - Class 26: ‘Belt clasps, fittings and ornaments for zip fasteners of precious metals’.
- 11 The Board of Appeal held that those goods and the goods covered by the earlier mark were not similar. In this context, it noted inter alia that the goods were, in part, spare parts and, in part, raw materials or semi-finished materials — used in the first place in the manufacture of other goods and directed at a particularly observant specialist public — whereas the goods covered by the earlier mark were end products, intended for the reasonably observant end consumer. The Board of Appeal concluded that, given the lack of similarity of the goods at issue, there was no likelihood of confusion between the marks at issue.

Forms of order sought

12 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs.

13 EUIPO contends that the Court should:

- dismiss the application;
- order the applicant to pay the costs.

Law

The admissibility of certain arguments put forward by the applicant

- 14 EUIPO argues that the applicant largely bases its claims regarding the similarity of the goods in Classes 14, 18 and 26 in the light of goods — such as ‘belts’, ‘clothes’ or ‘furniture’, ‘articles of bedding’ and ‘artists’ materials’ — which are in fact covered by other classes for which the earlier mark was registered, but which have not been the subject of administrative proceedings before EUIPO. Therefore, EUIPO submits, the applicant’s explanations in respect of those other goods must be considered inadmissible.
- 15 Furthermore, EUIPO claims that the applicant puts forward new arguments for the first time before the Court. In that regard, first of all, EUIPO refers to the applicant’s claim that ‘leather’ and ‘animal skins’ are not only used as raw materials intended for transformation into end products, but are also sold directly on the market as such as, inter alia, decoration objects. EUIPO goes on to submit that the applicant’s line of argument that the earlier mark of which it is the proprietor is also registered for actual ‘imitations of leather’ is also new. Finally, EUIPO points to the novel nature of the applicant’s argument relating to the approach followed by the Board of Appeals in earlier decisions, on the occasion of which they found a similarity between ‘leather’ and ‘animal skins’ for the purpose of semi-manufactured goods, first, and end products, manufactured from those materials, second. Given that those arguments are being submitted for the first time before the Court, they should, in EUIPO’s view, for that reason be declared inadmissible.
- 16 It must be noted that, according to settled case-law, the purpose of actions brought before the Court pursuant to Article 65(2) of Regulation No 207/2009 is to secure a review of the lawfulness of decisions of the Boards of Appeal. In the context of that regulation, Article 76 thereof requires that review to be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (see, to that effect, judgment of 1 February 2005, *SPAG v OHIM — Dann and Backer (HOOLIGAN)*, T-57/03, EU:T:2005:29, paragraph 17 and the case-law cited).
- 17 Moreover, under Article 188 of the Rules of Procedure of the General Court, the pleadings lodged by the parties in proceedings before the Court may not change the subject matter of the proceedings before the Board of Appeal.
- 18 EUIPO’s arguments relating to the admissibility of certain of the applicant’s arguments must be examined in the light of those principles.

- 19 As regards the admissibility of the applicant's argument concerning the comparison of the goods at issue in the light of goods other than those which were the subject of the administrative proceedings before EUIPO, it must be noted that, on the opposition form, the applicant did not select, under the section 'goods and services on which the opposition is based', the box 'all the goods and services covered by the registration/application', but the box 'part of the goods and services, namely' and indicated, in that section, 'all the goods in Classes 14, 18 and 26'. The applicant thus based the opposition solely on the goods in Classes 14, 18 and 26 covered by the earlier mark. Accordingly, the applicant's arguments regarding similarity with other goods did not form part of the subject matter of the action before the Board of Appeal and must, for that reason, be declared inadmissible.
- 20 By contrast, the applicant's argument that 'leather' and 'animal skins' are sold not only as raw materials but also as end products must be declared admissible.
- 21 In paragraphs 32 to 35 of the contested decision, the Board of Appeal relied in essence on well-known facts — that is to say, facts which are likely to be known by anyone or which may be learned from generally accessible sources — by stating that 'leather and imitations of leather, not included in other classes; animal skins' were semi-manufactured goods and were directed at a different public to that to which the end products covered by the earlier mark were directed.
- 22 It is apparent from the case-law that a party, against whom EUIPO relies on well-known facts, may challenge the accuracy of those facts before the General Court (judgment of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraph 52; order of 3 June 2009, *Zipcar v OHIM*, C-394/08 P, not published, EU:C:2009:334, paragraph 43; and judgment of 10 November 2011, *LG Electronics v OHIM*, C-88/11 P, not published, EU:C:2011:727, paragraph 28).
- 23 Furthermore, the applicant's argument concerning EUIPO's usual decision-making practice must also be considered admissible, in that, according to the case-law, a party has the right to refer to it, despite being produced for the first time before the General Court, and even if that practice occurs after the procedure before EUIPO is complete (see, to that effect, judgment of 24 November 2005, *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, EU:T:2005:420, paragraph 20).
- 24 Finally, the applicant's argument that the earlier mark of which it is the proprietor is also registered for actual 'imitations of leather' must also be declared admissible and its merits must be considered.
- 25 That argument of the applicant concerns, in essence, the interpretation of the list of goods covered by the earlier mark. In that regard, it is important to note that the question whether the wording of Class 18 with respect to the earlier mark should be read as including 'leather goods', actual 'imitations of leather' and 'goods made of imitations of leather' or whether it should be read as meaning that it only covers 'leather goods' and 'goods made of imitations of leather' is a question which was part of the factual and legal context before the Board of Appeal.
- 26 In order to be able to examine the identity or similarity of the goods at issue, the departments of EUIPO must always determine which goods are covered by the marks at issue and, in that context, they must, where appropriate, interpret the list of goods for which a mark is registered. An argument concerning the interpretation of the list of goods covered by the earlier mark cannot therefore be regarded as falling outside the scope of the dispute, as brought before the Board of Appeal. The issues which necessarily had to be resolved in order to rule in the opposition proceedings form part of the factual and legal framework before the Board of Appeal (see, to that effect, judgment of 1 February 2005, *HOOLIGAN*, T-57/03, EU:T:2005:29, paragraph 25).

The incorrect identification of the goods that are the subject of the action and the failure to adjudicate on certain goods

- 27 It must be noted that, in the statement of grounds for its appeal before the Board of Appeal, the applicant stated that the Opposition Division had rejected the opposition for ‘fittings and ornaments for zip fasteners of precious metals’, in Class 14, ‘animal skins’, in Class 18, and ‘belt clasps and fittings and ornaments for zip fasteners of precious metals’ in Class 26.
- 28 It must be stated that ‘precious metals and their alloys’ as well as ‘leather and imitations of leather’, for which the opposition was also rejected, do not appear in that list.
- 29 Although the Board of Appeal examined the goods ‘leather and imitations of leather’, this was not the case for ‘precious metals and their alloys’, since it considered that the Opposition Division had not rejected the opposition for those goods.
- 30 In that regard, it must be noted that it is apparent from the operative part of the Board of Appeal’s decision that, although the latter upheld the opposition for ‘products made of precious metals and their alloys’, it rejected, by contrast, the opposition for ‘precious metals and their alloys’, in respect of which it considered that there was no similarity with the goods protected by the earlier mark. At page 6 of the Opposition Division’s decision, the latter indicated that it rejected the opposition for all the goods which were not similar to the goods covered by the earlier mark, which included ‘precious metals and their alloys’.
- 31 Since the Board of Appeal held that the Opposition Division had rejected the opposition solely for the goods listed in paragraph 1 of the contested decision — which referred, as regards the goods in Class 14 covered by the international registration at issue, to ‘fittings and ornaments for zip fasteners of precious metals’ alone, without any reference to ‘precious metals and their alloys’ — the parties were invited, by way of a measure of organisation of procedure, pursuant to Article 89 of the Rules of Procedure, to take a view on, first, the scope of the subject matter of the proceedings before the Board of Appeal and, second, on the possible effect on the outcome of the present dispute of the Board of Appeal’s failure to adjudicate on ‘precious metals and their alloys’ in Class 14, as regards the international registration at issue.
- 32 In answer to the questions asked, first, the applicant explained that the appeal which it had brought before the Board of Appeal covered the Opposition Division’s decision as a whole, in so far as the opposition had been rejected. Therefore, the request before the Board of Appeal was to be understood as meaning that it challenged also the rejection of the opposition for ‘leather and imitations of leather’ and ‘precious metals and their alloys’.
- 33 The applicant submits that the error made by the Board of Appeal in failing to adjudicate on ‘precious metals and their alloys’ should be penalised by the annulment of the contested decision.
- 34 Second, EUIPO declared that the scope of the subject matter of the dispute was not clearly apparent from the applicant’s application before the Board of Appeal. EUIPO nevertheless stated that the Board of Appeal should have interpreted that application as covering all of the goods in respect of which the Opposition Division had rejected the opposition, which included ‘leather and imitations of leather’ and ‘precious metals and their alloys’.
- 35 According to EUIPO, the error caused by the Board of Appeal’s failure to adjudicate on ‘precious metals and their alloys’ has no bearing on the outcome of the present dispute, especially since the applicant itself failed to mention those goods in both its action before EUIPO and the proceedings before the Court.

- 36 In the light of the foregoing, it must be found that the appeal brought by the applicant before the Board of Appeal concerned the Opposition Division's decision as a whole, in so far as the opposition had been rejected. That finding is evident from both EUIPO's form concerning the scope of the appeal and the conclusions submitted in the applicant's statement of grounds for appeal. First, in that form, the applicant ticked the box indicating that the decision had been contested as a whole and, second, in its statement, the applicant submitted, firstly, that the opposition should be upheld for all of the goods at issue and, secondly, that the protection of the international registration in the European Union should be refused in its entirety. Both the applicant and EUIPO have indeed confirmed, in their responses to the questions asked, that the appeal brought by the applicant before the Board of Appeal had to be construed as having been brought against the Opposition Division's decision as a whole, in so far as the opposition had been rejected.
- 37 Therefore, it must be found that the Board of Appeal failed to adjudicate on the appeal brought before it as far as it concerned the rejection of the opposition in relation to 'precious metals and their alloys' in Class 14, for the international registration at issue. By doing so, the Board of Appeal infringed the obligation, stemming from the first sentence of Article 64(1) of Regulation No 207/2009, to decide on the appeal before it. That obligation must be understood to mean that the Board of Appeal is required to rule on each of the heads of claim before it in its entirety, either by upholding it, rejecting it as inadmissible or rejecting it on substantive grounds. It must be noted that failure to meet that obligation may affect the content of the decision of the Board of Appeal and that the obligation therefore represents an essential procedural requirement, infringement of which can be raised by the Court of its own motion (judgment of 10 June 2008, *Gabel Industria Tessile v OHIM — Creaciones Garel (GABEL)*, T-85/07, EU:T:2008:186, paragraph 20).
- 38 In contrast to EUIPO's contentions in its responses to the Court's written questions, it cannot be inferred that the Board of Appeal, by dismissing the appeal as a whole, upheld, in accordance with the principle of functional continuity, the opinion of the Opposition Division as regards 'precious metals and their alloys'. It is apparent from the contested decision that the Board of Appeal did not note that those goods were part of the appeal before it. It therefore cannot be accepted that the Board of Appeal intended to adopt the Opposition Division's findings relating to 'precious metals and their alloys'.
- 39 It should, furthermore, be noted that the Court cannot adjudicate on an issue on which the Board of Appeal has not taken a position (see, to that effect, judgment of 5 July 2011, *Edwin v OHIM*, C-263/09 P, EU:C:2011:452, paragraph 72). That is the situation in the present case, in that it is common ground that the Board of Appeal did not at all rule on 'precious metals and their alloys'. The contested decision must, therefore, be annulled in so far as the Board of Appeal failed to adjudicate on 'precious metals and their alloys', in Class 14, for the international registration at issue.

The goods protected by the earlier mark

- 40 In the context of its analysis relating to the relationship between the goods covered by the marks at issue in Class 18, the applicant claimed that the earlier mark of which it is the proprietor was registered for 'leather goods', actual 'imitations of leather' as such, as well as for 'goods made of imitations of leather'. Its reasoning is based on the wording of the list of goods in German, the language in which the application for registration of the earlier mark was submitted, and which is worded as follows: 'Waren aus Leder und Lederimitationen sowie Waren daraus (soweit in Klasse 18 enthalten)' (Leather and imitations of leather, and goods made of these (included in Class 18)).
- 41 EUIPO takes issue with that contention of the applicant. First, it stresses that the wording of the lists of goods in Class 18 covered by the earlier mark differs from that enshrined in the Nice Agreement, which is worded as follows: 'Leather and imitations of leather, and goods made of these materials and not included in other classes ...'. Second, EUIPO submits that the extent of the protection afforded by

that class is imprecise and subject to interpretation and, in any event, does not meet the criteria of clarity and precision set out by the Court of Justice in the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361).

- 42 It must be stated that, according to Article 120(3) of Regulation No 207/2009 — under which ‘[i]n cases of doubt, the text in the language of the Office in which the application for the [European Union] trade mark was filed shall be authentic’ —, the extent of the protection as afforded by the German version of the wording at issue must take precedence in the present case (see, to that effect, judgment of 21 March 2013, *Event v OHIM — CBT Comunicación Multimedia (eventer EVENT MANAGEMENT SYSTEMS)*, T-353/11, not published, EU:T:2013:147, paragraphs 14 to 16).
- 43 Moreover, it should be borne in mind that, under Rule 2(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as applicable at the material time, the list of goods and services for which a mark is applied for must be worded in such a way as to indicate clearly the nature of those goods and services.
- 44 It follows that it is for the person requesting registration of a sign as a European Union trade mark to give, in the application, a list of the goods or services in respect of which the registration is requested and to provide, for each of those goods or services, a description clearly indicating their nature (judgment of 23 November 2011, *Pukka Luggage v OHIM — Azpiroz Arruti (PUKKA)*, T-483/10, not published, EU:T:2011:692, paragraph 37).
- 45 This requirement for clarity has, furthermore, been reinforced by the judgment of 19 June 2012, *Chartered Institute of Patent Attorneys* (C-307/10, EU:C:2012:361), to which EUIPO refers in its observations, in which the Court of Justice ruled that the goods and services for which the protection of a trade mark is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark (judgment of 19 June 2012, *Chartered Institute of Patent Attorneys*, C-307/10, EU:C:2012:361, paragraph 64).
- 46 It must be pointed out that, in the present case, the aforementioned German phrase may be understood in two different ways. On the one hand, it can be interpreted in the way suggested by the applicant, as set out in paragraph 40 above. Such an interpretation is based on the premiss that, since the word ‘goods’ is used both at the beginning and at the end of the description of the Class-18 goods at issue, the first reference to that word refers solely to the element ‘leather’, whereas the expression ‘sowie Waren daraus (soweit in Klasse 18 enthalten)’ (and goods made of these (included in Class 18)) relates to the element ‘imitations of leather’. It follows that, according to that interpretation, ‘imitations of leather’ are also covered by that wording. On the other hand, that phrase can also be construed in the manner chosen by EUIPO, namely as referring to ‘leather goods and imitations of leather’ as end products only.
- 47 It must be stated that, by allowing both the aforementioned divergent interpretations, the phrase chosen by the applicant for the wording of the list of goods in Class 18 covered by the earlier mark is ambiguous and, consequently, cannot meet the requirement of clarity which stems from Rule 2(2) of Regulation No 2868/95 and the case-law. It must be noted that the applicant itself created that ambiguity, by adding the words ‘Waren aus’ (‘goods made of’) before the general indication of Class 18. In accordance with the case-law cited in paragraphs 44 and 45 above, it was up to the applicant to specify the wording of the list of goods in Class 18 covered by the earlier mark. In particular, if the applicant’s intention was to seek protection for ‘imitations of leather’, the responsibility rested on it to choose wording for the list of goods which made this intention clear.

48 The view must be taken that the proprietor of the trade mark should not gain from the infringement of its obligation to draw up the list of goods with clarity and precision. The wording concerned cannot, in any event, be interpreted in such a way as including, for the benefit of the applicant, actual ‘imitations of leather’ also.

49 The applicant’s argument that the earlier mark is protected for ‘imitations of leather’ must therefore be rejected.

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

50 The applicant essentially raises a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009.

51 It bases the action on a number of complaints concerning the Board of Appeal’s assessment in the contested decision of the likelihood of confusion between the marks at issue. More specifically, the applicant claims that the Board of Appeal mistakenly found that there was no similarity between the goods covered by the international registration at issue and those covered by the earlier mark. Consequently, it considers that the Board of Appeal erred in finding that there was no likelihood of confusion.

52 EUIPO disputes the applicant’s arguments.

53 As a preliminary point, it must be noted that, under Article 151(1) of Regulation No 207/2009, an international registration designating the European Union is, from the date of its registration pursuant to Article 3(4) of the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (OJ 2003 L 296, p. 22), to have the same effect as an application for an EU trade mark. Article 156(1) of Regulation No 207/2009 provides that any international registration designating the European Union is to be subject to opposition in the same way as published EU trade mark applications.

54 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.

55 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. 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 judgments of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442, paragraphs 16, 17 and 29 and the case-law cited, and of 9 July 2003, *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, EU:T:2003:199, paragraphs 30 to 33 and the case-law cited).

56 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 8 March 2013, *Mayer Naman v OHIM — Daniel e Mayer (David Mayer)*, T-498/10, not published, EU:T:2013:117, paragraph 47 and the case-law cited).

57 It is in the light of the abovementioned principles that the examination must be carried out as to whether the Board of Appeal was correct in finding that there was no likelihood of confusion between the marks at issue for the goods in question.

The relevant public

58 According to the case-law, in the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods 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 judgment of 13 February 2007, *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, EU:T:2007:46, paragraph 42 and the case-law cited).

59 In the present case, it should be noted that, having regard to the fact that the earlier mark is a European Union mark, the relevant territory for the assessment of the likelihood of confusion is the territory of the European Union, as the Board of Appeal correctly stated and which, moreover, is not disputed by the applicant.

60 On the other hand, the applicant disputes the Board of Appeal's finding that the relevant group of consumers for which the likelihood of confusion had to be assessed was a particularly attentive specialised public.

61 Since the argument put forward by the applicant on this issue overlaps, to a large extent, with certain elements coming within the scope of the analysis of the comparison of the goods at issue, those arguments will be examined at the stage when the similarity of those goods is being examined.

62 Consequently, it is in the context of the comparison of the goods that it is appropriate to continue the examination of the action.

The comparison of the goods

– The goods in Classes 14 and 26

63 In the contested decision, first, the Board of Appeal found that the two groups of goods at issue in Classes 14 and 26, as covered by the international registration at issue and the earlier mark respectively, differed in their nature, their intended purpose and their use. It held that the goods were dissimilar, on the ground that belt clasps, fittings and ornaments for zip fasteners of precious metals were spare parts, used primarily for manufacturing or ornamenting zip fasteners or belts, amounting therefore to semi-manufactured goods, whereas the goods in Classes 14 and 26 covered by the earlier mark were end products serving, in part, to show and measure the time ('horological and chronometric instruments') and, in part, as jewellery and ornaments.

64 The Board of Appeal noted, furthermore, that the goods at issue were not complementary, the contested spare parts being neither essential nor important for the use of the end products in Classes 14 and 26 covered by the earlier mark. Moreover, the goods at issue were not offered through the same distribution channels. Their respective functions were completely different and they were not in competition with each other either. Finally, given that the goods at issue were not directed at the same public, they were not, therefore, interchangeable. Consequently, the Board of Appeal found that the goods at issue in Classes 14 and 26 were not similar.

- 65 Second, the Board of Appeal held that end products, in particular ‘bags’ in Class 18 covered by the earlier mark, were dissimilar, both by their nature and by their aim and intended purpose, to the spare parts in Classes 14 and 26 covered by the international registration at issue. Even if it were assumed that the spare parts for zip fasteners and belts were necessary for the use of the end products in Class 18 covered by the earlier mark, inasmuch as those goods contain zip fasteners or belts or straps, the relevant consumers would still not assume that those goods are offered by the same manufacturers.
- 66 The applicant challenges the Board of Appeal’s assessment for several reasons. First of all, it claims that the Board of Appeal failed to take into account the fact that the goods at issue could also be used separately, as separate goods, also directed at end consumers. In this respect, the applicant refers in particular to the diversity of the items covered by the expression ‘ornaments for zip fasteners’ — such as trinkets, chains, rings — which can be added to zip fasteners for the purpose of ornamenting end products, such as bags or clothing. In the same way, ‘belt clasps’ are marketed as separate goods, allowing end consumers to fix, for example, long fabric, such as draping fabric, curtains or chasubles, to the body, or to enhance the shape. In addition, the applicant claims that the goods at issue are distributed by the same manufacturers, purchased by the same public, offered in the same sales outlets. Consequently, it argues, the public referred to is confused into thinking that there is a close connection and complementarity between them. Furthermore, the complementarity of those goods is based on their similar purpose, of an aesthetic nature, designed to ornament end products.
- 67 EUIPO takes issue with the applicant’s arguments.
- 68 As a preliminary point, it must be borne in mind that, according to settled case-law, in assessing the similarity of the goods or services at issue, 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, to that effect, judgment of 11 July 2007, *El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, T-443/05, EU:T:2007:219, paragraph 37 and the case-law cited).
- 69 In the first place, as regards the applicant’s argument that the goods at issue in Classes 14 and 26, namely ‘ornaments for zip fasteners of precious metals’ and ‘belt clasps’, can also be marketed directly to the end consumer as separate goods, it must be stated that, even if this were so, it is still the case that that situation has no bearing on the fact that those goods are intended mainly for sale to professionals manufacturing end products and, more specifically, to manufacturers of belts and zip fasteners.
- 70 That conclusion is not called into question by the arguments put forward by the applicant. In that regard, it must be noted, more specifically, that the applicant’s argument that ‘belt clasps’ allow consumers to fix draping fabric and curtains or chasubles to the body cannot be accepted. ‘Belt clasps’ are, by their very nature and intended purpose, goods intended to close belts and are not goods used for the purposes indicated by the applicant.
- 71 Moreover, it must be noted that the applicant states that the goods at issue are distributed by the same manufacturers or by connected manufacturers and offered for sale in the same distribution points and, in addition, in the same section. However, it merely makes a statement in that regard, without making it clear which kind of undertaking manufactures, in its view, both the goods concerned and those covered by the earlier mark and in which distribution points those goods are offered for sale.
- 72 In the second place, it is necessary to reject the applicant’s argument alleging that the goods at issue are complementary in nature on the basis of their similar purpose, of an aesthetic nature, consisting in ornamenting end products.

- 73 In that regard, it must first be noted that, in the light of the case-law, goods or services are complementary where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (judgment of 30 April 2015, *Tecalan v OHIM — Ensinger (TECALAN)*, T-100/14, not published, EU:T:2015:251, paragraph 40; see also, to that effect, judgment of 22 January 2009, *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraphs 57 and 58 and the case-law cited).
- 74 Furthermore, according to the case-law, such an aesthetically complementary nature must involve a genuine aesthetic necessity, in 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 (judgment of 11 July 2007, *Mülhens v OHIM — Minoronzoni (TOSCA BLU)*, T-150/04, EU:T:2007:214, paragraph 36; see also, to that effect, judgment of 1 March 2005, *Sergio Rossi v OHIM — Sissi Rossi (SISSI ROSSI)*, T-169/03, EU:T:2005:72, paragraphs 60 and 62).
- 75 In the present case, it must be held that, by reason of their different nature, the goods at issue, namely, first, ‘belt clasps’ and ‘fittings and ornaments for zip fasteners of precious metals’ in Classes 14 and 26 covered by the international registration at issue and, second, the goods included in those same classes as protected by the earlier mark, namely horological instruments; jewellery or even decorative articles of precious metal, such as key fobs and decorative articles of precious metal, as well as artificial flowers, are not indispensable or at least important for their respective uses.
- 76 As regards the applicant’s argument concerning the complementarity existing between ‘ornaments for zip fasteners of precious metals’, first, and ‘bags’, in Class 18 and covered by the earlier mark, second, it must be noted that ‘ornaments for zip fasteners of precious metals’ are not important or indispensable for the use of a bag. A bag, even if it has a zip fastener, can be used without the addition of an ornament to that zip. Moreover, although the question is approached from the perspective of importance, or even of the indispensable nature of ‘bags’ for the use of ‘fittings and ornaments for zip fasteners’, it must be noted that it is, admittedly, true that, in order to use an ornament for zip fasteners, a product with a zip fastener is needed. However, it must be stated that bags are not the only goods which can have such a fastening system. An ornament for zip fasteners can also be used, for example, with clothing with a zip fastener. Furthermore, it must be noted in this respect that some bags do not have a zip-fastening system. The connection between ‘ornaments for zip fasteners of precious metals’ and ‘bags’ is therefore not very close. In this regard, it must be noted that, in order to find similarity between products by reason of their complementarity, it is not sufficient for one product to be indispensable or important for the use of the other, but that situation must also have the effect of leading consumers to think that the responsibility for their production lies with the same undertaking (see paragraph 74 above). In other words, it is necessary to examine whether ‘bags’ are important for the use of ‘ornaments for zip fasteners’ to the extent that the public might imagine that the responsibility for their production lies with the same undertaking (see, to that effect, judgment of 14 May 2013, *Sanco v OHIM — Marsalman (Representation of a chicken)*, T-249/11, EU:T:2013:238, paragraph 39). It must be held that the connection existing between ‘ornaments for zip fasteners of precious metals’ and ‘bags’ is not sufficiently close for consumers to imagine that the same company is responsible for the production of those goods. The public does not expect a bag manufacturer also to offer for sale ornaments for zip fasteners.
- 77 Moreover, it must be observed that, as noted by the Board of Appeal in paragraph 26 of the contested decision, the fact that all of the goods at issue can be used for decorative purposes is insufficient to establish that the goods are similar. That situation is a factor which is too general to justify, in its own right, the finding that the goods at issue are complementary and, accordingly, similar.
- 78 It follows from the foregoing that the applicant’s argument relating to the alleged complementarity of the goods at issue must be rejected.

79 As regards the other factors of relevance under the case-law cited in paragraph 68 above, it should, first, be observed that the applicant itself acknowledged that there was no competitive relationship between the goods at issue. Second, it must be held that, by reason of their different nature, the goods at issue are not substitutable either.

80 Having regard to the foregoing, the Board of Appeal acted correctly in holding that there was no similarity between the goods at issue.

– The goods in Class 18

81 In the contested decision, the Board of Appeal took the view, in essence, that ‘leather’, ‘imitations of leather’ and ‘animal skins’, in Class 18 and covered by the international registration at issue, are raw materials or semi-finished goods, destined to undergo supplementary working or transformation and which, consequently, are aimed at manufacturers of leather goods, and therefore a specialised public. It considered that those goods were substantially different to the goods covered by the earlier mark, which are, for their part, end products aimed at end consumers. According to the Board of Appeal, the fact that the semi-manufactured goods at issue are necessary for the manufacture of a few end products covered by the earlier mark, such as bags and suitcases of all kinds, wallets or purses, does not suffice for a finding that the goods at issue are similar, since those end products may also be manufactured with other materials. The public does not therefore assume that the goods are offered by the same manufacturers. The Board of Appeal held that there was no similarity between the goods at issue in Class 18.

82 The applicant challenges the Board of Appeal’s assessment for several reasons. First, it submits that the different Boards of Appeal of EUIPO have already acknowledged, in previous decisions, the possibility of finding a similarity between, leather, imitations of leather and animal skins for the purpose of semi-manufactured goods, on the one hand, and of end products manufactured using these materials, on the other. Moreover, it claims that leather, imitations of leather and animal skins are also not marketed exclusively as semi-manufactured goods or raw materials, but can be sold as such directly to the end consumer. In that regard, the applicant refers to the use of those goods as decorations, such as floor rugs or wall decorations. In addition, animal skins are also used as mattress protectors or chair pads. In those cases, the goods at issue are not transformed into other goods, but are used as separate goods. In the applicant’s opinion, the goods at issue are, therefore, similar.

83 EUIPO disputes the applicant’s arguments.

84 In the first place, concerning the applicant’s argument relating to the previous decision-making practice of the Boards of Appeal, which allegedly found a similarity between, on the one hand, leather and animal skins as semi-manufactured goods and, on the other, goods manufactured using these materials, it must be borne in mind that it follows from established case-law that decisions concerning registration of a sign as a trade mark which the Boards of Appeal are called on to take under Regulation No 207/2009, regarding the registration of a sign as a European Union mark, are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of those decisions must be assessed solely on the basis of that regulation and not on the basis of any previous decision-making practice (judgment of 26 April 2007, *Alcon v OHIM*, C-412/05 P, EU:C:2007:252, paragraph 65, and judgment of 24 November 2005, *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, EU:T:2005:420, paragraph 71). In addition, and in any event, it must be noted that the Court has already found that ‘leather and imitations of leather’ and goods from those materials, such as bags, suitcases, umbrellas, parasols, sticks, such as those protected, in the present case, by the earlier mark, were not similar (see, to that effect, judgment of 25 November 2010, *Vidieffe v OHIM — Ellis International Group (GOTHA)*, T-169/09, not published, EU:T:2010:484, paragraphs 7 and 29).

- 85 In the second place, as regards the applicant's argument that leather, imitations of leather and animal skins are not marketed exclusively as raw or semi-manufactured goods, but can also be sold as separate goods directly to the end user, it must be considered that, even if that were the case, this situation cannot bring into question the fact that those goods are aimed primarily at a professional public (see, to that effect, judgment of 9 November 2016, *Birkenstock Sales v EUIPO (Representation of a pattern of wavy, crisscrossing lines)*, T-579/14, under appeal, EU:T:2016:650, paragraph 32).
- 86 Moreover, it must be noted that 'leather and imitations of leather; animal skins' have a different nature and purpose to those of the goods covered by the earlier mark. Although the goods covered by the international registration at issue are used mainly to provide the raw material for manufacturers of items of leather, imitations of leather and animal skins, the goods covered by the earlier mark are used to cover and dress parts of the human body, transport objects and provide protection against the rain and sun. In that regard, it is important to note, furthermore, that the EU Courts have accepted that a portion of the goods covered by the earlier mark – such as 'umbrellas' and 'parasols' – could, in addition to their main purpose, also be regarded as goods within the scope of the fashion sector in the broad sense of the term (see, to that effect, judgment of 9 November 2016, *Birkenstock Sales v EUIPO (Representation of a pattern of wavy, crisscrossing lines)*, T-579/14, under appeal, EU:T:2016:650, paragraph 118 and the case-law cited).
- 87 On the basis of their differing nature, the goods at issue are normally manufactured by different manufacturers and sold through different distribution channels. There is also no competitive relationship between those goods.
- 88 As to the possible complementarity of 'leather and imitations of leather; animal skins' with certain goods in Class 18 covered by the earlier mark, it should be borne in mind that, in accordance with the case-law, goods are complementary where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods lies with the same undertaking (see, to that effect, judgment of 11 July 2007, *PiraÑAM diseño original Juan Bolaños*, T-443/05, EU:T:2007:219, paragraph 48 and the case-law cited). In the present case, however, it must be noted that the applicant has not stated the reasons why the goods at issue are indispensable or at least important for their respective uses.
- 89 The applicant cannot claim that the goods designated by the earlier mark and 'leather and imitations of leather; animal skins' are complementary on the ground that the former are manufactured by using the latter. In that regard, it must be noted that the Board of Appeal was correct to find, in paragraphs 34 to 36 of the contested decision, that the fact that goods in Class 18 covered by the international registration at issue are necessary for the manufacture of certain goods included in Class 18 covered by the earlier mark, such as bags and cases of all kinds, is not sufficient for a finding that the goods at issue are similar, inasmuch as those goods may also be manufactured with other materials and, therefore, the public would not assume that those goods are offered by the same manufacturers.
- 90 It follows from the foregoing that the Board of Appeal acted correctly in finding that the goods at issue in Class 18 were not similar.
- 91 It must be noted that, since one of the cumulative conditions required for a finding that there is no likelihood of confusion is not satisfied in this case, the applicant's arguments relating to the similarity of the signs are ineffective.
- 92 In the light of all of the foregoing, it must be held that the Board of Appeal acted correctly in finding that there was no likelihood of confusion between the marks at issue in regard to the goods in question.

93 It follows that the contested decision must be annulled in so far as the Board of Appeal omitted to rule on the action brought before it with regard to ‘precious metals and their alloys’ in Class 14 and covered by the international registration at issue. The remainder of the action must be dismissed.

Costs

94 Under Article 134(3) of the Rules of Procedure, where each party succeeds on some and fails on other heads, the parties are to bear their own costs.

95 Each party must therefore be ordered to bear its own costs.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 12 November 2015 (Case R 679/2014-1), relating to opposition proceedings between Nanu-Nana Joachim Hoepp GmbH & Co. KG and Ms Nadine Fink, in so far as the Board of Appeal failed to rule on the action before it with regard to ‘precious metals and their alloys’ in Class 14 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 covered by the figurative mark which was the subject of International Registration No 1111651 designating the European Union;**
- 2. Dismisses the action as to the remainder;**
- 3. Orders each party to bear its own costs.**

Gratsias

Dittrich

Xuereb

Delivered in open court in Luxembourg on 6 April 2017.

[Signatures]