



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

6 December 2017*

(EU trade mark — Opposition proceedings — **International registration designating the European Union** — Figurative mark Burlington — Earlier national word marks BURLINGTON and BURLINGTON ARCADE — Earlier EU and national figurative marks BURLINGTON ARCADE — **Relative ground for refusal** — Likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 207/2009 (now Article 8(1)(b) of Regulation (EU) 2017/1001) — Use in the course of trade of a sign of more than mere local significance — Article 8(4) of Regulation No 207/2009 (now Article 8(4) of Regulation 2017/1001) — Unfair advantage taken of the distinctive character or the repute of the earlier trade marks — Article 8(5) of Regulation No 207/2009 (now Article 8(5) of Regulation 2017/1001))

In Case T-120/16,

Tulliallan Burlington Ltd, established in St Helier (Jersey), represented by A. Norris, Barrister,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by M. Fischer, acting as Agent,

defendant,

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

Burlington Fashion GmbH, established in Schmalleberg (Germany), represented by A. Parr, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 11 January 2016 (Case R 94/2014-4), relating to opposition proceedings between Tulliallan Burlington and Burlington Fashion,

THE GENERAL COURT (Third Chamber),

composed of S. Frimodt Nielsen, President, I.S. Forrester and E. Perillo (Rapporteur), Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 22 March 2016,

having regard to the response of EUIPO lodged at the Court Registry on 10 June 2016,

* Language of the case: English.

having regard to the response of the intervener lodged at the Court Registry on 13 June 2016,
further to the hearing on 28 April 2017,
gives the following

Judgment

Background to the dispute

- 1 On 12 November 2009, the intervener, Burlington Fashion GmbH, filed an application for protection in the European Union of international registration No 1017273 with 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), as amended (replaced by **Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark** (OJ 2017 L 154, p. 1)). The registration for which the protection was applied for is the figurative mark represented below:



- 2 The goods in respect of which the protection was applied for are in Classes 3, 14, 18 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 3: ‘Soaps for cosmetic purposes, soaps for textiles, perfumery, ethereal oils, cosmetic preparations for cleaning, caring for and embellishing the skin, the scalp and the hair; toilet articles, included in this class, deodorants for personal use, pre shave and after shave preparations’;
 - Class 14: ‘Jewellery, watches’;
 - Class 18: ‘Leather and imitations of leather, namely suitcases, bags (included in this class); small leather articles (included in this class), especially purses, wallets, key cases; umbrellas and sunshades in the nature of parasols’;
 - Class 25: ‘Footwear, clothing, headgear, belts’.
- 3 On 16 August 2010, the applicant, Tulliallan Burlington Ltd, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001) to registration of the mark applied for in respect of the goods in Classes 3, 14 and 18. It is the owner, in central London (United Kingdom), of the ‘Burlington Arcade’ shopping arcade.

- 4 The opposition was based, inter alia, on the following earlier trade marks and rights:
- the word mark BURLINGTON, registered in the United Kingdom under No 2314342 on 5 December 2003 and duly renewed on 29 October 2012, designating services in Classes 35 and 36 and corresponding, for each of those classes, to the following description:
 - Class 35: ‘Rental and leasing of advertising space; organisation of exhibitions for commercial or advertising purposes; organisation of trade fairs for commercial purposes; advertising and promotion services and information services relating thereto; the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores’;
 - Class 36: ‘Rental of shops and offices; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops and offices; real estate services; fund investments; mutual funds’;
 - the word mark BURLINGTON ARCADE, registered in the United Kingdom under No 2314343 on 7 November 2003 and duly renewed on 29 October 2012, designating services in Classes 35, 36 and 41 and corresponding, for Class 41, to the following description: ‘Entertainment services; organisation of competitions; organisation of exhibitions; provision of recreation information; presentation of live performances; provision of sports facilities; provision of live music and live entertainment; provision of facilities for live band performances; provision of live entertainment; provision of live music; provision of live musical performances; provision of live shows’;
 - the figurative mark reproduced below and registered in the United Kingdom under No 2330341 on 7 November 2003 and duly renewed on 25 April 2013, designating services in Classes 35, 36 and 41:



- EU figurative mark No 3618857 reproduced below, registered on 16 October 2006 and limited, as a result of cancellation proceedings No 8715 C, to the services in Classes 35, 36 and 41 corresponding, for each of those classes, to the following description: ‘Advertising and promotion services and information services relating thereto; the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores’ (Class 35); ‘Rental of shops; leasing of, or management of real

estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops' (Class 36); and 'Entertainment services; provision of live entertainment' (Class 41):



- 5 The grounds relied on in support of the opposition were those set out in Article 8(1)(b),(4) and (5) of Regulation No 207/2009 (now Article 8(1)(b),(4) and (5) of Regulation 2017/1001).
- 6 On 22 November 2013, the Opposition Division, after examining the applicant's opposition on the basis of EU figurative mark No 3618857, upheld that opposition for the goods in Classes 3, 14 and 18, and therefore ordered the intervener to pay the costs.
- 7 On 2 January 2014, the intervener filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the Opposition Division's decision.
- 8 By decision of 11 January 2016 ('the contested decision'), the Fourth Board of Appeal of EUIPO annulled the Opposition Division's decision, ordering the applicant to bear the costs of the opposition proceedings and the appeal proceedings.
- 9 In the contested decision, the Board of Appeal, found, first, that as regards the application of Article 8(5) of Regulation No 207/2009, the reputation of the earlier marks had been proven in the relevant territory for the services in Classes 35 and 36, with the exception, however, of the service of 'bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores', in Class 35. Secondly, as regards the ground referred to in Article 8(4) of that regulation, the Board of Appeal found, in essence, that the applicant had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had in the present case been met. Thirdly, as regards Article 8(1)(b) of that regulation, it found, in essence, that the goods and services at issue were dissimilar and that a likelihood of confusion was ruled out, irrespective moreover of the similarity of the marks concerned.

Forms of order sought

- 10 The applicant claims that the Court should:
 - annul the contested decision;
 - order EUIPO to pay the costs.

11 EUIPO and the intervener contend that the Court should:

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

Law

12 In support of the action, the applicant relies on three pleas in law. In essence, the first plea in law alleges an infringement of Article 8(5) of Regulation No 207/2009, a procedural defect and an infringement of the procedural rules, the second plea in law an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) of that regulation, and the third plea in law an infringement of Article 8(1)(b) of that regulation.

The first plea in law

13 First, the applicant complains, in essence, that the Board of Appeal misconstrued part of the services in Class 35 in respect of which the earlier marks' reputation had not been established. Secondly, it submits that the Board of Appeal made an error in the definition of the services included in Classes 35 and 36. Thirdly, it alleges a procedural infringement by the Board of Appeal.

14 In support of the first complaint, the applicant submits that the service 'bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores', in Class 35, also designates 'shopping arcade' services, not only the 'retail' service carried out in individual stores. According to the applicant, such an interpretation is borne out in particular by the use, in the description of Class 35, of the expression 'from a range of ... retail stores', which proves that, contrary to what the Board of Appeal reasoned, shopping arcade services corresponded to the bringing together of a variety of goods on sale within a 'range of stores' rather than solely within individual retail stores.

15 In that regard, moreover, the Board of Appeal erred in its application of the judgment of 7 July 2005, *Praktiker Bau- und Heimwerkermärkte* (C-418/02, 'the *Praktiker* judgment', EU:C:2005:425). According to the applicant, in that judgment the Court adopted a broad interpretation of the concept of retail trade and went as far as to include shopping arcade services.

16 Lastly, the applicant submits that the contested decision is also vitiated by a procedural error in so far as the Board of Appeal found that only the intervener had submitted observations whereas the applicant had also submitted observations on 12 November 2015.

17 In support of the second complaint, the applicant submits, in essence, that the Board of Appeal interpreted the concept of services included in Classes 35 and 36 strictly in finding that there was no link in the mind of the public between the services and the goods at issue, because the consumers of the goods and services in Classes 35 and 36 also include the end consumers of the goods sold in the shops.

18 Lastly, in support of the third complaint, the applicant states that the Board of Appeal infringed the procedural rules in finding that the applicant had not presented a line of argument demonstrating that the use of the mark applied for took unfair advantage of the earlier mark or was detrimental to it.

19 EUIPO and the intervener contend that the present plea should be rejected.

- 20 As regards the first two complaints raised by the applicant, it must be borne in mind that, under Article 8(5) of Regulation No 207/2009, a trade mark must not be registered where it is identical with, or similar to, an 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 that earlier trade mark is an EU trade mark which has a reputation in the European Union 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. As those conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (judgment of 22 March 2007, *Sigla v OHIM — Elleni Holding (VIPS)*, T-215/03, EU:T:2007:93, paragraph 34).
- 21 As regards, in particular, the requirement to be identical with, or similar to, an earlier mark, it must be borne in mind, with regard to the similarity of the signs at issue that, according to the case-law, the assessment of the visual, phonetic or conceptual similarity of the signs at issue must be based on the overall impression given by those signs, bearing in mind, in particular, their distinctive and dominant elements (see judgment of 9 March 2012, *Ella Valley Vineyards v OHIM — HFP (ELLA VALLEY VINEYARDS)*, T-32/10, EU:T:2012:118, paragraph 38 and the case-law cited).
- 22 In addition, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (see judgment of 14 April 2011, *Lancôme v OHIM — Focus Magazin Verlag (ACNO FOCUS)*, T-466/08, EU:T:2011:182, paragraph 52 and the case-law cited). Conceptually, for example, signs are fairly similar whenever they refer, in particular, to the same commercial idea (see, to that effect, judgment of 27 October 2016, *Spa Monopole v EUIPO — YTL Hotels & Properties (SPA VILLAGE)*, T-625/15, not published, EU:T:2016:631, paragraph 35).
- 23 Lastly, since Article 8(5) of Regulation No 207/2009 requires the similarity which exists to be capable of leading the relevant public to make a connection between the signs at issue, that is to say, to establish a link between them, but does not require that similarity to be capable of leading that public to confuse those signs, it must be held that the protection which that provision lays down in favour of marks with a reputation may apply even if there is a lower degree of similarity between the signs at issue (judgment of 10 December 2015, *El Corte Inglés v OHIM*, C-603/14 P, EU:C:2015:807, paragraph 42).
- 24 In the present case, it must be found, first, that the Board of Appeal's assessments in paragraphs 21 to 24 of the contested decision, not disputed moreover by the applicant, according to which the signs at issue are similar to an average degree due to their common word element 'burlington', must be endorsed.
- 25 Next, of the other conditions for protection laid down in Article 8(5) of Regulation No 207/2009, on which the applicant bases its first plea in law, the condition relating to the reputation of the earlier marks and rights and their possible protection must also be taken into consideration.
- 26 In that regard, the Court points out that since the concept of reputation has not been legally defined by the EU legislature, the EU judicature considers that in order to satisfy that condition, an earlier trade mark must be known to a significant part of the public concerned by the goods or services covered by that trade mark (see, to that effect, judgments of 6 February 2007, *Aktieselskabet af 21. november 2001 v OHIM — TDK Kabushiki Kaisha (TDK)*, T-477/04, EU:T:2007:35, paragraph 48, and of 2 October 2015, *The Tea Board v OHIM — Delta Lingerie (Darjeeling)*, T-627/13, not published, EU:T:2015:740, paragraph 74).
- 27 It is apparent also from the file that the applicant's earlier trade marks, which designate services in Classes 35 and 36, are known to a significant part of the public of the relevant market as being the name of a very well-known shopping arcade in the United Kingdom, located in central London, bringing together luxury boutiques within the arcade. Since that reputation of the applicant's earlier trade marks is not disputed by the parties, the question which arises, in the present case, is ultimately

whether that reputation corresponds in fact to the services in Class 35 for which the earlier trade marks have been registered, so that the applicant is properly entitled to benefit from the protection of the reputation in question.

- 28 According to the Board of Appeal, the reputation of the applicant's earlier trade marks has not been proven as regards the retail service in Class 35.
- 29 The Board of Appeal's conclusion cannot, however, be endorsed.
- 30 It must first be pointed out that, in the judgment of 7 July 2005, *Praktiker* (C-418/02, EU:C:2005:425), the Court of Justice held, in paragraph 34, that 'the objective of retail trade is the sale of goods to consumers', that 'that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction' and that 'that activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor'.
- 31 In addition, the General Court has also stated that the Court of Justice's interpretation of whether retail trade in goods constituted a service within the meaning of Article 2 of **First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks** (OJ 1989 L 40 p. 1), referred to in paragraph 30 above, 'cannot constitute an exhaustive definition of general scope of the concept of retail services' (judgment of 26 June 2014, *Basic v OHIM — Repsol YPF (basic)*, T-372/11, EU:T:2014:585, paragraph 55).
- 32 Thus, contrary to what EUIPO contends in the present case, the Court of Justice's interpretation in paragraph 34 of the judgment of 7 July 2005, *Praktiker* (C-418/02, EU:C:2005:425) does not support the assertion that shopping arcades or shopping centres are, by definition, excluded from the scope of the concept of retail service defined in Class 35.
- 33 The Court of Justice's interpretation in paragraph 34 of the judgment of 7 July 2005, *Praktiker* (C-418/02 EU:C:2005:425), indeed also precludes EUIPO's argument that shopping arcade services are essentially limited to rental and real estate management services and that, consequently, the customers to which those services are addressed are principally those persons interested in occupying the shops or offices in that arcade. The concept of 'a variety of services', as mentioned in that paragraph, must also include the services organised by a shopping arcade in order to retain all the attractiveness and practical advantages of such a place of commerce, in accordance moreover with the actual words used in the wording of Class 35; the aim is to enable the customers interested by the various goods 'to conveniently view and purchase [them] from a range of ... stores' and thereby to increase the number of customers visiting that location interested in purchasing those goods, rather than, as noted by the Court of Justice in that judgment, see those goods purchased from 'another competitor' not having its sales outlet in the shopping arcade in question.
- 34 It must, therefore, be concluded that, having regard to the wording of Class 35, the concept of retail service, as interpreted by the Court of Justice in paragraph 34 of the judgment of 7 July 2005, *Praktiker* (C-418/02, EU:C:2005:425), also includes a shopping arcade's services in relation to sales.
- 35 In the light of the foregoing, it must, therefore, be found that the strict interpretation of the concept of retail trade used in the present case by the Board of Appeal is erroneous and that the applicant may, consequently, rely on the protection of the earlier trade marks' reputation for services in Class 35.
- 36 In addition, the Board of Appeal found in the contested decision that there was no link between the marks at issue and that the applicant had failed to prove that the use of the mark applied for could have taken unfair advantage of, or been detrimental to, the distinctive character or the repute of the earlier trade marks.

- 37 In that regard, it must be borne in mind that in order to benefit from the protection provided for in Article 8(5) of Regulation No 207/2009, the proprietor of the earlier trade mark must also furnish, as one of the conditions mentioned in paragraph 20 above, proof, in accordance with the wording of that article, that 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 of 22 March 2007, *VIPS*, T-215/03, EU:T:2007:93, paragraph 34).
- 38 Furthermore, it must be borne in mind that the existence of unfair advantage being taken of the distinctive character or the repute of the earlier trade mark must be assessed by reference to average consumers of the goods or services covered by the trade mark, who are reasonably well informed and reasonably circumspect (see, to that effect, judgment of 12 March 2009, *Antartica v OHIM*, C-320/07 P, not published, EU:C:2009:146 paragraphs 46 to 48). As regards mass-consumption goods, such as soaps, toilet articles, leather articles and other similar articles, the relevant public in the present case is the general public, composed precisely of average consumers.
- 39 It should also be borne in mind that in order to benefit from the protection introduced by Article 8(5) of Regulation No 207/2009, the proprietor of the earlier trade mark is not required to demonstrate actual and present injury to its trade mark for the purposes of that provision. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for this actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future (judgment of 10 May 2012, *Rubinstein and L'Oréal v OHIM*, C-100/11 P, EU:C:2012:285, paragraph 93).
- 40 Consequently, in order to determine whether the use of the contested sign takes unfair advantage of the distinctive character or the repute of the earlier trade mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include in particular the strength of the reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue, and the nature and degree of closeness of the goods or services concerned (see, to that effect and by analogy, judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 42).
- 41 As regards, in particular, the strength of the reputation and the degree of distinctive character of the earlier mark, the Court of Justice has held that the stronger the earlier mark's distinctive character and reputation the easier it would be to accept that detriment has been caused to it. The more immediately and strongly the earlier mark is brought to mind by the contested sign, the greater the likelihood that the current or future use of the sign may take unfair advantage of the distinctive character or the repute of the earlier mark (see, to that effect, judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraphs 67 to 69).
- 42 In that context, it has also been held that it was for the proprietor of the earlier trade mark to show, if necessary, whether the economic behaviour of the average consumer of its goods or services had changed because of the use of the later mark or whether there would be a serious likelihood that such a change will occur in the future (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraphs 77 and 81 and point 6 of the operative part).
- 43 In the light of the foregoing, it must, therefore, be found that, in the present case, the applicant has not submitted to the Board of Appeal or the General Court consistent evidence from which it may be concluded that the use of the mark applied for takes unfair advantage of the distinctive character or the repute of the earlier trade marks.
- 44 Even though the applicant stresses the 'near uniqueness' of its earlier trade marks and their 'significant and exclusive' reputation, it must be found that it has not provided specific evidence capable of substantiating the fact that the use of the mark applied for would make its earlier marks less

attractive, in particular in the light of the criteria laid down in the judgment of 14 November 2013, *Environmental Manufacturing v OHIM* (C-383/12 P, EU:C:2013:741, paragraph 43), according to which such deductions must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.

- 45 The fact that another economic agent may be authorised to use a mark including the word ‘burlington’, for goods similar to those on sale in the applicant’s London arcade, is not such in itself as to affect, in the eyes of the average consumer, the commercial attractiveness of that place. As the Court of Justice made clear in the judgment of 7 July 2005, *Praktiker* (C-418/02, EU:C:2005:425) (see paragraph 30 above), such a characteristic is closely connected with the ‘variety of [commercial] services’ performed by the tenants of the shops in that arcade, not solely with the arcade’s name, which is the same moreover — as the Board of Appeal correctly noted in the contested decision — as the names of other also very well-known places near that arcade, such as Burlington Gardens or Burlington House.
- 46 Lastly, as regards the procedural defect allegedly vitiating the contested decision in so far as the Board of Appeal found that only the intervener had submitted observations, whereas the applicant had also submitted observations on 12 November 2015, it must be held, first, that those observations are on file in the case in question and, secondly, that at the hearing EUIPO confirmed that those observations, also included in the file of the relevant EUIPO adjudicating bodies, were duly taken into account by them. That argument must, therefore, be rejected as unfounded.
- 47 As regards the applicant’s third complaint, it is sufficient to note that it is apparent from the wording of paragraphs 33 and 34 of the contested decision that the Board of Appeal took formal notice that the applicant had indeed submitted observations, but that they were not such as to show, in the present case, that the conditions for applying Article 8(5) of Regulation No 207/2009 were met, and in particular to show that the use of the mark could take unfair advantage of the distinctive character or the repute of the applicant’s earlier trade marks. The complaint alleging an infringement of the procedural rules cannot, therefore, be upheld.
- 48 In the light of the foregoing, the first plea in law must be rejected.

The second plea in law

- 49 The applicant submits first, that, in the contested decision, the Board of Appeal provides no reasons for rejecting its argument alleging infringement, in the present case, of Article 8(4) of Regulation No 207/2009. In addition, it claims that the contested decision is vitiated by an error of law given that, because of the lack of reputation within the meaning of Article 8(5) of Regulation No 207/2009, the opposition based on Article 8(4) of that regulation had to be rejected as a consequence. The applicant further submits that when the assessment of ‘goodwill’, that is to say, the attractive force which brings in custom, is invoked at national level, in the context of an action for passing off, that assessment cannot be limited solely to the services in respect of which the earlier trade marks have been registered, as is the case, by contrast, when assessing reputation within the meaning of Article 8(5) of that regulation. It submits that in any event it had amply established before the Board of Appeal its reputation (that is, its goodwill) as an upmarket shopping arcade. Lastly, the applicant states that the Board of Appeal made a procedural error in not giving the parties, in the proceedings before it, a further opportunity to make submissions on the infringement of Article 8(4) of Regulation No 207/2009.
- 50 EUIPO contends that the present plea should be rejected.

- 51 The intervener contends, for its part, that some of the arguments concerning the correct application of Article 8(4) of Regulation No 207/2009 were raised by the applicant only at the stage of the proceedings before the Court and that, consequently, they cannot be taken into consideration by it.
- 52 First of all, the applicant's argument alleging an infringement of the obligation to state reasons and its argument alleging an infringement of the right to be heard must be rejected. Those arguments are indeed unfounded.
- 53 It is apparent from paragraph 36 et seq. of the contested decision that the Board of Appeal analysed the different conditions laid down by Article 8(4) of Regulation No 207/2009 and, in the present case, also the conditions relating to the action for passing off. In addition, as regards the parties being unable to submit their observations on those conditions, it is apparent from the file that throughout the proceedings before the adjudicating bodies of EUIPO the applicant was indeed in a position to submit its observations.
- 54 In that regard, while the applicant did not develop before the Board of Appeal the compliant which it had itself raised during the opposition proceedings, namely the infringement of Article 8(4) of Regulation No 207/2009, the Board of Appeal cannot be criticised for not requesting additional observations from the parties in that connection. Moreover, according to the relevant case-law, the right to be heard does not apply to the final opinion before it is adopted by the competent Board of Appeal. The latter is not required to inform the parties of its conclusions of law before issuing its final decision or to afford them the opportunity to submit their observations on those conclusions, or even to submit supplementary evidence (see judgment of 14 June 2012, *Seven Towns v OHIM (Representation of seven squares of different colours)*, T-293/10, not published, EU:T:2012:302, paragraph 46 and the case-law cited).
- 55 Lastly, it must be borne in mind that it is for the author of the decision-making act to assess the facts. The right to be heard extends to all the factual and legal factors on which the decision-making act is based, but not to the final position which the authority intends to adopt (see judgment of 7 June 2005, *Lidl Stiftung v OHIM — REWE-Zentral (Salvita)*, T-303/03, EU:T:2005:200, paragraph 62 and the case-law cited).
- 56 As regards, next, the applicant's arguments alleging an infringement of Article 8(4) of Regulation No 207/2009, it must be borne in mind that, under that provision, the proprietor of a sign other than a trade mark may oppose the registration of an EU mark if that sign satisfies all four of the following conditions: that sign must be used in the course of trade; it must be of more than mere local significance; the right to that sign must have been acquired pursuant to the law of the Member State in which the sign was used, prior to the date of application for registration of the EU trade mark; lastly, by reason of that sign, its proprietor must have the right to prohibit the use of a subsequent trade mark. Those conditions are cumulative, so that where a sign does not satisfy one of those conditions, the opposition cannot succeed (judgment of 30 June 2009, *Danjaq v OHIM — Mission Productions (Dr. No)*, T-435/05, EU:T:2009:226, paragraph 35).
- 57 In the present case, the Board of Appeal noted that an action for passing off brought in respect of a non-registered trade mark used in the course of trade in the United Kingdom may constitute an earlier right for the purposes of Article 8(4) of Regulation No 207/2009 (see in particular paragraphs 38 and 39 of the contested decision).
- 58 In that regard, it has been held that the opponent concerned must establish, in accordance with the legal rules governing actions for passing off, as laid down by the laws of the United Kingdom, that the following three conditions are satisfied: first, the non-registered mark or the sign at issue has acquired goodwill; secondly, there has been misrepresentation on the part of the proprietor of the later mark;

and, thirdly, damage has been caused to that goodwill (see, to that effect, judgment of 18 January 2012, *Tilda Riceland Private v OHIM — Siam Grains (BASmALI)*, T-304/09, EU:T:2012:13, paragraph 19).

- 59 It must also be noted that, in paragraph 38 of the contested decision, the Board of Appeal referred precisely to those three conditions and that the applicant concedes, moreover, that the Board of Appeal correctly identified the legal framework concerning actions for passing off.
- 60 In addition, it must be recalled that, in accordance with Article 76(1) of Regulation No 207/2009 (now Article 95(1) of Regulation 2017/1001), the burden of proof, before EUIPO, lies in that regard with the opponent concerned (see, to that effect, judgment of 29 March 2011, *Anheuser-Busch v Budějovický Budvar*, C-96/09 P, EU:C:2011:189, paragraph 189).
- 61 It is, therefore, apparent from the file that, during the proceedings before the Opposition Division, the applicant, as opponent, while pleading the infringement of Article 8(4) of Regulation No 207/2009, did not supply the factual or legal material necessary to prove that the conditions relating to the application of that provision were duly met. Next, before the Board of Appeal, the applicant simply stated that it ‘maintained its arguments [submitted before the Opposition Division]’, but it is not disputed that, before the Board of Appeal, those arguments were not substantiated further, either in fact or in law.
- 62 The Board of Appeal was, therefore, fully entitled, in paragraph 39 of the contested decision, to find that the applicant had not demonstrated that the prerequisites for an action for passing off were duly met. Since the Board of Appeal did not commit an error of law or procedure, the second plea in law must be rejected.

The third plea in law

- 63 The applicant alleges an infringement of Article 8(1)(b) of Regulation No 207/2009. It claims, in essence, that there is, first, clearly similarity between its shopping arcade services and the goods covered by the mark applied for, since the end customers are in the present case the same. In that connection, it states that the word ‘burlington’ is particularly distinctive. Secondly, contrary to what the Board of Appeal found in paragraph 45 of the contested decision, the applicant submits that, even though Class 35 also concerns the activity of a shopping arcade, the ‘Bringing Together’ specification in the wording of that class covers shopping arcade services rather than retail services generally and that, therefore, it is not required to specify the goods at issue. Thirdly, the applicant submits, in essence, that according to the Trade Marks Manual of the United Kingdom Intellectual Property Office and the case-law of the High Court of Justice (England & Wales) Chancery Division, it was under no obligation to specify the goods.
- 64 EUIPO and the intervener contend that the present plea should be rejected.
- 65 Article 8(1)(b) of Regulation No 207/2009 provides that 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.
- 66 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, *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).

- 67 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, *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraph 42 and the case-law cited).
- 68 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 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, *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 present case, the Board of Appeal found, in paragraph 44 of the contested decision, that the applicant's services and the goods covered by the mark applied for were dissimilar.
- 70 First, as regards the services in Class 36, it is not disputed that, for example, there is no similarity between the rental of shops and offices or real estate management services and goods such as soap, jewellery and leather articles. Secondly, as regards the services in Class 35, the EU judicature has clearly determined that, for the retail service, it was necessary for the goods offered for sale to be precisely specified (see, to that effect, judgment of 24 September 2008, *Oakley v OHIM — Venticinque (O STORE)*, T-116/06, EU:T:2008:399, paragraph 44; see also, to that effect and by analogy, judgment of 7 July 2005, *Praktiker*, C-418/02, EU:C:2005:425, paragraph 50).
- 71 The absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade such as Burlington Arcade precludes any association between those shops and the goods of the mark applied for, since the definition provided by the applicant in the present case relating to 'luxury goods' is insufficient in order to specify the goods concerned. Accordingly, in the absence of such a specification, no similarity or complementarity can be established between the services covered by the earlier trade marks and the goods covered by the mark applied for.
- 72 Consequently, the applicant's argument that, for shopping arcade services, it is not necessary to specify the goods concerned must also be rejected, in view of the fact that in paragraph 34 above the Court has held that, having regard to the wording of Class 35, the concept of retail service, as interpreted by the Court of Justice in paragraph 34 of the judgment of 7 July 2005, *Praktiker* (C-418/02, EU:C:2005:425), also includes a shopping arcade's services in relation to sales. In addition, it must be found that the overlap in the groups of end customers is insufficient to prove a likelihood of confusion in the absence of any specification of the goods that may be sold in the arcade units.
- 73 Lastly, the argument relating to the applicability of the Trade Marks Manual of the United Kingdom Intellectual Property Office and the case-law of the High Court of Justice (England & Wales), Chancery Division, is ineffective, because the legal framework of reference is, in the present case, Article 8(1)(b) of Regulation No 207/2009 and, according to settled case-law, the EU trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system (see judgment of 16 January 2014, *Message Management v OHIM — Absacker (ABSACKER of Germany)*, T-304/12, not published, EU:T:2014:5, paragraph 58 and the case-law cited).
- 74 In the light of all of the foregoing, given that one of the prerequisites referred to in Article 8(1)(b) of Regulation No 207/2009 is not met, the present plea must be rejected and the action dismissed in its entirety.

Costs

- 75 Under Article 134(1) 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.
- 76 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Tulliallan Burlington Ltd to pay the costs.**

Frimodt Nielsen

Forrester

Perillo

Delivered in open court in Luxembourg on 6 December 2017.

E. Coulon
Registrar

S. Frimodt Nielsen
President