JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

8 July 2010 *

In Case T-30/09,

Engelhorn KGaA, established in Mannheim (Germany), represented by W. Göpfert and K. Mende, lawyers,

applicant,

v

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

defendant,

* Language of the case: English.

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

The Outdoor Group Ltd, established in Northampton (United Kingdom), represented by M. Edenborough, Barrister,

ACTION brought against the decision of the Fifth Board of Appeal of OHIM of 28 October 2008 (Case R 167/2008-5), relating to opposition proceedings between The Outdoor Group Ltd and Engelhorn KGaA,

THE GENERAL COURT (Eighth Chamber),

composed of M.E. Martins Ribeiro, President, N. Wahl and A. Dittrich (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 21 January 2009,

having regard to the response of OHIM lodged at the Court Registry on 9 June 2009,

having regard to the response of the intervener lodged at the Court Registry on 1 June 2009,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur, to rule on the action without an oral procedure pursuant to Article 135a of the Rules of Procedure of the Court,

gives the following

Judgment

Background to the dispute

1 On 12 November 2004, the applicant, Engelhorn KGaA, filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 Registration as a mark was sought for the word sign peerstorm.

3 The goods in respect of which registration was sought are in Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: 'clothing, footwear, headgear'.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 25/2005 of 20 June 2005.

5 On 19 September 2005, the intervener, The Outdoor Group Ltd, filed a notice of opposition pursuant to Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) against registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

6 The opposition was based inter alia on:

— the earlier Community word mark PETER STORM ('the earlier mark') designating goods in Class 25 corresponding to the following description: 'clothing, footwear, headgear, trousers, shorts, skirts, dresses, jackets, shirts, tee-shirts, sweatshirts, blouses, jumpers, cardigans, coats, jumpsuits, tracksuits, overalls, belts, jeans, jog pants, blousons, underwear, ski wear, gilets, footwear, socks and headgear';

— the earlier United Kingdom word mark PETER STORM designating goods in Class 18 corresponding to the following description: 'articles made from leather or imitation leather; bags, back packs, haversacks, rucksacks, knapsacks, trunks, luggage, suitcases, holdalls, belts, wallets'.

7 The ground relied on in support of the opposition was that referred to in Article 8(1)(a) and (b) of Regulation No 40/94 (now Article 8(1)(a) and (b) of Regulation No 207/2009).

8 Upon request of the applicant on 30 May 2006, the intervener was invited by OHIM on 4 July 2006 to furnish proof of genuine use of the earlier mark pursuant to Article 43(2) of Regulation No 40/94 (now Article 42(2) of Regulation No 207/2009) and Rule 22 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation 40/94 (OJ 1995 L 303, p. 1), in the version applicable to the facts of the case, within a period which expired on 5 September 2006. That period was extended by OHIM to 5 November 2006. No proof of genuine use of the earlier United Kingdom trade mark was requested.

9 On 6 November 2006, the intervener submitted a witness statement made by a member of the firm representing it. In that statement, he stated that the intervener was the parent company of the companies M. and B. and that the earlier mark had been in use during the five-year period preceding the publication of the application for the Community trade mark. The intervener also submitted M.'s autumn/winter 2002 United Kingdom product brochure showing a range of clothing sold under the trade mark PETER STORM, the prices and a list of shops in the United Kingdom in which those items were sold. Furthermore, the intervener submitted M.'s spring/summer 2004 United Kingdom product brochure showing a range of footwear sold under the trade mark PETER STORM with the prices.

10 Following the applicant's observations of 20 February 2007, in which it maintained that the evidence of genuine use of the earlier mark was insufficient, the intervener, upon invitation by OHIM to submit its own observations, filed a witness statement from its company secretary on 4 May 2007. In that statement, the company secretary stated that the intervener traded throughout the United Kingdom from its retail store chains M. and B. and that sales of goods identified by the earlier mark in respect of clothing, footwear and headgear amounted to more than GBP 11 million over a four-week period in December 2004. That statement was accompanied by a financial trading report containing a list of sales figures for goods identified by a code in respect of the period of four weeks in December 2004.

11 On 30 November 2007, the Opposition Division rejected the opposition.

12 On 14 January 2008, the intervener filed an appeal with OHIM, pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009), against the decision of the Opposition Division.

13 By decision of 28 October 2008 ('the contested decision'), the Fifth Board of Appeal of OHIM upheld the appeal. It found, in particular, that proof of genuine use of the earlier mark had been furnished in respect of clothing, footwear and headgear. It concluded that, since the goods covered by the mark applied for and the earlier mark were identical and there was a degree of visual and aural similarity between both of the signs, and having regard to the average level of attention displayed by the average consumer when purchasing the goods at issue, there was a likelihood of confusion between the two signs.

Procedure and forms of order sought

14 The applicant claims that the Court should:

— annul the contested decision;

— reject the opposition in its entirety;

— order OHIM to pay the costs.

15 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

16 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Admissibility of the general reference by the applicant to its written submissions to OHIM

17 The applicant makes a reference to all the arguments made in written submissions during the procedure before OHIM.

18 Under Article 21 of the Statute of the Court of Justice of the European Union and Article 44(1)(c) of the Rules of Procedure of the General Court, applications must include a brief statement of the pleas in law on which they are based. It is settled case-law that, although specific points in the text of the application can be supported and completed by references to specific passages in the documents annexed to it, a general reference to other documents cannot compensate for the failure to set out the essential elements of the legal argument which must, under those provisions, appear in the application itself (Case T-183/03 *Applied Molecular Evolution* v *OHIM*

(APPLIED MOLECULAR EVOLUTION) [2004] ECR II-3113, paragraph 11; Joined Cases T-350/04 to T-352/04 *Bitburger Brauerei* v *OHIM — Anheuser-Busch (BUD, American Bud and Anheuser Busch Bud)* [2006] ECR II-4255, paragraph 33; and judgment of 15 October 2008 in Joined Cases T-305/06 to T-307/06 *Air Products and Chemicals* v *OHIM — Messer Group (Ferromix, Inomix and Alumix)*, not published in the ECR, paragraph 21).

19 It is not for the Court to take on the role of the parties by seeking to identify the relevant material in the documents to which they refer (judgment of 17 April 2008 in Case T-389/03 *Dainichiseika Colour & Chemicals Mfg.* v *OHIM — Pelikan (representation of a pelican)*, not published in the ECR, paragraph 19). It follows that the application, to the extent that it refers to the written submissions to OHIM, is inadmissible in so far as the general reference which it contains cannot be connected to pleas and arguments developed in that application.

Substance

20 The applicant relies on two pleas in law alleging, first, breach of Article 15 of Regulation No 40/94 (now Article 15 of Regulation No 207/2009) and Article 43(2) of that regulation and, secondly, breach of Article 8(1)(b) of that regulation.

The first plea: breach of Articles 15 and 43(2) of Regulation No 40/94

21 The applicant maintains, in essence, that the evidence adduced by the intervener was submitted out of time and was not sufficient to prove that the earlier mark was put to genuine use in connection with the goods in respect of which it had been registered and which were cited as justification for the intervener's opposition. First, the evidence submitted by the intervener on 6 November 2006 was submitted after the expiry of the time-limit on 5 November 2006. Furthermore, that evidence is not sufficient, given that it does not provide any information regarding actual use of the earlier mark. Secondly, the Board of Appeal erred in admitting the evidence submitted by the intervener on 4 May 2007 because it was submitted after the period set by OHIM for lodging evidence had expired.

22 OHIM and the intervener dispute the applicant's arguments.

23 In accordance with settled case-law, it is apparent from Article 43(2) and (3) of Regulation No 40/94 (now Article 42(2) and (3) of Regulation No 207/2009), read in the light of the ninth recital in the preamble to that regulation (now recital 10 in the preamble to Regulation No 207/2009), and from Rule 22(3) of Regulation No 2868/95 that the *ratio legis* of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification deriving from active functioning of the mark on the market. However, the purpose of those provisions is not to assess commercial success or to review the economic strategy of an undertaking, nor are they intended to restrict trade-mark protection to the case where large-scale commercial use has been made

of the marks (see, to that effect, Case T-203/02 *Sunrider* v *OHIM — Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraphs 36 to 38 and the case-law cited).

24 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (see, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). Furthermore, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (*VITAFRUIT*, paragraph 39; see also, to that effect and by analogy, *Ansul*, paragraph 37).

25 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*VITAFRUIT*, paragraph 40; see also, by analogy, *Ansul*, paragraph 43).

26 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (*VITAFRUIT*, paragraph 41, and Case T-334/01 *MFE Marienfelde* v *OHIM — Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 35).

27 To examine, in a particular case, whether an earlier trade mark has been put to genuine use, a global assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by a high intensity or some settled period of use of that mark or vice versa (*VITAFRUIT*, paragraph 42, and *HIPOVITON*, paragraph 36).

28 In addition, the turnover and the volume of sales of the goods under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the earlier mark need not always be quantitatively significant in order to be deemed genuine (*VITAFRUIT*, paragraph 42, and *HIPOVITON*, paragraph 36).

29 Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of actual and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes* v *OHIM - Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47, and Case T-356/02 *Vitakraft-Werke Wührmann* v *OHIM — Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 28).

30 In addition, it must be noted that, under Article 15(2)(a) of Regulation No 40/94 (now point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009) in conjunction with Article 43(2) and (3) of Regulation No 40/94, proof of genuine use of an earlier national or Community trade mark which forms the basis of an opposition

against a Community trade mark application also includes proof of use of the earlier mark in a form differing in elements which do not alter the distinctive character of that mark in the form in which it was registered (see Case T-29/04 *Castellblanch* v *OHIM — Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 30 and the case-law cited).

31 In the light of the foregoing it must be examined whether the Board of Appeal was right to find that the evidence submitted by the intervener during the procedure before OHIM shows genuine use of the earlier mark.

32 Since the application for a Community trade mark filed by the applicant was published on 20 June 2005, the period of five years referred to in Article 43(2) of Regulation No 40/94 runs from 20 June 2000 to 19 June 2005 ('the relevant period').

33 As is apparent from Article 15(1) of Regulation No 40/94, only trade marks genuine use of which has been suspended during an uninterrupted period of five years are subject to the sanctions provided for by the regulation. Accordingly, it is sufficient that a trade mark has been put to genuine use during a part of the relevant period for it not to be subject to the sanctions.

34 So far as concerns the evidence submitted by the intervener on 6 November 2006, the applicant maintains, first, that that evidence was submitted out of time and that it should therefore have been held to be inadmissible.

35 In that regard, it must be pointed out that the Opposition Division granted a period which expired on 5 November 2006 for the intervener to submit proof of genuine use of the earlier mark (see paragraph 8 above). Under Rule 72(1) of Regulation No 2868/95, if a time-limit expires on a day on which OHIM is not open for receipt of documents or on which, for reasons other than those referred to in Rule 72(2), ordinary mail is not delivered in the locality in which OHIM is located, the time-limit is to extend until the first day thereafter on which OHIM is open for receipt of documents and on which ordinary mail is delivered. As 5 November 2006 was a Sunday, that time-limit was extended until the next day on which OHIM was open for receipt of documents, namely Monday, 6 November 2006. It follows that the evidence provided on 6 November 2006 was submitted within the time-limit.

36 Secondly, the applicant maintains that the evidence submitted on 6 November 2006 was not sufficient given that it does not provide any information regarding actual use of the earlier mark. It states that no additional supporting documents, such as packaging, labels or drawings, showing that the goods were actually offered for sale were submitted.

37 In that regard, as the Board of Appeal stated in paragraph 15 of the contested decision, the evidence submitted by the intervener on 6 November 2006 is sufficient to prove genuine use of the earlier mark.

38 The intervener inter alia submitted two product brochures, which appeared in the United Kingdom, of the United Kingdom retailer, the company M. One of those catalogues dated from the autumn/winter 2002 season and the other from the spring/summer 2004 season. In that regard, it must be borne in mind that, under Rule 22(4) of Regulation No 2868/95, the evidence produced to show genuine use of the mark at

issue may include catalogues. The applicant has not cast doubt on the authenticity of those catalogues. It is therefore common ground that they are genuine and reliable.

39 So far as concerns the autumn/winter 2002 product brochure which comprises 36 pages, it must be pointed out that, in addition to items of clothing designated by different marks, more than 80 different items are offered for sale in that catalogue under the mark PETER STORM. They comprise men's and women's jackets, jumpers, trousers, tee-shirts, footwear, socks, hats and gloves, the respective characteristics of which are briefly described. The earlier mark appears, in stylised characters, next to each item. In that catalogue, the prices of the items in GBP and the reference number for each item are stated. The catalogue contains an order form, and a telephone number, fax number, postal address and Internet address are given for mail order purchases. Furthermore, detailed information is given as regards the different ways of ordering, and the general conditions of sale comprising inter alia information on exchanges and returns are included. In addition, a list of more than 240 stores in the United Kingdom in which the items of clothing may be purchased is provided. Their postal addresses and telephone numbers are also stated.

40 The spring/summer 2004 product brochure comprising six pages contains only footwear. In addition to items offered under other trade marks, that catalogue includes seven items offered for sale under the trade mark PETER STORM with brief descriptions of their respective characteristics. The earlier mark also appears, in stylised characters, next to each item. In that catalogue, the prices of the items in GBP and the reference number for each item are stated. A telephone number and an Internet address are given for mail order purchases.

41 By filing those catalogues the intervener proved, to the requisite legal standard, that the earlier mark was used for the purposes of creating or preserving an outlet for the goods at issue, even if, contrary to what the Board of Appeal stated in paragraph 15 of the contested decision, the company M. was not a third party in relation to the intervener because, in actual fact, the intervener was its parent company.

42 It is clear from those catalogues of the United Kingdom retailer M., which also contain items offered under other trade marks, that the trade mark PETER STORM was used in the United Kingdom in respect of items of clothing for a significant part of the relevant period, namely the autumn/winter 2002 and spring/summer 2004 seasons. The mark was affixed to a large number of goods which could be ordered by mail or purchased in certain shops. Those catalogues, which were intended for end consumers, contained specific information concerning the goods offered for sale under that trade mark, their prices and the way in which they were marketed in the United Kingdom. In the light of the telephone and fax numbers and postal and Internet addresses given for mail order purchasing and the specific information relating to a very large number of shops offering the goods at issue in the United Kingdom, it is clear that items of clothing were offered for sale under the trade mark PETER STORM to end consumers.

43 As to the extent of use of the earlier mark, it is true that those catalogues provide no information on the quantity of goods actually sold by the intervener under the trade mark PETER STORM. However, it is necessary to take into account, in that regard, the fact that a large number of items designated by the trade mark PETER STORM were offered in the catalogues and that those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment of whether the use to which the earlier mark was put was genuine, that the extent of its use was fairly significant. In that regard, it must also be remembered that the purpose of the

requirement for genuine use of the earlier mark is not to assess commercial success of the undertaking in question (see paragraph 23 above).

44 It follows that the intervener, by submitting the catalogues in question, furnished sufficient information on the place, the duration, the nature and the extent of use of the trade mark PETER STORM. That information makes it possible to rule out token use for the sole purpose of preserving the rights conferred by the mark in question, as was correctly stated by the Board of Appeal in paragraph 15 of the contested decision.

45 In those circumstances, the first plea must be rejected and there is no need to examine whether the Board of Appeal was justified in admitting the evidence produced by the intervener on 4 May 2007.

The second plea: breach of Article 8(1)(b) of Regulation No 40/94

46 In support of this plea, the applicant submits, in essence, that the goods covered by the earlier United Kingdom trade mark and the Community trade mark applied for are only marginally similar. Furthermore, in view, first, of the aural, visual and conceptual differences between the signs at issues and, secondly, of the weak distinctive character of the trade mark PETER STORM, there is no likelihood of confusion of the marks at issue.

47 OHIM and the intervener dispute the applicant's arguments.

48 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if because of its identity with or similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark. Furthermore, under Article 8(2)(a)(i) and (ii) of Regulation No 40/94 (now Article 8(2)(a)(i) and (ii) of Regulation No 207/2009), 'earlier trade marks' means Community trade marks and trade marks registered in a Member State.

49 According to established 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 that same line of case-law, the likelihood of confusion must be assessed globally according to the relevant public's perception of the signs and the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33 and the case-law cited).

50 As regards the definition of the relevant public, the goods covered by the marks at issue are intended for all consumers, with the result that the relevant public is the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect.

51 As regards the relevant territory, since the earlier mark taken into account by the Board of Appeal is a Community trade mark, the territory with regard to which the likelihood of confusion must be assessed is that of the European Union.

— The comparison of the goods

52 It is common ground in the present case that the goods covered by the earlier mark and the mark applied for are identical as what is involved in both cases is clothing, footwear and items of headgear.

53 In view of the fact that the goods covered by the mark applied for and the earlier mark are identical, there is no need to compare the goods covered by the earlier United Kingdom trade mark and those covered by the mark applied for.

— The comparison of the signs

54 The global assessment of the likelihood of confusion, in relation to the visual, phonetic or conceptual similarity of the signs in question, must be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods in question plays a decisive role in the global appreciation of such likelihood of confusion. In that regard, the average consumer normally perceives a mark as a whole

and does not proceed to analyse its various details (see Case C-334/05 P *OHIM* v *Shaker* [2007] ECR I-4529, paragraph 35 and the case-law cited).

55 The Board of Appeal found, in paragraphs 26 to 28 of the contested decision, that there is a degree of visual and aural similarity between the two signs at issue, namely the signs peerstorm and PETER STORM. However, there is, according to the Board of Appeal, no conceptual similarity between those two signs.

56 The applicant maintains, in essence, that the signs at issue display visual, aural and conceptual differences. It states that the mark PETER STORM consists of two words, namely a first name and a surname, whereas the mark applied for consists of a single word which cannot be separated into a first name and a surname.

57 OHIM and the intervener dispute the applicant's arguments in that respect.

58 First, as regards the visual comparison of the marks at issue, namely the earlier mark and the mark applied for, there are two differences between those marks. First, while the earlier mark consists of two words which are separated by a space, the mark applied for consists of a single word. Secondly, so far as concerns the first component of the marks at issue, in contrast to the mark applied for, the earlier mark contains the letter 't' between the two letters 'e' of its initial element. Apart from those differences, it must be pointed out that both of the marks at issue comprise the same letters in the same order and, in particular, that the element 'storm' in both of them is identical.

59 It is true that the first component of word marks may be more likely to catch the consumer's attention than the following components (see, to that effect, Joined Cases T-183/02 and T-184/02 *El Corte Inglés* v *OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81, and Case T-112/03 *L'Oréal* v *OHIM — Revlon (FLEXI AIR)* [2005] ECR II-949, paragraphs 64 and 65). However, that cannot apply in all cases (see, to that effect, Case T-292/01 *Phillips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 50, and Case T-117/02 *Grupo El Prado Cervera* v *OHIM — Héritiers Debuschewitz (CHUFAFIT)* [2004] ECR II-2073, paragraph 48).

60 Although, according to the case-law cited in paragraph 54 above, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (*VITAKRAFT*, paragraph 51, and Case T-256/04 *Mundipharma* v *OHIM — Altana Pharma (RESPICUR)* [2007] ECR II-449, paragraph 57).

61 In the present case, the element 'storm', which both of the marks at issue contain, will attract, in particular, the attention of the average English-speaking consumer on account of its appearance as a word and the fact that he will understand its meaning. It follows that that consumer will break down the mark applied for into two elements, 'peer' and 'storm', with the result that the dissimilarity stemming from the space in the earlier mark will fade into the background.

62 So far as concerns the dissimilarity resulting from the presence of the letter 't' in the first word of the earlier mark, as the Board of Appeal found in paragraph 27 of the contested decision, the fact that that letter is between two 'e's will make it less visible

to the relevant consumer. The Board of Appeal therefore correctly concluded that there is a degree of visual similarity between the two marks at issue taken as a whole.

63 Secondly, as regards the aural comparison of the marks at issue, the Board of Appeal was right in finding, in paragraph 26 of the contested decision, that the element 'storm' is pronounced in the same way in both of the marks at issue. So far as concerns the elements 'peer' and 'peter' in the mark applied for and the earlier mark respectively, as the Board of Appeal pointed out the sound of the letters 'ee' in the element 'peer' and of the letter 'e' in the first syllable of the element 'peter' is identical in several languages, whether it be an 'ie' sound in English, a long 'éé' in Dutch and German or an 'é' sound in French. The only difference stems from the presence of the letter 't' in the first element of the earlier mark. On account of the presence there of that letter, which generally produces a clear and hard sound, that mark has three syllables. By contrast, the mark applied for has only two syllables.

64 In this connection, it must be pointed out that the word 'peter' is pronounced by putting the main stress on the first syllable with the result that the letter 't' and the second syllable of that word become less audible. The fact that the letter 't' is not present in the first part of the mark applied for cannot therefore call into question the Board of Appeal's finding that there is a degree of aural similarity between the marks at issue.

65 Thirdly, as regards the conceptual comparison of the marks at issue, the applicant states that, contrary to the mark applied for, the earlier mark is made up of a first name and a surname. For English and German-speaking consumers, the element 'peer' in the mark applied for is not equated with the Nordic first name, but rather is understood as meaning 'lord'.

66 It must be pointed out that both of the marks at issue are made up of a first name and a surname. As regards the element 'storm' in the two marks at issue, it is common ground that it can be a surname. As regards the elements 'peer' and 'peter' in the mark applied for and the earlier mark respectively, the Board of Appeal correctly found, in paragraph 28 of the contested decision, that they are first names. It is true that the element 'peer' might be understood as meaning 'lord' by an English-speaking consumer. However, in particular in the Nordic countries and in Germany, Peer is a first name. The fact that the mark applied for is written as one word cannot cast doubt on the finding that the two marks at issue are made up of a first name and a surname. The intervener has correctly stated that the relevant consumer is accustomed to spaces between a first name and a surname which constitute a mark being omitted for the purposes of forming an Internet address.

67 In the present case, it must be added that, as stated by the applicant, English-speaking consumers will associate the surname Storm with bad weather. In view of the presence in both of the marks at issue of the element 'storm', which will attract, in particular, the attention of the average English-speaking consumer on account of its quality as a word and the fact that he will understand its meaning (see paragraphs 60 and 61 above), the marks at issue suggest that the goods designated, namely footwear, clothing and headgear, provide protection against bad weather.

68 Given that both of the marks at issue are made up of a first name and surname and that they suggest that the goods at issue protect against bad weather, there is, contrary to the Board of Appeal's finding in paragraph 28 of the contested decision, a degree of conceptual similarity between the two marks at issue.

69 In the light of all of the foregoing, the Board of Appeal therefore correctly found that there is a degree of visual and aural similarity between the marks at issue. Moreover, contrary to the Board of Appeal's findings, there is also a degree of conceptual similarity between the marks at issue.

— The likelihood of confusion

70 A global assessment of the likelihood of confusion implies some interdependence between the factors taken into account, and in particular between the similarity of the trade marks and the similarity of the goods or services concerned. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17, and Joined Cases T-81/03, T-82/03 and T-103/03 *Mast-Jägermeister* v *OHIM — Licorera Zacapaneca (VENADO with frame and others)* [2006] ECR II-5409, paragraph 74).

71 The Board of Appeal found, in paragraph 30 of the contested decision, that, since the goods at issue are identical and there is a degree of visual and aural similarity between the signs, there is a likelihood of confusion between the marks at issue for the relevant public.

72 The applicant maintains that the mark PETER STORM has a low degree of inherent distinctiveness because, first, the relevant public is accustomed to trade marks consisting of a first name and surname for items of clothing and, secondly, the first name Peter and the surname Storm are common and do not stand out. In particular,

English-speaking consumers will associate the surname Storm with bad weather. There is therefore no likelihood of confusion.

73 OHIM and the intervener dispute the applicant's arguments.

74 In that regard, first, it is true that the more distinctive the earlier mark, the greater the likelihood of confusion (see, by analogy, *Canon*, paragraph 18, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 20). However, the finding of weak distinctive character for the earlier mark does not prevent a finding that there is a likelihood of confusion in the present case. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see Case T-134/06 *Xentral* v *OHIM — Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70 and the case-law cited).

75 Secondly, in the present case, the applicant has not shown that the earlier mark, used as a whole in the clothing sector, has a low degree of inherent distinctiveness in the territory of the Union.

76 In that regard, it must be pointed out that the criteria for assessment of the distinctive character of trade marks constituted by a personal name are the same as those applicable to the other categories of trade mark. Stricter general criteria based, for example, on a predetermined number of persons with the same name, above which

that name may be regarded as devoid of distinctive character, and on the prevalence or otherwise of the use of surnames in the relevant trade cannot be applied to such trade marks. The distinctive character of a trade mark, in whatever category, must be the subject of a specific assessment (see, by analogy, Case C-404/02 *Nichols* [2004] ECR I-8499, paragraphs 25 to 27).

77 Although it is true that the use of signs made up of a first name and a surname is common in the clothing sector, the applicant's arguments relating respectively to the word 'peter' and to the word 'storm' cannot justify the conclusion that the earlier mark has a low degree of inherent distinctiveness. The earlier mark at issue is the sign PETER STORM which, although it consists of two elements, must be taken into account as a whole. In that regard, it must be remembered that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see the case-law cited in paragraph 54 above). The fact that the average consumer will break a word sign down into elements which, for him, suggest a concrete meaning or which resemble words known to him (see, to that effect, the case-law cited in paragraph 60 above) cannot however mean that that consumer will view those elements as separate signs. In stating that the words 'peter' and 'storm' are common and do not stand out and that the word 'storm' is used in forming trade marks, the applicant did not take into account the fact that the elements 'peter' and 'storm' actually form a single sign. The applicant's arguments which relate separately to the word 'peter' and the word 'storm' are not therefore sufficient to show that the earlier mark PETER STORM has weak distinctive character.

78 Furthermore, it must be borne in mind that the Board of Appeal was right to find that there is a degree of visual and aural similarity between the marks at issue. As regards the articles of apparel concerned, namely clothing, footwear and headgear, visual similarity is of particular importance in this instance since it is acknowledged that, in general, the purchase of clothing involves a visual examination of the marks (see, to

that effect, the judgment of 12 July 2006 in Case T-97/05 *Rossi* v *OHIM — Marcorossi (MARCOROSSI)*, not published in the ECR, paragraph 45 and the case-law cited).

79 Even if the earlier mark were to have only weak distinctive character, given that the goods covered by the earlier mark and the mark applied for are identical (see paragraph 52 above) and given the elements of similarity between the signs at issue that were found by the Board of Appeal in particular at a visual level, the Board of Appeal was correct to find, in paragraph 30 of the contested decision, that a likelihood of confusion between the marks at issue cannot be ruled out for the relevant public.

80 That is all the more so since, contrary to the findings of the Board of Appeal, there is also a degree of conceptual similarity between the marks at issue. The Court cannot be bound by the incorrect assessment by the Board of Appeal of the conceptual similarity between the two marks at issue, since that assessment is part of the findings the legality of which is being disputed before the Court (see, to that effect, Case C-16/06 P *Éditions Albert René* v *OHIM* [2008] ECR I-10053, paragraph 48).

81 In those circumstances, it follows from all of the foregoing that, without it being necessary for the Court to rule on the admissibility of the applicant's head of claim requesting that the Court reject the opposition in its entirety, the action must be dismissed (see, to that effect, the judgment of 22 May 2008 in Case T-205/06 *NewSoft Technology* v *OHIM — Soft (Presto! BizCard Reader)*, not published in the ECR, paragraph 70, and the judgment of 11 June 2009 in Case T-67/08 *Hedgefund Intelligence* v *OHIM — Hedge Invest (InvestHedge)*, not published in the ECR, paragraph 58).

Costs

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

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

1. Dismisses the action;

2. Orders Engelhorn KGaA to bear its own costs and to pay those of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and of The Outdoor Group Ltd.

Martins Ribeiro Wahl Dittrich

Delivered in open court in Luxembourg on 8 July 2010.

[Signatures]