



Reports of Cases

JUDGMENT OF THE COURT (Tenth Chamber)

4 July 2019*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Opposition proceedings — Article 8(1)(b) — Application for registration of the figurative mark including the word element ‘FI’ — Opposition by the proprietor of the figurative mark including the word element ‘fly.de’ — Rejection — Similarity between the signs — Name in normal script in the *European Union Trade Marks Bulletin* — Likelihood of confusion)

In Case C-99/18 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 12 February 2018,

FTI Touristik GmbH, established in Munich (Germany), represented by A. Parr, Rechtsanwältin,

appellant,

the other parties to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by D. Walicka and D. Botis, acting as Agents,

defendant at first instance,

Harald Prantner, residing in Hamburg (Germany),

Daniel Giersch, residing in Monaco (Monaco),

represented by S. Eble, Rechtsanwalt,

interveners at first instance,

THE COURT (Tenth Chamber),

composed of C. Lycourgos, President of the Chamber, M. Ilešič (Rapporteur) and I. Jarukaitis, Judges,

Advocate General: G. Pitruzzella,

Registrar: A. Calot Escobar,

having regard to the written procedure,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

* Language of the case: German.

gives the following

Judgment

- 1 By its appeal, FTI Touristik GmbH seeks to have set aside the judgment of the General Court of the European Union of 30 November 2017, *FTI Touristik v EUIPO — Prantner and Giersch (FI)* (T-475/16, not published, EU:T:2017:856) ('the judgment under appeal'), by which the General Court dismissed its action for annulment of the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 16 June 2016 (Case R 480/2015-5), relating to opposition proceedings between FTI Touristik, on the one side, and Mr Harald Prantner and Mr Daniel Giersch, on the other side ('the decision at issue').

Legal context

- 2 Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1) was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. Regulation No 207/2009, as amended, was repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union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). Nonetheless, given the date on which the application for registration at issue in the present case was filed, namely 7 October 2013, which is decisive for the purpose of identifying the applicable substantive law, the present dispute is governed by the substantive provisions of Regulation No 207/2009.
- 3 Article 8(1)(b) of Regulation No 207/2009 was worded as follows:

'Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

- (b) if because of its identity with, or similarity to, the 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.'

Background to the dispute and the decision at issue

- 4 The background to the dispute and the decision at issue are set out in paragraphs 1 to 15 of the judgment under appeal, as follows:

'1. On 7 October 2013, the interveners, Mr ... Prantner and Mr ... Giersch filed an application for registration of an EU trade mark with [EUIPO] under Regulation [No 207/2009].

2. Registration as a mark was sought for the following figurative sign:



3. The goods and services in respect of which registration was sought are in Classes 16, 39 and 43 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

- Class 16: “Printed matter; photographs; stationery; wrapping materials; printed publications; books; handbooks [manuals]; pamphlets; newsletters; albums; newspapers; magazines and periodicals; tickets; vouchers; coupons and travel documents; passes; tags and labels; posters; postcards; calendars; diaries; instructional material”;
- Class 39: “Transport; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travellers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation for passengers, goods and trips by land and sea; airline services; baggage handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; aircraft chartering; rental and hire of aircraft, cars and boats; taxi services; bus services; chauffeuring; coach services; train services; airport transfer services; airport parking services; aircraft parking services; escorting of travellers; travel agency services; advisory, consultancy and information services relating to all the aforesaid services; providing information regarding transportation services; providing travel information online; travel booking via computer databases or the Internet”;
- Class 43: “Services for providing food and drink, temporary accommodation; restaurant and bar services; food and drink catering; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; hotels and/or restaurants; reservations in connection with running hotels.”

4. The EU trade mark application was published in the *European Union Trade Marks Bulletin* No 225/2013 of 26 November 2013.

5. On 26 February 2014, the applicant, FTI Touristik ..., 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 and services referred to in paragraph 3 above.

6. The opposition was based on the following earlier EU figurative mark:



designating the following goods and services in Classes 16, 39, 41 and 43, and corresponding, for each of these classes, to the following description:

- Class 16: “Printed matter, in particular catalogues, prospectuses, information material; office requisites (other than furniture); instructional and teaching material, included in class 16; globes, atlases; paper, cardboard and goods made from these materials (included in class 16); stationery; plastic materials for packaging, including plastic bags, included in class 16, sleeves of plastic, in particular for travel documents”;
- Class 39: “Transport, including the organising and rental of transport; travel planning, arranging, booking and organising, including the aforesaid services using electronic devices; tourist services; sightseeing (tourism), escorting of travellers; transportation and travel information, including the aforesaid services using electronic devices”;
- Class 41: “Education; providing of training; hostess services and entertainment; sporting and cultural activities; providing recreation facilities; publication of printed matter and electronic media relating thereto (including CD-ROMs and CD-Is); rental of films, recorded videos, cinematographic, radio, television apparatus, sports equipment; arranging and conducting of conferences, congresses, symposiums, meetings and seminars”;
- Class 43: “Accommodation reservations; accommodation services; providing of food and drink and temporary accommodation; services for providing food and drink and temporary accommodation in hotels and restaurants, including the organising of tourist homes and holiday homes.”

7. The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009 (now Article 8(1)(b) of Regulation 2017/1001).

8. On 3 February 2015, the Opposition Division upheld the opposition and rejected the trade mark application in respect of all the goods and services in question.

9. On 26 February 2015, the interveners 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 decision of the Opposition Division.

10. By [the decision at issue], the Fifth Board of Appeal of EUIPO annulled the decision of the Opposition Division.

11. It noted, first, in paragraph 19 of the [decision at issue], that the goods and services in question were intended for both the public at large and a specialist public, and that it was appropriate to concern oneself with the public which has the lowest level of attention, namely the public at large with an average level of attention. It then took the view, in paragraph 20 of the [decision at issue], that the relevant territory for the purpose of assessing the likelihood of confusion was the whole European Union, before stating that the opposition was to be upheld even if there was a likelihood of confusion in one Member State only.

12. With regard to the comparison of goods and services, the [Fifth] Board of Appeal [of EUIPO] approved, in paragraph 25 of the [decision at issue], the conclusion, undisputed before it, of the Opposition Division, as set out in paragraph 24 of the [decision at issue], that the goods and services in question were in part identical and in part similar. It thus found that the goods, in Class 16, covered by the mark applied for and the goods, also in Class 16, covered by the earlier mark were identical. Similarly, it concluded that the services in Class 39, covered by the mark applied for, and those also in Class 39, covered by the earlier mark, were identical, except the services relating to the “provision of car parking facilities; airport parking services; aircraft parking services” which were found to be similar to the “Transport” service of the earlier mark. Lastly, it took the view that all the services in Class 43 of the mark applied for were identical to those of Class 43 also of the earlier mark, except the “booking and reservation services for restaurants and holiday accommodation” which bear similarity to the “providing of food and drink and temporary accommodation” of the earlier mark.

13. The [Fifth] Board of Appeal [of EUIPO] also proceeded to examine the signs at issue and found, in paragraph 32 of the [decision at issue], that they were not visually similar. Phonetically, it found, in essence, in paragraphs 33 and 34 of the [decision at issue], that for the public that did not know the English term “fly”, the signs at issue bore no similarity. For consumers that did know the English word “fly”, there was a phonetic similarity provided that the mark applied for was associated with the word “fly”. However, this seemed rather unlikely since, first, there was a great difference between the letter “y” and the stylised heart in the mark applied for and, secondly, it was unusual to replace the letter “y” with a heart symbol. Conceptually, it found, in essence, in paragraphs 35 and 36 of the [decision at issue], that, for the public that did not know the English term “fly”, the signs at issue bore no similarity. For consumers that did know and understand the English word “fly”, there was a conceptual similarity provided that the word “fly” was identified in the mark applied for. However, this seemed unlikely for the same reasons as those set out in the context of the assessment of the phonetic similarity.

14. The [Fifth] Board of Appeal [of EUIPO] found, in paragraph 40 of the [decision at issue], that the earlier mark had an average inherent distinctive character for the non-English-speaking consumers and a weak inherent distinctive character for the English-speaking public.

15. With regard to the assessment of the likelihood of confusion between the signs at issue, the [Fifth] Board of Appeal [of EUIPO] concluded, in paragraph 47 of the [decision at issue], that there was no such likelihood. It noted, in that respect, in paragraph 46 of the [decision at issue], that, due to the purely descriptive nature of the common element, the phonetic, conceptual and especially visual differences between the signs were sufficient to rule out with certainty a likelihood of confusion, including for identical goods and services.’

The action before the General Court

- 5 By application lodged at the Registry of the General Court on 26 August 2016, the appellant brought an action against the decision at issue, based on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009. The appellant submitted, in essence, that the analysis carried out by the Fifth Board of Appeal of EUIPO as to the visual, phonetic and conceptual similarities of the signs at issue was incorrect and that it was wrong to find that the earlier mark was weakly distinctive for the English-speaking public, to the extent that there was no likelihood of confusion between the signs at issue.
- 6 In the judgment under appeal, the General Court found, in the first place, with regard to the comparison of the signs at issue, that the Fifth Board of Appeal of EUIPO had been justified in finding no visual, phonetic or conceptual similarity between the mark applied for and the earlier mark. In the second place, as to the distinctive character of the earlier mark, the General Court found that the Board of Appeal had been right to find that the earlier mark had an average distinctive character for the non-English-speaking public, and a weak distinctive character for the

English-speaking public. In the third place, as to the likelihood of confusion, the General Court found that the appellant had failed to establish that the Board of Appeal had wrongly concluded that there was no likelihood of confusion between the mark applied for and the earlier mark. The General Court therefore rejected the single plea in law and dismissed the action in its entirety.

Forms of order sought by the parties to the appeal

- 7 FTI Touristik claims that the Court should:
 - set aside the judgment under appeal and
 - order EUIPO to pay the costs.
- 8 EUIPO contends that the Court should:
 - dismiss the appeal and
 - order FTI Touristik to pay the costs.
- 9 Mr Prantner and Mr Giersch contend that the Court should dismiss the appeal.

The appeal

- 10 In its appeal, the appellant raises a single ground of appeal, alleging infringement of Article 8(1)(b) of Regulation No 207/2009, which is divided into four parts. In the context of the first part of the single ground, it also alleges infringement by the General Court of its obligation to state reasons.

The first part of the single ground of appeal

- 11 By the first part of the single ground, the appellant puts forward a methodological error on the part of the General Court in its assessment of the possible existence of a likelihood of confusion, in that it failed to take account, in its examination of the similarity between the signs in question, of the name in normal script of the mark applied for, as set out in the *European Union Trade Marks Bulletin*. In its view, the General Court, in that context, also disregarded its obligation to state reasons by failing to examine the appellant's argument based on that name.
- 12 EUIPO contends that the first part of the single ground is inadmissible in that it constitutes an attempt by the appellant to submit to the Court of Justice issues of fact. According to EUIPO, that part of the single ground is, in any event, unfounded.
- 13 As to the admissibility of the first part of the single ground, it must be recalled, first, that it is settled case-law that the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case. Whereas the evaluation of those factors is an issue of fact that cannot be reviewed by the Court, failure to take all of those factors into account constitutes an error of law and may, as such, be raised before the Court in the context of an appeal (judgment of 16 June 2011, *Union Investment Privatfonds v UniCredito Italiano*, C-317/10 P, EU:C:2011:405, paragraph 45 and the case-law cited).
- 14 Secondly, the extent of the obligation to state reasons is a question of law reviewable by the Court on appeal (judgment of 28 June 2005, *Dansk Rørindustri and Others v Commission*, C-189/02 P, C-202/02 P, C-205/02 P to C-208/02 P and C-213/02 P, EU:C:2005:408, paragraph 453).

- 15 It follows that the first part of the single ground of appeal is admissible.
- 16 With regard to the merits of that part of the single ground, it is appropriate from the outset to rule out the alleged failure on the part of the General Court to comply with its obligation to state reasons.
- 17 In that regard, it should be recalled that, according to settled case-law, the duty owed by the General Court under Article 36 and the first paragraph of Article 53 of the Statute of the Court of Justice of the European Union to state reasons does not require the General Court to provide an account that follows exhaustively and one by one all the arguments articulated by the parties to the case. The reasoning may also be implicit, on condition that it enables the persons concerned to understand the grounds of the General Court's judgment and provides the Court of Justice with sufficient information to exercise its powers of review on appeal (judgment of 20 September 2016, *Mallis and Others v Commission and ECB*, C-105/15 P to C-109/15 P, EU:C:2016:702, paragraph 45 and the case-law cited).
- 18 In the present case, it must be stated that it follows from paragraph 43 of the judgment under appeal that 'the [name] in normal script of the mark applied for, as published in the *European Union Trade Marks Bulletin*, namely "fly", cannot be decisive in the assessment of the phonetic impression generated by composite marks in opposition proceedings'.
- 19 It follows that, contrary to the appellant's assertions, by considering that that name cannot be decisive in the assessment of the phonetic impression in question, the General Court implicitly but not necessarily considered that that very name is not indicative of how the relevant public perceives the mark in question.
- 20 Such a finding, moreover, is not marred by any error of law. As the General Court recalled, in paragraph 21 of the judgment under appeal, according to settled 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.
- 21 However, as the General Court found, in essence, in paragraph 43 of the judgment under appeal, as set out in paragraph 18 above, the name in normal script of a figurative mark in the *European Union Trade Marks Bulletin*, whether it corresponds to the intention of the applicant for the mark in question or to the reference made by EUIPO in the *Bulletin*, is irrelevant for the purpose of determining the relevant public's phonetic perception of the signs in question which should not be confused with their name in normal script in the *Bulletin*.
- 22 It follows that the first part of the single ground of appeal must be rejected.

The second part of the single ground of appeal

- 23 By the second part of the single ground, the appellant submits that, like the Fifth Board of Appeal of EUIPO, the General Court made a methodological error in its assessment of the existence of a likelihood of confusion. In that regard, while phonetic similarities may conceivably be cancelled out by visual differences with the result that, despite phonetic similarity, there is no likelihood of confusion, such cancelling out would have to be examined under the assessment of the possible existence of a likelihood of confusion. Should that examination already be carried out when comparing the signs, any similarity between the marks would be excluded per se, without it being possible to take into account any other possible effects on the likelihood of confusion, such as the distinctiveness of the mark at issue or the fact that the goods and services concerned are identical or similar.

- 24 EUIPO contends that the second part of the single ground is inadmissible, since it relates to the decision at issue and not to the judgment under appeal. According to EUIPO, that part of the single ground is, in any event, difficult to understand and unfounded.
- 25 With regard to the admissibility of the second part of the single ground, it must be noted that, contrary to EUIPO's assertions, the appellant does not merely dispute, in its appeal, the lawfulness of the decision at issue, but claims, rather, that in paragraph 64 of the judgment under appeal the General Court found, without sufficient justification, no similarity between the signs at issue, thus making a methodological error in its assessment of the likelihood of confusion. The second part of the single ground of appeal is therefore admissible.
- 26 As to the merits of that part of the single ground, it must be found that it is based on a misreading of the judgment under appeal.
- 27 In that regard, suffice it to note, first, that in paragraph 64 of the judgment under appeal the General Court found that 'the applicant's arguments relating to the likelihood of confusion are based on the misconception that the [Fifth] Board of Appeal [of EUIPO] ought have concluded that the signs at issue were highly similar insofar as, for the major part of the consumers, they share the common word element "fly" and referred, in that respect, to paragraphs 26 to 57 of that judgment. The General Court concluded, in paragraph 65 of the judgment under appeal, that the appellant had failed to establish that the Board of Appeal had been wrong to find that there was no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009. The General Court, thus, in paragraph 64 of the judgment under appeal, merely established, in essence, that the Board of Appeal had been justified in finding that there was no likelihood of confusion in the present case.
- 28 Secondly, it does not follow either from those paragraphs 26 to 57 and, in particular, from paragraphs 30 to 36 of the judgment under appeal, concerning the visual similarity of the signs at issue, from paragraphs 41 to 44 of that judgment, concerning the phonetic similarity of those signs, or from paragraphs 49 to 51 of that judgment, concerning the conceptual similarity of the signs, that the General Court relied on a 'cancelling out' of the phonetic similarity of the signs in question by the visual difference thereof in the context of its assessment of the similarity of the signs in question.
- 29 The second part of the single ground of appeal must therefore be rejected.

The third part of the single ground of appeal

- 30 By the third part of the single ground, the appellant disputes the General Court's finding in paragraph 42 of the judgment under appeal whereby it considered that, since the earlier mark contains the element '.de', there is no phonetic similarity between the signs in question, the earlier mark being, by virtue of that element, always pronounced as several syllables. In so doing, according to the appellant, the General Court conferred that element a dominant nature in the overall impression created by the earlier mark, although a domain name extension merely has a functional meaning and thus cannot, as a matter of principle, be regarded as dominant.
- 31 EUIPO contends that the third part of the single ground is unfounded.
- 32 It must be noted that, in paragraph 42 of the judgment under appeal, the General Court stated that 'it is unlikely that the relevant public would detect the letter "y" in the figurative element of the mark applied for. It is apparent from paragraph 34 above, first, that there is a great difference between the letter "y" and the heart symbol in the mark applied for and, secondly, it is unusual to replace the letter "y" with a heart symbol. Moreover, should, as the applicant maintains, the consumer identify the letter "y" in the stylised heart symbol, the phonetic coincidence between the word elements "fly" in each of the signs at issue would be weakened by the presence of the word element ".de" in the earlier mark.

The applicant puts forward no argument to challenge the finding of the [Fifth] Board of Appeal [of EUIPO], in paragraph 33 of the [decision at issue], regarding the pronunciation of that word element, that the earlier mark will always be pronounced as several syllables, whereby their exact number will vary according to the linguistic rules in each national language.'

- 33 As is apparent from paragraph 42 of the judgment under appeal, the General Court's assessment is based on the finding that, first, there is a great difference between the letter 'y' and the heart symbol in the mark applied for and, secondly, it is unusual to replace the letter 'y' with such a symbol and, accordingly, it is unlikely that the relevant public will detect the letter 'y' in the figurative element of the mark applied for. That assessment, in the absence of any allegation, in the present case, on the part of the appellant, of a distortion of the facts thus does not constitute a point of law which is subject, as such, to review by this Court on appeal (see, *inter alia*, judgment of 2 September 2010, *Calvin Klein Trademark Trust v OHIM*, C-254/09 P, EU:C:2010:488, paragraph 49 and the case-law cited).
- 34 It is, in that regard, only for the sake of completeness, should consumers identify the letter 'y' in the stylised heart symbol, that the General Court considered that the phonetic coincidence between the word elements 'fly' in each of the signs at issue would be weakened by the presence of the word element 'de' in the earlier mark.
- 35 Complaints directed against grounds of the judgment under appeal included purely for the sake of completeness cannot in any event lead to the judgment's being set aside (judgment of 6 September 2017, *Intel v Commission*, C-413/14 P, EU:C:2017:632, paragraph 63 and the case-law cited).
- 36 It follows that the third part of the single ground of appeal is ineffective.

The fourth part of the single ground of appeal

- 37 By the fourth part of the single ground, the appellant claims that the heart symbol, in the mark applied for, is most certainly intended by the intervening parties at first instance as the letter 'y' because in all their other EU trade marks, the heart symbol replaced the letter 'y', as in the present case. Moreover, according to the appellant, it is apparent from the website operated by the proprietor of the mark applied for that, with the heart symbol, it intends to substitute the letter 'y'.
- 38 EUIPO disputes the admissibility of the fourth part of the single ground, which, in its view, is a pure statement of fact. According to EUIPO, that part of the single ground is, in any event, unfounded.
- 39 It should be noted that, in accordance with Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal is limited to points of law. The General Court therefore has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts and evidence are distorted, constitute a point of law which is subject, as such, to review by this Court on appeal (see, *inter alia*, judgment of 2 September 2010, *Calvin Klein Trademark Trust v OHIM*, C-254/09 P, EU:C:2010:488, paragraph 49 and the case-law cited).
- 40 In the present case, clearly, by the fourth part of the single ground, the appellant merely challenges the factual analysis carried out by the General Court in paragraph 42 of the judgment under appeal.
- 41 The fourth part of the single ground of appeal is therefore inadmissible.
- 42 In the light of all the foregoing, the appeal must be dismissed in its entirety.

Costs

- ⁴³ Under Article 137 of the Rules of Procedure of the Court of Justice, applicable to the procedure on appeal pursuant to Article 184(1) of those rules, a decision as to costs is to be given in the judgment or order which closes the proceedings. Under Article 138(1) of the Rules of Procedure, which is also applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- ⁴⁴ Since EUIPO has applied for costs and the appellant has been unsuccessful, the latter must be ordered to bear its own costs and to pay those incurred by EUIPO. Since Mr Prantner and Mr Giersch have not applied for costs, they are to bear their own costs.

On those grounds, the Court (Tenth Chamber) hereby:

- 1. Dismisses the appeal;**
- 2. Orders FTI Touristik GmbH to bear its own costs and to pay those incurred by the Office of the European Union for Intellectual Property (EUIPO);**
- 3. Orders Mr Harald Prantner and Mr Daniel Giersch to bear their own costs.**

[Signatures]