



## Reports of Cases

### JUDGMENT OF THE GENERAL COURT (Second Chamber)

21 October 2015\*

(Community trade mark — Opposition proceedings — Application for the Community word mark PETCO — Earlier Community figurative mark PETCO — Relative ground for refusal — Article 8(1)(b) of Regulation (EC) No 207/2009 — Suspension of the administrative proceedings — Rule 20(7)(c) and Rule 50(1) of Regulation (EC) No 2868/95 — Plea which does not support the form of order sought — Prohibition on ruling ultra petita — Inadmissibility)

In Case T-664/13,

**Petco Animal Supplies Stores, Inc.**, established in San Diego, California (United States), represented by C. Aikens, Barrister,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by V. Melgar and Ó. Mondéjar Ortuño, acting as Agents,

defendant,

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

**Domingo Gutiérrez Ariza**, residing in Málaga (Spain),

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 7 October 2013 (Case R 347/2013-4) relating to opposition proceedings between Mr Domingo Gutiérrez Ariza and Petco Animal Supplies Stores, Inc.,

THE GENERAL COURT (Second Chamber),

composed of M.E. Martins Ribeiro, President, S. Gervasoni and L. Madise (Rapporteur), Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 10 December 2013,

having regard to the response lodged at the Court Registry on 11 April 2014,

further to the hearing on 14 April 2015,

gives the following

\* Language of the case: English.

## Judgment

### Background to the dispute

- 1 On 11 July 2011, the applicant, Petco Animal Supplies Stores, Inc., filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).
- 2 Registration as a mark was sought for the word sign PETCO.
- 3 The goods and services in respect of which registration was sought are in, inter alia, Classes 31 and 35 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 31: ‘Live animals; foodstuffs for animals; malt; food and beverages for animals; dog food and treats; cat food and treats; small animal food; fish food; reptile food and bird seed’;
  - Class 35: ‘Retail services and on-line store services connected with the sale of pet supplies, pet toys, pet food, and sports and sporting goods; promoting sports competitions and/or events of others, namely, entertainment in the nature of musical, and theatrical events, educational, cultural, and civic events and exhibitions; retail store services in the field of animal and pet supplies’.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 2011/170 of 8 September 2011.
- 5 On 16 November 2011, Mr Domingo Gutiérrez Ariza filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 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 Community figurative mark in red and white:



- 7 The goods and services in respect of which the earlier mark was registered are in, inter alia, Classes 31 and 35 of the Nice Agreement and correspond, for each of those classes, to the following description:
  - Class 31: ‘Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt’;
  - Class 35: ‘Advertising; business management; business administration; office functions; wholesaling, retailing and selling via global computer networks of: fodder, canary seed, pasta, seeds, colourants, vitamins, medicines, grit, eggs, food supplements, cages, kennels, aquariums, terrariums, animal

carriers, feeding troughs, drinking troughs, mattresses, cots, nests, fibres, fur, collars, leashes, harness, covers, cover accessories, brushes, sanitary preparations for animals, posts and books, traps, substrates, silos, hoppers, enclosures, grains and cereals, insecticides, acaricides, animals, plants, scissors, tweezers, tools, incubators, hatchers and playthings’.

- 8 The grounds relied on in support of the opposition were those set out in Article 8(1)(a) and (b) of Regulation No 207/2009.
- 9 On 18 December 2012, the Opposition Division upheld the opposition in part, rejecting the application for registration of the mark applied for in so far as it related to the goods and services in Classes 31 and 35, on the ground that there was a likelihood of confusion with the earlier mark.
- 10 On 15 February 2013, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division in so far as it had refused registration of the mark applied for in respect of the goods and services in Classes 31 and 35.
- 11 In its statement of grounds for the appeal, which was filed with OHIM on 18 April 2013, the applicant also requested that the proceedings before the Board of Appeal be suspended on the ground that it had, on 28 December 2012, filed with OHIM an application for a declaration that the earlier mark was invalid, an application which was registered under filing No 7442 C.
- 12 As was stated by the parties at the hearing, the application for a declaration that the earlier mark was invalid was rejected by OHIM on 10 March 2014 and that rejection formed the subject-matter of an appeal which was still pending before OHIM at the time of the hearing.
- 13 By decision of 7 October 2013 (‘the contested decision’), the Fourth Board of Appeal of OHIM annulled the Opposition Division’s decision of 18 December 2012 to the extent that that decision refused registration of the mark applied for in respect of the ‘retail services and on-line store services connected with the sale of ... sports and sporting goods’ in Class 35, and dismissed the appeal as to remainder.
- 14 The Board of Appeal found that, since the earlier mark is a Community trade mark, the relevant territory for the purposes of analysing the likelihood of confusion was the European Union and that the relevant public, the level of attention of which varied from average to high, consisted of the general public and of professionals (paragraphs 11 and 33 of the contested decision). Furthermore, it took the view that the ‘retail services and on-line store services connected with the sale of ... sports and sporting goods’ in Class 35 covered by the mark applied for were dissimilar to the goods and services in Classes 31 and 35 covered by the earlier mark and that, consequently, the opposition to registration of the mark applied for in respect of those services could not be upheld (paragraphs 13 to 20 and 36 of the contested decision). By contrast, it found, as is apparent from paragraphs 21 to 23 of the contested decision, that the other goods and services in Classes 31 and 35 covered by the signs at issue were identical, in particular the services of ‘promoting sports competitions and/or events of others, namely, entertainment in the nature of musical, and theatrical events, educational, cultural, and civic events and exhibitions’ in Class 35 covered by the mark applied for and the ‘advertising’ services covered by the earlier mark. In paragraphs 27 to 29 of the contested decision, the Board of Appeal observed that the signs at issue were visually similar to an above average degree, that they were phonetically identical and that, conceptually, the comparison between them remained neutral. It concluded, in paragraph 35 of the contested decision, that, in view of the identity of the goods and services covered by the signs at issue, the above average visual similarity of those signs, their phonetic identity and the normal distinctiveness of the earlier mark, there was a likelihood of confusion between those signs within the meaning of Article 8(1)(b) of Regulation No 207/2009, even taking into account an above average level of attention on the part of the relevant consumer.

- 15 The Board of Appeal found that a suspension of the appeal proceedings before it was not appropriate. It observed that, pursuant to Rule 20(7)(c) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), in conjunction with Rule 50(1) of Regulation No 2868/95, the decision as to whether or not to suspend the appeal was subject to its discretion (paragraphs 38 and 39 of the contested decision). Furthermore, first, it stated that the application for a declaration of invalidity based on Articles 52(1)(b) and 53(1)(a) of Regulation No 207/2009, in conjunction with Article 8(1)(b), 8(4) and 8(5) thereof, on which the request for suspension of the proceedings was based, had been filed more than one year after the opposition had been filed and after the Opposition Division had adopted its decision and therefore seemed to have the purpose of delaying the closure of the proceedings. Secondly, the Board of Appeal, first of all, stated that it was necessary to determine whether there was a *prima facie* likelihood that the earlier right might be declared invalid and whether such a declaration of invalidity would have an effect on the outcome of the opposition. Next, it stated that the applicant had based the application for a declaration of invalidity on the bad faith of the proprietor of the earlier mark and on a number of unregistered rights. Lastly, it concluded that the applicant had not provided sufficient objective evidence to warrant a suspension (paragraphs 37 to 40 of the contested decision).

### Forms of order sought

- 16 The applicant claims that the Court should:
- annul the contested decision in so far as it relates to the services ‘promoting sports competitions and/or events of others, namely, entertainment in the nature of musical, and theatrical events, educational, cultural, and civic events and exhibitions’ and reject the opposition in so far as it relates to those services;
  - order OHIM to pay the costs;
  - in the alternative, stay the proceedings until the delivery of the final decision on the application for a declaration of invalidity with the filing number 7442 C.
- 17 OHIM contends that the Court should:
- dismiss the action;
  - order the applicant to pay the costs.

### Law

- 18 In support of the action, the applicant relies, in essence, on two pleas in law, alleging, respectively: (i) infringement of Article 8(1)(b) of Regulation No 207/2009; and (ii) infringement of Rule 20(7)(c) of Regulation No 2868/95, read in conjunction with Rule 50(1) of that regulation.
- 19 As the examination of the question of whether to suspend the proceedings before the Board of Appeal must be carried out before the examination of whether there is a likelihood of confusion between the mark applied for and the earlier trade mark for the purposes of Article 8(1)(b) of Regulation No 207/2009, it is appropriate, first of all, to examine the second plea, alleging infringement of Rule 20(7)(c) of Regulation No 2868/95, read in conjunction with Rule 50(1) of that regulation, and, subsequently, the first plea, alleging infringement of Article 8(1)(b) of Regulation No 207/2009 (see, to that effect, judgment of 25 November 2014 in *Royalton Overseas v OHIM — S.C. Romarose Invest (KAISERHOFF)*, T-556/12, EU:T:2014:985, paragraph 52).

*The second plea, alleging infringement of Rule 20(7)(c) of Regulation No 2868/95, read in conjunction with Rule 50(1) of that regulation*

- 20 By the second plea, the applicant submits that the Board of Appeal infringed Rule 20(7)(c) of Regulation No 2868/95, read in conjunction with Rule 50(1) of that regulation. It takes the view that the Board of Appeal should have suspended the appeal proceedings pending the decision on the application filed with OHIM for a declaration that the earlier mark is invalid. In that regard, the applicant states that, since the Board of Appeal found that there was a likelihood of confusion between the signs at issue in respect of goods and services in Classes 31 and 35 covered by those signs and since there is a substantial overlap between the opposition and the application for a declaration of invalidity, there is a likelihood that the earlier mark might be declared invalid. The applicant maintains that, consequently, given that the earlier mark is the only right on which the opposition is based, a declaration that that mark is invalid will render the opposition devoid of any legal basis.
- 21 At the hearing, the parties were asked to present their observations on whether the second plea is inadmissible, on the ground that, if it were upheld, it would lead the Court to rule *ultra petita*.
- 22 In that regard, first, the applicant stated that the second plea was to be regarded as independent in relation to the first plea, which was the only plea that supported its claim for partial annulment of the contested decision. Secondly, it stated that it was immaterial to it whether it obtained a stay of the proceedings before the Court or a suspension of the proceedings before the Board of Appeal and that its request for a stay of the proceedings before the Court was to be interpreted as having been submitted as its principal claim and not in the alternative, as stated in its requested form of order. Lastly, it expressed its interest in the annulment of the contested decision in its entirety.
- 23 OHIM stated, first, that the form of order sought did not include an application for annulment of the contested decision in its entirety and that, consequently, the part of the contested decision that had not been disputed in the context of the first plea had to be regarded as having become final with regard to the applicant. Secondly, it conceded that if the second plea were to be held to be admissible it would result, if it were upheld, in the annulment of the contested decision in its entirety.
- 24 Under Article 21 of the Statute of the Court of Justice of the European Union, applicable to the procedure before the General Court by virtue of the first paragraph of Article 53 thereof, and Article 44 of the Rules of Procedure of the General Court of 2 May 1991, the application initiating proceedings must indicate, inter alia, the subject-matter of the dispute and contain the form of order sought by the applicant. The form of order sought must be set out in a precise and unequivocal manner, since otherwise the Court would risk giving a ruling *infra petita* or *ultra petita* and disregarding the rights of the defendant (order of 13 April 2011 in *Planet v Commission*, T-320/09, ECR, EU:T:2011:172, paragraph 22). Since the European Union Court before which an action for annulment has been brought may not rule *ultra petita*, the scope of the annulment which it pronounces may not go further than that sought by the applicant (see order of 24 May 2011 in *Government of Gibraltar v Commission*, T-176/09, EU:T:2011:239, paragraph 44 and the case-law cited).
- 25 Thus, only the form of order set out in the originating application may be taken into consideration and the substance of the application must be examined solely with reference to the order sought in the application initiating proceedings. Article 48(2) of the Rules of Procedure of 2 May 1991 allows new pleas in law to be introduced on condition that they are based on matters of law or of fact which came to light in the course of the procedure. It is apparent from the case-law that that condition governs *a fortiori* any amendment to the forms of order sought and that, in the absence of matters of law or of fact which came to light in the course of the written procedure, only the order sought in the application may be taken into consideration (see judgment of 26 October 2010 in *Germany v Commission*, T-236/07, ECR, EU:T:2010:451, paragraphs 27 and 28 and the case-law cited).

- 26 In the present case, even if the applicant wished to modify its requested form of order at the hearing and seek, by those means, the annulment of the contested decision in its entirety, such an amendment cannot be allowed in view of the absence of any new matters of law or of fact which came to light in the course of the written procedure.
- 27 Consequently, first, it must be held that, as is apparent from its wording, the only claim for annulment which is set out in the application seeks the partial annulment of the contested decision and is supported by the first plea in law.
- 28 Secondly, as is apparent from paragraph 6 of the contested decision, the Board of Appeal was requested to suspend the ‘appeal proceedings’, that is to say the whole of the applicant’s challenge to the Opposition Division’s decision. The Board of Appeal, in paragraphs 37 to 40 of the contested decision, rejected that request in its entirety.
- 29 However, if, as the applicant submits in the context of its second plea, the Board of Appeal made a manifest error of assessment in refusing to suspend the appeal proceedings before it, all of its assessments on the substance of the appeal, in paragraphs 9 to 36 of the contested decision, would necessarily be called into question. The Board of Appeal could not have examined the appeal and found, in part, in favour of the applicant, in paragraph 36 of the contested decision, in respect of the ‘retail services and on-line store services connected with the sale of ... sports and sporting goods’ in Class 35, if it had, as the applicant requested it to, suspended the appeal proceedings. Furthermore, if the decision refusing to suspend the appeal proceedings were annulled, the Board of Appeal, before which the case would again be brought, would be required to suspend the appeal proceedings and, following the suspension, draw the appropriate conclusions from the invalidity proceedings in respect of the earlier mark, as regards the analysis of the merits of all the arguments which the applicant put forward against the Opposition Division’s decision.
- 30 It follows that the decision refusing to suspend the appeal proceedings is not severable from the other reasons for the contested decision, by which the Board of Appeal ruled on the substance of the appeal. Consequently, if the second plea, alleging that the refusal to suspend the appeal proceedings is unlawful, were upheld, the Court would have to annul the contested decision in its entirety and, consequently, inasmuch as it has been seised only of a claim for partial annulment, to rule *ultra petita*. The second plea must therefore be rejected as inadmissible.
- 31 For the sake of completeness, even if the second plea were admissible, first, it must be borne in mind that the Board of Appeal has a broad discretion to suspend proceedings or not. Rule 20(7)(c) of Regulation No 2868/95, applicable to proceedings before the Board of Appeal in accordance with Rule 50(1) of that regulation, illustrates that broadness of discretion by providing that OHIM may suspend opposition proceedings where a suspension is appropriate under the circumstances. Suspending proceedings thus remains optional for the Board of Appeal, which will do so only if it considers it appropriate. Proceedings before the Board of Appeal are therefore not automatically suspended as a result of a request for suspension made by a party before it (judgment of 16 May 2011 in *Atlas Transport v OHIM — Atlas Air (ATLAS)*, T-145/08, ECR, EU:T:2011:213, paragraph 69, and judgment in *KAISERHOFF*, cited in paragraph 19 above, EU:T:2014:985, paragraph 30; see also, to that effect, judgment of 16 September 2004 in *Metro-Goldwyn-Mayer Lion v OHIM — Moser Grupo Media (Moser Grupo Media)*, T-342/02, ECR, EU:T:2004:268, paragraph 46).
- 32 Secondly, it must be pointed out that the fact that the Board of Appeal has a broad discretion to suspend proceedings before it does not mean that its assessment falls outside the scope of judicial review by the Courts of the European Union. That fact does, however, restrict judicial review on the merits to ascertaining that no manifest error of assessment or misuse of powers has occurred (judgments in *ATLAS*, cited in paragraph 31 above, EU:T:2011:213, paragraph 70, and *KAISERHOFF*, cited in paragraph 19 above, EU:T:2014:985, paragraph 31).

- 33 In that regard, it is apparent from the case-law that, in exercising its discretion with respect to the suspension of proceedings, the Board of Appeal must comply with the general principles governing procedural fairness within a European Union governed by the rule of law. It follows that, in exercising that discretion, the Board of Appeal must take into account not only the interests of the party whose Community trade mark is contested, but also those of the other parties. The decision whether or not to suspend the proceedings must follow upon a weighing of the competing interests (judgments in *ATLAS*, cited in paragraph 31 above, EU:T:2011:213, paragraph 76, and *KAISERHOFF*, cited in paragraph 19 above, EU:T:2014:985, paragraph 33).
- 34 In the present case, as is apparent from paragraph 39 of the contested decision and is not disputed by the applicant, the Board of Appeal carried out, inter alia, a *prima facie* analysis of the likelihood that the application for a declaration of invalidity would succeed. Such an analysis, which resulted in a finding that that likelihood was slight, is part of the broad discretion conferred on the Board of Appeal, as referred to in paragraph 31 above, and is justified by the objective of preventing the instrument of suspension from being used for delaying purposes.
- 35 In that regard, it must be held that, since the likelihood of success of the application for a declaration of invalidity, which it is for the Board of Appeal to determine, is *prima facie* regarded as low, the weighing of the parties' interests necessarily tends in favour of the opponent's legitimate interest in obtaining, without delay, a decision on the opposition.
- 36 It follows that it has not been established, in the present case, that there was any manifest error of assessment as regards the Board of Appeal's decision not to suspend the appeal proceedings before it. Consequently, even if the second plea were admissible, it would have to be rejected as unfounded.

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

- 37 By the first plea, the applicant submits that the services 'promoting sports competitions and/or events of others, namely, entertainment in the nature of musical, and theatrical events, educational, cultural, and civic events and exhibitions' covered by the mark applied for are different from the 'advertising' services covered by the earlier mark. According to the applicant, there are visual differences between the signs at issue because the mark applied for lacks any figurative elements and the text of which it consists is not stylised, whereas the earlier mark is a figurative mark in red and white with a stylised text. Lastly, the applicant takes the view that, having regard to the differences between the services at issue, the differences between the signs at issue and the high level of attention of the relevant consumer, the opposition to registration of its mark should be rejected as far as the abovementioned services are concerned.
- 38 Article 8(1)(b) of Regulation No 207/2009 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if because of its identity with, or similarity to, an earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark.
- 39 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 (judgments of 10 September 2008 in *Boston Scientific v OHIM — Terumo (CAPIO)*, T-325/06, EU:T:2008:338, paragraph 70, and 31 January 2012 in *Cervecería Modelo v OHIM — Plataforma Continental (LA VICTORIA DE MEXICO)*, T-205/10, EU:T:2012:36, paragraph 23; see also, by analogy, judgment of 29 September 1998 in *Canon*, C-39/97, ECR, EU:C:1998:442, paragraph 29).

- 40 Furthermore, the 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 (judgment in *CAPIO*, cited in paragraph 39 above, EU:T:2008:338, paragraph 71; see also, by analogy, judgments of 11 November 1997 in *SABEL*, C-251/95, ECR, EU:C:1997:528, paragraph 22, and *Canon*, cited in paragraph 39 above, EU:C:1998:442, paragraph 16).
- 41 That global assessment implies some interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and that of the goods or services covered. Accordingly, a low degree of similarity between those goods or services may be offset by a high degree of similarity between the marks, and vice versa (judgments of 13 September 2007 in *Il Ponte Finanziaria v OHIM*, C-234/06 P, ECR, EU:C:2007:514, paragraph 48, and 23 October 2002 in *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)*, T-6/01, ECR, EU:T:2002:261, paragraph 25; see also, by analogy, judgment in *Canon*, cited in paragraph 39 above, EU:C:1998:442, paragraph 17).
- 42 Furthermore, the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements. The wording of Article 8(1)(b) of Regulation No 207/2009 ('there exists a likelihood of confusion on the part of the public') shows that the perception of the marks by the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (judgment of 18 September 2012 in *Scandic Distilleries v OHIM — Bürgerbräu, Röhm & Söhne (BÜRGER)*, T-460/11, EU:T:2012:432, paragraph 27; see also, by analogy, judgment in *SABEL*, cited in paragraph 40 above, EU:C:1997:528, paragraph 23).
- 43 According to the case-law, in the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of products or services concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see judgment of 13 February 2007 in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, ECR, EU:T:2007:46, paragraph 42 and the case-law cited).
- 44 It is in the light of the foregoing considerations that the Board of Appeal's assessment of the likelihood of confusion between the signs at issue must be examined.
- 45 As a preliminary point, it is appropriate to confirm the Board of Appeal's finding in paragraph 11 of the contested decision, a finding which has not, moreover, been disputed by the applicant, that, since the earlier mark is a Community trade mark, the relevant territory with regard to which it is necessary to assess whether there is a likelihood of confusion between the signs at issue is the European Union.

#### The relevant public

- 46 It should be borne in mind that the relevant public consists of persons likely to use both the services covered by the earlier mark and those covered by the mark applied for (see, to that effect, judgments of 1 July 2008 in *Apple Computer v OHIM — TKS-Teknosoft (QUARTZ)*, T-328/05, EU:T:2008:238, paragraph 23, and 30 September 2010 in *PVS v OHIM — MeDiTA Medizinische Kurierdienst (medidata)*, T-270/09, EU:T:2010:419, paragraph 28). Furthermore, it is settled case-law that the level of attention of professionals must be regarded as high (judgment of 15 October 2008 in *Air Products and Chemicals v OHIM — Messer Group (Ferromix, Inomix and Alumix)*, T-305/06 to T-307/06, EU:T:2008:444, paragraph 34).

- 47 In the present case, as has been stated by the applicant and by OHIM and as is apparent from paragraphs 11, 33 and 35 of the contested decision, it must be held that, as regards the services in question covered by the signs at issue, the relevant public consists of professionals whose level of attention is high.

#### The comparison of the services

- 48 According to settled case-law, in assessing the similarity of the goods or services at issue, all the relevant factors relating to those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see judgment of 11 July 2007 in *El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, T-443/05, ECR, EU:T:2007:219, paragraph 37 and the case-law cited).
- 49 The applicant states, inter alia, that promoting sports competitions cannot constitute a service associated with an advertising agency and cannot therefore be included among the advertising services provided by that agency, which are covered by the earlier mark.
- 50 In that regard, it must be pointed out that the Board of Appeal correctly found that advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch or sale and that those services have the purpose of reinforcing the client's position on the market in order to enable him to acquire a competitive advantage through publicity. Furthermore, it rightly stated, in paragraph 23 of the contested decision, that the services of 'promoting sports competitions and/or events of others', which mainly consist of managing publicity for those events, are usually offered by advertising agencies and fall within the broad definition of advertising.
- 51 In the light of the foregoing, it must be acknowledged that the services in question covered by the signs at issue are identical.

#### The comparison of the signs

- 52 The comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (see judgments of 12 November 2008 in *Shaker v OHIM — Limiñana y Botella (Limoncello della Costiera Amalfitana shaker)*, T-7/04, ECR, EU:T:2008:481, paragraph 40 and the case-law cited, and *LA VICTORIA DE MEXICO*, cited in paragraph 39 above, EU:T:2012:36, paragraph 37).
- 53 According to the case-law, in assessing the dominant character of one or more given components of a composite trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite mark (judgment in *MATRATZEN*, cited in paragraph 41 above, EU:T:2002:261, paragraph 35). Lastly, where a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, because it will be easier for the average consumer to refer to the goods in question by citing the name rather than describing the figurative element of the

mark (judgment in *LA VICTORIA DE MEXICO*, cited in paragraph 39 above, EU:T:2012:36, paragraph 38; see, also, to that effect, judgment of 18 February 2004 in *Koubi v OHIM — Flabesa (CONFORFLEX)*, T-10/03, ECR, EU:T:2004:46, paragraph 45).

- 54 First, as regards the visual similarity, it must be pointed out that the signs to be compared are, on the one hand, the mark applied for, which is a word mark consisting of one word, 'petco', and, on the other hand, the earlier mark, which is a figurative mark consisting of the element 'petco', written in a stylised manner in white letters on a red oval, and also, below the letter 't' of 'petco', of a red circle within which the word 'petco', in smaller letters which are also white, is written twice, in such a way that the word written horizontally intersects with that written vertically at the level of the letter 't'.
- 55 Both of the signs at issue thus have the word element 'petco' in common.
- 56 The applicant submits that the signs at issue are different visually, inasmuch as the mark applied for does not comprise the red and white colours or the text stylisation of the earlier mark.
- 57 However, as OHIM points out, in essence and rightly, it must be stated that the size of the word element 'petco', the contrast between the white of the letters of which it consists and the red of the oval in which it is written, and the subsidiary nature of the remaining figurative elements make the term 'petco' the dominant and distinctive element of the earlier mark. The remaining figurative elements therefore have to be regarded as ornamental, in particular because the layout of the earlier mark is very similar to that of a label.
- 58 In those circumstances, the Board of Appeal did not err in finding that the signs at issue are visually similar to an above average degree, on the ground that they have the word element 'petco' in common, and that the sole difference is in the figurative elements of the earlier mark, which will, however, in the present case, mainly be perceived as decorative (paragraph 27 of the contested decision). The Board of Appeal was correct in stating that it is apparent from the case-law that, when signs consist of both word and figurative components, the word component usually has a stronger impact on the consumer than the figurative component (judgments in *CONFORFLEX*, cited in paragraph 53 above, EU:T:2004:46, paragraph 45, and *LA VICTORIA DE MEXICO*, cited in paragraph 39 above, EU:T:2012:36, paragraph 38) and that this applies in particular to the earlier mark at issue in the present case.
- 59 Secondly, it is common ground that, having regard to the fact that the figurative elements of the earlier mark will not be pronounced, the signs at issue are phonetically identical.
- 60 Thirdly, as regards the conceptual similarity, the Board of Appeal rightly found, in paragraph 29 of the contested decision, a finding which the applicant has not disputed, that the signs at issue do not have any meaning in the relevant territory and rightly deduced from this that the conceptual comparison does not therefore have any bearing on the present case.
- 61 In that regard, it should, however, be stated that, although the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details, the fact remains that, when perceiving a word sign, the consumer will break it down into word elements which, for him, suggest a concrete meaning or which resemble words known to him (see, to that effect, judgment of 27 February 2008 in *Citigroup v OHIM — Link Interchange Network (WORLDLINK)*, T-325/04, EU:T:2008:51, paragraph 80 and the case-law cited).
- 62 Consequently, as OHIM rightly submits, the word element 'petco' might, with regard to both the earlier mark and the mark applied for, be understood by a section of the English-speaking public as an invented word which refers to the English word 'pet'.

### The likelihood of confusion

- 63 For the purposes of the global assessment of the likelihood of confusion between the signs at issue, it must be borne in mind that, according to the case-law, the point is to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion (judgment of 8 May 2014 in *Bimbo v OHIM*, C-591/12 P, ECR, EU:C:2014:305, paragraph 34), whilst also applying the principle of the interdependence of the factors to be taken into consideration, as mentioned in paragraph 41 above.
- 64 In the present case, in view of the high degree of visual similarity between the signs at issue, their phonetic identity, the normal distinctiveness of the earlier mark and the identity between the services at issue covered by those signs, the Board of Appeal was right to find, in paragraph 35 of the contested decision, that there is a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 207/2009, between the earlier mark and the mark applied for, even though the level of attention of the relevant public is above average.
- 65 The first plea put forward by the applicant must therefore be rejected as unfounded.
- 66 In the light of all of the foregoing considerations, it must be held that it is not necessary to stay the present proceedings, without there being any need to decide upon whether the applicant's request for a stay of the proceedings before the Court, as it is set out in the application, is to be interpreted as an independent head of claim or as a request for a stay of the proceedings pursuant to Article 77 of the Rules of Procedure of 2 May 1991.
- 67 The action must therefore be dismissed in its entirety and there is no need to rule on the admissibility of the applicant's request seeking the rejection of the opposition by the Court (see, to that effect, judgments of 21 January 2015 in *Copernicus-Trademarks v OHIM — Blue Coat Systems (BLUECO)*, T-685/13, EU:T:2015:38, paragraph 57, and 4 February 2015 in *KSR v OHIM — Lampenwelt (Moon)*, T-374/13, EU:T:2015:69, paragraph 55).

### Costs

- 68 Under Article 134(1) 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.
- 69 Since the applicant has been unsuccessful, it must be ordered to bear its own costs and to pay those incurred by OHIM, in accordance with the form of order sought by the latter.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Petco Animal Supplies Stores, Inc. to pay the costs.**

Martins Ribeiro

Gervasoni

Madise

Delivered in open court in Luxembourg on 21 October 2015.

[Signatures]