

JUDGMENT OF THE GENERAL COURT (First Chamber)

30 September 2015 (*)

(Community trade mark — Opposition proceedings — Application for Community figurative mark KAJMAN — Earlier Community figurative mark representing a crocodile — Relative ground for refusal — Likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 207/2009 — Applications for annulment and alteration brought by the intervener — Article 134(3) of the Rules of Procedure of 2 May 1991)

In Case T-364/13,

Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna, established in Chojnice (Poland), represented by K. Grala and B. Szczepaniak, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by P. Geroulakos, and subsequently by D. Gája, acting as Agents,

defendant,

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

Lacoste SA, established in Paris (France), represented by P. Gaultier, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 10 May 2013 (Case R 2466/2010-4), relating to opposition proceedings between Lacoste SA and Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna,

THE GENERAL COURT (First Chamber),

composed of H. Kanninen, President, I. Pelikánová and E. Buttigieg (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 12 July 2013,

having regard to the response of OHIM lodged at the Court Registry on 20 November 2013,

having regard to the response of the intervener lodged at the Court Registry on 18 November 2013,

having regard to the pleading of the applicant lodged at the Court Registry on 27 March 2014,

having regard to the reply lodged at the Court Registry on 9 April 2014,

having regard to the rejoinder of the intervener lodged at the Court Registry on 23 July 2014,

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 General Court of 2 May 1991,

gives the following

Judgment

Background to the dispute

- 1 On 1 February 2007, the applicant, Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna, 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 following figurative sign:
- 3 The goods and services in respect of which registration was sought are in Classes 18, 20, 22, 25 and 36 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, for each of those classes, to the following description:
 - Class 18: ‘Clothing for pets, harnesses for animals, footwear for animals, bands, pocket wallets, purses, handbags — all goods made of leather, imitation leather, waterproof and textile fabrics, game bags, tool bags of leather, traveling bags, bags for shopping, beach bags’;
 - Class 20: ‘Pet cushions, nesting boxes for household pets, beds for animals’;
 - Class 22: ‘Bags of textile for packaging’;
 - Class 25: ‘Footwear (except for orthopaedic footwear), belts (clothing) — all goods made of leather, imitation leather, waterproof and textile fabrics’;
 - Class 36: ‘Renting of flats, rental of offices, real estate appraisal, real estate management’.
- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 7/2008 of 11 February 2008.

- 5 On 6 May 2008, Lacoste SA filed a notice of opposition pursuant to Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) to 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 figurative mark registered on 26 May 2004 under number 2979581 and renewed until 2022, represented below:
- 7 The earlier mark was registered in respect of goods and services falling within, inter alia, Classes 18, 20, 24 and 25 and corresponding, for each of those classes, to the following description:
 - Class 18: ‘Leather and imitations of leather; articles of leather and imitations of leather, namely: luggage (except sacks made of textile materials for packaging and sacks for the transport and warehousing of goods in bulk), travel bags, sports bags (except fitted bags designed to hold particular sporting articles), leather goods, vanity cases (not fitted), toilet bags (empty), hand bags, beach bags, rucksacks, briefcases, satchels, wallets, card cases, purses, coin purses (not of precious metal), pouches designed to be attached to belts, pouches; skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery’;
 - Class 20: ‘Furniture, mirrors, picture frames, works of art of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics’;
 - Class 24: ‘Cushion covers’;
 - Class 25: ‘Clothing, footwear, headgear’.
- 8 In so far as the opposition was based on the earlier mark, the grounds relied on in support of the opposition were those set out in Article 8(1)(b) and Article 8(5) of Regulation No 40/94 (now Article 8(1)(b) and Article 8(5) of Regulation No 207/2009).
- 9 The intervener relied on the reputation of the earlier mark within the European Union for certain goods referred to in paragraph 7 above, and produced a number of documents as proof of that reputation.
- 10 By decision of 20 October 2010, the Opposition Division rejected the opposition. In so far as the opposition was filed on the basis of the ground set out in Article 8(1)(b) of Regulation No 207/2009, it found that the goods and services covered by the marks at issue were either identical or similar, that the conflicting signs were visually and phonetically different, that they had a low conceptual similarity and that the distinctiveness of the earlier mark was at least normal. It also found that the graphic representations of the marks at issue were so different that the conceptual link between the marks was not sufficient to counteract the visual and phonetic differences and, accordingly, concluded that there was no likelihood of confusion between the marks at issue. Finally, it stated that the opposition could not be upheld under Article 8(5) of Regulation No 207/2009, given that the intervener had not provided any facts, arguments or evidence which could support the conclusion that the use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

- 11 On 15 December 2010, the intervener 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.
- 12 By decision of 10 May 2013 ('the contested decision'), the Fourth Board of Appeal of OHIM upheld the appeal in part and annulled the decision of the Opposition Division in so far as it concluded that there was no likelihood of confusion between the marks at issue in respect of the goods in Classes 18 and 25. Contrary to the Opposition Division, the Board of Appeal decided that there was a likelihood of confusion in respect of those goods in view of the conceptual similarity between the conflicting signs arising from the presence of figurative elements with analogous semantic content and of the proven enhanced distinctiveness and reputation of the earlier mark in respect of some of the goods in Classes 18 and 25, despite the fact that the marks at issue were phonetically different and the fact that there was a low degree of visual similarity. However, it dismissed the remainder of the appeal, holding that there was no likelihood of confusion in respect of the goods and services in Classes 20, 22 and 36 given that those goods and services were not similar to the goods in Classes 18 and 25 for which the enhanced distinctiveness and reputation had been established, and that it had not been proven that the use of the mark applied for in respect of those goods and services would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark in respect of the goods in Classes 18 and 25, for the purposes of Article 8(5) of Regulation No 207/2009. It also decided that each party should bear its own costs.

Forms of order sought

- 13 The applicant claims that the Court should:
- annul the contested decision in part in so far as it refused registration of the trade mark applied for in respect of the goods in Classes 18 and 25 and grant the protection of the trade mark applied for in respect of all the goods covered by the application for registration;
 - dismiss the application for annulment and alteration submitted by the intervener;
 - order OHIM to pay the costs, including those relating to the applications for annulment in part and for alteration submitted by the intervener and those incurred in the proceedings before the Board of Appeal.
- 14 OHIM contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.
- 15 The intervener contends that the Court should:
- dismiss the action;
 - annul, in part, and alter the contested decision in so far as it rejects the opposition in relation to the goods in Class 20 covered by the application for registration;

- order the applicant to pay the costs, including those incurred in the administrative proceedings.

The plea put forward by the applicant alleging infringement of Article 8(1)(b) of Regulation No 207/2009

- 16 In support of its action, the applicant relies on a single plea in law, essentially consisting of three complaints, alleging infringement of Article 8(1)(b) of Regulation No 207/2009. It claims that the Board of Appeal was wrong to conclude that there was a likelihood of confusion between the mark applied for and the earlier mark, and committed errors (i) in relation to the definition of the relevant public (ii) in that it concluded that there was a similarity between the conflicting signs, while at same time acknowledging that they were phonetically and visually different, and (iii) due to the fact that it ‘marginalised’ the visual aspect in its global assessment of the likelihood of confusion.
- 17 OHIM and the intervener dispute the applicant’s arguments.
- 18 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.
- 19 According to settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. According to the same case-law, the likelihood of confusion must be assessed globally, according to the relevant public’s perception of the signs and goods or services in question and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services covered (see judgment of 9 July 2003 in *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, ECR, EU:T:2003:199, paragraphs 30 to 33 and the case-law cited).
- 20 For the purposes of applying Article 8(1)(b) of Regulation No 207/2009, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009 in *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, ECR, EU:T:2009:14, paragraph 42 and the case-law cited).

The relevant public

- 21 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 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).

- 22 In the present case, the Board of Appeal stated in paragraphs 14 and 49 of the contested decision that the goods covered by the marks at issue were directed at the general public in all Member States of the European Union, which, having regard to the nature of those goods, had an average level of attention. Referring to the case-law, according to which only the group of goods or services protected by the marks must be taken into account, and not the goods or services actually marketed under those marks or the circumstances under which these goods and services are marketed, it also rejected the applicant's argument that the relevant public's level of attention should be regarded as being higher due to the fact that the goods covered by the earlier mark are expensive, high-class goods.
- 23 The applicant disputes that interpretation of the Board of Appeal, claiming that the case-law which it relied on lacked relevance. The applicant reiterates before the Court the argument it made to the Board of Appeal that consumers of the goods covered by the earlier trade mark, which are expensive, high-class goods, pay particular attention by purchasing them 'with extreme caution' in view also of the reputation of the earlier mark, the consumer's intention to avoid counterfeit goods and the manner in which the goods are marketed under the earlier mark, mainly in Lacoste's retail stores (salesrooms). Furthermore, the applicant claims 'incidentally' that the goods covered by the earlier mark are not purchased every day, and that each purchase is preceded by 'at least a very short analysis'.
- 24 OHIM and the intervener dispute the applicant's arguments.
- 25 In that regard, it should be pointed out that the rights conferred or capable of being conferred by the marks at issue extend to each category of goods or services in respect of which those marks are protected or to each category of goods covered by the application for registration. The commercial choices made or which may be made by the proprietors of the marks at issue are factors which must be distinguished from the rights derived from those marks and may change, since they depend solely on the will of the proprietors of those marks. So long as the list of the goods covered by the marks at issue has not been amended, such factors cannot affect the relevant public to be taken into account when assessing whether there is a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009 (see, to that effect, judgment of 3 September 2010 in *Companhia Muller de Bebidas v OHIM — Missiato Industria e Comercio (61 A NOSSA ALEGRIA)*, T-472/08, ECR, EU:T:2010:347, paragraph 38).
- 26 In the present case, although they are not purchased every day, the goods covered by the earlier mark in Classes 18 and 25 are consumer goods and are directed at a wider public. For such goods, which are not aimed at a specialist public, the consumer's level of attention is therefore average (judgments of 25 May 2012 in *Nike International v OHIM — Intermar Simanto Nahmias (JUMPMAN)*, T-233/10, EU:T:2012:267, paragraph 22, and 18 September 2014 in *El Corte Inglés v OHIM — Gaffashion (BAUSS)*, T-267/13, EU:T:2014:780, paragraph 28). Although it may be accepted that the average consumer pays some attention to the quality and price of those goods when buying them, nothing in the description of the goods as covered by the earlier mark indicates that they are expensive, high-class goods, so that the relevant public would be likely to be particularly attentive with regard to them. In the absence of any specific information to the contrary, they may come within any range and are not necessarily expensive or luxury items (see, to that effect and by analogy, judgments of 29 September 2009 in *The Smiley Company v OHIM (Representation of half a smiley face)*, T-139/08, ECR, EU:T:2009:364, paragraph 19, and 7 December 2011 in *El Corte Inglés v OHIM — Azzedine Alaïa (ALIA)*, T-152/10, EU:T:2011:715, paragraph 20).

27 The Court cannot accept the applicant's argument that the goods covered by the earlier mark are sold mainly in 'Lacoste's retail stores' to demonstrate that the level of attention of a consumer of the goods covered by the earlier mark is high. By that argument, the applicant makes reference to the particular marketing strategies for the goods in question and not the 'normal' marketing strategies with respect to the category of goods covered. Even though the objective marketing strategies for the goods covered by the marks at issue must be taken into account when assessing the likelihood of confusion (see paragraph 70 below), that is not the case with regard to the particular marketing strategies for those goods, which may vary over time and depend on the wishes of the proprietors of those marks. An analysis of whether there will be a likelihood of confusion between two marks cannot be dependent on the marketing intentions of the proprietors of the marks, whether implemented or not, which are by their very nature subjective (judgments of 15 March 2007 in *T.I.M.E. ART v OHIM*, C-171/06 P, EU:C:2007:171, paragraph 59, and 9 September 2008 in *Honda Motor Europe v OHIM — Seat (MAGIC SEAT)*, T-363/06, ECR, EU:T:2008:319, paragraph 63).

28 It follows that the Board of Appeal was right to take the view that the likelihood of confusion had to be analysed with reference to consumers who are members of the general public with an average level of attention.

The comparison of the goods

29 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).

30 In the present case, the Board of Appeal, like the Opposition Division, found that the goods in Classes 18 and 25 covered by the mark applied for and the goods in the same classes covered by the earlier mark were either identical or similar. That conclusion of the Board of Appeal, which, moreover, is not disputed by the applicant, must be upheld.

The comparison of the signs

31 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 perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (see judgment of 12 June 2007 in *OHIM v Shaker*, C-334/05 P, ECR, EU:C:2007:333, paragraph 35 and the case-law cited).

32 According to settled case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (judgments of 23 October 2002 in *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)*, T-6/01, ECR, EU:T:2002:261, paragraph 30, and 26 January 2006 in *Volkswagen v OHIM — Nacional Motor (Variant)*, T-317/03, EU:T:2006:27, paragraph 46).

- 33 In the present case, the signs to be compared are, first, the mark applied for, which is a composite mark consisting of a stylised representation in colour of a crocodilian lying down with its tail curved downwards on the left-hand side and its head pointing to the right. The animal's torso is made up of the letters of the word element 'kajman' in printed characters. The earlier figurative mark consists of a representation in black and white of a crocodile with its tail raised on the left-hand side, while the animal's head is pointed to the right with its muzzle open.
- The visual similarity
- 34 The Board of Appeal stated in paragraph 29 of the contested decision that visually the marks at issue were the same in that they both represented a crocodile. However, in view of the fact that the manner in which that animal is represented in each mark varied in different aspects, it concluded that the signs had a low visual similarity.
- 35 Whilst accepting that the marks at issue have in common a representation of an animal of the order of crocodilians, the applicant claims that they are not visually similar, given that those representations are very different. The applicant states that the earlier mark represents an attacking, aggressive crocodile, with its muzzle open, while the mark applied for consists of the word 'kajman' in printed characters, stylised to form a sleeping reptile, with the mark's overall appearance suggesting a technical object rather than an animal, given the geometrical forms and regular straight lines which, as a rule, do not exist in the animal world. It also states that the earlier mark is registered in black and white, while the mark applied for uses the colour blue, 'determined ... as green'. In addition, it claims that the earlier mark is used in trade with the image of a crocodile in green with a visible red tongue against a white background around the crocodile, and that that image is preserved in the memory of the consumers.
- 36 OHIM and the intervener dispute the applicant's arguments.
- 37 It must be observed, as the Board of Appeal did, that visually the marks at issue have in common a representation of a reptile of the order of crocodilians.
- 38 It is true, as the applicant claims, that in the mark applied for the reptile is represented in a stylised manner in a sleeping position, with the torso made up of the letters of the word 'kajman', while in the earlier mark there is a rather realistic representation of a crocodile in an aggressive position standing on its feet. However, given that the average consumer must, as a general rule, place his trust in the imperfect picture of the marks that he has kept in his mind (judgment of 22 June 1999 in *Lloyd Schuhfabrik Meyer*, C-342/97, ECR, EU:C:1999:323, paragraph 26), the visual perception of the marks at issue will not be sufficiently affected by those visual differences. Contrary to what the applicant claims, in both cases the general public will clearly recognise and retain a memory of the representation of a reptile of the order of crocodilians, presented in profile with a curved tail (see, by analogy, judgment of 17 April 2008 in *Dainichiseika Colour & Chemicals Mfg. v OHIM — Pelikan (Representation of a pelican)*, T-389/03, EU:T:2008:114, paragraphs 80 and 82).
- 39 The presence of the verbal element 'kajman' in the composition of the mark applied for does not, moreover, neutralise the existence of a certain visual similarity between the signs at issue in that it is possible that a consumer will not perceive it separately, but as an integral part of the figurative aspect of the mark. The applicant itself accepts, in essence, that that element is

incorporated in the image of a crocodile forming the central part of its body (see paragraph 35 above).

- 40 Finally, the fact that the applicant claims a colour for the mark applied for, while the earlier mark is registered in black and white, could diminish the visual similarity between the signs at issue but does not eliminate it completely. The presence of a colour in the mark applied for essentially loses any significance when making the comparison with the earlier mark, because the earlier mark is a black-and-white image. Thus, confronted with the mark applied for, the average consumer, who keeps in mind only an imperfect picture of the marks (see paragraph 38 above), might reasonably think that it is only the colour version of the earlier mark (judgment of 14 December 2006 in *Mast-Jägermeister v OHIM — Licorera Zacapaneca (VENADO with frame and others)*, T-81/03, T-82/03 and T-103/03, ECR, EU:T:2006:397, paragraph 104).
- 41 Moreover, the applicant's argument that, in trade, the intervener uses the image of a green crocodile with a visible red tongue against a white background must be rejected as irrelevant, since it effectively makes a comparison between the mark applied for and a sign other than the mark on which the opposition was based.
- 42 It follows that the Board of Appeal was correct in finding that, bearing in mind that the signs vary in different aspects of the representation of a crocodile, there was a low degree of visual similarity between the signs at issue.
- The phonetic similarity
- 43 In view of the fact that the earlier mark does not contain any verbal element and that its figurative element cannot be pronounced, the Board of Appeal took the view, in paragraph 30 of the contested decision, that the signs at issue were not phonetically similar. That assessment is not disputed by the applicant.
- 44 By contrast, the intervener contends that, where a consumer sees the representation of an object or an animal, he inevitably retains that image in the form of a word. The intervener concludes from this that in the present case the marks at issue are phonetically similar, since they are described by the consumer in very similar, if not identical, terms.
- 45 In that regard, it must be pointed out, as the applicant rightly does, that a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, judgment of 25 March 2010 in *Nestlé v OHIM — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)*, T-5/08 to T-7/08, ECR, EU:T:2010:123, paragraph 67). A figurative mark lacking word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Accordingly, there is no need to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks (judgment of 7 February 2012 in *Dosenbach-Ochsner v OHIM — Sisma (Representation of elephants in a rectangle)*, T-424/10, ECR, EU:T:2012:58, paragraph 46).
- 46 It follows, in the present case, that it cannot be concluded that there is either a phonetic similarity or a phonetic dissimilarity between the marks at issue given that the earlier mark is a figurative mark lacking word elements.

– The conceptual similarity

- 47 It is apparent from paragraph 31 of the contested decision that the Board of Appeal took the view that, since the marks at issue are perceived as representing an animal of the order of crocodylians, they had an analogous semantic content and were thus conceptually similar. That similarity, according to the Board of Appeal, is strengthened by the presence of the word ‘kajman’ in the mark applied for, which is very close to the English word ‘caiman’, the French word ‘caïman’, the German word ‘kaiman’, the Spanish word ‘caimán’ and the Italian word ‘caimano’. In combination with the figurative aspect of the mark applied for, the verbal element ‘kajman’ underlines the perception of that mark as an animal, more specifically as a caiman which belongs, together with crocodiles and alligators, to the order of crocodylians. The Board of Appeal did not define the level of conceptual similarity between the signs at issue.
- 48 In that regard, it must be pointed out, as the Board of Appeal did, that the signs at issue are conceptually similar, in that their component figurative elements refer to the idea of a reptile of the order of crocodylians. Furthermore, as regards the mark applied for, the verbal element ‘kajman’, which means ‘caiman’ *inter alia* in Polish, Czech, and Slovakian, as the intervener rightly points out, and which is sufficiently close to its linguistic versions in the languages of various other Member States, as the Board of Appeal rightly pointed out (see paragraph 47 above), will be understood by the relevant public, at least in those Member States, as a direct reference to its figurative element. Each of those two elements, appearing side by side, reinforces the other, so that consumers more easily understand one because of the other (see, to that effect and by analogy, judgment in *Representation of a pelican*, cited in paragraph 38 above, EU:T:2008:114, paragraph 91).
- 49 That assessment, moreover, is not disputed by the applicant who accepts that part of the relevant public may recognise an animal of the order of crocodylians in the representations of the two marks at issue, which could thus indicate a certain conceptual similarity.
- 50 The applicant claims, however, that there is only a low degree of conceptual similarity, in that the signs at issue convey to the relevant public the same conceptual content but in a very remote manner, given that the earlier mark suggests an aggressive animal in an attack position, while the mark applied for conveys the idea of a sleeping reptile, using ‘means of expression ... from the world of mechanics’. The applicant adds that, due to certain specific characteristics of the representation of the animal appearing in the mark applied for, the relevant consumer may consider it to be a reptile other than a crocodile, belonging, for example to the order of Squamata.
- 51 OHIM and the intervener dispute the applicant’s arguments.
- 52 That argument of the applicant cannot be accepted. Given that the average consumer must, as a general rule, place his trust in the imperfect picture of the marks that he has kept in his mind, as is apparent from the case-law set out in paragraph 38 above, the conceptual perception of the contested mark will not be affected by the differences in the representation of the reptiles in the two marks at issue (see, to that effect and by analogy, judgment in *Representation of elephants in a rectangle*, cited in paragraph 45 above, EU:T:2012:58, paragraph 50). Furthermore, contrary to what the applicant claimed at the reply stage, the presence of the verbal element ‘kajman’ in the mark applied for makes it unlikely that the consumer will perceive the figurative aspect of that mark as referring to a reptile of the order of Squamata rather than of the order of crocodylians, given that caimans, to which the verbal

element of the mark applied for refers, belong to the latter order. In any event, it must be observed that a consumer of the goods covered by the marks at issue is an average consumer, who is reasonably well informed and reasonably observant and circumspect, and who would not be able to identify clearly the order to which each of the reptiles represented in the two marks belongs, but will most likely think that they both represent a crocodile.

- 53 Accordingly, it must be concluded that the relevant public will perceive the contested marks as referring, on a conceptual level, simply to reptiles of the order of crocodylians, if not just crocodiles, irrespective of the specific characteristics of those representations. Therefore, the Board of Appeal was correct in finding that the signs at issue were similar on a conceptual level. Furthermore, bearing in mind what has been stated in paragraph 52 above, that similarity must be regarded as being at least average and not low, contrary to what the applicant claims.

The enhanced distinctiveness of the earlier mark

- 54 As is apparent from recital 8 in the preamble to Regulation No 207/2009, the assessment of the likelihood of confusion depends on numerous elements, in particular the public's recognition of the trade mark on the market in question. The more distinctive the trade mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character, either per se or because of their recognition by the public, enjoy broader protection than marks with less distinctive character (see, by analogy, judgments of 11 November 1997 in *SABEL*, C-251/95, ECR, EU:C:1997:528, paragraph 24; 29 September 1998 in *Canon*, C-39/97, ECR, EU:C:1998:442, paragraph 18; and in *Lloyd Schuhfabrik Meyer*, cited in paragraph 38 above, EU:C:1999:323, paragraph 20).

- 55 The acquisition of distinctive character through use of a mark requires that at least a significant proportion of the relevant public identifies the goods or services concerned as originating from a particular undertaking because of the mark, and thus distinguishes those goods or services from those of other undertakings (see judgment of 21 April 2005 in *Ampafrance v OHIM — Johnson & Johnson (monBeBé)*, T-164/03, ECR, EU:T:2005:140, paragraph 71 and the case-law cited).

- 56 In the present case, after analysing the information submitted by the intervener as evidence of the repute of the earlier mark, the Board of Appeal concluded, in paragraph 44 of the contested judgment, that that mark had acquired through use a highly distinctive character for leather goods, in particular bags, in Class 18, and for clothing and footwear in Class 25.

- 57 That conclusion of the Board of Appeal, which moreover is not disputed by the applicant, must be endorsed. Furthermore, it must be observed that the applicant itself refers on a number of occasions to the highly distinctive character of the earlier mark, acquired through usage, in particular by stating that that element must be taken into account in the global assessment of the likelihood of confusion (see paragraph 62 below).

The likelihood of confusion

- 58 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 that of the goods or services concerned. Accordingly, a low degree of similarity between the goods or services may be offset by a high degree of similarity between the marks, and vice

versa (judgments in *Canon*, cited in paragraph 54 above, EU:C:1998:442, paragraph 17, and *VENADO with frame and others*, cited in paragraph 40 above, EU:T:2006:397, paragraph 74).

59 Moreover, as is clear from the settled case-law referred to in paragraph 54 above, the more distinctive the earlier trade mark, the greater the likelihood of confusion will be.

60 In the present case, the Board of Appeal stated, in paragraph 51 of the contested decision, that there was a likelihood of confusion between the marks at issue due to the conceptual similarity between the signs, coupled with the highly distinctive character of the earlier mark for certain goods in Classes 18 and 25, similar or identical to the goods in the same classes covered by the mark applied for.

61 The applicant disputes the Board of Appeal's assessment. It maintains, as did the Opposition Division, that the graphic representation of the reptiles in the marks at issue is so different that a conceptual link between the marks is not sufficient to counteract the visual and aural differences. Since the goods covered by the earlier mark are usually sold in self-service stores, where consumers choose the products themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual aspect of the comparison of the signs at issue, according to the applicant, is of utmost importance. In the present case the Board of Appeal failed to take into account the fact that the signs at issue are not 'as a general rule' visually similar. The applicant therefore criticises the Board of Appeal for not giving sufficient weight to the visual aspect of the signs by ignoring the principle of the global assessment of the likelihood of confusion on all three levels, including for marks which have a strong distinctive character, thereby creating an unlimited monopoly in favour of the intervener for a sign representing an animal of the order of crocodylians.

62 In addition, the applicant claims that the Board of Appeal also failed to take into account in its global assessment of the likelihood of confusion the allegedly higher than average level of attention of the relevant public, in particular with regard to the highly distinctive character of the earlier mark and the presence on the market of counterfeit goods bearing the earlier mark.

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

64 Bearing in mind the principle of the interdependence of the factors to be taken into account, recalled in paragraphs 58 and 59 above, it must be concluded, as did the Board of Appeal, that in the present case there is a likelihood that the public for which the goods in Classes 18 and 25 are intended may believe that those goods come from the same undertaking or from economically-linked undertakings.

65 That conclusion cannot be called into question by the arguments put forward by the applicant.

66 In the first place, it has already been established that the Board of Appeal did not err in concluding that there was a low degree of visual similarity (see paragraph 42 above) or that the conceptual similarity could not be described as low (see paragraph 53 above). It has also been noted that the phonetic comparison was not relevant in the present case (see paragraph 46 above). The applicant is therefore wrong to claim that the signs at issue are visually and phonetically dissimilar and conceptually similar, but only to a low degree.

67 In the second place, with regard to the argument that the Board of Appeal erred in its global assessment of the likelihood of confusion on all three levels, it must be observed that it is not

impossible that the similarity between the marks, even on only one level, specifically the conceptual similarity resulting from the fact that two marks use images with analogous semantic content, may give rise to a likelihood of confusion for identical or similar goods or services where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public (judgments in *SABEL*, cited in paragraph 54 above, EU:C:1997:528, paragraph 24, and *Lloyd Schuhfabrik Meyer*, cited in paragraph 38 above, EU:C:1999:323, paragraph 28; see also judgment of 16 September 2013 in *Golden Balls v OHIM — Intra-Press (GOLDEN BALLS)*, T-448/11, EU:T:2013:456, paragraph 53 and the case-law cited).

- 68 In the present case, the marks at issue have a low degree of visual similarity and a conceptual similarity that is at least average, and the earlier mark has a highly distinctive character acquired through use for leather goods, in particular bags, in Class 18, and for clothing and footwear in Class 25, as is clear from paragraph 56 above, something which the applicant has also asserted on a number of occasions. Furthermore, it must also be pointed out that, in accordance with the case-law set out in paragraph 59 above, the more distinctive the earlier mark, the greater the likelihood of confusion will be, and that that is not diminished, as the applicant appears to maintain, as a result of the consumer paying particular attention to a known mark.
- 69 It follows that, in view of the fact that the visual comparison is only one of the elements to be taken into consideration when making the global assessment of the likelihood of confusion, and bearing in mind the case-law cited in paragraph 67 above, the Board of Appeal did not err in law in concluding that there is a likelihood of confusion between the marks at issue given the conceptual similarity between the signs, coupled with the highly distinctive character of the earlier mark for leather goods, in particular bags, in Class 18, and for clothing and footwear in Class 25, and with the similarity or identity of the goods in Classes 18 and 25, irrespective of the visual differences in the signs at issue.
- 70 In the third place, with regard to the importance to be attached in the present case to the visual aspect of the comparison between the signs at issue, having regard to the nature of the goods, the applicant is right in stating that in the global assessment of the likelihood of confusion, the visual, phonetic and conceptual aspects of the signs at issue do not always have the same weight and that it is important to analyse the objective conditions in which the marks may be presented on the market. The extent of the similarity or difference between the signs at issue may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the marks at issue are usually sold in stores where consumers choose the product themselves and must therefore rely primarily on the image of the mark applied to the product, which is the case for the goods referred to in the present case in Classes 18 and 25, the visual similarity between the signs will, as a general rule, be more important (judgment of 6 October 2004 in *New Look v OHIM — Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection)*, T-117/03 to T-119/03 and T-171/03, ECR, EU:T:2004:293, paragraph 49).
- 71 However, the conditions under which the goods are marketed, and consequently the importance of similarity between the signs at issue, which is tied in with the nature of the goods, are only one of the elements to be taken into consideration when carrying out the global assessment of the likelihood of confusion on the part of the relevant public. Consequently, the likelihood of confusion between the marks at issue is not precluded even if it is conceded that the visual aspect is particularly important in a case such as the present in which the goods are sold mainly in stores where consumers choose the product themselves. It

is not impossible that the representation of a caiman in the mark applied for may be perceived as a variant of the representation of a crocodile in the earlier mark, the latter being widely known among the relevant public, as is clear from paragraphs 36 to 43 of the contested decision, a fact which, moreover, is not disputed by the applicant.

72 Finally, the applicant's argument that, if it were not annulled, the Board of Appeal's decision would amount to granting the intervener an unjustified monopoly of the representation of a reptile of the order of crocodylans, regardless of its degree of artistic stylisation, must also be rejected. It must be observed in that respect that the Board of Appeal was entirely correct in stating, in paragraph 50 of the contested decision, that the representation of a crocodile has normal inherent distinctiveness (see paragraph 88 below) and that the earlier mark acquired by use an enhanced distinctive character for leather goods, in particular bags, in Class 18, and for clothing and footwear in Class 25. Such a representation must be regarded as arbitrary for the goods in question and deserves to be protected against subsequent applications depicting confusingly similar devices. Indeed, the advantage of the legal regime of the Community trade mark lies precisely in the fact that it enables holders of an earlier trade mark to oppose the registration of later marks which take unfair advantage of the distinctive character or the repute of the earlier trade mark. Hence, far from according an unfair and unjustifiable monopoly to the proprietors of an earlier mark, that regime enables those proprietors to protect and exploit the substantial investment made to promote their earlier mark (see, to that effect and by analogy, judgment of 21 February 2006 in *Royal County of Berkshire Polo Club v OHIM — Polo/Lauren (ROYAL COUNTY OF BERKSHIRE POLO CLUB)*, T-214/04, ECR, EU:T:2006:58, paragraph 43).

73 Given that the applicant's complaints have been rejected, its argument that there is no likelihood of confusion between the marks at issue on the part of the relevant public must be rejected.

74 Consequently, the single plea in law must be rejected and therefore the action dismissed in its entirety.

The plea put forward by the intervener alleging infringement of Article 8(1)(b) of Regulation No 207/2009

75 The intervener requests the Court to annul in part the contested decision in so far as the Board of Appeal rejected the opposition against registration of the mark applied for in respect of the goods in Class 20 without acknowledging the enhanced distinctiveness and reputation of the earlier mark for goods in the same class covered by that mark. It further requests the Court to alter the contested decision by also rejecting the application for registration in respect of the goods in Class 20.

76 In submitting those applications, the intervener makes use of the opportunity afforded to it by Article 134(3) of the Rules of Procedure of 2 May 1991 to seek, in its response, a form of order annulling or altering the contested decision on a point not raised in the application (see, to that effect, judgments in *ROYAL COUNTY OF BERKSHIRE POLO CLUB*, cited in paragraph 72 above, EU:T:2006:58, paragraph 50, and of 24 September 2008 in *Oakley v OHIM — Venticinque (O STORE)*, T-116/06, ECR, EU:T:2008:399, paragraph 81). The applicant expressed its position on those applications in its pleading of 27 March 2014 and asked the Court to dismiss the intervener's applications as inadmissible or as unfounded. OHIM has not made use of the opportunity to present observations under Article 135(3) of the Rules of Procedure of 2 May 1991.

- 77 First, the intervener refers to an alleged ‘blatantly ... factual drafting error’ in the contested decision in that the Board of Appeal, on the one hand, concluded that the goods in Class 20 covered by the marks at issue were similar, and on the other, ruled out the existence of any such similarity.
- 78 However, contrary to what the intervener submits, no inconsistency in the Board of Appeal’s reasoning or its finding on that point is apparent from the contested decision. In paragraphs 20 and 52 of the contested decision, the Board of Appeal confirmed the finding of the Opposition Division that the goods in Class 20 covered by the mark applied for were identical to the ‘furniture’ covered by the earlier mark from the same class. By contrast, in paragraph 52 of the contested decision, the Board of Appeal stated that the goods in Class 20, covered by the mark applied for, and the goods in Classes 18 and 25, for which the earlier mark’s highly distinctive character had been claimed and proved, were neither identical nor similar. That complaint on the part of the intervener must therefore be rejected as unfounded.
- 79 Secondly, the intervener claims that the Board of Appeal did not acknowledge the enhanced distinctiveness of the earlier trade mark for goods in Class 20, even though it also submitted to the Board of Appeal evidence of the reputation of the earlier mark for ‘household linen’ falling within Class 20, and more particularly ‘furniture’ in so far as that category of goods also includes ‘beds and bedding’. It claims that, contrary to what the applicant submits (see paragraph 80 below), it had also claimed the earlier mark’s enhanced distinctiveness for goods in Class 20 by stating, in the procedure before the Board of Appeal, that the earlier mark had acquired that enhanced distinctiveness ‘notably’ for goods in Classes 18 and 25.
- 80 The applicant disputes the intervener’s arguments. It submits that the complaint concerning the allegedly enhanced distinctiveness of the earlier mark for goods in Class 20 was out of time, in that the intervener did not claim such enhanced distinctiveness during the administrative procedure. The documents produced by the intervener at that procedure relating to the reputation of the earlier mark are, in any event, not such as to establish its enhanced distinctiveness for goods in Class 20.
- 81 In that regard, it must be pointed out that, contrary to what the intervener claims, ‘household linen’ does not belong to Class 20. Although ‘beds’ are included in the broad product group ‘furniture’, in Class 20, and although it is also true that ‘bedding’ belongs to that class, it is clear from the Explanatory Note to the Nice Agreement that ‘bedding linen’ is expressly excluded from Class 20, as is stated in that Explanatory Note. As it is, ‘household linen’, including ‘bedding linen’, falls within Class 24.
- 82 The intervener does not claim that the earlier mark acquired the enhanced distinctiveness or reputation for goods in Class 24 for which it is registered, nor, in any event, does it claim that the Board of Appeal should have found a similarity between those goods in Class 24 covered by the earlier mark and the goods in Class 20 covered by the mark applied for.
- 83 It follows that, even if the intervener presented to the Board of Appeal evidence concerning the reputation of the earlier mark for ‘household linen’, it could not reasonably claim that the Board of Appeal was therefore wrong in failing to acknowledge the enhanced distinctiveness of the earlier mark for goods in Class 20, and more particularly for ‘furniture’, or that the likelihood of confusion would have been acknowledged in that respect with regard to goods in Class 20 covered by the application for registration. That complaint on the part of the intervener must also be rejected.

- 84 Thirdly, in its rejoinder the intervener argues that, not only the enhanced distinctiveness and reputation of the earlier mark but also its high degree of inherent distinctiveness with regard to the goods in Class 20 should have been taken into account by the Board of Appeal in order to conclude that there is a likelihood of confusion between the marks at issue for goods in that class covered by the mark applied for.
- 85 In that regard, it must be observed that the Board of Appeal found, in paragraph 50 of the contested decision, that the earlier mark's inherent distinctiveness was normal. The intervener did not dispute that finding of the Board of Appeal in its response, but raised the issue for the sake of completeness for the first time in its rejoinder in reply to the applicant's argument that the intervener's claims relating to the enhanced distinctiveness of the earlier mark for goods in Class 20 were inadmissible, because they had been submitted for the first time before the Court.
- 86 That complaint on the part of the intervener relating to the high degree of inherent distinctiveness is new. Article 84(1) of the Rules of Procedure provides that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or fact which have come to light in the course of the procedure. However, a plea which constitutes an amplification of a plea previously made, either expressly or by implication, in the original application and is closely linked to it must be declared admissible (order of 24 September 2009 in *Alcon v OHIM*, C-481/08 P, EU:C:2009:579, paragraph 17). The same applies to a submission made in support of a plea in law (judgment of 21 March 2002 in *Joynton v Commission*, T-231/99, ECR, EU:T:2002:84, paragraph 156).
- 87 The intervener's complaint is not based on matters which came to light during the proceedings before the Court. Nor does it constitute an amplification of a plea previously made in the response, given that it is based on a ground of illegality different from that raised in the response, which was based on the allegedly high degree of distinctiveness of the earlier mark for goods in Class 20, and more particularly for 'furniture', as a result of its reputation. It follows that the intervener's complaint relating to an allegedly high degree of inherent distinctiveness is out of time and must be rejected as inadmissible.
- 88 In any event, the Board of Appeal's finding that the earlier mark's inherent distinctiveness is higher than normal with regard to goods in Class 20 must be upheld, given that the image of a crocodile has no relevance to the goods and services concerned. The intervener has not put forward any argument capable of undermining that conclusion.
- 89 It follows from the foregoing that the single plea in law put forward by the intervener in support of its applications for annulment in part and alteration of the contested decision must be rejected without it being necessary to rule on the admissibility of those applications which was disputed by the applicant (see paragraph 80 above).
- 90 Therefore, both the action and the applications submitted by the intervener under Article 134(3) of the Rules of Procedure of 2 May 1991 must be dismissed in their entirety.

Costs

- 91 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. Furthermore, under Article 134(3) of the Rules of Procedure, the parties are to bear their own costs where each

party succeeds on some and fails on other heads. However, if it appears justified in the circumstances of the case, the Court may order that one party, in addition to bearing its own costs, pay a proportion of the costs of the other party.

- 92 In the present case, the applicant applied for OHIM to be ordered to pay the costs, including the costs relating to the applications for annulment in part and alteration submitted by the intervener. OHIM and the intervener contended that the applicant should be ordered to pay the costs. The applications of the applicant and the intervener refer, not only to the costs of the proceedings before the Court, but also to those incurred before OHIM.
- 93 In that respect, as a preliminary point, since the applications for annulment and alteration of the contested decision submitted by the applicant and the intervener have been dismissed, their applications relating to the allocation of the costs incurred before OHIM must also be dismissed.
- 94 With regard to the proceedings before the Court, in view of the fact that the applicant and the intervener have been unsuccessful in respect of certain heads of claim, it must be ordered, first, that the applicant is to bear its own costs and pay those incurred by OHIM and by the intervener in connection with its action, in accordance with the forms order sought by OHIM and the intervener, and secondly that, since the intervener has been unsuccessful in its claims for annulment in part and alteration, it is to bear its own costs in connection with those applications.
- 95 Furthermore, since the intervener's claims for annulment in part and alteration do not result in OHIM being unsuccessful in respect of any of its heads of claim, the applicant's application for OHIM to be ordered to pay the costs incurred by the applicant in connection with those claims must be dismissed. Accordingly, it must be ordered that the costs in question are to be borne by the applicant.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Dismisses the applications for annulment and alteration submitted by Lacoste SA;**
- 3. Orders Eugenia Mocek, Jadwiga Wenta KAJMAN Firma Handlowo-Uslugowo-Produkcyjna to pay all the costs relating to the action and to bear its own costs relating to the applications of Lacoste SA for annulment and alteration;**
- 4. Orders Lacoste SA to bear its own costs relating to its applications for annulment and alteration.**

Kanninen

Pelikánová

Buttigieg

Delivered in open court in Luxembourg on 30 September 2015.

[Signatures]

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