

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

8 July 2004^{*}

In Case T-203/02,

The Sunrider Corp., established in Torrance, California (United States),
represented by A. Kockläuner, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by S. Laitinen, acting as Agent,

defendant,

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

Juan Espadafor Caba, resident in Granada (Spain),

ACTION brought against the decision of the First Board of Appeal of OHIM of 8 April 2002 (Case R 1046/2000-1), relating to opposition proceedings between Juan Espadafor Caba and The Sunrider Corp.,

* Language of the case: English.

THE COURT OF FIRST INSTANCE OF THE EUROPEAN COMMUNITIES
(Second Chamber),

composed of: J. Pirrung, President, A.W.H. Meij and N.J. Forwood, Judges,
Registrar : M. J. Plingers, Administrator,

having regard to the application and reply lodged at the Court Registry on 2 July 2002 and 27 March 2003,

having regard to OHIM's response and the rejoinder lodged at the Court Registry on 23 October 2002 and 23 June 2003,

following the hearing on 3 December 2003,

gives the following

Judgment

Facts

- 1 On 1 April 1996, the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade marks and Designs) ('OHIM') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The mark for which registration was sought is the word mark VITAFRUIT.
- 3 The products in respect of which registration of the trade mark was sought are in classes 5, 29 and 32 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, after subsequent amendments to the application for a trade mark by letters from the applicant of 30 July and 14 December 1998, for each class respectively to the following description:
- Class 5: ‘Medicaments, pharmaceutical and chemical preparations for hygiene; dietetic substances and nutritional replacement adapted for medical use; food for babies; preparations on the basis of vitamins, trace elements and/or minerals for dietetic purposes or as nutritional supplementation; nutritional concentrates or nutritional supplements on the basis of herbs, herbal teas, all for health care purposes’;

 - Class 29: ‘Meat, fish, non-living mollusc and crustacean, poultry and game; meats and sausages, seafood, poultry and game, also preserved or deep-frozen; fruits and vegetable (including mushrooms and potatoes, especially french fries and other potato products) preserved, deep-frozen, dried, boiled or prepared for immediate consumption; soups or soup preserves; delicatessen salads; dishes of meat, fish, poultry, game and vegetable, also deep-frozen; eggs; meat- and bouillon extracts; vegetable extracts and preserved herbs for the kitchen; non-medical nutritional concentrates or nutritional supplements on herbal basis, herbal food, also in form of snack bars’;

 - Class 32: ‘Beers; mineral and aerated waters and other non-alcoholic drinks; fruit and vegetable drinks, fruit juices; syrups and other preparations for making beverages; herbal and vitamin beverages’.

- 4 The application was published in the *Community Trade Marks Bulletin*, No 2/98, on 5 January 1998.
- 5 On 1 April 1998, the other party to the proceedings before the Board of Appeal filed a notice of opposition under Article 42(1) of Regulation No 40/94 against registration of the trade mark in respect of all the products referred to in the trade-mark application. The opposition was based on the fact that a trade mark had already been registered in Spain, the date of priority for which was 19 October 1960. That trade mark ('the earlier trade mark'), which consists of the word mark VITAFRUT, was registered in respect of products falling within classes 30 and 32 of the Nice Agreement and corresponding to the following description: 'Non-alcoholic and non-therapeutic carbonic drinks, non-therapeutical cold beverages of all kind[s], gaseous, granulated effervescent; fruit and vegetable juices without fermentation (except must), lemonades, orangeades, cold beverages (except orgeat), soda water, Seidlitz water and artificial ice'.
- 6 In support of its opposition, the other party to the proceedings before the Board of Appeal relied on the relative ground for refusal set out in Article 8(1)(b) of Regulation No 40/94.
- 7 By letter of 21 October 1998, the applicant requested that the other party to the proceedings before the Board of Appeal should furnish proof, in accordance with Article 43(2) and (3) of Regulation No 40/94, that, during the period of five years preceding the date of publication of the Community trade-mark application, the earlier trade mark had been put to genuine use in the Member State in which it was protected. By letter of 26 November 1998 the OHIM Opposition Division ('the Opposition Division') called upon the other party to the proceedings before the Board of Appeal to furnish such proof within two months.

- 8 On 22 January 1999, the other party to the proceedings before the Board of Appeal provided OHIM with (i) six bottle labels on which the earlier trade mark was displayed and (ii) 14 invoices and orders, 10 of which dated from before 5 January 1998.
- 9 By decision of 23 August 2000 the Opposition Division rejected the trade-mark application under the first sentence of Article 43(5) of Regulation No 40/94 in respect of 'mineral and aerated waters and other non-alcoholic drinks; fruit and vegetable drinks, fruit juices; syrups and other preparations for making beverages; herbal and vitamin beverages'. In so far as it refused to register the trade mark, it held, first, that the evidence produced by the other party to the proceedings before the Board of Appeal showed that the earlier trade mark had been put to genuine use under Article 43(2) and (3) of Regulation No 40/94 in respect of 'fruit and vegetable juices without fermentation, lemonades, orangeades'. Second, the Opposition Division took the view that those products were in part identical with, and in part similar to, the products identified as 'mineral and aerated waters and other non-alcoholic drinks; fruit and vegetable drinks, fruit juices; syrups and other preparations for making beverages; herbal and vitamin beverages', referred to in the trade-mark application, and that there was a likelihood of confusion for the purposes of Article 8(1)(b) of Regulation No 40/94 between the signs in question.
- 10 On 23 October 2000, the applicant filed a notice of appeal at OHIM under Article 59 of Regulation No 40/94 against the decision of the Opposition Division. The applicant sought, principally, partial annulment of the decision in so far as it rejected the trade-mark application and, in the alternative, partial annulment of the decision in so far as it rejected the trade-mark application in respect of products identified as 'herbal and vitamin beverages'.
- 11 By decision of 8 April 2002 ('the contested decision'), the OHIM First Board of Appeal dismissed the appeal. In substance, it upheld the findings made by the Opposition Division in its decision, pointing out, however, that use of the earlier trade mark had been proven only for products identified as 'juice concentrates'.

Forms of order sought

12 The applicant claims that the Court should:

- primarily, annul the contested decision;

- in the alternative, annul the contested decision to the extent that it dismissed the appeal in so far as the appeal sought annulment of the Opposition Division's decision with regard to 'herbal and vitamin beverages';

- order OHIM to pay the costs.

13 OHIM contends that the Court should:

- dismiss the application;

- order the applicant to pay the costs.

Law

14 In support of its application, the applicant raises two pleas in law. The first, on which its principal claim is based, alleges infringement of Article 43(2) of Regulation No 40/94. That plea is divided into two parts, the first alleging that OHIM took into

account as genuine use of the earlier trade mark the use made thereof by a third party, without it being proved that the consent of the proprietor of the trade mark had been obtained. The second part of the plea alleges that OHIM misinterpreted the notion of genuine use. The second plea, on which its alternative claim is based, alleges infringement of Article 8(1)(b) of Regulation No 40/94.

Plea alleging infringement of Article 43(2) of Regulation No 40/94

The first part of the plea: the Board of Appeal wrongly took into account the use of the trade mark made by a third party

— Arguments of the parties

- 15 The applicant argues that it is apparent from the invoices produced by the other party to the proceedings before the Board of Appeal that the earlier trade mark was used by the company Industrias Espadafor SA, and not by the proprietor of the earlier trade mark himself, Juan Espadafor Caba. The other party to the proceedings before the Board of Appeal is a natural person whilst the person which used the earlier trade mark is a company. Furthermore, in the applicant's submission, the other party to the proceedings before the Board of Appeal did not prove that consent to use of the earlier mark had been obtained from it, as proprietor of that mark, for the purposes of Article 15(3) of Regulation No 40/94.
- 16 The applicant stated at the hearing that it had indicated in the documents that it submitted during the proceedings before OHIM, dated 22 September 1999 and 22 December 2000, that the evidence produced by the other party to the proceedings before OHIM did not prove genuine use of the earlier trade mark by that party. It concludes from that that this part of the plea, which alleges infringement of Article 43 of Regulation No 40/94, has not been put forward out of time.

- 17 OHIM submits that this part of the plea is inadmissible under Article 135(4) of the Rules of Procedure of the Court of First Instance, since it was not raised either in the course of the opposition proceedings or before the Board of Appeal.
- 18 As regards the substance of the plea, OHIM contends that where, in opposition proceedings, an opposing party is in a position to provide proof that the earlier trade mark has been put to use, the inference may be drawn that the proprietor of the mark consented to that use. Such a finding may be rebutted only when the person applying for the mark explicitly contests it.

— Findings of the Court

- 19 Under Article 43(2) and (3) and Article 15(1) of Regulation No 40/94, opposition to registration of a Community trade mark is rejected if the proprietor of the earlier trade mark at issue does not furnish proof that the earlier mark has been put to genuine use by its proprietor during the period of five years preceding the date of publication of the Community trade-mark application. However, if the proprietor of the earlier trade mark successfully furnishes that proof, OHIM will examine the grounds for refusal advanced by the opposing party.
- 20 Pursuant to Article 15(3) of Regulation No 40/94, in conjunction with Article 43(3) thereof, use of an earlier national trade mark by a third party with the consent of the proprietor is deemed to constitute use by the proprietor.

- 21 It must be stated at the outset that the Court of First Instance has already held that the extent of the examination which the Board of Appeal is required to conduct with regard to the decision under appeal (in this instance the Opposition Division's decision) does not depend upon whether or not the party bringing the appeal has raised a specific ground of appeal with regard to that decision, criticising the interpretation or application of a provision by the department at OHIM which heard the application at first instance, or upon that department's assessment of a piece of evidence (see, to that effect, Case T-308/01 *Henkel v OHIM — LHS (UK) (KLEENCARE)* [2003] ECR II-3253, paragraph 32). Therefore, even if the party bringing the appeal before the Board of Appeal of OHIM has not raised a specific plea, the Board of Appeal is none the less bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling (*KLEENCARE*, paragraph 29). That examination must include consideration of whether, in the light of the facts and evidence put forward by the other party to the proceedings before the Board of Appeal, that party has furnished proof of genuine use, either by the proprietor of the earlier trade mark or by an authorised third party, for the purposes of Article 43(2)(and (3) and Article 15(3) of Regulation No 40/94. It follows that the first part of this plea is admissible.
- 22 However, the relevance of the contention that the applicant did not dispute, before either the Opposition Division or the Board of Appeal, that consent had been granted by the proprietor of the earlier mark pertains to the examination of the merits.
- 23 As is apparent from the invoices submitted by the other party to the proceedings before the Board of Appeal, sales of products under the earlier trade mark were made by Industrias Espadafor SA rather than by the proprietor of the trade mark, although the latter's name also features in the name of the company in question.

- 24 Where an opposing party maintains that the use of an earlier trade mark by a third party constitutes genuine use for the purposes of Article 43(2) and (3) of Regulation No 40/94, he claims, by implication, that he consented to that use.
- 25 As to the truth of what that implies, it is evident that, if the use of the earlier trade mark, as shown by the invoices produced to OHIM, was without the proprietor's consent and consequently in breach of the proprietor's trade-mark right, it would have been in Industrias Espadafor SA's interests, in the normal course of events, not to disclose evidence of such use to the proprietor of the trade mark in question. Consequently, it seems unlikely that the proprietor of a trade mark would be in a position to submit proof that the mark had been used against his wishes.
- 26 There was all the more reason for OHIM to rely on that presumption given that the applicant did not dispute that the earlier trade mark had been put to use by Industrias Espadafor SA with the opposing party's consent. It is not sufficient that the applicant argued generally in the course of the proceedings before OHIM that the evidence produced by the opposing party was not adequate to establish genuine use by the latter.
- 27 It is apparent from the documents before the Court that the applicant made very specific criticism of the alleged fact that the volume of sales entailed by the use shown was too low and of the quality of the evidence adduced. However, nothing in the documents submitted by the applicant during the proceedings before OHIM allows the inference to be drawn that the applicant drew OHIM's attention to the fact that the trade mark had been used by a third party or that it expressed doubts as to whether the proprietor of the trade mark had consented to that use.
- 28 Those factors formed a sufficiently firm basis to allow the Board of Appeal to conclude that the earlier trade mark had been used with its proprietor's consent.

29 It follows that the first part of the plea alleging infringement of Article 43(2) and (3) of Regulation No 40/94 must be rejected as unfounded.

The second part of the plea, alleging that the Board of Appeal misinterpreted the notion of genuine use

— Arguments of the parties

30 The applicant asserts, first, that the labels produced by the other party to the proceedings before the Board of Appeal should not have been relied on as evidence, since they do not bear dates. Furthermore, the applicant points out that the other party did not produce any evidence to show that those labels were actually used during the relevant period in the marketing in Spain of the products designated by the earlier trade mark. At the hearing the applicant explained that the other party to the proceedings before the Board of Appeal should have supplemented the evidence produced with an affidavit stating that the labels were used on the Spanish market during the relevant period.

31 Second, the applicant submits that the Board of Appeal was wrong in finding that the scale of use of the earlier trade mark, as shown by the evidence produced by the other party to the proceedings before the Board of Appeal, was significant enough to give grounds for finding that the mark had been put to genuine use for the purposes of Article 43(2) of Regulation No 40/94. In that regard, it observes that the other party to the proceedings before the Board of Appeal did not produce an affidavit showing the annual turnover of product sales made under the earlier trade mark. Furthermore, the invoices produced by that party show only that product sales made under that mark amounted to approximately EUR 5 400 for all the relevant period. At the hearing the applicant reassessed that figure, stating that relevant product sales amounted to approximately EUR 3 500 in 1996 and EUR 1 300 in 1997.

- 32 Third, the applicant maintains that the invoices produced by the other party to the proceedings before the Board of Appeal do not give any indication of the form in which the earlier trade mark was used.
- 33 Finally, the applicant submits that the contested decision is not consistent with the decision of the Fourth Board of Appeal of OHIM of 26 September 2001 in Case R-578/2000-4 (HIPOVITON/HIPPOVIT), in which account was taken of the relationship of the turnover for sales made under the earlier trade mark to the total annual turnover of the undertaking using the mark.
- 34 OHIM contends, as regards the nature of the use of the earlier trade mark and the place of use, that it is clear from the material filed that the mark was used in the relevant territory, namely Spain, as a word mark and, therefore, in the form in which it was registered.
- 35 As regards the scale of the use of the earlier trade mark, OHIM recognises that the volume of sales made under the earlier trade mark throughout the relevant period is not high, and that, additionally, the invoices produced relate only to sales to a single customer. However, OHIM submits that sufficient use was made of the earlier trade mark for the use to be regarded as genuine.

— Findings of the Court

- 36 As is clear from the ninth recital in the preamble to Regulation No 40/94, the legislature considered there to be no justification for protecting an earlier trade

mark except where the mark has actually been used. In keeping with that recital, Article 43(2) and (3) of Regulation No 40/94 provides that an applicant for a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory where it is protected during the five years preceding the date of publication of the Community trade-mark application against which an opposition has been filed (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 34).

37 Under Rule 22(2) 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), evidence of use must concern the place, time, extent and nature of use of the earlier trade mark. However, the opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. Articles 43(2) and 76 of Regulation No 40/94 and Rule 22(3) of Regulation No 2868/95 leave it to the opposing party to select the form of evidence which he considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period. Therefore, the applicant's complaint about the failure to submit an affidavit concerning the total turnover resulting from sales of the products made under the earlier trade mark must be rejected.

38 In interpreting the notion of 'genuine use', account must be taken of the fact that the *ratio legis* of the provision requiring that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade-mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification deriving from active functioning of the mark on the market (Case T-174/01 *Goulbourn v OHIM — Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks.

- 39 As is apparent from the judgment of the Court of Justice in Case C-40/01 *Ansul* [2003] ECR I-2439 concerning the interpretation of Article 12(1) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the provisions of which correspond in essence to those of Article 43(2) of Regulation No 40/94, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (*Ansul*, paragraph 43). In that regard, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (*Ansul*, paragraph 37, and *Silk Cocoon v OHIM*, paragraph 39).
- 40 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the products or services protected by the mark, the nature of those products or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).
- 41 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use.
- 42 To examine, in a particular case, whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact

that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine (*Ansul*, paragraph 39).

- 43 In the light of the foregoing, it is appropriate to consider whether OHIM was right to find that the evidence produced by the other party to the proceedings before it established that the earlier trade mark had been put to genuine use.
- 44 Since the application for a Community trade mark filed by the applicant was published on 5 January 1998, the period of five years referred to in Article 43(2) of Regulation No 40/94 runs from 5 January 1993 to 4 January 1998 ('the relevant period').
- 45 As is clear from Article 15(1) of Regulation No 40/94, only trade marks genuine use of which has been suspended during an uninterrupted period of five years are subject to the sanctions provided for by the regulation. Accordingly, it is sufficient that a trade mark should have been put to genuine use during a part of the relevant period for it not to be subject to the sanctions.
- 46 The invoices submitted by the other party to the proceedings before OHIM establish that the trade mark was put to use between the end of May 1996 and the middle of May 1997, a period of eleven and a half months.

- 47 They also show that the deliveries were made to a customer in Spain and that they were invoiced in Spanish pesetas. It follows that the products were intended for the Spanish market, which was the relevant market.
- 48 The value of the volume of sales of the product amounts to no more than EUR 4 800, corresponding to the sale of 293 units, identified as 'cajas' (cases) in the invoices, of 12 items each, or 3 516 items in total, the price per unit without value added tax being ESP 227 (EUR 1.36). Although the volume of sales is relatively low, the invoices submitted suggest that the products to which they refer were marketed relatively regularly throughout a period of over 11 months, a period which is neither particularly short nor particularly close to the publication of the Community trademark application filed by the applicant.
- 49 The sales in question constitute use which objectively is such as to create or preserve an outlet for the products concerned and which entails a volume of sales which, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark.
- 50 The same is true of the fact that the invoices were made out to a single customer. It is sufficient that the trade mark is used publicly and outwardly and not solely within the undertaking which owns the earlier trade mark or within a distribution network owned or controlled by that undertaking. In this instance, the applicant has not maintained that the addressee of the invoices belongs to the other party to the proceedings before OHIM and none of the circumstances of the case suggests that that is so. Therefore, there is no need to rely on the argument advanced by OHIM at the hearing that the customer is a major supplier of Spanish supermarkets.

- 51 As to the nature of the use to which the earlier trade mark was put, the products to which the invoices refer are identified as 'concentrado' (concentrate), followed, first, by a description of the flavour ('kiwi', 'menta' (mint), 'granadina' (grenadine), 'maracuya' (passion fruit), 'lima' (lime) and 'azul trop.') and, second, by the word 'vitafrut' in inverted commas. That name suggests that the products concerned are concentrated fruit juices or juice concentrates of various fruits.
- 52 Furthermore, it can be seen from the labels produced by the other party to the proceedings that what is at issue are concentrated juices of various fruits, intended for end consumers, and not juice concentrates intended for manufacturers producing fruit juices. Thus, the labels include a description 'bebida concentrada para diluir 1 + 3' ('concentrated drink to be diluted 1 + 3'), the drink being evidently intended for the end consumer.
- 53 As the applicant has stated, the labels bear no date. Therefore, the issue as to whether labels usually bear dates, a proposition advanced by the applicant and challenged by OHIM, is irrelevant. However, although the labels alone are not decisive, they are capable of supporting other evidence produced in the course of the proceedings before OHIM.
- 54 It follows that the other party to the proceedings before the Board of Appeal furnished proof that sales were made, with its consent, to a Spanish customer during the period from May 1996 to May 1997 of around 300 units of 12 items each of concentrated juices of various fruits, representing sales of approximately EUR 4 800. Although the scale of the use to which the earlier trade mark was put is limited and although it might be preferable to have more evidence relating to the nature of the use during the relevant period, the facts and evidence put forward by the other party to the proceedings are sufficient for a finding of genuine use. Consequently, OHIM was right to find, in the contested decision, that the earlier trade mark was put to genuine use in respect of some of the products for which it was registered, namely for fruit juices.

- 55 As regards the alleged inconsistency between the contested decision and the decision of the Fourth Board of Appeal of OHIM in Case R 578/2000-4 (HIPOVITON/HIPPOVIT), it should be noted that that decision has been annulled by the judgment of this Court of ... in Case T-334/01 *MFE Marienfelde v OHIM — Vétoquinol (HIPOVITON)*, the ECR II-2787.
- 56 In the light of the foregoing, the second part of this plea is unfounded. It follows that the principal claim seeking annulment of the contested decision must be rejected.
- 57 Since the first plea in law is unfounded, it is necessary to consider the alternative claim seeking partial annulment of the contested decision on the ground that Article 8(1)(b) of Regulation No 40/94 was infringed.

The plea alleging infringement of Article 8(1)(b) of Regulation No 40/94

— Arguments of the parties

- 58 The applicant submits that the products in respect of which the earlier trade mark has been put to genuine use, 'juice concentrates', and the products described in the trade-mark application as 'herbal and vitamin beverages' are, at best, only remotely similar.

- 59 First, the products are different in nature, since juice concentrates are generally made from fruit, whilst 'herbal and vitamin beverages' are made from water and either herbs or synthetic components. Furthermore, production of those different products also requires different machinery and facilities and specialised know-how.
- 60 Second, the products serve different purposes: juice concentrates are intended to be used in the production of refreshing drinks, whilst herbal and vitamin beverages are used mainly for dietetic, beauty and/or health care purposes.
- 61 The differences between the products are reflected in the fact that they are intended for different purchasers, manufacturers producing fruit juices in the case of juice concentrates and end consumers in the case of herbal and vitamin beverages. Nevertheless, in so far as juice concentrates are also bought by end consumers, the applicant submits that there are different distribution channels for those products, on the one hand, and for herbal and vitamin beverages, on the other hand. In the applicant's submission, juice concentrates are sold in supermarkets, whereas vitamin and herbal beverages are more likely to be sold in drugstores or health-food shops. Even in the event of both types of product being sold in the same shop, they would be offered for sale in different sections of the shop.
- 62 OHIM considers both juice concentrates and fruit juices to be similar to the products described as 'herbal and vitamin beverages' in the trade-mark application.

— Findings of the Court

- ⁶³ Upon opposition by the proprietor of an earlier trade mark, a trade mark is not to be registered, pursuant to Article 8(1)(b) of Regulation No 40/94, if the products or services for which registration is sought are identical with or similar to those for which an earlier trade mark is registered and if the degree of similarity between the marks concerned is sufficient for it to be considered that there is a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. Furthermore, under Article 8(2)(a)(ii) of Regulation No 40/94, 'earlier trade marks' means trade marks registered in a Member State, with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.
- ⁶⁴ In this instance, the applicant is challenging the findings of the Board of Appeal only in relation to the question as to whether the products described in the trade-mark application as 'herbal and vitamin beverages' are identical with or similar to the products in respect of which the earlier trade mark was put to use, namely 'fruit juices' (paragraphs 19 and 20 of the contested decision).
- ⁶⁵ It has been held that in order to assess the similarity of the products or services concerned, all the relevant features of the relationship between those products or services should be taken into account, including their nature, their end users, their method of use and whether they are in competition with each other or are complementary (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 23).
- ⁶⁶ In this instance, as stated in paragraph 52 above, the earlier trade mark was used for concentrated fruit juices, intended for end consumers, and not for fruit juice concentrates, intended for manufacturers producing fruit juices. Therefore, the

applicant's argument that the products concerned are intended for different purchasers, namely manufacturers in the case of juice concentrates and end consumers in the case of herbal and vitamin beverages, must be rejected.

67 Next, the Board of Appeal rightly stated that the products concerned share the same purpose, that of quenching thirst, and that to a large extent they are in competition. As to the nature and use of the products at issue, in both cases the products concerned are non-alcoholic beverages normally drunk cold, the ingredients being admittedly different in most cases. The fact that their ingredients differ does not, however, affect the finding that they are interchangeable because they are intended to meet an identical need.

68 It follows that the Board of Appeal did not make an error of assessment in finding that the products concerned are similar. This plea is therefore unfounded and consequently the alternative claim must also be rejected.

Costs

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

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

- 1. Dismisses the action;**

- 2. Orders the applicant to pay the costs.**

Pirrung

Meij

Forwood

Delivered in open court in Luxembourg on 8 July 2004.

H. Jung

Registrar

J. Pirrung

President