Reports of Cases

JUDGMENT OF THE GENERAL COURT (Seventh Chamber)

24 September 2019*

(EU trade mark — Opposition proceedings — Application for the EU figurative mark V V-WHEELS — Earlier EU, national and unregistered figurative marks VOLVO — Relative ground for refusal — Similarity of the signs — Article 8(5) of Regulation (EU) 2017/1001)

In Case T-356/18,

Volvo Trademark Holding AB, established in Gothenburg (Sweden), represented by T. Dolde, lawyer, and M. Hawkins, Solicitor,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by S. Bonne and H. O'Neill, acting as Agents,

defendant,

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

Paalupaikka Oy, established in Iisalmi (Finland),

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 21 March 2018 (Case R 1852/2017-4), relating to opposition proceedings between Volvo Trademark Holding and Paalupaikka,

THE GENERAL COURT (Seventh Chamber),

composed of V. Tomljenović, President, E. Bieliūnas and A. Kornezov (Rapporteur), Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the application lodged at the Court Registry on 7 June 2018,

having regard to the response lodged at the Court Registry on 4 October 2018,

further to the hearing on 16 May 2019,

gives the following

* Language of the case: English.

Judgment

Background to the dispute

1 On 4 August 2015, Paalupaikka Oy filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

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



3 That sign is described in the application for registration as 'a blue circle containing a letter "[v]" in silver'. The circle 'is surrounded by a narrow silver band' and appears above 'the text "[v-wheels]"' in which 'the letter "[v]" is silver while the rest of the text is blue'. The goods in respect of which registration was sought are in Class 12 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 to the following description: 'Wheel rims [for automobiles]; [r]ims for vehicle wheels; [w]heels; [c]asters [wheels] for vehicles; [a]utomobile wheels; [w]heels for motorcycles; [v]ehicle wheels; [c]asters [wheels] for trolleys; [w]heels [land vehicle parts]; [w]heels for racing karts; [w]heels, tyres and continuous tracks'.

4 The trade mark application was published in *European Union Trade Marks Bulletin* No 182/2015 of 25 September 2015.

5 On 31 December 2015, the applicant, Volvo Trademark Holding AB, filed a notice of opposition to registration of the sign applied for in respect of the goods referred to in paragraph 3 above.

6 The opposition was based on the following earlier marks, which all covered goods in Class 12:

– the EU figurative mark registered under the number 10397016, reproduced below:

– the EU figurative mark registered under the number 4804522, reproduced below:



– the EU figurative mark registered under the number 9045311, reproduced below:



– the Finnish figurative mark registered under the number 66240, reproduced below:



– the Swedish figurative mark registered under the number 385923, reproduced below:



– the Swedish figurative mark which was the subject of an application for registration on 22 August 2014, reproduced below:



– the trade mark which is well known in the European Union, reproduced below:



– the trade mark which is well known in the European Union, reproduced below:



– the trade mark which is well known in the European Union, reproduced below:



7 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) and (5) of Regulation No 207/2009 (now Article 8(1)(b) and (5) of Regulation 2017/1001).

8 On 19 June 2017, the Opposition Division rejected the opposition in its entirety.

9 On 22 August 2017, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the decision of the Opposition Division.

10 By decision of 21 March 2018 (‘the contested decision’), the Fourth Board of Appeal of EUIPO dismissed the appeal. In particular, first of all, it found that the sign in respect of which registration was sought was dissimilar to the earlier marks relied on in support of the opposition and that, consequently, there could be no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation 2017/1001. Next, it rejected the ground for opposition based on Article 8(5) of that

regulation because the first condition for the application of that provision was not fulfilled, since the signs at issue were dissimilar. Lastly, it stated that neither the opinion surveys nor the decision of the Patentstyret (Norwegian Industrial Property Office), submitted by the applicant, could call those findings into question.

Forms of order sought

11 The applicant claims that the Court should:

– annul the contested decision;

– order EUIPO to pay the costs, including those incurred in the proceedings before the Opposition Division and the Fourth Board of Appeal of EUIPO.

12 EUIPO contends that the Court should:

– dismiss the action in its entirety;

– order the applicant to pay the costs incurred by EUIPO.

Law

13 In support of the action, the applicant relies on four pleas in law. The first and second pleas allege infringement of Article 8(5) and Article 8(1)(b) of Regulation 2017/1001 respectively. The third plea alleges that the Board of Appeal distorted the facts and evidence, in infringement of Article 72(2) of Regulation 2017/1001. The fourth plea alleges that the Board of Appeal infringed its obligation to state reasons pursuant to Article 94(1) of Regulation 2017/1001.

14 It is clear from the contested decision that the Board of Appeal found, when analysing the relative ground for refusal under Article 8(1)(b) of Regulation 2017/1001, that the signs at issue were dissimilar, with the result that the opposition based both on Article 8(1)(b) and on Article 8(5) of that regulation had to be rejected.

15 As regards the first plea, alleging infringement of Article 8(5) of Regulation 2017/1001, the applicant submits, in essence, that the Board of Appeal erred in finding that there was no similarity between the signs and in therefore rejecting the relative ground for refusal set out in that provision.

16 Article 8(5) of Regulation 2017/1001 provides that, upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for must not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

17 It is apparent from the wording of Article 8(5) of Regulation 2017/1001 that the application of that provision is subject to the cumulative conditions that, first, the marks at issue must be identical or similar; secondly, the earlier mark cited in opposition must have a reputation; and, thirdly, there must

be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (judgment of 28 June 2018, *EUIPO* v *Puma*, C-564/16 P, EU:C:2018:509, paragraph 54).

18 According to settled case-law, the infringements referred to in Article 8(5) of Regulation 2017/1001, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, as a result of which the relevant public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see judgment of 12 March 2009, *Antartica* v *OHIM*, C-320/07 P, not published, EU:C:2009:146, paragraph 43 and the case-law cited).

19 As regards, in particular, the first condition for the application of Article 8(5) of Regulation 2017/1001, which has been referred to in paragraph 17 above, namely that the signs at issue must be identical or similar, it must be borne in mind that, according to the case-law of the Court of Justice, the degree of similarity required under Article 8(1)(b) of Regulation 2017/1001, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation 2017/1001 is conditional upon the finding that there is such a degree of similarity between the marks at issue that there is a likelihood of confusion between them on the part of the relevant public, such a likelihood of confusion is not necessary for the purposes of the protection conferred by Article 8(5) of that regulation. Accordingly, the types of harm referred to in Article 8(5) of Regulation 2017/1001 may be the consequence of a lower degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant public to make a connection between those marks, that is to say, to establish a link between them (judgments of 24 March 2011, *Ferrero* v *OHIM*, C-552/09 P, EU:C:2011:177, paragraph 53, and of 20 November 2014, *Intra-Presse* v *OHIM*, C-581/13 P and C-582/13 P, not published, EU:C:2014:2387, paragraph 72).

20 It follows that, where any similarity between the signs at issue is ruled out, Article 8(5) of Regulation 2017/1001 is, like Article 8(1)(b) of that regulation, manifestly inapplicable. It is only if there is some similarity, even faint, between the marks at issue that it is necessary to carry out an overall assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the renown or reputation enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks on the part of the relevant public (see, to that effect, judgments of 24 March 2011, *Ferrero* v *OHIM*, C-552/09 P, EU:C:2011:177, paragraph 66, and of 20 November 2014, *Intra-Presse* v *OHIM*, C-581/13 P and C-582/13 P, not published, EU:C:2014:2387, paragraph 73).

21 It is in the light of those preliminary considerations that the first plea put forward by the applicant must be examined.

22 In the present case, the Board of Appeal found that the signs at issue were dissimilar and concluded, on that basis, that the ground for refusal set out in Article 8(5) of Regulation 2017/1001 was not applicable, without examining the other conditions laid down in that provision, which have been referred to in paragraph 17 above.

23 It must therefore be ascertained whether the Board of Appeal could legitimately conclude that there was no similarity, even faint, between the signs at issue.

24 In that regard, it must be borne in mind that two signs 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, namely the visual, phonetic and conceptual aspects (see judgment of 29 November 2018, *Louis Vuitton Malletier* v *EUIPO — Fulia Trading (LV BET ZAKŁADY BUKMACHERSKIE)*, T-373/17, not published, EU:T:2018:850, paragraph 66 and the case-law cited).

25 Assessment of the similarity between two signs means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see judgment of 12 June 2007, *OHIM* v *Shaker*, C-334/05 P, EU:C:2007:333, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (judgments of 12 June 2007, *OHIM* v *Shaker*, C-334/05 P, EU:C:2007:333, paragraph 42, and of 20 September 2007, *Nestlé* v *OHIM*, C-193/06 P, not published, EU:C:2007:539, paragraph 43). That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (judgment of 20 September 2007, *Nestlé* v *OHIM*, C-193/06 P, not published, EU:C:2007:539, paragraph 43).

26 In the present case, first of all, the Board of Appeal found, in the context of its assessment based on Article 8(1)(b) of Regulation 2017/1001, that the relevant public to be taken into consideration was the general public, namely end consumers and consumers who are professionals, the level of attention of which general public ranged from average to high, and that the relevant territory for the purposes of assessing whether there was a likelihood of confusion was the European Union as regards the earlier EU trade marks and the earlier unregistered well-known trade marks and Sweden and Finland as regards the national trade marks registered in those territories. The parties do not dispute that definition of the relevant public.

27 Next, the Board of Appeal carried out the visual, phonetic and conceptual comparison of the signs at issue. In the first place, it examined the opposition in so far as it was based on EU trade mark No 10397016, reproduced in paragraph 6 above.

28 In that regard, the Board of Appeal found that the sign in respect of which registration had been sought was a figurative sign consisting of a stylised letter ‘v’, written in silver and placed in a blue circle. It took the view that the font used resembled the standard font Garamond, which was available in any word processing program. It added that the same stylised letter, albeit smaller in size, was reproduced under the circle and was followed by a hyphen and the word ‘wheels’ written in a font which resembled the font Arial. It found that that word, which was a basic English word that was likely to be understood throughout the European Union, was descriptive of the goods covered by the mark in respect of which registration had been sought and non-distinctive with respect to cars and that the letter ‘v’ had no meaning at all with respect to cars. On that basis it stated that, ‘in the appellant’s best case scenario’, the sign in respect of which registration had been sought was dominated by the silver letter ‘v’ in a blue circle and that the colour blue was a basic colour.

29 As regards EU trade mark No 10397016, the Board of Appeal observed that it consisted of the stylised representation of the word element ‘volvo’ in blue letters, that the colour blue was a basic colour and that that word element was written in a font resembling the standard font Garamond, ‘the only difference [being] that [those] letters … [appeared] slightly thicker than in [that font]’. As regards the signs at issue, it stated that both the font and the colour used were very simple and commonly used in the course of trade, with the result that they did not confer distinctive character on those signs.

30 As regards the visual comparison of the signs at issue, the Board of Appeal found, in paragraph 30 of the contested decision, that the dominant elements in those signs, namely the letter ‘v’ in the sign in respect of which registration had been sought and the word element ‘volvo’ in the earlier mark, were dissimilar. It observed that a one-letter sign could not be held to be similar to any word which began with that letter. In its view, the additional figurative elements were also different. It stated that, even though the colour blue was used in both signs and even if it was the same shade of blue, that did not outweigh the dissimilarities between those signs.

31 From a phonetic standpoint, the Board of Appeal found that, in English, Spanish and German, the single letter 'v' in the sign in respect of which registration had been sought was pronounced differently from the letter 'v' in the word element 'volvo' in the earlier mark. Given that it did not have any example to the contrary in another language, it concluded that the signs at issue were phonetically dissimilar.

32 From a conceptual standpoint, the Board of Appeal found that no comparison was possible because neither the dominant and distinctive element of the sign in respect of which registration had been sought nor the earlier mark had any meaning.

33 Furthermore, the Board of Appeal pointed out that, if the element 'v-wheels' in the sign in respect of which registration had been sought were to be taken into consideration, the signs at issue would be visually and phonetically even further apart. Likewise, it took the view that, if a concept were to be attributed to the dominant element of that sign, namely that of a single letter, or if the word 'wheels' in the element 'v-wheels' of that sign were to be taken into consideration, the signs at issue would be conceptually dissimilar.

34 In the second place, the Board of Appeal compared the sign in respect of which registration had been sought with all the other earlier figurative marks that had been put forward in support of the opposition and have been reproduced in paragraph 6 above. In that regard, it observed that all those marks comprised the distinctive word element 'volvo', written in the same font as EU trade mark No 10397016, and 'a co-dominant figurative element' and that the word element 'volvo' was written in black on a white label or in white on a black or blue label. It also found that those marks did not, contrary to the applicant's claims, contain a circle, because the figurative element in those marks could not be split into a circle and an arrow, but would be seen as one element resembling the well-known symbol for the male gender (), with the result that the signs at issue did not share the same circular device. Furthermore, it stated that the word element 'volvo' was not, unlike the letter 'v' in the sign in respect of which registration had been sought, written in silver in any of those marks. It observed that, since those marks all contained an additional 'co-dominant' element, the differences between them and that sign were 'even wider'. Consequently, the Board of Appeal concluded that the sign in respect of which registration had been sought was dissimilar to any of the other abovementioned marks.

35 The applicant submits that, for the purposes of the application of Article 8(5) of Regulation 2017/1001, the Board of Appeal's assessment as to whether the signs at issue were similar is flawed in various respects. In the application and at the hearing, it stated that its arguments focussed essentially on the comparison between the sign in respect of which registration had been sought and the trade mark which is well known in the European Union and is reproduced below ('the earlier mark relied on'):

Sign in respect of which registration has been sought	Earlier trade mark which is well known in the European Union
	

36 According to the applicant, there is a certain visual similarity between the signs at issue reproduced in paragraph 35 above on the ground that they have a number of elements in common, namely the letter 'v', the circular shapes, the positioning of the word elements within those circular shapes, the same blue and silver colour combination and the use of the same font, which is not the standard font Garamond, but a font that has been specifically created for the applicant. It submits that the Board of Appeal did not take some of those similarities and the overall impression created by those signs into account. Furthermore, it maintains that there is also a certain phonetic similarity between those signs.

37 EUIPO contends that, first, the fact that the word element 'volvo' in the earlier mark relied on begins with the letter 'v', which is subsequently repeated, is not sufficient to overcome the dissimilarities between the signs at issue reproduced in paragraph 35 above and that the font used is not particularly distinctive. Secondly, it submits that those signs do not contain the same figurative elements, in particular a circular shape, or the same word elements, so they cannot be considered to be similar. Thirdly, it maintains that, contrary to what the applicant submits, the word element in the earlier mark relied on is positioned in a rectangle that covers less than one third of the symbol for the male gender, whereas the element 'v' in the sign in respect of which registration has been sought covers the whole surface of the disk onto which it has been applied. Fourthly, it contends that the tone of silver used in that sign does not coincide with the silver in the earlier mark relied on and that the proportion of the colours is not identical to the point of making those signs similar. It submits that the combination of the colours blue and silver is not, moreover, inherently distinctive.

38 It must be pointed out that the sign in respect of which registration has been sought is a composite figurative sign. It contains an element which, in the light of its size and position, is the dominant element and which consists of the letter 'v', written in silver in a slightly stylised font and placed in a blue circle with a fine silver outline. There is a smaller word element below that element, namely the word element 'v-wheels', in which the letter 'v' is the same as that in the blue circle, but is reproduced in a smaller size, and the other letters are written in blue in a font resembling the font Arial.

39 In that regard, the Board of Appeal correctly pointed out, in paragraph 27 of the contested decision, that the dominant element of the sign in respect of which registration had been sought was that consisting of the capital letter 'v', written in silver and placed in a blue circle. It must, however, be stated that that blue circle is surrounded by a fine silver circular line (see paragraphs 2 and 3 above), which was not pointed out by the Board of Appeal. As regards the word element 'v-wheels' in that sign, it must be held that that element cannot, in view of its size and the fact that part of it reproduces the large stylised letter 'v' in the dominant element, be considered to be dominant. It is not, however, negligible.

40 The earlier mark relied on is also a composite mark and consists of the word element 'volvo' written in slightly stylised white letters on a blue rectangular background placed in a silver circular element which has a small arrow in the same colour coming out at the top on the right. In that regard, the Board of Appeal correctly pointed out that that mark consisted of dominant elements, namely the word element 'volvo' and a circular element which has a small arrow coming out at the top on the right.

41 In the first place, as regards the visual comparison of the signs at issue reproduced in paragraph 35 above, the Board of Appeal found, in essence, that they were dissimilar.

42 However, it must be pointed out in that regard, as the applicant, in essence, submits, that there are elements of visual similarity between the signs at issue reproduced in paragraph 35 above.

43 First, there are certain similarities between the word element of the dominant element in the sign in respect of which registration has been sought and the word element in the earlier mark relied on, namely the letter 'v' and the word element 'volvo' respectively. The first is that that letter 'v' coincides, in particular, with the first letter of the word element 'volvo'. The second is that, in both cases, they are written in the same font. Even though that font is not particularly fanciful, it is nevertheless stylised and is not, as the parties confirmed at the hearing, one of the 'standard' fonts in word processing software programs. EUIPO does not, moreover, dispute that the font in question was designed specifically for the applicant and has been used by the applicant for many years. Furthermore, as the applicant correctly submits and contrary to what the Board of Appeal stated, the differences between the font Garamond and the font used in the signs at issue reproduced in paragraph 35 above do not lie solely in the 'slightly thicker' writing of the letters, but also in the fact that, unlike in the font Garamond, the letter 'v' in those signs is written by cutting off the lower pointed part of that letter. It

must therefore be held that the same font is used for the word elements 'v' and 'volvo' in those signs, a font which is not, contrary to what the Board of Appeal stated, one of the fonts that is commonly used in the course of trade.

44 In any event, the Court has already had occasion to point out that the use of the same font, even if that font is a standard font, is an element that has to be taken into consideration in examining the visual comparison of the signs at issue (see, to that effect and by analogy, judgment of 16 January 2018, *Starbucks* v *EUIPO — Nersesyan (COFFEE ROCKS)*, T-398/16, not published, EU:T:2018:4, paragraphs 29 and 52), with the result that, even if the word elements of the signs at issue had been written in a standard font, that would not preclude a finding that there is an element of similarity between them.

45 Secondly, the word elements 'v' and 'volvo' in the signs at issue are positioned in the middle of their respective signs and are clearly given prominence. In the signs at issue reproduced in paragraph 35 above, those word elements, written in silver and white respectively, are both displayed on a blue background in the centre of a circular figurative element (see paragraph 50 below), which makes them stand out. They are clearly highlighted because of their positioning and the carefully chosen contrast in the colours used. However, as the applicant correctly submits, the Board of Appeal did not take that aspect into account when assessing whether those signs were visually similar.

46 Thirdly, a highly similar combination of colours is used in the sign in respect of which registration has been sought and the earlier mark relied on. They have a very similar, if not identical, shade of blue in common, which is used, in that sign, for the circle in which the letter 'v', written in silver, is placed and, in that mark, for the rectangle in which the word 'volvo', in white, is written. They also have in common that the colour silver is used for the letter 'v' and the fine circular line surrounding the blue circle in that sign and for the symbol for the male gender in that mark.

47 In that regard, although the Board of Appeal noticed that the signs at issue reproduced in paragraph 35 above had the use of the colour blue in common, it did not more generally take into account the use of a highly similar combination of colours. The fact, pointed out by the Board of Appeal, that the word element in the earlier mark relied on is written in white, whereas the word element in the dominant element of the sign in respect of which registration has been sought is written in silver, does not in any way eliminate the similarity as regards the combination of colours used in those signs, since the difference between them is not easy to perceive when those two colours are contrasted with a blue background as in the present case. In actual fact, it is precisely those combinations of colours that contribute towards highlighting those word elements and achieving an overall aesthetic effect that is similar.

48 Likewise, the Board of Appeal's observation that the blue used in the signs at issue reproduced in paragraph 35 above is very simple and commonly used in the course of trade does not eliminate the similarity which has been found to exist as regards the combinations of colours used. In that regard, it is sufficient to point out that, for the purposes of the visual comparison of two signs, account must be taken of the use of the same colours, even if they are basic, like the combination of black and white in the case which gave rise to the judgment of 16 January 2018, *COFFEE ROCKS* (T-398/16, not published, EU:T:2018:4, paragraph 52).

49 Furthermore, as regards EUIPO's argument in the response that both the proportions in which the colours are distributed in the signs at issue reproduced in paragraph 35 above and the tones of silver used in those signs are different, it must be stated that that reasoning is not set out in the contested decision, with the result that, by that argument, EUIPO seeks to substantiate the contested decision with matters that were not taken into account in that decision. Such additional reasoning cannot successfully be relied on before the Court and must be rejected as inadmissible (see, to that effect, judgment of 11 December 2014, *CEDC International* v *OHIM — Underberg (Shape of a blade of grass in a bottle)*, T-235/12, EU:T:2014:1058, paragraph 71). In any event, the alleged differences in

proportion and in the tone of silver do not in any way invalidate the finding that very similar combinations of colours, which can clearly and immediately be perceived, are used in the sign in respect of which registration has been sought and the earlier mark relied on.

50 Fourthly, it must be pointed out that both the sign in respect of which registration has been sought and the earlier mark relied on are circular in shape overall. First, it is not disputed that the sign in respect of which registration has been sought contains a large blue circle, which is surrounded by a fine circular silver line, even though the Board of Appeal did not take the latter element into account. Secondly, the Board of Appeal did not take into consideration the fact that the earlier mark relied on contains an inner circular shape surrounded by the silver contours of the symbol for the male gender, or, at the very least, two semi-circles placed above and below the blue rectangle in which the word element 'volvo' is written. Furthermore, the symbol for the male gender () in that mark consists of a circular element and an arrow. Even if, as EUIPO maintains, the relevant public immediately recognises that symbol, that does not, however, mean, contrary to what the Board of Appeal observed in paragraph 37 of the contested decision, that that public will not perceive that the symbol for the male gender consists, inter alia, of a clearly visible circular element, particularly because the arrow which is joined to it is much smaller in size than the circular element itself. The Board of Appeal therefore erred in finding, in that paragraph, that the mark concerned '[did] not contain a circle'.

51 It follows that the sign in respect of which registration has been sought and the earlier mark relied on have a number of visual elements in common, namely the use of the same font, a very similar combination of colours, and circular shapes in the centre of which their respective word elements are positioned and highlighted. Furthermore, those word elements coincide in the letter 'v', which is the only letter in the dominant element of the sign in respect of which registration has been sought and the first letter of the word element in the earlier mark relied on.

52 It is true that, as is stated in the contested decision and as EUIPO submits, there are also significant visual differences between the signs at issue reproduced in paragraph 35 above. Accordingly, in particular, (i) the word element in the dominant element of the sign in respect of which registration has been sought, consisting of a single letter, namely 'v', differs from the word element 'volvo' in the earlier mark relied on, which consists of five letters; (ii) the sign in respect of which registration has been sought contains a blue circle unlike the earlier mark relied on in which the contours of the circular shape are in silver (see paragraph 40 above); (iii) that mark, unlike that sign, contains a blue rectangle in which the word element 'volvo' is written and a figurative element resembling the symbol for the male gender; and (iv) the earlier mark relied on does not contain the word element 'v-wheels', which is contained in the sign in respect of which registration has been sought.

53 However, those differences, significant as they are, do not make the similarities pointed out in paragraphs 43 to 51 above negligible in the overall impression created by the signs at issue reproduced in paragraph 35 above. All of those similarities relate to various aspects of the dominant elements of the sign in respect of which registration has been sought and the earlier mark relied on, with the result that they cannot be held to be irrelevant.

54 Furthermore, even if, as EUIPO maintains, none of the similarities pointed out in paragraphs 43 to 51 above, taken on its own, is sufficient for it to be held that the signs at issue reproduced in paragraph 35 above are similar for the purposes of the application of Article 8(5) of Regulation 2017/1001, the fact remains that those similarities, taken together, show that there is a low degree of visual similarity, which has to be taken into consideration for the purposes of the application of that article. It is sufficient to point out in that regard that, according to the case-law referred to in paragraphs 24 and 25 above, two signs are similar when, from the point of view of the relevant public, they are at least partially similar as regards one or more relevant aspects.

55 Moreover, at the hearing, EUIPO admitted that there were some similarities between the signs at issue reproduced in paragraph 35 above, although it maintained that what was involved here was a 'borderline situation' in which the degree of similarity required by the case-law was not attained. In that regard, however, it is important to bear in mind that, according to the case-law referred to in paragraph 19 above, the degree of similarity required by Article 8(5) of Regulation 2017/1001 is lower than that required by Article 8(1)(b) of that regulation and that the similarities pointed out in paragraphs 43 to 51 above, taken together, are sufficient to hold that there is a low degree of visual similarity between the sign in respect of which registration has been sought and the earlier mark relied on, which must be taken into consideration for the purposes of the application of Article 8(5) of Regulation 2017/1001.

56 It follows that the Board of Appeal erred in finding that the signs at issue reproduced in paragraph 35 above were visually dissimilar.

57 In the second place, as regards the phonetic comparison of the signs at issue reproduced in paragraph 35 above, it must be held that the Board of Appeal was right in finding that those signs are dissimilar. First, if the sign in respect of which registration has been sought is pronounced solely as the letter 'v', the Board of Appeal correctly pointed out, in paragraph 31 of the contested decision, that the letter 'v' is pronounced differently from the word element 'volvo' in the earlier mark relied on. In that case, the letter 'v' is pronounced by making the sound corresponding to that letter of the alphabet, whereas the word element 'volvo', which consists of the syllables 'vol' and 'vo', is pronounced in a continuous manner and has a different stress, intonation and rhythm.

58 Secondly, if the sign in respect of which registration has been sought is pronounced in the same way as its word element 'v-wheels', that pronunciation can also not be likened to that of the word element 'volvo' in the earlier mark relied on. Contrary to what the applicant submits, the syllables into which the signs at issue reproduced in paragraph 35 above can be broken down are pronounced differently. Consequently, even though some letters coincide, they are pronounced in a different order, with a different stress and rhythm.

59 Lastly, in the third place, as regards the conceptual comparison of the signs at issue reproduced in paragraph 35 above, it is sufficient to point out that the parties do not dispute the Board of Appeal's finding that such a comparison is not, in the present case, possible.

60 It must therefore be held that there is a low degree of visual similarity between the signs at issue reproduced in paragraph 35 above and that there is no phonetic similarity between them.

61 Furthermore, it should be borne in mind that the visual, phonetic and conceptual aspects of the signs at issue do not always have the same weight. The importance of elements of similarity or dissimilarity between the signs may depend, in particular, on the inherent characteristics of the signs or the conditions under which the goods or services covered by the marks at issue are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the goods themselves and must therefore rely primarily on the image of the trade mark applied to the goods, the visual similarity between the signs will, as a general rule, be more important. If, on the other hand, the goods covered are primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs. Accordingly, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives the mark designating those goods visually (judgment of 11 December 2014, *Coca-Cola* v *OHIM — Mitico (Master)*, T-480/12, EU:T:2014:1062, paragraph 68; see also, to that effect, judgment of 5 July 2016, *Future Enterprises* v *EUIPO — McDonald's International Property (MACCOFFEE)*, T-518/13, EU:T:2016:389, paragraph 32).

62 It follows that, by incorrectly finding that the signs at issue reproduced in paragraph 35 above were visually dissimilar, the Board of Appeal erred in not carrying out an assessment of the overall similarity of those signs and, consequently, in not carrying out an examination of all the other conditions for the application of Article 8(5) of Regulation 2017/1001 referred to in paragraphs 17 and 18 above.

63 The first plea in law must therefore be upheld.

64 In those circumstances, since a single relative ground for refusal, such as that set out in Article 8(5) of Regulation 2017/1001, is sufficient to preclude registration of the mark applied for and the Board of Appeal will have to examine the other conditions for the application of that article, the contested decision must be annulled in its entirety without it being necessary to examine the other pleas in law put forward by the applicant (see, to that effect, judgment of 27 October 2016, *Spa Monopole* v *EUIPO — YTL Hotels & Properties (SPA VILLAGE)*, T-625/15, not published, EU:T:2016:631, paragraph 71).

Costs

65 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

66 Since EUIPO has been unsuccessful, it must be ordered to bear its own costs and to pay the costs relating to the proceedings before the Court incurred by the applicant, in accordance with the form of order sought by the applicant.

67 Furthermore, since the applicant has claimed that EUIPO should be ordered to pay the costs incurred by the applicant in the proceedings before the Opposition Division and the Board of Appeal, it must be pointed out that, under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs, with the result that the applicant's claim in respect of those costs is admissible. However, that does not apply to costs incurred for the purposes of the proceedings before the Opposition Division. Accordingly, the applicant's claim regarding the costs relating to the proceedings before the Opposition Division, which do not constitute recoverable costs, is inadmissible (judgment of 20 September 2018, *Kwizda Holding* v *EUIPO — Dermapharm (UROAKUT)*, T-266/17, EU:T:2018:569, paragraphs 90 and 91).

On those grounds,

THE GENERAL COURT (Seventh Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 21 March 2018 (Case R 1852/2017-4);**

2. **Orders EUIPO to pay the costs, including the costs necessarily incurred by Volvo Trademark Holding AB for the purposes of the proceedings before the Board of Appeal of EUIPO.**

Tomljenović Bieliūnas Kornezov

Delivered in open court in Luxembourg on 24 September 2019.

E. Coulon
Registrar

V. Tomljenović
President