# JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
13 July 2005 *

In Case T-40/03,

**Julián Murúa Entrena,** residing in Elciego (Spain), represented by I. Temiño Ceniceros, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),** represented by I. de Medrano Caballero and G. Schneider, acting as Agents,

defendant,

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

* Language of the case: Spanish.

**Bodegas Murúa, SA,** established in Elciego, represented by J. González Aparicio, avocat,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 9 December 2002 (Case R 599/1999-2) concerning opposition proceedings between Bodegas Murúa, SA and Julián Murúa Entrena,

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

composed of H. Legal, President, P. Mengozzi and I. Wiszniewska-Białecka, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 10 February 2003,

having regard to the response lodged at the Court Registry on 7 August 2003,

having regard to the response of the intervener lodged at the Registry of the Court on 23 July 2003,

further to the hearing on 9 March 2005,

gives the following

## Judgment

### Background to the dispute

1 On 1 April 1996 the applicant applied for registration of 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 trade mark in respect of which registration was sought is the figurative sign reproduced below:



3 The goods in respect of which registration of the mark was sought are in Class 33 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 to the following description: 'wines'.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 14/97 of 11 August 1997.

5 On 10 November 1997 Bodegas Murúa, SA ('the intervener') filed a notice of opposition on the basis of Article 42 of Regulation No 40/94.

6 The ground relied on in support of the opposition was laid down in Article 8(1)(b) of Regulation No 40/94. The opposition was based on the existence of, first, the word mark MURÚA, registered in Spain on 20 December 1978 under No 865063 and, secondly, the international word mark MURÚA, registered on 20 March 1984 under No 482779 and protected in Germany, France, Austria, Switzerland and the Benelux countries. These trade marks both designate goods corresponding to the following description: 'all types of wine', in Class 33.

7 On 2 July 1999 the Opposition Division allowed the opposition and refused registration of the Community trade mark applied for.

8 On 30 November 1999 the applicant appealed to OHIM against the Opposition Division's decision.

9 By decision of 9 December 2002 ('the contested decision'), the Second Board of Appeal of OHIM upheld the Opposition Division's decision and dismissed the appeal.

10 The Board of Appeal essentially held that the conflicting trade marks designated identical goods and that the verbal element dominating the Community trade mark applied for, in so far as it contained the element 'Murúa' as the first surname, was identical to the intervener's earlier word marks, with the result that there was a likelihood of confusion between the conflicting trade marks.

**Forms of order sought by the parties**

11 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM and the intervener each to pay half of the costs.

12 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

## Law

13 The applicant raises a single plea in law, infringement of Article 8(1)(b) of Regulation No 40/94.

*Arguments of the parties*

14 After arguing in general terms that the principle, developed by case-law, of the interdependence between the similarity of goods and the similarity of trade marks may be disregarded in certain circumstances, the applicant alleges, first of all, that the Board of Appeal wrongly restricted its examination to the verbal element of the trade mark applied for and failed to make an overall comparison of the conflicting signs. In the applicant's opinion, the Board of Appeal made errors at three levels — visual, aural and conceptual — in the comparison of the conflicting signs.

15 As far as the visual comparison of the signs is concerned, the applicant points out that the trade mark applied for is a figurative mark comprising, in its upper part, a drawing showing a farmhouse surrounded by trees and vineyards and, in its lower part, a coat of arms surmounted by the words 'Julián Murúa Entrena'. In the view of the applicant, the presence of these figurative elements makes it possible to rule out a likelihood of confusion with the earlier mark. It is not therefore possible, in the applicant's opinion, simply to assess the verbal element of the trade mark applied for, as this would infringe — as in the contested decision — the principle of an overall comparison of the conflicting signs. The applicant also stresses that, in the wine sector, in accordance with Council Regulation (EC) No 1493/1999 of 17 May 1999 on the common organisation of the market in wine (OJ 1999 L 179, p. 1), the label has particular importance for the consumer as a means of identifying goods. The verbal element and the figurative elements of the trade mark applied for, which specifically constitute the labelling for the wine, must be regarded as a single whole.

16 As regards the aural comparison, the applicant observes that the conflicting signs are similar only in the presence of the word 'Murúa', the only verbal element in the earlier mark, whereas the trade mark applied for is composed of the first name and surnames 'Julián Murúa Entrena'. Whilst the applicant acknowledges that the first name 'Julián' is relatively common, he claims that the extremely uncommon combination of the surnames 'Murúa' and 'Entrena' has a unique and differentiated character that is aurally easy to distinguish. The applicant therefore rejects the assertion made by the Board of Appeal in paragraph 17 of the contested decision that, when confronted with a verbal element composed of a first name, in this case 'Julián', and two surnames, in this case 'Murúa' and 'Entrena', Spanish consumers tend to disregard the first name and the second surname. On the contrary, in a legal system such as exists in Spain, where a person's civil status is based on two surnames, the important factor, according to the applicant, is the distinctiveness of each of the components of the verbal element in question.

17 With respect to the conceptual comparison, the applicant believes that there are sufficient conceptual differences between the conflicting signs, since the trade mark applied for is, after all, composed of the applicant's own name. In this regard, and for the sake of completeness, the applicant considers that the intervener cannot appropriate the word 'Murúa' exclusively and, in doing so, prevent the applicant from using his surname. In support of this argument, the applicant cites Article 6(1) of First 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), as regards limitation of the effects of the trade mark, and the previous decision-making practice of OHIM.

18 Even though the applicant states that he is aware that decisions by national courts or tribunals are not binding on either OHIM or the Court of First Instance, he nevertheless draws the Court's attention to the facts that distinguish the present case from the one that gave rise to judgment No 559/1994 of the Tribunal Supremo (Spanish Supreme Court), which was delivered on 20 June 1994 in a case between the same parties. In particular, the applicant stresses that the Spanish national trade mark 'Julián Murúa Entrena', which was at issue in that case and was annulled by the

Tribunal Supremo, was composed solely of the abovementioned verbal elements, unlike the trade mark at issue in the present case, and claims that the Spanish legislation applied in that case is obsolete.

19 Lastly, even though the applicant accepts that the intervener bought some of the trade marks owned by it from the applicant's father, the applicant is surprised that it might be thought, as the intervener does, that there is a likelihood of confusion between trade marks which have coexisted peacefully in Spain, and in Denmark, for a long time. Furthermore, the applicant submits several documents annexed to his application which seek to demonstrate the existence of a large number of Spanish registrations all containing the word 'Murúa' which, in his view, highlight the possibility of the peaceful coexistence of the conflicting trade marks on the market. The applicant also annexes other documents to his application to show that many registrations coexist on the market in the wine sector even though they include verbal elements that are common to several of them.

20 As a preliminary point, OHIM notes that the documents annexed to the application which seek to demonstrate the alleged peaceful coexistence of many Spanish registrations including the word 'Murúa' are being submitted for the first time to the Court and are consequently inadmissible.

21 As to the substance, after pointing out that the Board of Appeal examined solely the likelihood of confusion between the conflicting trade marks on the part of Spanish consumers, OHIM rejects the applicant's claims.

22 OHIM argues, first of all, that, in the case of the trade mark applied for, the verbal element 'Julián Murúa Entrena' is the dominant element because of its preponderant position in the sign. On the other hand, OHIM takes the view that the figurative

elements that make up the sign have a decorative or accessory character in so far as they are commonly used on wine labels.

23 Having made this clarification, OHIM considers, secondly, that the comparison of the dominant verbal element of the trade mark applied for with the earlier trade mark reveals a certain visual similarity. Whilst OHIM shares the applicant's view about the particular importance of the label in the wine sector, the fact remains, in the view of OHIM, that consumers normally take the verbal element that identifies the wine as its distinctive sign.

24 As far as the aural comparison is concerned, although OHIM notes that the contested decision does not make any findings in this regard, it nevertheless considers that the conflicting signs are aurally similar.

25 As regards conceptual similarity, OHIM considers that, as a general rule, such similarity exists where the relevant public perceives the two conflicting signs to share an identical or similar semantic component. In the present case, according to OHIM, the conceptual element common to the two conflicting signs is the fact that they contain proper names and surnames of Spanish origin, which are recognised as such by the relevant public, since the name 'Murúa' is the predominant element in the verbal component of the trade mark applied for, while it is the only element of the earlier trade mark.

26 In addition, although OHIM recognises that, from the point of view of Spanish civil status, natural persons are identified by two surnames, the fact remains, in its opinion, that the first surname is predominant over the second, since the relevant public usually identify people solely by their first surname. In the view of OHIM, it

follows that there is a high degree of conceptual similarity between the two conflicting signs because the word 'Murúa' is present in those signs.

27 OHIM concludes that there is a likelihood of confusion between the two conflicting marks in view of the identity between the goods designated by the conflicting trade marks, which is not disputed by the applicant, and the similarity between the conflicting signs established by the contested decision. In particular, OHIM claims that consumers who are familiar with the wines designated by the earlier trade mark run the objective risk of believing the wine identified by the label including the name 'Julián Murúa Entrena' to be a new product from the same undertaking that markets the wines designated by the earlier trade mark. Furthermore, OHIM stresses that the applicant's comment that the principle of the interdependence of the similarity of the trade marks and the similarity of the goods does not apply in certain circumstances is irrelevant, since the applicant fails to substantiate these circumstances at all.

28 As regards the decision by the Tribunal Supremo, mentioned in paragraph 18 above, OHIM considers that although it is not bound by decisions given by national courts or tribunals, the matters of fact and of law on which the decision by the Tribunal Supremo is based may be helpful to the resolution of the dispute. In particular, OHIM considers, first, that this decision disproves the applicant's argument that the conflicting trade marks have coexisted peacefully in Spain and, second, it demonstrates the applicant's intention to seek to register the word sign which gave rise to the judgment of the Tribunal Supremo as a Community trade mark, this time as part of a figurative mark.

29 Lastly, OHIM also rejects the applicant's complaint alleging that the intervener appropriated his surname, stating, first, that the limitation of the effects of the trade mark is relevant only once the trade mark is registered. Second, OHIM takes the view that the free availability of proper names may be inferred from the information provided in the abovementioned judgment of the Tribunal Supremo, according to

which a surname must be examined with respect to likelihood of confusion where an economic operator wishes to use it as a trade mark. Consequently, according to OHIM, the Board of Appeal was right to take the view in the present case that the limitation of the effects of the trade mark did not have any effect on the assessment of the likelihood of confusion between the conflicting trade marks.

30 As a preliminary point, the intervener states that it became the proprietor of the earlier trade mark following a contract of transfer concluded under Spanish law with the applicant's father. The intervener therefore claims that the applicant cannot now interfere with the exclusive use of that trade mark. Moreover, the intervener disputes the applicant's claim that the earlier trade mark coexisted in Spain over a lengthy period with the earlier Spanish word mark of the applicant, Julián Murúa Entrena, which included the same verbal element as the trade mark applied for. All the facts on which the abovementioned judgment by the Tribunal Supremo, in a case between the same parties, was based indicate quite the contrary.

31 As regards the Board of Appeal's assessment based on a comparison of the conflicting signs, the intervener essentially concurs with the position expressed by OHIM. With regard to the importance of the first surname in the present case, it adds that in the past, for the period in which the applicant used the Spanish word mark Julián Murúa Entrena — before that mark was annulled by the judgment of the Tribunal Supremo — it never occurred to the applicant to use his second surname, whereas he employed his first surname on several occasions.

32 As far as the likelihood of confusion between the conflicting trade marks is concerned, the intervener points out that that likelihood is certainly real, since, in addition to the analysis by the Board of Appeal, which should be endorsed, that likelihood had already been recognised in the past. In this respect, the considerations set out by the applicant regarding the importance of labelling and the existence of trade marks that included the word 'Murúa' are irrelevant. With

respect to the first point, the intervener considers that the label, which is always produced after a trade mark has been registered, would, if the trade mark applied for were registered, be an additional factor of confusion, in so far as it showed not only the name of the trade mark proprietor but also the location of the company's registered office. In the present case, the locations of the applicant's and the intervener's registered offices are the same. The relevant public might therefore think that the goods designated by the conflicting trade marks come from the same undertaking or, as the case may be, from economically-linked undertakings. With respect to the second point, the intervener considers that the trade marks mentioned by the applicant are not relevant since they all designate goods other than wine, in respect of which there is in principle no obstacle to registration.

*Findings of the Court*

33 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

34 According to consistent case-law, the fact that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings constitutes a likelihood of confusion. According to the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the signs and of the goods or services in question and taking into account all factors relevant to the circumstances of the case, and in particular the interdependence between similarity of the signs and similarity of the goods or services (see Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 to 33, and the case-law cited).

35 It is clear from consistent case-law that the global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the conflicting signs, must be based on the overall impression given by the signs, bearing in mind, inter alia, their distinctive and dominant components (Case T-292/01 *Phillips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47, and the case-law cited).

The relevant public

36 In the present case, as far as the earlier trade marks are concerned, as was pointed out in paragraph 6 above, the opposition is based both on the word mark No 865063, registered in Spain, and on the international word mark No 482779, protected in Germany, France, Austria, Switzerland and the Benelux countries. The relevant public is therefore in principle the public in Spain, Germany, France, Austria, Switzerland and the Benelux states.

37 The existence of a likelihood of confusion need only be established on the part of the relevant public in one of the abovementioned Member States for the ground for refusal mentioned in Article 8(1)(b) of Regulation No 40/94 to apply.

38 However, it should be noted that the Board of Appeal only examined the similarity between the conflicting signs and the likelihood of confusion according to the perception of the Spanish public, drawing the implicit conclusion that the result of that examination applied to all the intervener's earlier 'trade marks'.

39 While it is not necessary to take a view on the lawfulness of such an approach, it should be stated that any consideration relating to the degree of similarity between the trade mark applied for and the intervener's earlier international trade mark could be relevant only in the event that, on the basis of the arguments relied on by the applicant, the Court, unlike the Board of Appeal, ruled out the existence of a likelihood of confusion on the part of the Spanish public between the trade mark applied for and the earlier trade mark registered in Spain.

40 It is therefore necessary to ascertain whether, as the applicant claims, in concluding that there was a likelihood of confusion between the conflicting trade marks on the part of the Spanish public, the Board of Appeal infringed Article 8(1)(b) of the regulation.

41 The subject-matter of the present case relates to the comparison of the signs. The identity of the goods covered by the conflicting trade marks is not contested.

The similarity of the signs

42 It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is also common ground that the first surname making up the verbal element of the trade mark applied for and the sole element of the earlier trade mark are identical.

43 The dispute therefore turns principally on whether, as the applicant claims, the presence of figurative elements, the first name and the second surname in the trade mark applied for suffices to rule out any likelihood of confusion on the part of Spanish consumers or whether, on the contrary, the presence of the word 'Murúa' in the trade mark applied for is the dominant element according to the perception of the relevant public, who will be liable to confuse the trade mark applied for with the earlier trade mark.

44 Before considering this issue, two comments should be made by way of introduction.

45 First, as regards the applicant's argument in relation to Article 6(1)(a) of Directive 89/104, it should be pointed out that that provision concerns the limitations of the right conferred by a national trade mark on its proprietor with respect to its use in the course of trade, among other things preventing the proprietor from prohibiting a third party from using his own name or address, provided he uses them in accordance with honest practices in industrial or commercial matters.

46 Account cannot therefore be taken of that provision during the procedure for registration of a Community trade mark because it does not, as the applicant seems to argue, entitle third parties to use their name or their address as a trade mark (see Case C-404/02 *Nichols* [2004] ECR I-8499, paragraph 33, and, with regard to Article 12 of Regulation No 40/94, Case T-20/02 *Interquell* v *OHIM — SCA Nutrition (HAPPY DOG)* [2004] ECR II-1001, paragraph 56).

47 Second, the case-law mentioned in paragraphs 34 and 35 above is fully applicable to an application for registration as a Community trade mark of a sign composed of one or more surnames.

48 It should be noted that under Article 4 of Regulation No 40/94 '[a] Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names ... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings'.

49 Consequently, an application for registration as a Community trade mark of a sign consisting, all or in part, of one or more personal names is subject to the criteria for assessment relating to registration that are applicable to other categories of trade marks. While such signs may constitute Community trade marks under Article 4 of Regulation No 40/94 provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings, none of the provisions of Regulation No 40/94 lays down criteria for assessment for the registration of signs of this kind that differ from the criteria for other signs capable of constituting a Community trade mark. Thus, just as it has been ruled that the criteria for assessment of the distinctive character of trade marks constituted by a personal name are the same as those applicable to the other categories of trade mark (*Nichols*, cited in paragraph 46 above, paragraph 25), the same must hold true for criteria for assessing the existence of a likelihood of confusion between a Community trade mark whose registration has been sought and an earlier trade mark within the meaning of Article 8(1)(b) of Regulation No 40/94, unless otherwise provided by that regulation (see, to that effect, Case T-185/03 *Fusco* v *OHIM — Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 45).

50 It follows that a sign containing the first name and surnames of a natural person may not be registered as a Community trade mark where this is precluded by a relative ground for refusal of registration following a notice of opposition lodged by the proprietor of an earlier trade mark.

51 In the light of these introductory statements, the applicant's argument that the Board of Appeal wrongly restricted the comparison of the conflicting signs to their verbal elements alone cannot be accepted.

52 It must be recalled that, according to the case-law, a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33, and Case T-117/02 *Grupo El Prado Cervera* v *OHIM — Héritiers Debuschewitz (CHUFAFIT)* [2004] ECR I-2073, paragraph 45).

53 That approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components (*MATRATZEN*, cited in paragraph 52 above, paragraph 34).

54 With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorily, account may be taken of the relative position of the various components within the arrangement of the complex mark (*MATRATZEN*, cited in paragraph 52 above, paragraph 35).

55 In the present case, it should be borne in mind that, in paragraph 17 of the contested decision, the Board of Appeal considered that the figurative element of the trade

mark applied for, showing a typical farmhouse surrounded by vineyards and trees, had a weak distinctive character for the goods covered by the trade mark applied for and that, as a result, the verbal element of that trade mark, namely 'Julián Murúa Entrena', dominated the overall impression created by the sign.

56 This assessment can only be endorsed. In the case of a product like wine, a representation of a farmhouse surrounded by vineyards and trees is not an element that allows the relevant public to perceive that figurative component as dominating the image they retain of the trade mark applied for. On the contrary, as OHIM has rightly claimed, consumers usually describe and recognise wine by reference to the verbal element which identifies it, since this element designates in particular the grower or the estate on which the wine is produced.

57 This assessment must be extended to the presence of the coat of arms below the verbal element of the trade mark applied for. In addition, it should be noted that, in view of the position and size of the representation of the coat of arms in the trade mark applied for, it is only a decorative element without any real meaning, as was stated by the Opposition Division. As a result, that element is not capable of dominating the mental image the relevant public will have of the trade mark applied for.

58 Furthermore, the complaint raised by the applicant that, because of the importance of wine labelling in the European Community, OHIM does not have the right to determine the dominant and distinctive elements of the trade mark applied for, is irrelevant.

59 It is true that under Regulation No 1493/1999 labelling is an essential means of designating the wines referred to by that regulation.

60 However, this does not mean that, for the purposes of the application of Regulation No 40/94, where the labelling includes a trade mark, such as a Community trade mark whose registration is sought, that trade mark cannot be subject, as part of opposition proceedings initiated pursuant to the regulation, to an examination by OHIM in order to determine its dominant and distinctive element or elements.

61 Moreover, it should be noted that the examination carried out by OHIM does not call into question the importance of labelling for purposes of consumer protection, an objective explicitly referred to in Regulation No 1493/1999. On the contrary, that examination contributes to their protection by making it possible to ensure that a trade mark contained in wine labelling cannot create a likelihood of confusion on the part of consumers, in particular regarding the identity of the natural or legal persons involved in the production or distribution of the product within the meaning of Article 48 of and point F of Annex VII to Regulation No 1493/1999.

62 In these circumstances, the applicant's first argument must be rejected.

63 The applicant also claims that the Board of Appeal was wrong in its view that, in the trade mark applied for, the first surname 'Murúa' was the dominant element of the group of words 'Julián Murúa Entrena'.

64 It should be noted that, in order to determine the dominant character of the surname 'Murúa' in the trade mark applied for, the Board of Appeal stated, in paragraph 17 of the contested decision:

'... in Spain, the first surname has particular importance in a trade mark composed of the first name and the surnames of its proprietor, since the average consumer usually omits the first name and the second surname. Consequently, the dominant element of the trade mark whose registration is sought and [that of the mark] on which the opposition is based are identical'.

65 The grounds of the decision by the Board of Appeal regarding the pre-eminence of the first surname in Spain are systematic in nature and should be qualified. It cannot be ruled out that, depending on the circumstances of each individual case, a sign composed of a first name and two surnames whose registration as a Community trade mark is sought could be distinctive for the Spanish public in particular because of the presence of the second surname, which will thus be the dominant element of the sign in question.

66 However, the Board of Appeal was correct in its view that in the present case the surname 'Murúa' lent the trade mark applied for its distinctiveness and was therefore its dominant element.

67 It should be noted, first, that the perception of signs made up of personal names may vary from country to country within the European Community (*ENZO FUSCO*, cited in paragraph 49 above, paragraph 52).

68 In the present case, the applicant has accepted that the first name 'Julián', which is contained in the word sign of the trade mark applied for, is relatively common in Spain and therefore does not have any particular distinctiveness.

69 As regards the question whether the relevant public in Spain will generally pay greater attention to the surname 'Murúa' than to the surname 'Entrena' in the trade mark applied for, the Court considers that, while it is not binding on Community bodies, Spanish case-law can provide a helpful source of guidance.

70 In this respect, account should be taken of judgment No 559/1994 of the Tribunal Supremo of 20 June 1994, delivered in a dispute between the parties to the present case, which was produced in the course of the administrative procedure before OHIM.

71 In that case, in a dispute between the applicant and the intervener, the Tribunal Supremo ruled that the word mark Julián Murúa Entrena, registered in Spain, which covered the same goods as those designated by the trade mark applied for, should be annulled because of the likelihood of confusion, on the part of the Spanish public, with the earlier word mark MURÚA, of which the intervener is the proprietor and on which the opposition before OHIM was also based. More specifically, the Tribunal Supremo held that it was clear from the later registration of the trade marks Viñas Murúa and Murúa that the surname 'Murúa' was the dominant element of that trade mark. The likelihood of confusion was demonstrated by the fact that, when they classified Rioja wines, persons unrelated to the defendant (the applicant in the present case), without its intervention, were confused between the

trade marks Murúa and Bodegas Murúa, SA, on the one hand, and Bodegas Murúa Entrena, SA, on the other, and perceived the wine designated by the trade mark Murúa as coming from both undertakings, as the defendant had acknowledged, while imputing the mistake to third parties. Against this background, the Tribunal Supremo ruled that 'since the word "Murúa" [was] the means of identifying the wines and it [was] this word that [had] led, upon the defendant's application, to the refusal to register the trade marks "Murúa Gangutia" and "Heredad Murúa Gangutia", it [was] clear that registration should also [have been] refused, at the administrative stage, in respect of the trade mark "Julián Murúa Entrena" and that it should now, at the judicial stage, be annulled'.

72 It must be considered that, unless shown otherwise, the perception that the relevant public has of the trade mark applied for can be no different from the perception, established by the Tribunal Supremo, that the same public had of the word mark Julián Murúa Entrena. Despite the presence of figurative elements in the trade mark applied for, as was held in paragraphs 56 and 57 above, they cannot dominate the image that the relevant public has of that trade mark.

73 Second, it should be noted that, visually, the word 'Murúa' is in the centre of the verbal element of the trade mark applied for and is vertically aligned with the figurative elements of the trade mark applied for, in particular with its heraldic elements. This design of the trade mark applied for tends to place emphasis on the surname 'Murúa' in relation to the first name and the second surname.

74 Third, while the verbal element of the trade mark applied for indeed differs aurally from the earlier mark through the presence of the first name 'Julián' and the

surname 'Entrena', as the applicant showed at the hearing by way of various examples of wine names, Spanish consumers do not generally say the full name of the wine, but will tend to abbreviate it. This fact, which was also highlighted by the Opposition Division, is sufficient to suggest that, aurally, Spanish consumers will generally tend to say the name of the trade mark applied for in abbreviated form, most often referring to the name 'Murúa', the applicant's first surname.

75 It follows that in the present case doubt should not be cast upon the assessment made by the Board of Appeal, and also shared by the Opposition Division, according to which the surname 'Murúa', the applicant's first surname, which makes up the word sign of the trade mark applied for, will dominate the Spanish public's image of that trade mark.

76 The Board of Appeal was therefore correct in its view that the conflicting signs are similar because the dominant element of the verbal sign of the trade mark applied for and the only element of the earlier trade mark are identical.

The likelihood of confusion

77 It is settled case-law that an assessment of the likelihood of confusion implies some interdependence between the relevant factors, in particular between similarity of the trade marks and similarity of the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of

similarity between the signs (see, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17, and, with regard to the application of Regulation No 40/94, *GIORGIO BEVERLY HILLS*, cited in paragraph 34 above, paragraph 32).

78 In the present case, it should be noted that, first, it is common ground that the goods covered by the conflicting trade marks are identical and, second, the conflicting signs are similar. This fact justifies the conclusion that there is a likelihood of confusion between the conflicting trade marks, since the average Spanish consumer, when confronted with a product bearing the trade mark applied for, is liable to regard that product as having the same commercial origin as a product bearing the earlier trade mark. Moreover, it should be stressed that it is also common ground that the surname 'Murúa', which is shared by the conflicting signs, has the same origin, namely the applicant's father, who transferred the earlier trade mark, registered in Spain, to the intervener. This fact reinforces the likelihood of Spanish consumers regarding the applicant's goods and the goods of the proprietor of the earlier trade mark as having the same commercial origin. For this same reason, it is also very possible, as OHIM claims, that the relevant public will regard the addition, in the trade mark applied for, of the first name and the surname 'Entrena' merely as a way to distinguish a range of wines produced by the undertaking that owns the earlier trade mark or, at least, an undertaking economically linked to the intervener.

79 This assessment cannot be called into question by the applicant's other arguments.

80 First, as regards the applicant's claim that the principle from case-law of the interdependence between the similarity of goods and the similarity of marks may be disregarded in certain circumstances, it need only be pointed out that, even assuming that it were possible to disregard the principle in such a way, the applicant has not provided any evidence in support of that claim.

81 Next, with regard to the documents annexed to the application, which seek to demonstrate the alleged peaceful coexistence of trade marks containing the word 'Murúa', it should be noted that those documents, relied on for the first time before the Court, are inadmissible, without its being necessary to assess their probative value (see, to that effect, Case T-247/01 *eCopy* v *OHIM (ECOPY)* [2002] ECR II-5301, paragraph 49, and Case T-129/01 *Alejandro* v *OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67). In any event, in so far as those documents related to the claim made by the applicant at the hearing that the Spanish word mark Julián Murúa Entrena and the earlier trade mark coexisted on the Spanish market, the fact remains that the annulment by the Tribunal Supremo of the applicant's abovementioned word mark, on grounds of a likelihood of confusion on the part of the Spanish public between that trade mark and the earlier trade mark, is enough to show that the alleged 'peaceful coexistence' of those trade marks was not a reality.

82 Most of the documents annexed to the application which seek to demonstrate the peaceful coexistence on the market in the wine sector of registrations which have common verbal elements should also be declared inadmissible, since they were relied on for the first time in the proceedings before the Court.

83 On the other hand, the documents annexed to the application relating to the surnames Faustino, Medrano and Palacios, which were relied on before OHIM, are admissible. However, they are irrelevant. The national registrations mentioned in those documents concern trade marks that bear no relation to the conflicting trade marks. Those documents and the arguments they are intended to support are thus irrelevant for the purposes of examining the likelihood of confusion between the conflicting marks in this case (see *BUDMEN*, cited in paragraph 81 above, paragraph 63).

84 Lastly, as regards the applicant's claim that the trade marks in question coexisted peacefully in Denmark, it need only be stated that that argument is irrelevant since the intervener's earlier trade mark is not protected in Denmark.

85 Since there is a likelihood of confusion in a Member State, in this case Spain, this is sufficient reason to refuse registration of the trade mark applied for, as was pointed out in paragraph 39 above. It is not therefore necessary to rule on the likelihood of confusion, accepted by the Board of Appeal, between the trade mark applied for and the earlier international trade mark protected in Germany, France, Austria, Switzerland and the Benelux countries.

86 Since the single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94, is not well founded, the action must be dismissed.

## Costs

87 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, 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 and OHIM and the intervener have asked for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

**1. Dismisses the action;**

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

Legal Mengozzi Wiszniewska-Białecka

Delivered in open court in Luxembourg on 13 July 2005.

H. Jung H. Legal

Registrar President