JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)
20 April 2005 *

In Case T-211/03,

Faber Chimica Srl, established in Fabriano (Italy), represented by P. Tartuferi and M. Andreano, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by M. Capostagno and O. Montalto, acting as Agents,

defendant,

* Language of the case: Italian.

the other party to the proceedings before the Board of Appeal of OHIM having been

Industrias Quimicas Naber, SA Nabersa, established in Valencia (Spain),

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 19 March 2003 (Case R 620/2001-4) concerning opposition proceedings between Faber Chimica Srl and Industrias Quimicas Naber, SA Nabersa,

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

composed of J. Pirrung, President, N.J. Forwood and S. Papasavvas, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Court Registry on 13 June 2003,

having regard to the response lodged at the Court Registry on 23 September 2003,

further to the hearing on 11 January 2005,

gives the following

Judgment

Background to the dispute

1 On 14 November 1997, the applicant filed an application under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).

2 The trade mark in respect of which registration was sought was the figurative mark Faber, as reproduced below:



3 The goods in respect of which registration was sought are in Classes 1, 2 and 3 of the Nice Agreement concerning the International Classification of Goods and Services

for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 1: 'Chemicals used in industry and science; unprocessed artificial resins; tanning substances; adhesives used in industry';

— Class 2: 'Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists';

— Class 3: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.

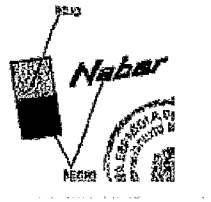
4 On 11 January 1999, that application was published in *Community Trade Marks Bulletin* No 2/1999.

5 On 12 April 1999, Industrias Quimicas Naber, SA Nabersa ('the opponent'), filed an opposition under Article 42 of Regulation No 40/94 against registration of the mark applied for, in respect of all goods covered by the trade-mark application. The ground relied on in support of the opposition was the likelihood of confusion referred to by Article 8(1)(b) of Regulation No 40/94. The opposition was based on

the existence of the following earlier national marks, of which the opponent is the proprietor:

— the verbal mark NABER, registered in Spain under No 801 202 for goods in Class 1 ('Chemicals and adhesives used in industry; decolourising agents; artificial and synthetic resins');

— the three figurative marks Naber, the graphic representation of which is reproduced below, registered in Spain under Nos 2 072 120, 2 072 121 and 2 072 122 to designate goods in Class 1 ('Chemicals used in industry and science (with the exception of those chemicals used in medical sciences), photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures (artificial and natural); fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry'), Class 2 ('Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists') and Class 3 ('Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use').



6 By decision of 23 April 2001, the Opposition Division rejected the opposition on the ground that there was no visual, aural or conceptual similarity between the marks at issue, nor therefore any likelihood of confusion between them.

7 On 25 June 2001, the opponent lodged an appeal with OHIM under Articles 57 to 62 of Regulation No 40/94 against the decision of the Opposition Division.

8 By decision of 19 March 2003 ('the contested decision'), notified to the applicant by letter of 3 April 2003, the Fourth Board of Appeal of OHIM firstly upheld the finding of the Opposition Division that there was no similarity between the mark applied for and the opponent's earlier figurative marks. Secondly, the Board of Appeal, having rejected the relevance, in the present case, of the conceptual aspect of the comparison, acknowledged that there was visual and aural similarity between the mark applied for and the opponent's earlier word mark and a similarity between the goods covered by those two marks. Consequently, the Board of Appeal upheld the appeal and partially annulled the decision of the Opposition Division.

Forms of order sought

9 The applicant claims that the Court should:

— annul or alter the contested decision to the extent that it finds that there is similarity, and therefore a likelihood of confusion, between the mark applied for and the opponent's earlier word mark;

— order OHIM to pay the costs, including those incurred in the course of the administrative procedure before OHIM;

— order, by way of a measure of inquiry, a technical expert's report to establish that the Spanish language precludes any phonetic similarity between the words 'naber' and 'faber'.

10 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

In law

Arguments of the parties

11 The applicant relies essentially on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

12 The applicant criticises the Board of Appeal for having reasoned in a contradictory manner in the contested decision by assessing the similarity between the mark applied for and the opponent's earlier marks differently, according to whether the latter were figurative or verbal. Thus, having correctly concluded that there is no likelihood of confusion between the mark applied for and the earlier figurative marks on the basis that the visual element of the signs at issue is decisive

(paragraphs 14 to 25 of the contested decision), the Board of Appeal erroneously concluded that there is such a likelihood of confusion between that mark and the opponent's earlier word mark, on the ground, in particular, that the the opponent's mark was 'capable of adopting any type of graphic representation' (paragraph 26 of the contested decision). By reasoning in this manner, the Board of Appeal incorrectly relied on a 'potential, hypothetical and future transformation' of the mark at issue.

13 As regards the comparison between the signs at issue in their current form, the applicant argues that there is no visual, aural or conceptual similarity between them, since, in its view, the visual aspect is to be regarded as predominant for the purposes of that comparison and, therefore, in the absence of any visual similarity, there can be no likelihood of confusion.

14 The applicant also calls into question the comparison between the goods covered by the marks at issue and the global assessment of the likelihood of confusion which were made in the contested decision. It also puts forward certain arguments with respect to the absence of actual competition on the market between the undertakings concerned and the absence of evidence of the reputation of the opponent's earlier marks in Spain.

15 OHIM contends that the contested decision is not vitiated by any contradiction or error of assessment. More specifically, the Board of Appeal correctly compared the mark applied for and the earlier marks by distinguishing the earlier marks according to their type, which has a significant influence on the overall impression produced by them. It is irrefutable that the earlier marks have different morphological characteristics which justify and even require a separate assessment and lead to different conclusions.

16 Moreover, the Board of Appeal was correct to take the view that the earlier word mark, having been registered independently of any specific graphic characteristic, could be used in different styles, so that it was not possible to rule out the use of a style which would make it similar, in actual use, to the mark applied for.

17 As regards the comparison between the signs at issue in the present case, more specifically from the visual perspective, OHIM submits that the Board of Appeal was correct to find that four out of the five letters constituting the suffix 'aber' are identical and that the letter 'F' at the beginning of the mark applied for has little impact, its specific stylisation reducing the extent to which it is immediately intelligible.

18 Secondly, as regards the aural aspect, OHIM agrees with the Board of Appeal's assessment which, while acknowledging the difference between the first letters 'F' and 'N' that the Opposition Division had wrongly deemed decisive, placed greater weight on the identity of the common final part 'aber'. That assessment is based on the effect of the vowels, the phonetic effect of which is generally greater than that of consonants, in particular in Romance languages such as Spanish. In the case of the two marks, the presence of the letter 'A' and of the suffix 'ber' creates an overall resonance that is greater than that of the first letter 'F' or 'N'.

19 OHIM also challenges the arguments by which the applicant calls into question the comparison between the goods covered by the marks at issue and the global assessment of the likelihood of confusion which were made in the contested decision. Likewise, OHIM disputes the applicant's arguments that there was no actual competition on the market between the undertakings concerned and no evidence of reputation of the opponent's earlier marks in Spain.

Findings of the Court

20 In accordance with 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 two 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.

21 According to settled case-law, the likelihood of confusion as regards the commercial origin of goods or services must be assessed globally, according to the perception in the mind of the relevant public of the signs and goods or services in question and taking into account all factors relevant to the circumstances of the case, and in particular the interdependence, as regards similarity, between the signs and the goods or services covered (see Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 29 to 33, and the case-law cited therein).

22 In the present case, the opponent's earlier word mark, the only one at issue in these proceedings, is registered in Spain, which is thus the relevant territory for the purposes of Article 8(1)(b) of Regulation No 40/94.

23 As regards the definition of the relevant public in the present case, it should be noted, as the Board of Appeal has done (paragraph 31 of the contested decision), that the goods covered by the opponent's earlier word mark fall within Class 1 and are intended essentially for industrial customers ('Chemicals and adhesives used in industry; decolourising agents; artificial and synthetic resins').

24 Account should therefore be taken, for the purposes of the global assessment of likelihood of confusion, of the point of view of the relevant public, essentially industrial consumers in Spain. As businesses, they are likely to take greater care than the average consumer in the selection of the goods in question (see, to that effect, Case T-224/01 *Durferrit* v *OHIM — Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 52, and Case T-317/01 *M+M* v *OHIM — Mediametrie (M+M EUROdATA)* [2004] ECR II-1817, paragraph 52).

25 In light of those considerations, it is appropriate to examine the comparison by the Board of Appeal, first, of the signs at issue and, second, of the goods in question.

26 As regards, first, the comparison of the goods at issue, it should be pointed out, in general terms, that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects. As the case-law of the Court of Justice indicates, the visual, aural and conceptual aspects are relevant (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25). It is also clear from that case-law that the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant elements.

27 Furthermore, contrary to the applicant's contention that the visual aspect is to be regarded as predominant, the Court of Justice has held that it is possible that mere aural similarity between trade marks may create a likelihood of confusion (see, to that effect, *Lloyd Schuhfabrik Meyer*, cited in paragraph 26 above, paragraph 28, and Case T-99/01 *Mystery Drinks* v *OHIM — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 42).

28 In the present case, it is apparent from the contested decision that the signs at issue were regarded as similar by the Board of Appeal following a visual and aural analysis. Furthermore, it is common ground (see paragraph 16 of the contested decision, which was not challenged by the applicant in this action) that, since the signs at issue are meaningless in Spanish, they are not comparable conceptually.

29 As regards, first of all, the visual comparison, the Board of Appeal started from the principle that a word mark is 'capable of adopting any type of graphic representation' (paragraph 26 of the contested decision). According to OHIM's written pleadings, the Board of Appeal thereby envisaged the possibility of future use of the opponent's word mark in a stylised form that would make it graphically similar to the mark applied for.

30 The applicant submits that by reasoning in that manner, the Board of Appeal incorrectly relied on a 'potential, hypothetical and future transformation' of the mark at issue. According to the applicant, the comparison should, on the contrary, be made in relation to the sign as it currently appears, and not by speculating on future modifications which bear no relation to the current global assessment. The applicant adds that if the opponent were to modify the graphics of its mark in the future, it would result in another, unprotected, distinctive sign that its clients would no longer recognise and which could therefore no longer indicate the commercial origin of its goods.

31 OHIM counters by saying that the assessment criteria used by the Board of Appeal is well known and generally applied, as the registration of a purely word mark confers on its proprietor an exclusive right that is not limited to a predefined stylistic configuration of the sign. It does not in any way prejudice the finding of a likelihood of confusion made by the Board of Appeal in the present case. *A contrario*, figurative marks are, by nature, exclusively protected in the exact morphology covered by their registration. In the present case, it is precisely the 'fixed nature' of their morphology

which makes it possible to distinguish the opponent's earlier figurative marks in such a way as to preclude any likelihood of confusion with the mark applied for.

32 In that regard, the Court points out that in the present case the visual comparison must be made between a word mark, comprising the word 'naber', and a complex figurative mark, including both a word element, namely the word 'faber', and a graphic element. That complex figurative mark is described as follows in the trade-mark application:

'Name FABER written in lower case block letters, where the upper horizontal stroke of the letter F is extended surmounting the whole name and curves down above the vertical stroke of the letter R without touching it, and where the lower horizontal stroke of the letter F crosses the vertical stroke of the same letter F and is extended, curving down towards the bottom, then underlines the whole name, finally curving up to finish in front of the horizontal stroke of the letter R, without touching it, the whole name and the extensions being written in an ellipse'.

33 As OHIM correctly states on its internet site, a word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. On the other hand, a figurative mark is a specific representation of word or graphic characteristics or a combination of word and graphic elements, whether or not in colour. A complex figurative mark consists of two or more categories of signs, combining, for example, letters and graphics, as in the case of the mark applied for in this instance.

34 In light of those preliminary considerations, neither the reasoning of the applicant nor that of OHIM may be followed.

35 On the one hand, the applicant fails to appreciate the characteristics of the earlier word mark by seeing in it only a particular type of figurative mark, which is fixed in a particular morphology. Furthermore, the applicant makes a second error by failing to take account of the word element of the complex mark applied for.

36 On the other hand, OHIM appears to confer a graphic element on the word mark which, by definition, it does not have. In addition, OHIM adopts a truncated approach by justifying the protection conferred on the earlier word mark by its capacity to imitate, in the future, the particular form of the complex mark applied for.

37 In order to assess the similarity between a complex figurative mark and an earlier word mark, the particular graphic or stylistic aspects that the earlier mark might adopt are irrelevant. In any event, the assessment of the similarity with the earlier word mark, which is the only relevant assessment in the present case, should not be replaced by an assessment of similarity with a figurative element which does not form part of the protection conferred by the earlier registration.

38 In fact, it is not because an earlier word mark may adopt a written form in the future which would make it identical or similar to a complex mark applied for that the latter mark must be refused registration, but because the complex mark is in fact made up, in addition to an unusual figurative aspect, of a word element identical or similar to that comprising the earlier mark, and that, as part of the global assessment of the likelihood of confusion, that word element cannot be regarded as subsidiary in relation to the other component of the sign (see, *a contrario*, the reasoning of the Court of First Instance in Case T-110/01 *Vedial* v *OHIM — France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 50 et seq.).

39 Thus, in the present case, it is appropriate to begin by analysing the visual similarity between the word elements 'naber' and 'faber'; then, if such a similarity is found, to ascertain whether the additional graphic or figurative element, specific to the mark applied for, is capable of constituting a distinguishing feature sufficient to preclude any visual similarity between the signs at issue in the eyes of the relevant public (see, to that effect, *HUBERT*, cited in paragraph 38 above).

40 As regards, first of all, the visual comparison of the purely word elements 'faber' and 'naber', it is true that those two words share the four letters 'aber'. However, as the Board of Appeal states at paragraph 18 of the contested decision, the fact that there is an element common to the two marks being compared does not mean that that element is necessarily the most striking in both marks. The assessment of their similarity will thus depend essentially on how much importance is attached to the first letter, which distinguishes the two marks from one another, in comparison with the last four letters, which they share not only with one another, but also, according to the information provided by the applicant during the administrative procedure, with a large number of other marks present on the Spanish market (see paragraph II of the decision of the Opposition Division and paragraph 4 of the contested decision). Having regard to that latter factor, the balance is not clearly in favour of either view. It must therefore be concluded that there is a certain visual similarity between these two signs, but that it does not appear to be particularly decisive.

41 As regards, secondly, consideration of the additional figurative element specific to the mark applied for, the Court agrees with the assessment of the Opposition Division, according to which that element is not secondary, since it 'consists of an invented construction requiring a conceptual effort of construction'. More specifically, the Opposition Division stated that '[the] first letter "F" is highly stylised since it covers, firstly, the whole of the word element in its upper part and secondly the bar of the "F" underlines the word element by passing round underneath it before finishing up against the bar of the final letter "R"'. Moreover, the ellipse in which that construction is enclosed strongly accentuates its particular figurative aspect.

42 At paragraph 27 of the contested decision, the Board of Appeal also acknowledged the 'significant figurative aspect' of the mark applied for.

43 Those two assessments, taken together, in the global assessment of visual similarity, lead the Court to find that the additional graphic or figurative element which is specific to the mark applied for is capable of constituting a distinguishing feature sufficient to preclude visual similarity between the signs at issue in the eyes of the relevant public, which consists of professionals.

44 The Board of Appeal was thus wrong to conclude, at paragraph 27 of the contested decision, that the signs at issue are similar, notwithstanding the 'significant figurative aspect' of the mark applied for, on the ground that the 'aber' at the end was 'clearly discernible' in it.

45 The Court also emphasises the contradiction, which the applicant has also pointed out, between that latter assessment and that set out at paragraph 21 of the contested decision, according to which the 'aber' at the end 'is not particularly distinguishable' in the mark at issue.

46 As regards the aural comparison, the Opposition Division had observed, firstly, that the public notices the first letter more because of its position at the start, and, secondly, that the sound 'F' is clearly distinct from the sound 'N'. According to the Opposition Division, that difference alone was enough to preclude any phonetic similarity between the conflicting marks.

47 By contrast, at paragraph 22 of the contested decision, the Board of Appeal held that that difference was not decisive. It stated that, phonetically, the words are divided

into syllables, and that within a syllable, particularly in Spanish, the intensity of the voice increases on vowels, in accordance with the phenomenon of accentuation. In the present case, in the initial syllable of the words 'naber' and 'faber', the letter 'A' is consequently more resonant than the initial consonant. Moreover, since the second syllable 'ber' is identical in the two words, the Board of Appeal found that there was a certain phonetic resemblance between the conflicting signs.

48 The Court of First Instance considers that there is indisputably a certain phonetic resemblance between the conflicting signs and that there is no need to resort to the expert's report which the applicant requests in order to refute that argument. However, even taking into account the phenomenon of accentuation relied on by OHIM, that resemblance does not suffice to neutralise the phonetic distinction brought about by the first letter, since, as the Opposition Division stated, the sounds produced by the consonants 'F' and 'N' are clearly distinct.

49 First, the consonant 'F' is unvoiced, that is to say that the vocal cords do not vibrate when the sound is uttered, unlike the consonant 'N' which is voiced. Second, the consonant 'F' is fricative, that is to say that when it is uttered it produces an impression of friction, whereas the consonant 'N' is nasal, in other words, when it is uttered it produces an impression of resonance.

50 Having regard to the fact that the relevant public is a specialised public, with a greater level of attention than that of the average consumer, that phonetic difference between the two signs, and above all the marked visual difference resulting from the significant figurative aspect specific to one of the signs are sufficient for a finding, following a global assessment, that the signs constituting the marks at issue, each considered as a whole and taking into account in particular their distinctive and dominant elements, are not similar.

51 It follows from the foregoing that one of the essential conditions for applying Article 8(1)(b) of Regulation No 40/94 has not been satisfied. with a with a

52 It is therefore necessary to uphold the plea of infringement of Article 8(1)(b) of Regulation No 40/94 and to grant the form of order sought by the applicant, and there is no need to compare the goods at issue or to examine the other arguments of the applicant.

Costs

53 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.

54 Pursuant to Article 136(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of proceedings before the Board of Appeal are regarded as recoverable costs.

55 Since OHIM has been unsuccessful, it must be ordered to pay the costs, including the costs necessarily incurred by the applicant in the proceedings before the Board of Appeal, in accordance with the form of order sought by the applicant.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 19 March 2003 (Case R 620/2001-4) in so far as it upholds the opposition of the proprietor of the Spanish word mark NABER;**

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

Pirrung Forwood Papasavvas

Delivered in open court in Luxembourg on 20 April 2005.

H. Jung J. Pirrung

Registrar President