JUDGMENT OF THE COURT OF FIRST INSTANCE (Sixth Chamber)

18 December 2008 *

In Case T-287/06,

Miguel Torres SA, established in Vilafranca del Penedés (Spain), represented by E. Armijo Chávarri, M. Baz de San Ceferino and A. Castán Pérez-Gómez, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Mondéjar Ortuño and J. García Murillo, acting as Agents,

defendant,

* Language of the case: Spanish.

the other party to proceedings before the Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), intervener before the Court of First Instance, being

Bodegas Peñalba Lopez SL, established in Aranda de Duero (Spain), represented by J. Calderón Chavero, T. Villate Consonni and M. Yañez Manglano, lawyers,

ACTION brought against the decision of the Second Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) of 27 July 2006 (Case R 597/2004-2) relating to opposition proceedings between Miguel Torres SA and Bodegas Peñalba Lopez SL,

THE COURT OF FIRST INSTANCE

OF THE EUROPEAN COMMUNITIES (Sixth Chamber),

composed of A.W.H. Meij (Rapporteur), President, D. Šváby and V. Vadapalas, Judges,

Registrar: K. Andová, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 11 October 2006,

having regard to the response lodged by OHIM at the Registry of the Court on 30 January 2007,

having regard to the response lodged by the intervener at the Registry of the Court on 22 January 2007,

having regard to the altered composition of the Chambers of the Court of First Instance,

having regard to the designation of another judge to complete the Chamber as one of its members was prevented from sitting,

further to the hearing on 10 January 2008,

gives the following

Judgment

Background to the dispute

1 On 1 June 1999 Ms Maria del Pilar Pérez Albéniz Iglesias filed an application for registration of a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) ('OHIM'), under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark (OJ 1994 L 11, p. 1), as amended.

2 The mark in respect of which registration was sought is the following figurative sign:



3 The goods and services in respect of which registration was sought are in Classes 32, 33 and 39 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 32: 'Beers; mineral and aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages';

— Class 33: 'Wines';

— Class 39: 'Storage, distribution, transport; warehousing, packing and packaging of various goods'.

4 In the course of proceedings before OHIM the trade mark application was transferred to the intervener, Bodegas Peñalba López SL. The intervener restricted the application to goods in Class 33 and services in Class 39.

5 The application was published in *Community Trade Marks Bulletin* No 72/2000 of 11 September 2000.

6 On 11 December 2000 the applicant, Miguel Torres SA, filed a notice of opposition against the Community trade mark application, pursuant to Article 8(1)(b) of Regulation No 40/94.

7 The opposition was based on the following earlier registrations:

— Community registration No 2783 on 1 February 1999 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Community registration No 376681 on 27 September 1999 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Community registration No 376947 on 14 September 1999 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Community registration No 462267 on 3 February 1999 of the word mark VIÑA LAS TORRES for goods in Class 33 (alcoholic beverages (except beers));

— Community registration No 466839 on 1 February 1999 of the word mark GRAN TORRES for goods in Class 33 (alcoholic beverages (except beers));

— Community registration No 466896 on 12 February 1997 of the word mark TORRES 10 for goods in Class 33 (alcoholic beverages (except beers));

— Community registration No 466912 on 1 February 1999 of the word mark 5 TORRES for goods in Class 33 (alcoholic beverages (except beers));

— Spanish registration No 2234398 on 20 September 1999 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Spanish registration No 18132 on 7 January 1911 of the figurative mark represented below for goods in Class 33 (wines):



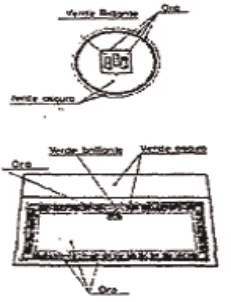
— Spanish registration No 35802 on 8 April 1920 of the figurative mark represented below for goods in Class 33 (brandies, eaux-de-vie and liqueurs (except wines)):



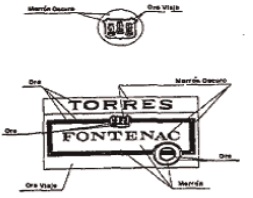
— Spanish registration No 149441 on 13 October 1947 of the figurative mark represented below for goods in Classes 30, 32 and 33 (wines, oenology, musts, beers and vinegars):



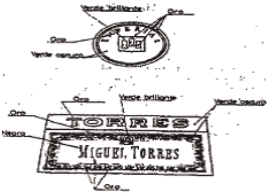
— Spanish registration No 1677345 on 5 October 1992 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers) and in particular brandy):



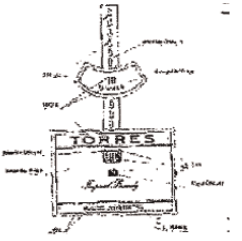
— Spanish registration No 1751690 on 20 July 1993 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers) and in particular brandy):



— Spanish registration No 1677346 on 3 March 1995 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers) and in particular brandy):



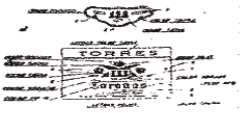
— Spanish registration No 1718386 on 5 April 1994 of the figurative mark represented below for goods in Class 33 (brandy):



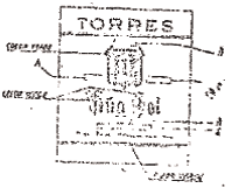
— Spanish registration No 1787982 on 3 April 1996 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Spanish registration No 397808 on 11 May 1963 of the figurative mark represented below for goods in Classes 1, 30, 32 and 33 (sparkling wines, œnology, wines, musts, beers, vinegars and tartaric acid for treatment of wines):



— Spanish registration No 400056 on 17 January 1963 of the figurative mark represented below for goods in Class 33 (all types of wines, except extra dry white table wines with characteristics similar to those of the Rhine):



— Spanish registration No 529931 on 2 September 1968 of the figurative mark represented below:



— Spanish registration No 592542 on 21 September 1971 of the figurative mark represented below for goods in Class 33 (wines):



— Spanish registration No 592543 on 8 January 1972 of the figurative mark represented below for goods in Class 33 (wines):



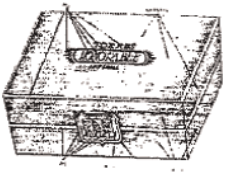
— Spanish registration No 1119998 on 20 June 1986 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Spanish registration No 1119999 on 5 February 1987 of the figurative mark represented below for goods in Class 33 (wines):



— Spanish registration No 1172809 on 5 January 1989 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers)):



— Spanish registration No 1938607 on 5 March 1996 of the figurative mark represented below for goods in Class 33 (alcoholic beverages (except beers) and in particular brandy):



— Spanish registration No 715533 on 11 November 1976 of the figurative mark represented below for goods in Class 33 (spirits and liqueurs):



— United Kingdom registration B 857391 on 3 December 1963 of the figurative mark represented below for goods in Class 33 (wines):



— Irish registration B 87182 on 17 July 1974 of the figurative mark represented below for goods in Class 33 (wines):



— Swedish registration No 238430 on 31 July 1992 of the figurative mark represented below for goods in Class 33 (all goods, inter alia, wines, sparkling wines, brandy and liqueurs):



— Finnish registration No 33633 on 22 August 1977 of the figurative mark represented below for goods in Class 33 (wines, alcohols and liqueurs):



— United Kingdom registration No 113347 on 17 October 1995 of the figurative mark represented below:



— Danish registration No 1373 on 11 April 1964 of the figurative mark represented below:



8 The opposition was based on all the goods covered by the earlier rights and was directed solely against the goods 'wines' in Class 33 and covered by the trade mark applied for.

9 By decision of 18 May 2004 and on the basis of a comparison between the mark applied for and the earlier Community figurative mark TORRES No 2783 ('the earlier mark'), the Opposition Division upheld the opposition, considering that there was a likelihood of confusion between the marks at issue by reason of the fact that the goods covered by those marks were identical, that there were a number of similarities, both visual (representation of a tower and the word 'torres') and aural (the syllables 'to' and 'rre') and that the earlier mark was well known.

10 On 16 July 2004 the intervener brought an appeal against the decision of the Opposition Division.

11 By decision of 27 July 2006 ('the contested decision') the Second Board of Appeal of OHIM annulled the decision of the Opposition Division, on the ground that the condition of similarity between the marks at issue was not satisfied and that consequently there was no likelihood of confusion between them.

12 In that regard, the Board of Appeal held, inter alia, that the fact that the word 'torre' is placed first in the mark applied for did not make that word dominant as compared with the other elements of that mark. The mark applied for is distinctive because of the logical and conceptual unit formed by the combination of the two words, 'torre' and 'albéniz', and the latter word, because it gives the tower an individual identity, is dominant in that mark (paragraphs 28 and 29 of the contested decision). The Board of Appeal also held that while the fact that an earlier mark is well known may strengthen its distinctiveness, that fact does not, in all circumstances, make more distinctive an identical or similar element in a compound mark to the extent that that element

becomes the dominant component in the overall impression produced by the compound mark, where that element forms with the other components an indivisible logical and conceptual unit which can be entirely distinguished from and cannot be associated with the earlier mark which is well known (paragraph 30 of the contested decision). Next, the Board of Appeal held that the overall impression produced by the marks at issue was different, that the phonetic coincidence of the element 'torre' was offset by the element 'albéniz' and that, conceptually, the perception of the relevant public will vary according to whether or not it is familiar with the meaning of the word 'torre'. For those who understand the meaning of that word, there will be a conceptual difference, while for those who do not perceive any meaning in the word 'torre', the conceptual similarity is of little relevance (paragraphs 35 to 37 of the contested decision).

Forms of order sought by the parties

13 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

14 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

15 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

Arguments of the parties

16 In support of its action the applicant relies on a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94.

17 The applicant claims that the Board of Appeal made three errors when applying the rules set out by the case-law relating to the interpretation of that provision. First, the Board took no account of the fact that the earlier marks were well known when it determined which element in the mark applied for was dominant and when it examined whether there was a likelihood of confusion. Second, the Board did not base that

examination on the perception of the relevant public (the average consumer in the European Union) but solely on the perception of a minority group of consumers (Spanish, Italian and Portuguese consumers). Third, the Board took no account of the fact that the applicant's marks were a 'family of marks' or a 'series of marks'.

18 That plea in law is based on four arguments. The first is that the fact that the TORRES sign is well known throughout the European Union adds to the distinctiveness of the element which is common to the signs at issue and which is thereby dominant. Secondly, having regard to their distinctive and dominant elements, the signs at issue can be seen to be phonetically and visually similar and alike. Thirdly, the fact that the TORRES sign is well known, added to the fact that the goods are identical, strengthens the *ius prohibendi* of the earlier marks in the assessment of the likelihood of confusion. Fourthly, the likelihood of confusion is increased by the existence of a 'family of marks' containing the word 'torres' and the graphic element of one or more towers.

19 As regards the first argument, the applicant claims, in the first place, that, given that the TORRES sign is well known and well established throughout the European Union, the element 'torre' in the mark applied for is perceived by the relevant consumer as the dominant element in the overall impression produced by that mark.

20 The applicant refers to Spanish case-law and academic writing and claims that, just as the fact that an earlier mark is well known strengthens its protection and its distinctiveness, that fact also strengthens the distinctiveness of the identical or similar element in a mark applied for when that mark is a compound mark.

21 Secondly, the applicant considers that the Board of Appeal's assertion that the mark applied for is an indivisible logical and conceptual unit is valid solely in Spain, Portugal and Italy, countries where the meaning of the marks at issue is understood or may be understood. In other countries where the TORRES marks are also registered the words 'torre' and 'albéniz' have no specific meaning and only with difficulty therefore can they be regarded as forming a unique logical and conceptual unit.

22 The applicant emphasises, on that point, that the Board of Appeal's position on the logical and conceptual unity of the mark applied for is inconsistent with the position taken by the Board in paragraph 29 of the contested decision where it was said that the word 'albéniz' gave individuality to the tower it designates and therefore played a dominant and distinctive role in the mark applied for. The vast majority of relevant consumers will not understand the meaning of that word and will not associate it with the Spanish musician Albéniz.

23 Thirdly, the applicant claims that the argument that the earlier mark is not identical to the word 'torre' because of the absence of the letter 's' in the latter is weak, since the letter 's' marks the plural, but in no way alters the meaning of the noun.

24 Lastly, the applicant considers that while the position of one component of a compound mark is not a decisive criterion for the determination of the dominant element, positioning always plays a role in the assessment of consumers who know the word 'torres' or who are familiar with it. Those consumers will tend to abbreviate the mark applied for and pay attention essentially to the word 'torre'. The fact that the earlier TORRES marks are well known and that the word 'torre' is placed first in the mark applied for will lead the relevant consumer to pay particular attention to that word ('torre').

25 As regards the second argument, the applicant's actual comparison of the signs at issue is based, in the interests of procedural economy, on those compared by the Opposition Division and by the Board of Appeal in their respective decisions; the applicant's conclusion is that the signs at issue are phonetically similar and visually alike, and that there are no conceptual differences which can cancel out those similarities.

26 Visually, the applicant claims that, given the particular nature of wine, the overall impression given by trade marks for that product is essentially determined by their word elements, figurative elements being of secondary importance. Consequently, the similarity between the marks at issue caused by the common word element 'torre(s)', is not cancelled out by the graphic element (the representation of a tower) contained in the mark applied for. On that latter point, the applicant refers to the case-law of the Court in support of the claim that almost all labels on beverages within Class 33 present in the market contain decorative elements which can be remembered only with difficulty when the product is asked for.

27 The applicant then claims that the representation, in the mark applied for, of a tower features in all the applicant's earlier marks, and that some of them contain, like the mark applied for, the representation of a single tower. Moreover, the applicant points out that the figurative element itself reinforces the common word element 'torre(s)' through the representation of the image of a tower.

28 Phonetically, the applicant observes that the mark applied for contains almost all of the earlier mark, with the single difference of the final letter 's'. It claims that the coincidence of the syllables 'to' and 'rre(s)', accentuated by their being placed first in the two marks at issue, gives them an attractiveness greater than that of the syllables 'al', 'bé' and 'niz'. Moreover, the syllables 'to' and 'rre(s)' are those which the relevant consumer finds most difficult to pronounce, because of the double 'r', and therefore those which one would reasonably expect to capture his attention the most.

29 The applicant claims that the conceptual difference does not cancel out either the phonetic, or, to a lesser extent, the visual similarities between the marks at issue. To the extent that the majority of relevant consumers (Austrian, German, Netherlands, United Kingdom, Belgian, Danish, French consumers, and so on) do not know the meaning of the word 'torre' or of its plural 'torres', the conceptual comparison of the signs is of little importance. The only possible conceptual significance of the signs at issue in those countries is, clearly, that of the earlier mark, for the reason that it is established, well known and present in the relevant countries and because 'torres' is the word which indicates the commercial origin of the goods concerned.

30 On that point, the applicant adds that, while it is true that, for Spanish, Italian and Portuguese consumers, the conceptual element is a factor of relevance to the comparison of the marks at issue, the conceptual perception of that group of consumers, whatever it may be, has no effect on how the perception of the marks by the vast majority of consumers is to be assessed. The applicant refers to the Court's case-law and claims that, as a general rule, the existence of a likelihood of confusion in one part of the European Community is enough to permit the application of Article 8(1)(b) of Regulation No 40/94.

31 Lastly, the applicant refers to the Court's case-law in support of the submission that, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar within the meaning of Article 8(1)(b) of Regulation No 40/94.

32 As regards the global assessment of the likelihood of confusion, the applicant considers, first, that recognition of the fact that the TORRES sign is well known throughout the European Union means that the TORRES marks have greater protection and stronger

distinctiveness, that there is a greater likelihood of confusion and that comparison of the earlier mark with the mark applied must be carried out with greater rigour.

33 Secondly, the fact that the goods covered by the marks at issue are identical adds force to the assessment that the signs at issue are similar and alike, since those marks are present in the same sector of production, marketing and consumption.

34 Further, the applicant claims that it is impossible to assert, as did the Board of Appeal, that a consumer of wine is a specially qualified consumer who can distinguish trade marks with no difficulty, because wine is a product consumed by people from all sections of society and of various levels of education. There are specially qualified consumers, but there are others who buy a wine because the trade mark is familiar to them.

35 Furthermore, the Board of Appeal should not refuse to accept the effect of judgments by Spanish courts in cases analogous to the present case.

36 Lastly, the applicant claims that the likelihood of confusion between the mark applied for and the applicant's well known marks has been acknowledged at Community level, in an analogous case, where the question arose as to whether the TORRES marks and the appellation of origin consisting of the phrase 'torres vedras' could coexist.

37 In addition, and irrespective of the outcome of the comparison between the mark applied for and the earlier marks, the applicant claims that the existence of a 'family of marks' or of a 'series of marks' containing the word element 'torres' and the representation of one or more towers increases the likelihood of confusion between the marks at issue.

38 Those marks are all constructed on the basis of two common elements: the word 'torres' and the representation of one or more towers; some also contain an additional element in order to identify the particular product in question. The applicant thereby emphasises the fact that the element 'torre' and the representation of a tower in the mark applied for naturally encourage the consumer to regard that mark as belonging to the applicant's family of marks.

39 The applicant refers to Case T-194/03 *Il Ponte Finanziaria* v *OHIM* — Marine Enterprise Projects (BAINBRIDGE) [2006] ECR II-445 and considers that it has established the two conditions necessary to permit recognition of the effect of a family of marks on the likelihood of confusion, namely, first, the use and presence on the market of all the marks belonging to the family on which the opposition is based and, second, the existence in the mark applied for of the fundamental element which identifies the family of marks.

40 OHIM and the intervener do not accept the applicant's arguments.

Findings of the Court

41 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 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.

42 According to established case-law, the risk that the relevant public might believe that the goods or services covered by the marks at issue come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. The likelihood of confusion must be assessed globally on the basis of the perception that the relevant public has of the signs and the goods or services in question and taking into account all factors relevant to the circumstances of the case ([Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case T-162/01 *Laboratorios RTB* v *OHIM* — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS) [2003] ECR II-2821, paragraphs 30 and 31]).

43 That global assessment takes account, in particular, of awareness of the mark on the market, and of the degree of similarity between the marks and between the goods or services covered. In that respect, it implies some interdependence between the factors taken into account, so that a low degree of similarity between the goods or services covered may be offset by a high degree of similarity between the marks, and vice versa (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

44 Further, the perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25). For the

purposes of that global assessment, the average consumer of the goods concerned is deemed to be reasonably well informed and reasonably observant and circumspect. Account should also be taken of the fact that the average consumer's level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, paragraph 26).

45 In the present case, the relevant public comprises the average consumers of the Member States in which the earlier sign is protected.

46 The identity of the goods in question is not disputed by the parties.

47 It is clear from the 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 components (see judgment of 11 July 2006 in Case T-247/03 *Torres* v *OHIM — Bodegas Muga* (*Torre Muga*), paragraph 45 and case-law cited).

48 Further, according to established case-law, a compound trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the compound mark, unless that component forms the dominant element within the overall impression created by the compound 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. (see *Torre Muga*, paragraph 46 and case-law cited).

49 However, 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 (see *Torre Muga*, paragraph 47 and case-law cited).

50 In the present case, the earlier mark consists of the word 'torres', written in capital letters and positioned above a coat of arms on which are represented three towers, whereas the mark applied for consists of the representation of one tower under which appears the phrase 'torre albéniz', written in italics and in a particular letter font.

51 For the purposes of comparison of the signs at issue, the applicant has put forward various arguments designed to establish that the word 'torre' constitutes the dominant element in the mark applied for. In light of the relevance of that factor to the assessment of the signs' similarity, those arguments must be examined before a comparison of the signs at issue is undertaken.

The dominance of the element 'torre' in the mark applied for

52 In relation to the effect which recognition of the fact that the TORRES sign is well known might have on identification of the dominant element in the mark applied for and, consequently, on the similarity of the marks at issue, the fact that an earlier mark is

well known may, in an appropriate case, strengthen the distinctiveness of the identical or similar element in a compound mark with the result that that element becomes its dominant element.

53 However, that does not apply in the present case.

54 As regards, first, the applicant's claim that, due to the fact that the earlier TORRES marks are well known throughout the European Union and that the word 'torre' is placed first in the mark applied for, the relevant consumer will pay particular attention to that word and will disregard the other components of the mark applied for, it must be stated that, while, in order to assess the dominant character of one or more components of a complex trade mark, account may, accessorily, be taken of the relative position of the various components within the arrangement of such a mark (Case T-6/01 *Matratzen Concord* v *OHIM* — Hukla Germany (MATRATZEN) [2002] ECR II-4335, paragraph 35), the relative position does not, in all circumstances, make one element of a mark dominant while removing all significance, in the overall impression, from the other elements which are components of that mark (*Torre Muga*, paragraph 50).

55 In the present case, the fact that the word 'torre' is placed first in the mark applied for does not mean that the word placed second, namely 'albéniz', is insignificant in the overall impression produced by that mark, in particular phonetically and conceptually. On the contrary, the decisive factor in the distinctiveness of the mark applied for is the combination of the words 'torre' and 'albéniz', which form, together, a unique logical and conceptual unit. Consequently, even if the earlier mark was well known, the existence of the other components of the mark applied for cannot be ignored.

56 There is no basis for the proposition that the average consumer who is reasonably well informed and reasonably observant and circumspect will systematically disregard the second part of the word element of a mark to the point of remembering only the first part, as claimed by the applicant.

57 That is more particularly true in the alcoholic beverages sector, where consumers are accustomed to the practice of goods being designated by marks which include several word elements (*Torre Muga*, paragraphs 52 and 53).

58 In the present case, the earlier well known TORRES sign is not identical to the element 'torre' in the mark applied for, since that element does not end with the letter 's'. Further it must be noted that, first, the word element 'torre' in the mark applied for is commonly used to designate the goods concerned and, secondly, that word is combined with the element 'albéniz' in such a way that they form together a logical and conceptual unit which has a decisive effect on the capacity of the mark applied for to distinguish the goods which it designates. Given those factors, it cannot be held that the word 'torre' renders the other components of the compound mark insignificant in the overall impression produced by the mark, even though that element has some degree of similarity with the highly distinctive TORRES sign (see, to that effect, *Torre Muga*, paragraph 57).

59 As regards, next, the alleged inconsistency between, on the one hand, the Board of Appeal's finding that the expression contained in the mark applied for forms a unique logical and conceptual unit and, on the other hand, the Board's finding that the word 'albéniz' occupies a dominant and distinctive position in the mark applied for, it must be held that the relevant public will perceive the mark applied for as a syntactic unit, irrespective of the understanding of that term. For that part of that public, more particularly Spanish, Portuguese or Italian, which understands the meaning of those words or expression, it is probable that the word 'torre' is less important and that the

second part of the mark applied for, which introduces a specific feature and evokes a place or a person, is more dominant.

60 In light of the foregoing, it must be held, for the purposes of the comparison of the signs at issue, that the Board of Appeal did not err in law by declining to hold that the word 'torre' was the dominant element in the impression produced by the mark applied for.

The visual similarity

61 Visually, while comparison of the signs at issue reveals a coincidence of the first five letters of the single element in the TORRES sign and the element 'torre' in the mark applied for, the Board of Appeal was correct to find that the overall visual impression produced by each of the signs at issue was different.

62 First, the element 'torre' in the mark applied for is not identical to the TORRES sign, since the latter ends with the letter 's' indicating a plural.

63 Next, while the earlier mark is composed of the word 'torres', written in capital letters and positioned above a coat of arms on which are represented three towers, the mark applied for consists of the representation of one tower beneath which appears the expression 'torre albéniz', written in italics and in a particular letter font.

64 While it may be considered, as is claimed by the applicant, that in the mark applied for the figurative element is of secondary importance as compared with the word element, which is much more likely to differentiate the designated goods and to attract the consumer's attention, it is clear that in the mark applied for the word element 'torre albéniz' alone is, on any view of the matter, sufficiently distinct from the TORRES sign to ensure that, visually, the differences as perceived by the consumer are greater than the similarities. That conclusion is not affected by the fact, relied on by the applicant, that the public's attention will focus as least as intensely on the first part of the word element of the mark applied for as on its second part.

The phonetic similarity

65 Phonetically, the earlier sign consists of a single word, composed of two syllables 'to' and 'rres', whereas the mark applied for comprises two words representing a total of five syllables, namely 'to', 'rre', 'al', 'bé' and 'niz'. That being the case, the fact that the mark applied for contains almost all of the earlier mark, except for the last letter 's', cannot outweigh the phonetic differences between the signs when each is considered as a whole. It must therefore be held that the Board of Appeal was correct to decide that the signs at issue were, phonetically, clearly different.

66 That assessment cannot be invalidated by the applicant's other arguments on this point.

67 Even though it cannot be denied that one part of the two marks at issue is clearly similar, it remains the case that that fact is cancelled out by manifest phonetic differences

between the two signs, whether in the number of syllables to be pronounced or in the presence of the word 'albéniz'.

68 The Court must therefore reject the applicant's argument that the coincidence of the syllables 'to' and 'rre(s)', allegedly accentuated by their being placed first in the two marks at issue, gives them a greater attractiveness, further enhanced by the fact that the syllables 'to' and 'rre(s)' are more difficult to pronounce than the other word which is a component of the mark applied for. As stated in paragraph 55 above, the words 'torre' and 'albéniz' form a unique logical and conceptual unit. No evidence has been produced to support the conclusion that that unit is likely to have significantly less strength when it is pronounced. Further, the applicant has in no way substantiated the argument that the syllables 'to' and 'rre(s)' are those which are the more difficult, for the relevant consumer, to pronounce, because of the double 'r'. On that point, it must be stated that words containing a double 'r' are found in the majority of the relevant countries and, consequently, it has not been established that pronunciation of that sound is difficult. In addition, pronunciation of the syllable 'bé', in the word 'albéniz', is clearly stressed and could not go unnoticed in the phonetic whole produced by pronunciation of the mark applied for. The same is true of the last syllable 'niz'.

The conceptual similarity

69 As regards the conceptual similarity, a distinction must be made between the impression produced by the signs at issue in countries where consumers know the meaning of the word 'torre', namely Spain, Italy and Portugal, and the impression produced in other countries.

70 As regards countries where consumers know the meaning of the word 'torre', the Board of Appeal has not erred by holding that the ideas suggested by the word 'torres' and the expression 'torre albéniz' are different. Whereas the word 'torres' evokes, at least for the Spanish public, the idea of towers, in the plural, the second word of the mark applied for is associated with the famous Spanish musician. While there is some degree of similarity, the frequent use of the word 'torre' to designate the goods in question in Spain, Italy and Portugal will none the less cause consumers in those countries not to overlook the element 'albéniz' in the mark applied for and, consequently, to be more alert to the conceptual difference between the signs at issue.

71 On the other hand, in countries where the meaning of the word 'torre' is not known, the conceptual similarity is of limited relevance, as is pointed out by both the applicant and OHIM.

72 In that regard, the applicant claims that the majority of European consumers do not understand the meaning of the word 'torre' and that it is impossible to hold, on the basis of the perception of a minority of the intended public, that there are conceptual differences between the signs at issue. It must however be observed that the fact that the conceptual comparison of the signs at issue is of limited relevance in the majority of European Union countries does not preclude account being taken of the conceptual differences between the signs at issue in countries where the meaning of that word is known by the public.

73 In light of the foregoing, it must be held that the Board of Appeal was right to conclude that the differences between the signs at issue prevailed, visually and phonetically, for all the consumers concerned, and, conceptually, for the Spanish, Italian and Portuguese public. It is clear from the comparison of the signs at issue that the overall impression produced by them is different. The mere coincidence of the first five letters of the earlier

sign and the element 'torre' in the mark applied for does not alter the finding that, in the overall impression, the differences between the signs are greater than the weak points of similarity.

The overall assessment of likelihood of confusion

74 In light of the differences between the signs at issue, the Board of Appeal was correct to hold that there was no likelihood of confusion between them, notwithstanding the fact that the goods concerned were identical. When making an overall assessment of the marks at issue, the visual, aural and possible conceptual differences between the signs at issue are sufficient, in spite of the identity of the goods designated and the fact that they belong to the same sector of production and marketing, to preclude the resemblances between the signs at issue from giving rise to a likelihood of confusion in the mind of the average consumer (see, to that effect, *Torre Muga*, paragraph 71 and case-law cited).

75 The fact that the TORRES sign is well known in all the relevant countries cannot call in question that conclusion. While there is established case-law that the more distinctive the earlier mark, the greater will be the likelihood of confusion, it must be emphasised that a likelihood of confusion presupposes that the signs are identical or similar. The fact that a mark is well known is one factor which, far from giving rise, in itself, to a likelihood of confusion, must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a likelihood of confusion (see *Torre Muga*, paragraph 72 and case-law cited).

76 In the present case, although the Board of Appeal recognised that the TORRES sign was well known in Spain, or even in the other Member States where it is protected, the comparison of the signs at issue none the less revealed that the overall impression produced by the mark applied for was very different from that produced by the earlier mark. That being the case, the high distinctiveness of the earlier sign resulting from the public's knowledge of it on the market cannot, by itself, disturb the conclusion that there is no likelihood of confusion.

77 That conclusion is also not affected by the applicant's argument referring to the appellation of origin containing the expression 'torres vedras', to the effect that the Community legislature more specifically recognised that a name made up of the words 'torres' and 'vedras' could be confused with the TORRES marks, in spite of the presence of the second word, 'vedras', and accordingly inserted Article 23a in Commission Regulation (EEC) No 3201/90 of 16 October 1990 laying down detailed rules for the description and presentation of wines and grape musts (OJ 1990 L 309, p. 1) in order to avoid that possibility. In that regard, the legislation to which the applicant refers deals with provisions relating to quality wines produced in specific regions ('quality wines p.s.r.') and provisions on the description and presentation of wines, more particularly labelling. However, while it is true that the Community legislature recognised a possible risk of confusion with a number of well known marks when a new quality wine in the 'quality wines p.s.r.' category appears and therefore states how the name of the specific region must be specified on the label, the applicant's reference to that fact is, all the same, not a serious argument that there was a likelihood of confusion in the present case and that, therefore, a mark applied for containing the word 'torre' was not to be registered.

78 Lastly, as regards the applicant's criticism that the Board of Appeal denies any effect to the judgments of Spanish courts, it must be recalled that the legality of decisions of the

Boards of Appeal must be assessed solely on the basis of Regulation No 40/94 as interpreted by the Community Courts (Case T-36/01 *Glaverbel* v *OHIM* (Surface of a sheet of glass) [2002] ECR II-3887, paragraph 34).

The argument based on the alleged existence of a 'family of marks'

79 As regards the applicant's argument that its earlier marks constitute a 'family of marks' or a 'series of marks', which can increase the likelihood of confusion with the mark applied for, such a possibility was recognised in BAINBRIDGE and confirmed in Case C-234/06 P *Il Ponte Finanziaria* [2007] ECR I-7333.

80 According to that case-law, there can be said to be a 'series' or a 'family' of marks when either those earlier marks reproduce in full the same distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of the same prefix or suffix taken from an original mark (BAINBRIDGE, paragraph 123). In such circumstances, a likelihood of confusion may be created by the possibility of association between the trade mark applied for and the earlier marks forming part of the series where the trade mark applied for displays such similarities to those marks as might lead the consumer to believe that it forms part of that same series and therefore that the goods covered by it have the same commercial origin as those covered by the earlier marks, or a related origin. Such a likelihood of association between the trade mark applied for and the earlier marks in a series, which could give rise to confusion as to the commercial origin of the goods identified by the signs at issue, may exist even where the comparison between the trade mark applied for and the earlier marks, each taken individually, does not prove the existence of a likelihood of direct confusion (BAINBRIDGE, paragraph 124). When there is a 'family' or a 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the

provenance or origin of goods or services covered by the trade mark applied for and considers erroneously that that trade mark is part of that family or series of marks (*Il Ponte Finanziaria*, paragraph 63).

81 However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied. First, the earlier marks forming part of the 'family' or 'series' must be present on the market. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That might not be the case, for example, where the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content (BAINBRIDGE, paragraphs 125 to 127).

82 In the present case, first of all, the common element of the earlier word and figurative marks on which the opposition is based comprises the word 'torres' and/or the representation, in various forms, of a number of towers, which in almost all cases, as the applicant confirmed at the hearing, are three in number. It follows that the constant element in the earlier marks, both in word form and figuratively, is the presence of a number of towers.

83 Next, apart from the word in the plural, 'torres', and/or the representation of three towers, the earlier marks do not have, in a particular and unvarying form, any characteristics capable of leading the relevant consumer to associate the mark applied for with all of the earlier marks, conceived as a 'family' or 'series' of marks, and, therefore, to be mistaken as to the provenance or origin of the goods covered by that mark. In fact, both in its word form and figuratively, the Torre Albéniz sign can be

distinguished from the earlier marks by its individuality as described above, and in particular by the distinctive addition of the element 'albéniz'.

84 Consequently, since the second condition referred to in paragraph 81 above is not satisfied, the applicant's argument based on the existence of a family of earlier marks must be rejected, and, that being the case, it is unnecessary to determine whether the earlier marks are present on the market. It follows that the Board of Appeal was right to hold that it could not be considered that the word 'torre' might be perceived by the relevant consumer as being connected with the family of TORRES marks.

85 It follows from all of the foregoing that the Board of Appeal did not err by holding that there was no likelihood of confusion between the signs at issue.

86 Consequently, 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, it must be ordered to pay the costs, in accordance with the form of order sought by OHIM and the intervener.

On those grounds,

THE COURT OF FIRST INSTANCE (Sixth Chamber)

hereby:

1. Dismisses the action;

2. Orders Miguel Torres SA to pay the costs.

Meij Šváby Vadapalas

Delivered in open court in Luxembourg on 18 December 2008.

[Signatures]