OPINION OF ADVOCATE GENERAL MAZÁK

delivered on 3 February 2009 [1]

1. By its appeal, Aceites del Sur-Coosur SA, formerly Aceites del Sur SA ('the appellant') asks the Court to set aside the judgment of the Court of First Instance in *Koipe* v *OHIM — Aceites del Sur (La Española)*. [2] The decision of the Fourth Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 11 May 2004 [3] was altered by the Court of First Instance, which found that the appeal brought by Aceites Carbonell, now Koipe Corporación SL ('Koipe') before the Board of Appeal was well founded and, consequently, that its opposition was to be upheld.

I — Legal background

2. Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [4] provides:

'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

…

(b) 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'

1 — Original language: English.

2 — Case T-363/04 [2007] ECR II-3355 ('the judgment under appeal').

3 — Case R 1109/2000-4 ('the contested decision').

4 — OJ 1994 L 11, p. 1.

3. Article 8(2) of Regulation No 40/94 provides:

'For the purposes of paragraph 1, "earlier trade marks" means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) Community trade marks

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office …'

II — Background to the dispute

4. On 23 April 1996, the appellant filed an application for a Community figurative mark at OHIM ('the mark applied for' or 'the La Española mark') which is depicted below:



5. On 23 November 1998, the trade mark application was published in *Community Trade Marks Bulletin* No 89/98. On 23 February 1999, Koipe filed a notice of opposition to the registration of the mark applied for in respect of all the goods it covered. Koipe relied on the likelihood of confusion, as provided for in Article 8(1)(b),

(2)(c) and (5) of Regulation No 40/94, between the mark applied for and Koipe's earlier figurative mark Carbonell ('the earlier mark' or 'the Carbonell mark'), depicted below:



6. The Opposition Division of OHIM held that Koipe had successfully established the existence of only three Spanish registrations and a Community registration in respect of 'olive oil' ('the earlier Spanish marks'). [5] The Opposition Division rejected Koipe's opposition in Decision No 2084/2000, of 21 September 2000.

7. On 19 January 2001, Koipe filed an appeal before OHIM against the decision of the Opposition Division. On 11 May 2004, the Fourth Board of Appeal of OHIM dismissed the appeal by adopting the contested decision and, following the approach reflected in the Opposition Division's decision, confirmed that the visual impression produced by those signs was different overall. It observed that the figurative elements, consisting essentially of the image of a person seated in an olive grove, had only a weak distinctive character with respect to olive oil, the effect of which was to confer the utmost importance on the word elements 'la española' and 'carbonell'. As regards the comparison of the signs from a phonetic and conceptual point of view, it held that Koipe had not denied the complete absence of similarity between the word elements, and the weakness of the conceptual link between the signs at issue. Finally, it acknowledged that the Opposition Division should have given a ruling on the reputation of the earlier Spanish marks. However, it took the view that that assessment, together with the examination of the documents produced before the Board of Appeal to establish that reputation, were not strictly necessary since one of the pre-conditions for determining a likelihood of confusion with a mark which has a reputation or is well known, that is the existence of a similarity between the signs, was, in any event, not satisfied.

5 — As evidence of the existence of the earlier mark, Koipe had relied on six Spanish registrations, Community registration No 338 681, two international registrations and Irish, Danish, Swedish and United Kingdom national registrations.

III — The proceedings before the Court of First Instance and the judgment under appeal

8. On 31 August 2004, Koipe brought an action before the Court of First Instance for the annulment of the contested decision. In support of its claim, Koipe alleged (i) infringement of Article 8(1)(b) of Regulation No 40/94, and (ii) infringement of the obligation to examine the evidence of the reputation of the earlier mark.

9. First, the Court of First Instance noted that the parties were in dispute as to the registrations which had to be taken into consideration in order to determine whether the right of opposition claimed by Koipe existed or not. OHIM and the appellant argued that, since the date on which Community registration No 338681 ('Koipe's Community mark') was filed by Koipe was later than the date on which the Community mark applied for was filed, the Board of Appeal should not have taken it into consideration. The Court of First Instance considered, however, that that question was irrelevant and held that '… the contested decision is based essentially on the lack of similarity between the figurative element of the Carbonell mark and that of the mark applied for. The figurative element of the Carbonell mark is identical in all the registrations relied on by Koipe, both in those taken account of by the Board of Appeal and in those which it excluded'. [6]

10. The Court of First Instance proceeded to examine Koipe's first plea, in which it claimed that the contested decision infringed Article 8(1)(b) of Regulation No 40/94 by failing to take account of the fact that, at first sight, the marks at issue were similar overall and could therefore give rise to confusion on the market, and of the fact that the goods designated by the mark applied for were identical to the goods designated by the earlier mark.

11. Thus in paragraphs 75 to 78 of the judgment under appeal, the Court of First Instance stated that, in the contested decision, the Board of Appeal merely noted, in order to substantiate its findings relating to the weak distinctive character of the figurative elements of the marks at issue, that they were common place in the olive oil sector. The figurative elements consisted essentially of a person seated in a pastoral setting, more specifically, in an olive grove. However, the Court of First Instance considered that the Board of Appeal did not provide any details as to the reasons for its findings that the figurative elements had a weak distinctive character, nor did it mention any mark other than those in dispute, containing figurative elements similar to the marks at issue. In paragraph 87 of the judgment under appeal, the Court of First Instance therefore held that the Board of Appeal was wrong to conclude in the contested decision that the figurative elements of the marks at issue had a weak distinctive character.

12. In addition, the Court of First Instance held that the Board of Appeal was incorrect to hold that the comparison of the word elements of the marks at issue was of overriding importance in this case in the light of the weak distinctive character of the figurative elements of those marks, even though the word element of the La Española mark has in itself only a low degree of distinctive character. [7]

6 — See paragraph 48 of the judgment under appeal.

7 — See paragraphs 88 and 89 of the judgment under appeal. In paragraphs 92 and 93 of the judgment under appeal, the Court of First Instance stated that 'OHIM itself [had] maintained a position contrary to that which it [defended] in these proceedings', as it had found in other opposition proceedings that 'the expression "la española" had only a weak distinctive character, because it was a common brand name in the food sector, and suggested a reference to the geographical origin of the goods'.

13. With regard to similarity of the marks and the likelihood of confusion, in paragraph 103 of the judgment under appeal the Court of First Instance held that 'the elements common to the two marks at issue, seen as a whole, produce an overall visual impression of great similarity, since the La Española mark reproduces very precisely the essence of the message and the visual impression given by the Carbonell mark: the woman dressed in traditional clothes, seated in a certain manner, close to an olive branch with an olive grove in the background, the overall image consisting of an almost identical arrangement of spaces, colours, places for brand names and style of lettering'. The Court of First Instance considered that that overall similar impression inescapably gave rise on the part of the consumer to a likelihood of confusion between the marks at issue which was not diminished by the existence of the different word element since the word element of the mark applied for had a very weak distinctive character, as it referred to the geographical origin of the goods. [8]

14. Therefore, the Court of First Instance considered that the Board of Appeal was wrong to conclude that any likelihood of confusion between the marks at issue was excluded. On the contrary, it followed from all of the findings of the Court of First Instance that there was a likelihood of confusion between the marks. [9] Consequently, the Court of First Instance accepted the first plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94, and, considering that there was no need to examine the second plea in law, the Court of First Instance held that the contested decision had to be altered. [10]

IV — The appeal

15. The appellant raises two grounds in support of its appeal. The first ground of appeal and the first complaint under the second ground of appeal should be assessed jointly.

A — *The first ground of appeal and the first complaint under the second ground of appeal*

16. By its *first ground of appeal*, the *appellant* claims that the Court of First Instance erred in holding that, in determining whether Koipe's opposition is well founded, the question of which registrations must be taken into consideration is irrelevant. The judgment under appeal should have excluded Koipe's Community mark on the ground that it is not an earlier mark within the meaning of Article 8(2)(a)(i) of Regulation No 40/94. The only relevant marks were thus the earlier Spanish marks. Therefore, the question whether a likelihood of confusion exists between the mark applied for and the earlier

8 — See paragraphs 104 and 105 of the judgment under appeal.
9 — See paragraph 112 of the judgment under appeal.
10 — See paragraphs 113 and 114 of the judgment under appeal.

Spanish marks falls to be assessed by reference solely to the public in Spain, which is where Koipe's earlier marks are protected, and not the public throughout the territory of the Community.

17. *Koipe* and *OHIM* maintain, in substance, that the appellant is giving unwarranted importance to the wording of paragraphs 47 and 48 of the judgment under appeal. They submit essentially that the analysis by the Court of First Instance of the existence of a likelihood of confusion between the marks at issue was carried out, at every stage, solely in relation to the Spanish territory and market.

18. In its *first complaint under the second ground of appeal*, the *appellant* maintains that, in not identifying the earlier marks correctly, the Court of First Instance improperly delimited the relevant public and territory for the purposes of assessing the likelihood of confusion.

19. *Koipe* and *OHIM* maintain essentially that in the context of the assessment of a likelihood of confusion between the marks at issue, the Court of First Instance correctly limited the analysis of the relevant public and territory to Spain.

1. Appraisal

20. I consider that the appellant is correct in arguing that the Court of First Instance erred in law when it failed to delimit precisely the earlier marks to be taken into account in the present case. In particular, the Court of First Instance did not expressly exclude Koipe's Community mark from the marks to be taken into account on the ground that that mark was not an earlier mark within the meaning of Article 8 of Regulation No 40/94. [11]

21. However, the error in question would not appear to have had any decisive bearing on the categorisation of the relevant public or, for that matter, on the result of the judgment under appeal. [12] Indeed, it is apparent from the judgment under appeal that the Court of First Instance did not refer to any public or territory other than the Spanish public and the Spanish territory.

22. It follows that the first ground of appeal and the first complaint under the second ground of appeal should be rejected as unfounded.

11 — In that it postdates the application of 23 April 1996 for the mark applied for.

12 — See, to that effect, Case C-94/02 *Biret* v *Council* [2003] ECR I-10565, paragraph 63.

B — *The second complaint under the second ground of appeal*

23. By the *second complaint under the second ground of appeal*, the *appellant* maintains that, in spite of the fact that the case-law provides that 'the likelihood of confusion must … be appreciated globally, taking into account all factors relevant to the circumstances of the case', [13] in the judgment under appeal, the Court of First Instance failed to consider two extremely important and pertinent factors, namely: (i) the marks' earlier co-existence over a long period and (ii) the reputation of the mark applied for and the earlier Spanish marks.

24. Secondly, the appellant considers that the judgment under appeal examined the marks at issue not on the basis of the criterion of a 'global assessment' or 'overall impression', but took a separate, successive and analytical approach to the constituent elements of the compound marks, thereby infringing Article 8(1)(b) and the case-law interpreting it. Thus, in giving the figurative elements a decisive weight and denying any importance to the word elements of the mark, the Court of First Instance distorted the facts and evidence in the file.

25. Thirdly, according to the appellant and OHIM the Court of First Instance did not correctly assess the relevant public in that it established the profile of the average Spanish consumer of olive oil as a consumer who is closer to the model of the average consumer used under German case-law, namely 'a careless and rash consumer', rather than the model European consumer defined by Community case-law who is 'reasonably well informed and reasonably observant and circumspect'. [14] In addition, the judgment under appeal assumes a lower level of attention by consumers with regard to marks of olive oil, instead of assuming the level of attention normally paid to olive oil by the average Spanish consumer who is reasonably well informed and reasonably observant and circumspect.

26. *Koipe*, however, submits that the Court of First Instance applied the criterion of global assessment in an appropriate manner, since it correctly assessed the existence of a likelihood of confusion, taking into account all the relevant factors in the case, including the fact that while the marks had co-existed on the Spanish market they had not done so peacefully. Indeed, according to the case-law on the matter, not all the constitutive elements of a mark bear the same value or importance. Consequently, the fact that the Court of First Instance decided to treat the figurative element as being decisive, concluding that there existed a likelihood of confusion between the marks at issue, while none the less taking account of the word element, does not infringe Community trade mark case-law. The Court of First Instance did not deviate from the established criteria

13 — See Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22, and Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-643, paragraph 18.

14 — Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26.

concerning the assessment of such a likelihood. As regards the appellant's arguments concerning the allegedly incorrect categorisation of the Spanish consumer of olive oil, Koipe submits that these are mere factual allegations which are inadmissible at the appeal stage.

27. *OHIM* considers, first of all, that the fact that the Court of First Instance failed to take into account the co-existence of marks in the relevant territory and the reputation of the mark applied for in Spain did not have a decisive bearing on the outcome of the judgment under appeal. Secondly, OHIM maintains that the Court of First Instance carried out the comparison between the signs at issue on the basis of figurative elements only, given the insignificant character of the other factors, but leaves the resolution of that point to the discretion of the Court and merely indicates two possible outcomes of the appeal.

1. Appraisal

28. As regards the appellant's argument concerning the question of co-existence of the marks at issue, it is apparent from the documents before the Court that such co-existence of those marks as there has been has been far from 'peaceful'. It appears that the owners of the Carbonell mark brought a number of court actions against the La Española mark in which they sought the annulment or refusal of registration of that mark [15] before, inter alia, the Spanish courts.

29. It appears from the documents and observations submitted before the Court that in substance the Spanish courts consistently decided in favour of the appellant's line of argument and thus allowed a situation in which the marks at issue were effectively permitted to co-exist on the Spanish market. [16] In my view, even if one assumes that the co-existence of the marks on the Spanish market has been established, the appellant has not properly established that such co-existence was based upon the absence of a likelihood of confusion. [17]

30. Secondly, as to the question of reputation, it is sufficient to recall that in principle it is the earlier trade mark's reputation and not that of

15 — On the basis of the similarity of the figurative representation of the marks at issue.

16 — In a number of judgments, the Court of First Instance has held that a possibility that the co-existence of the marks on the market may eventually lessen the risk of confusion cannot be entirely dismissed. See Case T-31/03 *Grupo Sada* v *OHIM — Sadia (GROUPO SADA)* [2005] ECR II-1667, paragraph 86; judgment of 25 October 2006 in Case T-13/05 *Castell del Remei* v *OHIM — Bodegas Roda (ODA)*; and judgment of 11 December 2007 in Case T-10/06 *Portela & Companhia* v *OHIM — Torrens Cuadrado and Sanz (Bial)*.

17 — Thus it has not been established that the relevant public is aware that the marks at issue belong to different undertakings.

the mark applied for which should be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to a likelihood of confusion. [18]

31. In my view, in the judgment under appeal the Court of First Instance failed to assess the relevance of the co-existence of the marks and reputation of the mark applied for with respect to the likelihood of confusion. However, in the light of my findings at points 29 and 30 above, the failure of the Court of First Instance does not warrant the setting aside of the judgment under appeal. Given that it has not been established that the co-existence of the marks at issue was based upon the absence of a likelihood of confusion and that it is in principle the reputation or lack of it of the Carbonell mark rather than the La Española mark that must be examined in assessing the likelihood of confusion, the outcome of the judgment under appeal was not affected by the Court of First Instance's failure.

32. I consider that the real crux of the present appeal lies in the allegedly incorrect interpretation and application of Article 8(1)(b) of Regulation No 40/94 (in particular, with respect to the visual differences between the word elements of the brand names in question) by the Court of First Instance.

33. In that connection, I consider it appropriate to cite the standard case-law, as it was neatly summarised by the Court in *OHIM* v *Shaker*, [19] where the Court held that 'it should be recalled that, pursuant to [Article 8(1)(b) of Regulation No 40/94], upon application by the owner of an earlier trade mark, the trade mark applied for is refused registration when, by reason of its identical nature or its similarity with the earlier trade mark and by reason of the identical nature or similarity of the goods or services covered by the two trade marks, there is a likelihood of confusion on the part of the public in the territory where the earlier trade mark is protected. Such a risk of confusion includes the risk of association with the earlier trade mark'.

34. In the same judgment, the Court held that 'on this point, the Community legislature explained, in the seventh recital of Regulation No 40/94, that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified'. [20]

35. It is settled case-law that 'the risk 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

18 — See, to that effect, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 24.

19 — Case C-334/05 P [2007] ECR I-4529, paragraph 31. See also judgment of 20 September 2007 in Case C-193/06 P *Nestlé* v *OHIM*, paragraph 31.

20 — *OHIM* v *Shaker*, cited in footnote 19, paragraph 32.

of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94'. [21]

36. Furthermore, the existence of a likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case. [22]

37. In addition, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. [23]

38. Finally, the Court has held that 'in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, taking account of the category of goods or services in question and the circumstances in which they are marketed'. [24]

39. Turning to the judgment under appeal, in paragraph 87, the Court of First Instance firstly concluded that contrary to what was held in the contested decision the figurative elements of the marks at issue were to be given greater importance and held that they did not have a weak distinctive character.

40. Secondly, in paragraphs 88 to 93 of the judgment under appeal, and also contrary to what was held in the contested decision, the Court of First Instance attributed a lower degree of importance to the word element of the La Española mark and held that it did not have a dominant character.

41. The Court of First Instance then proceeded to examine the similarity of the marks at issue and the likelihood of confusion.

21 — See *OHIM* v *Shaker*, cited in footnote 19, paragraph 33, and *Nestlé* v *OHIM*, cited in footnote 19, paragraph 32 and the case-law cited.

22 — *OHIM* v *Shaker*, cited in footnote 19, paragraph 34, and *Nestlé* v *OHIM*, cited in footnote 19, paragraph 33.

23 — *OHIM* v *Shaker*, cited in footnote 19, paragraph 35, and *Nestlé* v *OHIM*, cited in footnote 19, paragraph 34.

24 — *OHIM* v *Shaker*, cited in footnote 19, paragraph 36.

42. In paragraph 98 of the judgment under appeal, the Court of First Instance recalled the case-law of the Court of First Instance according to which 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. [25] In paragraphs 100 to 103 of the judgment under appeal, the Court of First Instance undertook a visual comparison of the marks at issue.

43. In that regard, it would appear that the Court of First Instance examined from a visual perspective certain aspects of the presentation of the brand names in question. [26] The Court of First Instance stated that 'the brand name appears in a white box against the red background placed on the lower part of the label' and that 'the brand name features in the white letters of the same height against the red background of the box'. However, I would like to emphasise that the Court of First Instance did not examine and compare the actual content of the word elements of the brand names themselves.

44. Furthermore, in paragraph 103 of the judgment under appeal, the Court of First Instance again referred to the brand names but did so merely with respect to the 'places for brand names and style of lettering'. Once again, the Court of First Instance failed to examine the actual content of the words and the visual differences between the two words.

45. Only in paragraph 105 of the judgment under appeal did the Court of First Instance, in fact, refer to the different word elements of the brand names but effectively stated that because 'La Española' had a very weak distinctive character [27] that difference does not diminish the likelihood of confusion. However, the Court of First Instance did not carry out any visual comparison of the words 'La Española' and 'Carbonell'.

46. Finally, in paragraph 109 of the judgment under appeal the Court of First Instance held that the phonetic differences between the marks at issue were irrelevant for the purposes of distinguishing the goods.

47. In view of the above, I consider that the appellant is not correct when it maintains that the Court of First Instance omitted in its

25 — Referring to Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30, and Case T-168/04 *L & D* v *OHIM — Sämann (Aire Limpio)* [2006] ECR II-2699, paragraph 91.

26 — See paragraph 100 of the judgment under appeal.

27 — Since it refers to the geographical origin of the goods.

global assessment of the marks at issue to examine the word elements of those marks. It is clear that some assessment of the brand names was carried out by the Court of First Instance.

48. However the appellant also argues that in its analysis of the likelihood of confusion the Court of First Instance distorted the facts and the evidence in the file before it.

49. In that regard, in accordance with Article 225(1) EC and the first paragraph of Article 58 of the Statute of the Court of Justice, an appeal lies on a point of law only. The Court of First Instance thus has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal. [28] Such distortion must be obvious from the documents on the Court's file, without there being any need to carry out a new assessment of the facts and the evidence. [29]

50. While the Court of First Instance would appear at first glance to have carried out a global assessment of the risk of confusion between the marks at issue, I consider that the Court of First Instance only effectively took into account in that assessment the brand name 'La Española'. [30] However, apart from recognising in paragraph 105 that the word element is different, the judgment under appeal contains no express assessment of the distinctiveness or otherwise of the brand name 'Carbonell'. I therefore consider that the Court of First Instance failed adequately to compare the actual content of the word elements of the brand names 'Carbonell' and 'La Española'.

51. It follows from a reading of paragraphs 94 to 112 of the judgment under appeal concerning the analysis of the similarity of the marks and the likelihood of confusion that in assessing the word elements of the marks at

28 — See, in particular, Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 22; Case C-173/04 P *Deutsche SiSi-Werke* v *OHIM* [2006] ECR I-551, paragraph 35; and Case C-25/05 P *Storck* v *OHIM* [2006] ECR I-5719, paragraph 40.

29 — See Case C-8/95 P *New Holland Ford* v *Commission* [1998] ECR I-3175, paragraph 72; Case C-551/03 P *General Motors* v *Commission* [2006] ECR I-3173, paragraph 54; and Case C-167/04 P *JCB Service* v *Commission* [2006] ECR I-8935, paragraph 108.

30 — In particular, in paragraph 92 of the judgment under appeal, the Court of First Instance considered that 'La Española' has only a very weak distinctive character.

issue, the Court of First Instance bypassed in that assessment the actual content of the word element of the brand name 'Carbonell' and carried out a one-sided and therefore legally incorrect comparison of the two brand names at issue. [31] I consider that this omission led to a distortion of the facts and evidence in the file.

52. At the same time, the above omission on the part of the Court of First Instance led, in my view, to an error of law as regards the interpretation and application of Article 8(1)(b) of Regulation No 40/94.

53. I would add in that regard that even if the Court of First Instance considered the contents of the word elements of the brand names 'Carbonell' and 'La Española' to be non-dominant and/or of lower importance, it was nonetheless obliged, unless it took the view that those elements were negligible, [32] to compare the actual content of the word elements of the brand names. [33] On that point, in *Medion*, [34] for instance, the Court found that a likelihood of confusion arose from a non-dominant component.

54. Moreover, the Court of First Instance did not provide any express reason as to why, in the context of the visual comparison of the marks at issue, it did not compare the actual content of the word elements of the brand names directly (that is to say, the brand names of the respective marks 'Carbonell' and 'La Española').

55. In addition, I also agree with the appellant and OHIM that — in spite of having cited in paragraph 107 of the judgment under appeal the correct case-law concerning the standard of 'a reasonably well-informed and reasonably observant and circumspect' average

31 — In my view the weak distinctive character of the expression 'La Española' is manifestly not sufficient to justify a failure to compare, from the visual point of view, that name with the earlier mark 'Carbonell'.

32 — See, to that effect, *OHIM* v *Shaker*, cited in footnote 19, paragraphs 41 and 42. In those paragraphs the Court found inter alia that, in the context of consideration of the likelihood of confusion, the assessment of the similarity between two marks must be made by examining each of the marks in question as a whole. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.

33 — See to that effect point 45 above with regard to 'La Española'.

34 — Case C-120/04 [2005] ECR I-8551, paragraph 32 et seq.

consumer to be applied in the context of a global appreciation — the Court of First Instance in fact applied a standard which more closely resembles one of an excessively negligent consumer.

56. In my view, the assessment by the Court of First Instance of the relevant consumer [35] does not comply with the case-law which states that the average consumer is 'reasonably well informed and reasonably observant and circumspect'.

57. I consider that it was illogical for the Court of First Instance to state that a 'reasonably well-informed and reasonably observant and circumspect' average consumer would fail to observe the actual content of the word elements of the brand names of the marks at issue, not least when their size and importance in the signs at issue is not negligible.

58. Finally, as regards OHIM's procedural argument that it is not open to the Court of First Instance to decide in a manner which is contrary to the challenged decision of a Community body and that it may only annul such a decision, suffice it to state that according to Article 63(3) of Regulation No 40/94 and Article 135 of the Rules of Procedure of the Court of First Instance the latter may alter the decision of the Board of Appeal and in terms of Article 63(6) of that regulation OHIM is required to take the necessary measures to comply with the judgment of the Court of Justice. [36]

59. It follows from all the foregoing that in my view the Court of First Instance distorted the facts and evidence in the file before it and infringed Article 8(1)(b) of Regulation No 40/94 and, therefore, that the judgment under appeal should be set aside.

60. In the present case, I consider that, in accordance with the second sentence of the first paragraph of Article 61 of the Statute of the Court of Justice, the Court should refer the case back to the Court of First Instance so that the latter may undertake an assessment of the facts (a new comparison of the marks at issue), carrying out a correct global assessment of the signs in question.

35 — In particular, in paragraph 109 of the judgment under appeal, the Court of First Instance found that 'olive oil is most commonly purchased in supermarkets or establishments where goods bearing different trade marks are arranged on shelves … [and thus] the consumer is guided more by an impression than by a direct comparison of the various marks and often does not read all the information on each olive oil container. In most cases, he merely takes a bottle whose label provides him with the visual impact of the brand he is looking for. [Hence] it is the figurative element of the marks at issue which acquires greater importance …'.

36 — See, for instance, Case T-425/03 *AMS* v *OHIM — American Medical Systems (AMS Advanced Medical Services)* [2007] ECR II-4265, paragraph 15 and the case-law cited.

V — Conclusion

61. Therefore I am of the opinion that the Court should:

(1) set aside the judgment in Case T-363/04 *Koipe* v *OHIM — Aceites del Sur (La Española)*;

(2) refer the case back to the Court of First Instance of the European Communities for judgment;

(3) reserve the costs of the proceedings.