JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
9 July 2003 *

In Case T-156/01,

Laboratorios RTB, SL, established in Bigues i Riells (Spain), represented by A. Canela Giménez, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto and J.F. Crespo Carillo, acting as Agents,

defendant,

* Language of the case: Spanish.

the other party to the proceedings before the Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) being

Giorgio Beverly Hills, Inc., established in Santa Monica, California (United States of America),

ACTION brought against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 11 April 2001 (Case R 258/2000-1),

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

composed of: V. Tiili, President, P. Mengozzi, and M. Vilaras, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the written procedure and further to the hearing on 22 January 2003,

gives the following

Judgment

Legal background

1 Article 52 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, provides, *inter alia*:

'1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or 5 of that Article are fulfilled;

...'

2 Article 8 of Regulation No 40/94 provides, *inter alia:*

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

(a)...;

(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.

2. 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;

...'

3 Article 56 of Regulation No 40/94 provides, *inter alia*:

'2. If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 43(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

4 Rule 40(5) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) provides:

'If the applicant, under Article 56(2) or (3) of [Regulation No 40/94], has to furnish proof of use or proof that there are proper reasons for non-use, Rule 22 shall apply *mutatis mutandis*.'

5 Rule 22 of Regulation No 2868/95 provides as follows:

'(1) Where, pursuant to Article 43(2) or (3) of [Regulation No 40/94], the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

(2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.

(3) The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) of [Regulation No 40/94].

(4) Where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language, within a period specified by the Office.'

Background to the dispute

6 On 1 April 1996, Giorgio Beverly Hills, Inc. ('the proprietor') filed an application for a Community trade mark under Regulation No 40/94 at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).

7 The trade mark in respect of which registration was sought was the word mark GIORGIO AIRE.

8 The goods in respect of which registration was sought are in Class 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 to the following description:

'Toiletry and soap preparations for men and women, namely perfume, cologne, essential oil for use as personal fragrance, after shave lotion and after shave balm, body moisturizer and body cream, perfumed soap and gel, and dusting powder.'

9 The trade mark was registered on 17 February 1998 and was published in *Community Trade Marks Bulletin* No 78/98 of 12 October 1998.

10 On 20 November 1998, the applicant filed an application under Article 52(1)(a) of Regulation No 40/94 for a declaration that registration of that Community trade mark was invalid. The application was filed in respect of all the goods covered by the Community trade mark. In support of its application, the applicant, relying on Article 8(1)(b) of Regulation No 40/94, cited the following earlier Spanish trade mark registrations:

— No 1 747 375: figurative sign, reproduced below, for 'Perfumery products and cosmetics, especially cosmetic preparations for the hair and bath', within Class 3;



— No 1 160 413: figurative sign, reproduced below, for 'Eau-de-cologne, body deodorant, shampoo, bath gel, hair-spray, hair conditioner cream, hair-

cream, body milk, cleansing milk, lipsticks; nail polish, suntan lotions, facial tonics', within Class 3;



— No 1 747 374: figurative sign, reproduced below, for 'Perfumery products and cosmetics, especially cosmetic preparations for the hair and bath', within Class 3;



— No 1 789 484: figurative sign, reproduced below, for 'Perfumery and cosmetics', within Class 3;



— No 957 216: word mark AIR GIORGI for 'insecticides, air freshening and purifying appliances', within Class 5.

11 On application by the proprietor of the Community trade mark, the applicant was requested to furnish proof of genuine use of the earlier trade marks under Article 56(2) and (3) of Regulation No 40/94.

12 Within the period laid down by OHIM for proving genuine use of the earlier trade marks, the applicant produced various documents, including invoices, catalogues and promotional material.

13 By decision of 17 December 1999, the Cancellation Division declared the Community trade mark GIORGIO AIRE invalid, in view of the likelihood of confusion in the mind of the public between that mark and the earlier marks GIORGI LINE (No 1 747 375), MISS GIORGI (No 1 747 374) and GIORGI LINE (No 1 789 484). The Cancellation Division also found that genuine use of the earlier marks AIR GIORGI (No 957 216) and J GIORGI (No 1 160 413) was not proved for the goods for which they had been registered during the five years preceding the application for a declaration of invalidity.

14 On 11 February 2000, the proprietor brought an appeal before OHIM under Article 59 of Regulation No 40/94 against the decision of the Cancellation Division.

15 The appeal was upheld by decision of the First Board of Appeal of 11 April 2001 ('the contested decision'). The Board of Appeal annulled the decision of the Cancellation Division and dismissed the application for a declaration of invalidity.

16 The Board of Appeal essentially held first, that the Cancellation Division was right to find that the evidence submitted by the applicant was insufficient to demonstrate genuine use of the earlier AIR GIORGI and J GIORGI marks during the five years preceding the application for a declaration of invalidity and, secondly, that, notwithstanding the identity of the goods in question, there were sufficient differences between the contested mark GIORGIO AIRE and the earlier marks containing the words GIORGI LINE and MISS GIORGI to preclude any likelihood of confusion.

Procedure and forms of order sought

17 By application lodged at the Registry of the Court on 9 July 2001, the applicant brought this action.

18 On 14 December 2001, OHIM lodged its response at the Registry of the Court.

19 The applicant claims that the Court should:

— annul the contested decision;

— declare the trade mark GIORGIO AIRE invalid;

— order OHIM to pay the costs.

20 OHIM contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

21 At the hearing, the applicant withdrew its second head of claim, for a declaration that the contested mark was invalid.

Law

22 The applicant advances two pleas in law in support of its application. By the first, it alleges infringement of Article 56(2) and (3) of Regulation No 40/94 and, by the second, infringement of Article 52(1)(a) of Regulation No 40/94.

First plea in law: infringement of Article 56(2) and (3) of Regulation No 40/94

Arguments of the parties

23 The applicant submits that the documents produced before OHIM prove that during the five years preceding the date of the application for a declaration of invalidity the earlier marks AIR GIORGI and J GIORGI were put to real and effective use.

24 The applicant maintains that it acquired the earlier marks by a transfer registered at the Oficina española de patentes y marcas (Spanish Patent and Trade Mark Office) on 2 June 1998, the assignor being Industria de la Keratina Aerosoles SA. In this connection, the applicant claims that, although use of the earlier marks must be demonstrated for the period from 20 November 1993 to 20 November 1998, use of the marks during the period preceding the transfer was restricted owing to the difficult economic situation of the previous owner, which led to the marks in question being sold and the company subsequently being placed in voluntary liquidation.

25 In any event, the applicant claims that it has produced sufficient evidence of use of the earlier marks. Thus, it maintains that the invoices which it submitted to the Cancellation Division as Annexes 1, 2, 3, 5 and 6 to its observations of 6 July 1999 show that thousands of goods were sold and placed on the market under the earlier marks.

26 Furthermore, the applicant maintains that effective use of a trade mark is not dependent on selling a fixed or specified quantity of goods. The presence of each mark on the market depends on the characteristics of the mark and on the recognition of the product concerned by the public at a given time.

27 As for the invoices submitted as Annexes 10, 11 and 12 to the observations of 6 July 1999, the applicant maintains that they refer only to the word giorgi because that is the only word common to all the earlier trade marks and constitutes their principal, most characteristic and most distinctive component.

28 The applicant concludes that the use of the earlier marks AIR GIORGI and J GIORGI has been demonstrated by the means provided for in Rule 22 of Regulation No 2868/95.

29 OHIM submits, *in limine*, that its participation in this case relates solely to issues in regard to which it considers it necessary to elucidate the way in which the Community trade mark rules are to be applied.

30 OHIM submits that the Board of Appeal was right to conclude that the applicant had not established use of the earlier AIR GIORGI and J GIORGI marks.

31 As regards the evidence of use of the earlier J GIORGI mark, OHIM asserts, first of all, that the Board of Appeal was wrong to hold, probably owing to the poor quality of the copy, that the invoice submitted as Exhibit 1 refers to the product CHAMP J GIORGI 750 ML C/16. In fact, according to OHIM, the invoice relates to CHAMPU J GIORGI 750 ML C/16. Secondly, OHIM insists that none of the documents submitted by the applicant as evidence of use contains any reference to the J GIORGI mark and that use of this mark therefore remains unproven.

32 As regards evidence of use of the earlier AIR GIORGI mark, OHIM contends that sales of goods under that mark of which the applicant provided evidence were very low in a number of years during the five-year period preceding the date on which the application for a declaration of invalidity was filed.

33 Finally, OHIM claims that the Board of Appeal was right to observe that 'it is strange that the cancellation applicant has not produced a single example of the products in question', and that there is no evidence to suggest that the two marks were ever brought to the notice of a significant number of consumers.

Findings of the Court

34 The ninth recital in the preamble to Regulation No 40/94 states that there is no justification for protecting earlier trade marks except where the marks are

actually used. Consistently with that recital, Article 56(2) and (3) of Regulation No 40/94 provides that the proprietor of a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory in which it is protected during the period of five years preceding the date of the application for a declaration of invalidity. Thus, if the applicant for a declaration of invalidity, after having been asked to furnish proof of genuine use of the earlier mark, fails to prove that the earlier mark has indeed been put to use on the market concerned, that earlier mark cannot render a Community trade mark invalid.

35 First of all, genuine use implies real use of the mark on the market concerned for the purpose of identifying goods or services. Genuine use is therefore to be regarded as excluding minimal or insufficient use for the purpose of determining that a mark is being put to real, effective use on a given market. In that regard, even if it is the owner's intention to make real use of his trade mark, if the trade mark is not objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign, so that it cannot be perceived by consumers as an indication of the origin of the goods or services in question, there is no genuine use of the trade mark (Case T-39/01 *Kabushiki Kaisha Fernandes* v *OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 36).

36 As to the criteria for assessing genuine use, under Rule 40(5) of Regulation No 2868/95, account must be taken of the facts and circumstances of each case, regard being had to the wording of Rule 22(2) of Regulation No 2868/95, which states that the indications and evidence for the furnishing of proof of use are to consist of indications concerning the place, time, extent and nature of the use.

37 In this case, the applicant was required to show use in Spain, first, of the figurative trade mark J GIORGI for 'Eau-de-cologne, body deodorant, shampoo, bath gel, hair-spray, hair conditioner cream, haircream, body milk, cleansing milk, lipsticks; nail polish, suntan lotions, facial tonics', within Class 3, and, secondly, of the word mark AIR GIORGI for 'insecticides, air freshening and purifying appliances', within Class 5. Furthermore, that evidence was required to be adduced for the five years preceding the date of the application for a declaration of invalidity, that is to say for the period from 20 November 1993 to 20 November 1998.

38 To that end, the applicant produced to the Cancellation Division, in the form of annexes to its observations of 6 July 1999, a number of items, including invoices (Exhibits 1 to 15), publicity material in the form of catalogues (Exhibits 16 to 18), and a videotape (Exhibit 19) as evidence of use of the earlier marks.

39 The applicant states that it acquired the earlier marks as a result of a transfer registered at the Oficina española de patentes y marcas (Spanish Patent and Trade Mark Office) on 2 June 1998, the assignor being the company Industria de la Keratina Aerosoles SA, and that use of the marks during the period preceding the transfer was restricted owing to the difficult economic situation of the previous owner, and which led to the marks in question being sold and the company subsequently being placed in voluntary liquidation.

40 It must be observed in that regard that the particular circumstances of the current or previous proprietors of the trade marks are irrelevant for the purposes of assessing the use to which the marks have been put, since evidence of genuine use must establish that the trade mark was effectively present on the market concerned during the five years preceding the date of the application for a declaration of invalidity, irrespective of who owned them during that period.

41 Furthermore, the applicant has not alleged any proper reasons for the non-use of the marks in question within the meaning of Article 56(2) of Regulation No 40/94. In any event, the concept of proper reasons in that article must be considered to refer essentially to circumstances unconnected with the trade mark owner which prohibit him from using the mark, rather than to circumstances associated with the commercial difficulties he is experiencing.

42 With regard, first of all, to use of the earlier J GIORGI mark, the Board of Appeal observes that none of the invoices submitted by the applicant shows a significant quantity of products sold under that mark.

43 The applicant submitted a number of invoices that make no mention of that mark, with the exception of invoice No 1, which the Board of Appeal stated relates to the sale of 32 units of CHAMP J GIORGI (paragraph 13 of the contested decision). In that regard, OHIM's finding, which was accepted by the applicant at the hearing, that the Board of Appeal was wrong to hold, probably owing to the poor quality of the copy, that the invoice submitted as Exhibit 1 refers to CHAMP J GIORGI 750 ML C/16 whereas it in fact relates to CHAMPU GIORGI 750 ML C/16, must be upheld.

44 Accordingly, there is no proof of use of that mark during the reference period, since the documents which refer to GIORGI, MISS GIORGI or GIORGI LINE products cannot be taken as evidence of use of the earlier J GIORGI mark. Although, under Article 15(2)(a) of Regulation No 40/94, the use of a Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered is considered to constitute use of the mark, in this case the use of the signs GIORGI, MISS GIORGI and GIORGI LINE does alter the distinctive character of the J GIORGI mark. Use of the mark has accordingly not been proven.

45 With regard, secondly, to the earlier AIR GIORGI mark, the applicant submitted several invoices mentioning 'antitabaco, lavanda, maderas, floral' air fresheners designated by the mark which in OHIM'S view show the sale of 24 units in 1994, 4 800 units with returns of 2 640 units (in other words, actual sales of 2 160 units) in 1995 and 312 units in 1996 for these goods. In addition, the catalogues adduced as Exhibits 16 and 18 show that five spray air fresheners ('antitabaco, lavanda, maderas, floral and seco') and two spray air fresheners of the 'ecológico' variety were sold under the AIR GIORGI mark.

46 The sales of goods identified with this mark of which the applicant has produced evidence are very low — in some cases even nonexistent — for four of the five years preceding the date of the application for a declaration of invalidity, that is to say 1994, 1996, 1997 and 1998.

47 The Court therefore finds that the evidence adduced by the applicant does not establish that the mark in question was consistently present during the five-year period preceding the date of the application for a declaration of invalidity.

48 Since the applicant has failed to show genuine use in Spain from 20 November 1993 to 20 November 1998 of its AIR GIORGI and J GIORGI marks for the goods in respect of which those marks are registered, the Court finds that the Board of Appeal was right to conclude that genuine use of those marks was not proven.

49 The first plea in law, alleging infringement of Article 56(2) and (3) of Regulation No 40/94, must accordingly be dismissed.

Second plea in law: infringement of Article 52(1)(a) of Regulation No 40/94

Arguments of the parties

50 With regard to the GIORGI LINE mark (No 1 789 484), the applicant maintains that the figurative element of the mark is abstract in nature and that it is not capable of being reproduced phonetically. Nor is the figurative element conceptually distinctive. As to the word 'line', the applicant submits that the Board of Appeal was right to find that this would go almost unnoticed by the consumer and that the word therefore has a purely aesthetic function.

51 From a visual standpoint, the applicant considers that the predominant element of the GIORGI LINE mark is the word 'giorgi', because it is that component which the consumer perceives with the greatest force and it is the only component capable of being retained by the consumer for the purpose of asking for the product in question again. In the applicant's view, the word 'giorgi' is clearly distinct from the word 'line'. In addition, the applicant points out that all the earlier marks contain the word 'giorgi' and that it is the most important word in all of them.

52 The applicant submits that, in view of the particular importance of proper nouns in the perfumery and luxury goods sector, the Board of Appeal's argument that the word 'giorgi' is devoid of distinctive force is immaterial.

53 The applicant adds that the arguments put forward in relation to the GIORGI LINE mark (No 1 789 484) also apply to MISS GIORGI (No 1 747 374) and GIORGI LINE (No 1 747 375). However, the applicant contends that the graphic

element is simpler still in those marks and is therefore less noticeable to the consumer.

54 As regards the contested mark GIORGIO AIRE, the applicant submits that particular consideration must be given to the first part of the mark, that is the word 'giorgio', because, first, it occurs at the beginning of the sign and, secondly, it has characteristic force as a man's name. As regards the second element of the mark, the word 'aire', the applicant submits that it is purely secondary and in no way distinguishes the goods covered by the contested mark, since it suggests one of the product's qualities, namely the fact that it is an aerosol or is intended to be used in the air.

55 The applicant further submits that the Board of Appeal was right to conclude that there was conceptual similarity between the conflicting marks and identity between the goods covered by the marks.

56 OHIM contends that, when assessing the likelihood of confusion, it is necessary to consider all aspects of each sign and in that regard it contests the applicant's analysis, which limits the comparison of the conflicting signs to the words 'giorgi' and 'giorgio', while ignoring the other figurative and verbal aspects of the signs.

57 OHIM concurs with the Board of Appeal's statement at paragraph 18 of the contested decision that there is some phonetic and visual resemblance between the contested mark and the earlier marks, and also some conceptual similarity inasmuch as the word 'giorgi', which is an Italian surname and occurs in all the earlier marks, forms part of the word 'giorgio', which is also an Italian first name. None the less, it submits that there are significant and subtle differences between the words 'giorgio' and 'giorgi'.

58 OHIM also maintains that the word 'aire' in the contested mark does not suggest that the goods identified by that mark are aerosols.

59 OHIM concludes that there is no likelihood of confusion between the earlier marks GIORGI LINE (No 1 747 375 and No 1 789 484) and the contested mark GIORGIO AIRE.

60 Finally, as regards the earlier MISS GIORGI mark (No 1 747 374), OHIM argues that the 'miss' element cannot be severed from the word 'giorgi', and that it probably designates a line of goods targeted specifically at women. OHIM also submits that the mark is phonetically different from the contested mark GIORGIO AIRE, and that there is consequently no likelihood of confusion between them.

Findings of the Court

61 According to the case-law of the Court of Justice on the interpretation of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision which is in essence the same as Article 8(1)(b) of Regulation No 40/94, 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 of confusion (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17; and Case T-104/01 *Oberhauser* v *OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 25).

62 According to the same line of case-law, the likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Canon*, paragraph 16; *Lloyd Schuhfabrik Meyer*, paragraph 18; Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40; and *Fifties*, paragraph 26).

63 That global assessment of the likelihood of confusion implies some interdependence between the factors taken into account, and in particular similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19). The interdependence of these factors is expressly referred to in the seventh recital in Regulation No 40/94, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends, among other factors, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

64 In addition, the perception of 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 (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). For the purposes of that global assessment, the average consumer of the products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. In addition, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but has to place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind 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).

65 In this case, given that the earlier marks are registered in Spain and that the goods in question are everyday consumer items, the targeted public by reference to which the likelihood of confusion must be assessed is composed of average consumers in Spain.

66 In the light of the foregoing considerations, it is appropriate first of all to compare the goods and then the conflicting signs.

67 As regards the comparison of the goods, the Spanish marks MISS GIORGI (No 1 747 374) and GIORGI LINE (No 1 747 375) are registered for 'Perfumery products and cosmetics, especially cosmetic preparations for the hair and bath' and GIORGI LINE (No 1 789 484) for 'Perfumery and cosmetics', all of which are within Class 3.

68 The Board of Appeal held at paragraph 17 of the contested decision that the goods covered by the Spanish marks GIORGI LINE (No 1 747 375 and No 1 789 484) and MISS GIORGI must be regarded as identical to those covered by the contested mark GIORGIO AIRE.

69 It is common ground between the parties, moreover, that there is identity or similarity between the goods covered by the earlier marks and those designated by the contested mark.

70 As regards the comparison of the signs, 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 (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). In addition, the Court of Justice has held that it is possible that mere aural similarity between trade marks may create a likelihood of confusion (*Lloyd Schuhfabrik Meyer*, paragraph 28).

71 It is therefore necessary to compare the visual, aural and conceptual aspects of the conflicting signs.

72 As regards visual comparison, the Board of Appeal held that, although the contested mark GIORGIO AIRE bears some resemblance to the earlier marks in that the word GIORGI occurs in all the earlier marks and is contained in the word giorgi, there are none the less a number of major differences between it and the earlier marks. The earlier marks all contain significant figurative elements and an additional verbal element (LINE or MISS). The contested mark also contains an additional verbal element, 'aire', which appears in capital letters of the same size as the word 'giorgio' (paragraph 18 of the contested decision).

73 In that connection, it must be observed that the fact that the earlier marks and the contested mark contain the words 'giorgi' and 'giorgio', which bear a certain resemblance to one another, is of little consequence in the context of a global comparison and is not in itself sufficient to justify the conclusion that the conflicting signs are visually similar.

74 Because the signs contain other word elements, namely the words 'line' and 'miss' in the earlier marks and the word 'aire' in the contested mark, the overall impression conveyed by each sign is different. In addition, the earlier marks include figurative elements in an individual and original configuration.

75 It follows that the Board of Appeal was right to hold that the differences between the conflicting signs are sufficient to support the conclusion that they are not visually similar.

76 The Board of Appeal did not specifically evaluate the signs in question with a view to a phonetic comparison. It merely stated that whilst the contested mark GIORGIO AIRE resembles the earlier marks in so far as the word 'giorgi' occurs in all the earlier marks and is contained within the word 'giorgio', there are none the less important differences between the marks (paragraph 18 of the contested decision).

77 It must be observed in that connection that there are significant differences between the conflicting signs and that the similarities between them are negligible by comparison with the differences. The contested mark is composed of four syllables (gior-gio-ai-re), of which only one, the syllable 'gior', is the same as the syllables occurring in the earlier marks, which are composed of three syllables (miss-gior-gi) and four syllables (gior-gi-li-ne)

78 The conflicting signs accordingly have fewer phonetic elements in common than not. The marks in question must therefore be regarded as phonetically dissimilar.

79 As regards the conceptual comparison of the conflicting signs, the Board of Appeal agreed with the applicant for a declaration of invalidity (the applicant before this Court) that the conflicting marks cannot be similar from this perspective because the word 'giorgio' is dominant in the contested mark GIORGIO AIRE, while the word 'aire' is descriptive of the qualities of the goods covered by the trade mark and cannot therefore be distinctive in relation to them.

80 In that connection, it must be observed with regard to the contested mark that the word 'aire', apart from being non-descriptive of the goods in question, has a semantic importance which, combined with that of the man's first name GIORGIO, produces a whole that is conceptually different from the earlier marks, and in particular from the components other than GIORGI, namely the words 'line' and 'miss'.

81 Secondly, it must be observed that, contrary to the applicant's contention, words such as 'giorgi' and 'giorgio' are not characteristic for perfumery and cosmetics. As the Board of Appeal observed, in view of the prevalence of real or assumed Italian names in the perfume market, and the fact that consumers are used to trade marks which contain common names, they will not assume that every time a particular common name occurs in a trade mark in conjunction with other elements, verbal or figurative, the goods in question all emanate from the same source (paragraph 18 of the contested decision).

82 Consequently, the Board of Appeal was right to conclude that there is no conceptual concurrence between the signs in question.

83 Accordingly, even though there is identity and similarity between the goods covered by the conflicting marks in this case, the visual, aural and conceptual differences between the signs constitute sufficient grounds for holding that there is no likelihood of confusion in the mind of the targeted public (Case T-110/01 *Vedial* v *OHIM — France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 63).

84 In the light of the foregoing, the Board of Appeal was entitled to conclude that there is no likelihood of confusion between the contested mark GIORGIO AIRE and the earlier Spanish marks MISS GIORGI (No 1 747 374), GIORGI LINE (No 1 747 375) and GIORGI LINE (No 1 789 484). The second plea in law, alleging infringement of Regulation No 40/94, must therefore be rejected.

85 It follows that the application must be dismissed.

Costs

86 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been asked for in the successful party's pleadings. Since the applicant has been unsuccessful and OHIM has asked for costs, it must be ordered to pay OHIM's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. Dismisses the application;

2. Orders the applicant to pay the costs.

Tiili Mengozzi Vilaras

Delivered in open court in Luxembourg on 9 July 2003.

H. Jung
Registrar

V. Tiili
President