JUDGMENT OF THE COURT (Fourth Chamber)

24 June 2010 *

In Case C-51/09 P,

APPEAL under Article 56 of the Statute of the Court of Justice, brought on 3 February 2009,

Barbara Becker, residing in Miami (United States), represented by P. Baronikians, Rechtsanwalt,

appellant,

the other parties to the proceedings being:

Harman International Industries, Inc., established in Northridge (United States), represented by M. Vanhegan, Barrister,

applicant at first instance,

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by G. Schneider, acting as Agent,

defendant at first instance,

* Language of the case: English.

THE COURT (Fourth Chamber),

composed of J.-C. Bonichot, President of the Chamber, C. Toader, K. Schiemann, P. Kūris (Rapporteur) and L. Bay Larsen, Judges,

Advocate General: P. Cruz Villalón,
Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 11 February 2010,

after hearing the Opinion of the Advocate General at the sitting on 25 March 2010,

gives the following

Judgment

1 By her appeal, Ms Becker requests the Court to set aside the judgment of the Court of First Instance of the European Communities (now 'the General Court') in Case T-212/07 *Harman International Industries* v *OHIM - Becker (Barbara Becker)* [2008] ECR II-3431 ('the judgment under appeal'), by which that court annulled the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 7 March 2007 (Case R 502/2006-1) ('the contested decision') which had annulled the Opposition Division's decision upholding the opposition brought by Harman International Industries Inc. ('Harman') against registration of the Community word mark Barbara Becker.

Legal background

2 Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) provides:

'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.'

3 Pursuant to Article 8(2)(a) of Regulation No 40/94, 'earlier trade marks' means, inter alia, Community trade marks with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

Facts

4 On 19 November 2002, Ms Becker filed an application at OHIM for registration of the word mark Barbara Becker as a Community trade mark.

5 The goods in respect of which registration of the mark was sought fall within Class 9 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:

'Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers.'

6 On 24 June 2004, Harman filed a notice of opposition against registration of the trade mark Barbara Becker in respect of all the goods covered by the mark, pursuant to Article 8(1)(b) and Article 8(5) of Regulation No 40/94. The opposition was based on the Community word mark BECKER ONLINE PRO No 1823228, registered on 1 July 2002, and on the application for registration, of 2 November 2000, of Community word mark BECKER No 1944578, registered on 17 September 2004, which also cover various goods falling within Class 9 of the Nice Agreement.

7 By decision of 15 February 2005, the Opposition Division of OHIM, accepting that there was a likelihood of confusion between the marks at issue, upheld Harman's opposition. It held that the goods designated by those marks were identical and that the marks were similar overall, in that they had an average degree of visual and phonetic similarity, and that they were conceptually identical since they refer to the same surname.

8 On 11 April 2006, Ms Becker filed an appeal against that decision, which led to its annulment by the contested decision. In the latter decision, the First Board of Appeal of OHIM ('the Board of Appeal') held that the goods designated by the marks at issue were partly identical and partly similar. It distinguished between the goods directed at the general public, those directed at professionals, and those which, directed at both of those groups, fell within an intermediate category.

9 As regards the signs at issue, the Board of Appeal compared only the earlier word mark BECKER and the mark Barbara Becker for which registration is sought. It found that visually and phonetically there was only some degree of similarity between those signs but that conceptually, however, the signs were clearly distinct in Germany and in other countries of the European Union by reason of the fact that the relevant public would perceive the mark Barbara Becker in its entirety, rather than as a combination of 'Barbara' and 'Becker'. It also noted that Ms Becker was famous in Germany, while 'Becker' was a very common surname. Therefore, it concluded that the differences between the signs at issue were significant enough to rule out a likelihood of confusion.

10 Furthermore, the Board of Appeal held that the condition that, for the application of Article 8(5) of Regulation No 40/94, there must be a degree of similarity between the marks at issue such that the relevant public establishes a link between them, had not been satisfied.

The action before the General Court and the judgment under appeal

11 By application lodged at the Registry of the General Court on 15 June 2007 Harman brought an action against the contested decision. In support of its action it put forward two pleas alleging infringement of Article 8(1)(b) and Article 8(5) of Regulation No 40/94 respectively.

12 Upholding the first of those pleas the General Court, by the judgment under appeal, annulled the contested decision, considering that the Board of Appeal had wrongly concluded that the marks at issue were clearly distinct. After noting, in paragraph 33 of the judgment under appeal, that visually and phonetically they had a certain similarity, as the Board of Appeal had found, it held, in paragraph 34 of the judgment, that the Board of Appeal had incorrectly assessed the relative importance of the component 'Becker' as compared with the component 'Barbara'.

13 First, the General Court, referring to Case T-185/03 *Fusco* v *OHIM - Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54, observed, in paragraph 35 of the judgment under appeal, that the case-law had stated that, at least in Italy, consumers generally attributed greater distinctiveness to the surname than to the forename making up a trade mark, so that the surname 'Becker' was likely to have attributed to it a stronger distinctive character than the first name 'Barbara' in the composite mark.

14 Second, the General Court stated, in paragraph 36 of the judgment under appeal, that the fact that Ms Becker is famous in Germany as the former wife of Boris Becker did not mean that, conceptually, the marks at issue were not similar. It observed that

those two marks referred to the same surname and were therefore similar, especially since in a part of the European Union the component 'Becker' in the mark Barbara Becker was, as a surname, likely to have attributed to it a stronger distinctive character than the component 'Barbara', which is simply a first name.

15 Third, referring to Case C-120/04 *Medion* [2005] ECR I-8551, paragraphs 30 and 37, the General Court held, in paragraph 37 of the judgment under appeal, that the component 'Becker', even if it was not the dominant component of the composite mark, would be perceived as a surname, which is commonly used to describe a person, and would retain an independent distinctive role in that mark.

16 Therefore, noting that the identical or similar nature of the goods designated by the marks at issue was not contested and that those marks were visually, phonetically and conceptually similar, the General Court, in paragraph 40 of the judgment under appeal, held that there was a likelihood of confusion between them even if the relevant goods were intended for a public with a relatively high level of attention.

17 Lastly, in paragraphs 41 and 42 of the judgment under appeal, the General Court held that that finding was not invalidated by OHIM's argument that a composite mark and another mark can be considered to be similar only if the common component constitutes the dominant component in the overall impression created by the composite mark. It also dismissed Ms Becker's argument that the case-law on composite marks was not applicable in the present case because the mark Barbara Becker consisted of a first name and a surname.

Forms of order sought

18 By her appeal, the appellant claims that the Court should set aside the judgment under appeal in so far as it annulled the contested decision and ordered her to pay the costs. She also seeks an order for the respondent to pay the costs.

19 Harman contends essentially that the Court should dismiss the appeal and order the appellant to pay the costs.

20 OHIM contends that the Court should set aside the judgment under appeal and order Harman to pay the costs incurred by it.

The appeal

Arguments of the parties

21 In support of her appeal, Ms Becker puts forward a single plea alleging infringement of Article 8(1)(b) of Regulation No 40/94. She submits that the General Court erred in considering that there was a similarity between the marks at issue and therefore misapplied that provision in concluding that there was a likelihood of confusion.

22 First, Ms Becker criticises the General Court for having based its assessment on the judgment in *Fusco* v *OHIM – Fusco International (ENZO FUSCO)*, according to which Italian consumers attribute greater distinctiveness to the surname than the forename in a trade mark. She observes in that respect that in a more recent judgment, of 12 July 2006, in Case T-97/05 *Rossi* v *OHIM – Marcorossi (MARCOROSSI)*, paragraphs 46 and 47, the General Court stated that such a general rule did not automatically apply in every situation, as each case should be examined individually, and that the surname common to the two marks in that case was not sufficiently dominant in those marks to lead to a likelihood of confusion.

23 Second, the appellant submits that the General Court erroneously concluded from *Medion* that the component 'Becker' had an independent distinctive role in the composite mark so that the two marks at issue had to be regarded as similar. That judgment merely stated that it is not sufficient for a third party to add its company name to a registered trade mark in order to claim protection for its composite trade mark. It can by no means be construed as establishing a general rule that any element shared by two trade marks is to be regarded as distinctive even though it is not dominant.

24 Moreover, that judgment concerned trade marks which cannot be compared with those at issue in the present case. The present case concerns not the imitation of an earlier trade mark to which a company name has been added, but an amendment of the earlier mark by the addition of a first name in front of the surname. The relevant public will perceive the sign 'Barbara Becker' as the name of a woman, while the name 'Becker', which is very common, is not sufficiently individualised for there to be a conceptual similarity between the marks at issue. The General Court therefore misapplied Article 8(1)(b) of Regulation No 40/94 in stating that the component 'Barbara' is simply a first name, when the overall impression given by the trade mark applied for is decisively affected by the addition of that first name, in so far as it conveys a whole new conceptual meaning to the surname Becker.

25 OHIM concurs essentially with the grounds relied on by the appellant. It submits that the General Court failed to take into account all the factors relevant to the circumstances of the case in assessing the existence of a likelihood of confusion, wrongly considering the factual assessment made in *Fusco* v *OHIM – Fusco International (ENZO FUSCO)* to be a rule of law and automatically applying the case-law resulting from *Medion*.

26 The General Court thus failed, inter alia, to take into consideration the fact that the surname in the mark applied for is a very common German surname. It omitted, in paragraph 36 of the judgment under appeal, to ascertain whether the fact that Ms Becker is a celebrity was capable of counteracting the aural and visual similarities between the signs at issue. Likewise, it erroneously held that the component 'Becker' played an independent distinctive role without analysing the impact of Ms Becker's celebrity status on the perception of consumers.

27 At the hearing, OHIM added that the General Court had erred in law in inferring from its finding, that the second part of the sign had a dominant distinctive character as compared with the first, that it also played an independent distinctive role.

28 By contrast, Harman objects to the plea put forward by the appellant. It submits, first, that, contrary to the appellant's assertion, it is apparent from the judgment under appeal that the General Court referred to *Fusco* v *OHIM – Fusco International (ENZO FUSCO)* as a guideline and not as a rule of law which applies to all situations. It further observes that that reference is not decisive in the reasoning followed by the General Court for the purposes of concluding that there was a likelihood of confusion.

29 Secondly, it agrees with the analysis carried out by the General Court as regards the independent distinctive role of the component 'Becker', which is consistent, in its view, with *Medion*.

Findings of the Court

30 Since the appellant has criticised the General Court for incorrectly applying Article 8(1)(b) of Regulation No 40/94, it should be recalled that, according to that provision, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

31 In that regard, 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 of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM* v *Shaker* [2007] ECR I-4529, paragraph 33, and judgment of 20 September 2007 in Case C-193/06 P *Nestlé* v *OHIM*, paragraph 32; and, to that effect, with respect to 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), 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 *Medion*, paragraph 26).

32 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 (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Lloyd Schuhfabrik Meyer*, paragraph 18; *Medion*, paragraph 27; *OHIM* v *Shaker*, paragraph 34; and *Nestlé* v *OHIM*, paragraph 33).

33 It is also settled case-law that the global appreciation 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 (see, to that effect, *SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; *Medion*, paragraph 28; *OHIM* v *Shaker*, paragraph 35; and *Nestlé* v *OHIM*, paragraph 34).

34 However, in paragraphs 30 and 31 of *Medion*, the Court held that, beyond the usual case where the average consumer perceives a mark as a whole, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element. In such a case, the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

35 In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36 Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37 Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38 Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39 Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.

40 It follows from all the foregoing that the General Court erred in law in basing its assessment of the conceptual similarity of the marks on general considerations taken from the case-law without analysing all the relevant factors specific to the case, in disregard of the requirement of an overall assessment of the likelihood of confusion, taking account of all factors relevant to the circumstances of the case, and based on the overall impression produced by the marks at issue.

41 It follows that the ground of appeal alleging infringement of Article 8(1)(b) of Regulation No 40/94 must be upheld and that, therefore, the judgment under appeal must be set aside and the case referred back to the General Court.

Costs

42 As the case is being referred back to the General Court, it is appropriate to reserve the costs relating to the present appeal proceedings.

On those grounds, the Court (Fourth Chamber) hereby:

1. **Sets aside the judgment of the Court of First Instance of the European Communities of 2 December 2008 in Case T-212/07 *Harman International Industries* v *OHIM – Becker (Barbara Becker)*;**

2. **Refers the case back to the General Court of the European Union;**

3. **Reserves the costs.**

[Signatures]