JUDGMENT OF THE COURT OF FIRST INSTANCE (First Chamber)

6 July 2004 *

In Case T-117/02,

Grupo El Prado Cervera, SL, established in Valencia (Spain), represented by P. Koch Moreno, lawyer,

applicant,

v

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

defendant,

* Language of the case: German.

the other parties to the proceedings before the Board of Appeal of OHIM, intervening before the Court of First Instance, being

Helene Debuschewitz and Others, as heirs of Johann Debuschewitz, residing at Rösrath-Forsbach (Germany), represented by E. Krings, lawyer,

ACTION for annulment of the decision of the First Board of Appeal of OHIM of 12 February 2002 (Case R 798/2001-1) concerning the opposition proceedings between Grupo El Prado Cervera, SL, and J. Debuschewitz,

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

composed of: B. Vesterdorf, President, P. Mengozzi and M.E. Martins Ribeiro, Judges,

Registrar: I. Natsinas, Administrator,

having regard to the written procedure and further to the hearing on 9 March 2004,

gives the following

Judgment

Background to the dispute

1 On 18 December 1998, Mr Debuschewitz (hereinafter 'the other party before the Office') filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office') under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The trade mark in respect of which registration was sought is the sign 'CHUFAFIT'.

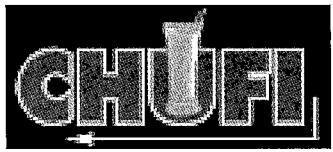
3 The goods in respect of which the registration was sought come within Classes 29 and 31 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following descriptions for each Class:

— Class 29: 'Processed nuts';

— Class 31: 'Fresh nuts'.

4 That application was published in *Community Trade Marks Bulletin* No 69/1999 of 30 August 1999.

5 On 29 November 1999, the company Grupo El Prado Cervera, SL (formerly Compañia Derivados de Alimentación, SL), the applicant before the Court, gave notice of opposition, pursuant to Article 42 of Regulation No 40/94. The opposition was against the registration of the mark applied for, in respect of all the goods covered by the trade mark application. The ground relied on in support of the opposition was a likelihood of confusion under Article 8(1)(b) of Regulation No 40/94. The opposition was based on the existence of two earlier national trade marks registered in Spain. The first mark, registered on 4 February 1994 under No 1 778 419, is the word mark 'CHUFI' designating a range of goods in Class 29, namely 'meat, fish and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats'. The second trade mark, which was registered in Spain under No 2 063 328 on 5 May 1997, is the following figurative mark:



6 That mark covers a range of goods in Class 31, namely 'agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt'.

7 By decision of 11 July 2001, the Office's Opposition Division rejected the opposition in its entirety on the ground that, although the goods covered by the mark applied for were identical to those protected by the applicant's earlier national marks, there were visual, phonetic and conceptual differences between the sign which was the

subject of the Community trade mark application and the applicant's earlier national marks, enabling any likelihood of confusion on the part of the Spanish public to be excluded.

8 On 31 August 2001 the applicant filed at the Office notice of appeal under Article 59 of Regulation No 40/94, against the Opposition Division's decision.

9 By decision of 12 February 2002 (hereinafter 'the contested decision'), the Office's First Board of Appeal dismissed the appeal and upheld the Opposition Division's decision on the same grounds.

10 In essence, the Board of Appeal held that, despite the goods being identical, the trade marks were neither identical nor so similar as to give rise to a likelihood of confusion between them. The Board of Appeal held, first, that although the competing signs shared the syllable 'chu', they were visually and phonetically different as regards the number of syllables and their pronunciation (paragraph 18 of the contested decision). Secondly, as regards conceptual comparison the Board of Appeal held that the common element 'chuf', which evokes in Spain the word 'chufa', meaning tiger (or rush) nut from which the drink 'horchata' (tiger nut cordial) is made, was directly related to the tiger nut and did not, in itself, enable either the signs to be distinguished as marks or the marks to be distinguished from each other. By contrast, the Board of Appeal held that, in the global comparison of the marks, it was the final elements of the competing signs which distinguished them, in the consumer's mind, as trade marks. In the Board of Appeal's view, since those elements are sufficiently different, they will prevent any confusion arising, even on the part of the inattentive consumer (paragraphs 19 and 20 of the contested decision).

Procedure and forms of order sought by the parties

11 By application in Spanish lodged at the Court Registry on 15 April 2002, the applicant brought this action.

12 By letter of 3 May 2002, the other parties before the Office objected, within the meaning of the first subparagraph of Article 131(2) of the Rules of Procedure of the Court of First Instance, to Spanish being the language of the case before the Court and requested that German be the language of the case.

13 Pursuant to the third subparagraph of Article 131(2) of the Rules of Procedure, the Court designated German as the language of the case, on the ground that the other party before the Office had filed the contested trade mark application, under Article 115(1) of Regulation No 40/94, in that language.

14 The Office lodged its response at the Court Registry on 7 October 2002, the other parties before the Office having lodged their response on 16 September 2002.

15 Upon hearing the report of the Judge-Rapporteur, the Court of First Instance (First Chamber) decided to open the oral procedure.

16 The parties presented oral argument and replied to the oral questions put by the Court at the hearing on 9 March 2004, apart from the other parties before the Office who did not appear.

17 The applicant claims that the Court should:

— declare the contested decision incompatible with Article 8(1)(b) of Regulation No 40/94 and annul that decision;

— declare that there is a likelihood of confusion between the Community trade mark application 'CHUFAFIT', in respect of Classes 29 and 31 and, first, Spanish trade mark No 1 778 419, 'CHUFI', which protects goods in Class 29, and, second, figurative Spanish trade mark No 2 063 328, 'CHUFI', which protects goods in Class 31;

— refuse Community trade mark application No 1 021 229, 'CHUFAFIT', in respect of Classes 29 and 31;

— order the Office and, if appropriate, the other parties before the Office to pay the costs.

18 The Office contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

19 The other parties before the Office contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

20 By its action, the applicant requests the Court, first, to refuse the registration of the Community trade mark applied for and, second, to annul the contested decision.

The application for refusal of the registration of the Community trade mark applied for

21 By its third head of claim, the applicant in essence requests the Court to order the Office to refuse registration of the mark applied for.

22 In that regard, it is appropriate to recall that, under Article 63(6) of Regulation No 40/94, the Office is required to take the measures necessary to comply with the judgment of the Community judicature. Accordingly, it is not for the Court of First Instance to issue orders to the Office. It is for the latter to draw the appropriate inferences from the operative part and the grounds of the Court's judgments (Case

T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 12; and Case T-129/01 *José Alejandro* v *OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 22). The applicant's third head of claim is therefore inadmissible.

The application for annulment of the contested decision

23 By its first and second heads of claim, the applicant seeks, in essence, annulment of the contested decision. In support of its action, it relies on a single plea in law alleging infringement of Article 8(1)(b) of Regulation No 40/94. That plea in law is in two parts. The first part is based on the alleged failure of the contested decision to take proper account of the renown and/or reputation of the Spanish trade mark 'CHUFI' and its highly distinctive character. The second part is based on alleged errors regarding the assessment of the lack of a likelihood of confusion between the competing signs.

24 As a preliminary point, it should be noted that, at the hearing, and as a result of the Office's plea of inadmissibility in its written pleadings, the applicant abandoned the first part of its single plea in law, of which the Court took formal notice in the minutes of the hearing.

25 It follows that the single plea in law is limited to requesting the Court to review whether, by the contested decision, the Office's First Board of Appeal wrongly concluded that there was no likelihood of confusion between the competing signs.

Arguments of the parties

26 The applicant submits that the two competing signs present visual, phonetic and conceptual similarities which should have led the First Board of Appeal to find a likelihood of confusion.

27 First of all, as regards the visual similarity of the competing signs, the applicant claims that the mark 'CHUFI' is practically identical to the first part of the mark 'CHUFAFIT' and that, since the public is attracted principally by the first part of a word mark, the two trade marks are, as a result, visually similar. The applicant points out also that the consumer may even more readily associate the origin of the two competing marks with the same undertaking because owners of well-known trade marks in the foodstuffs sector use the first part of their marks to conceive other marks containing that same part.

28 The applicant submits next that the Community trade mark applied for, 'CHUFAFIT', does not present any phonetic difference from the mark 'CHUFI', since the latter is wholly reproduced within it. According to the applicant, the Board of Appeal, in considering the syllabic structure of the two signs, overlooked the fact that the mark 'CHUFI' is wholly included in the sign 'CHUFAFIT'. It adds that such reproduction of the earlier mark in the sign applied for increases the likelihood of association.

29 Finally, on the conceptual level, the applicant submits that, if it is the case that the marks 'CHUFI' and 'CHUFAFIT' evoke the word 'chufa', that is to say the ingredient from which tiger nut cordial is made, that fact should have led the Board of Appeal, because of the common element 'chuf', to find that there was a likelihood of confusion between those two marks. In addition, the applicant points out that the

contested decision is inconsistent with the Office's decision in *FLEXICON* v *FLEXON* (R 183/2002-3), in which the Third Board of Appeal found that there was conceptual similarity, because the two competing marks alluded to the same meaning and were close to the Spanish word 'flexion'.

30 For the sake of completeness, the applicant submits that the contested decision did not take account of the reference consumer's low level of attention, a factor which should have been taken into consideration in deciding whether the similarity between the two marks was such as to give rise to a likelihood of confusion. According to the applicant, faced with trade marks serving to distinguish foodstuffs or major consumer goods, it is appropriate to take as a reference the average consumer characterised by inattentive behaviour. In this case, at the time that that type of consumer makes his purchases, he will be likely, according to the applicant, to associate the mark applied for with the earlier mark 'CHUFI', the trade mark of the best-selling tiger nut cordial in Spain, which is entirely contained in the sign 'CHUFAFIT' and the first phonemes of which are the same as that sign.

31 The Office notes that the Board of Appeal's assessment as to the identical nature of the goods covered by the two marks is not challenged by the applicant and contends that the contested decision correctly rejected the opposition as a result of the visual, phonetic and conceptual comparison of the competing signs. In essence, the Office contends, first, that the competing signs are visually and phonetically dissimilar, in particular because of their different syllabic structure. Secondly, on the conceptual level, the Office maintains that the element 'chuf', which evokes, on the part of the Spanish public, the ingredient 'chufa', is descriptive of the goods protected by the two marks. Hence, according to the Office, the distinctive character of the competing signs cannot be based on the prefix 'chuf', but is, on the contrary, based on the final parts of the two fanciful signs: on the one hand, for the sign 'CHUFI', the addition of an 'i', on the other hand, for the sign 'CHUFAFIT', the addition of 'afit'. It is also because of the descriptive nature of the element 'chuf' that, the Office submits, the applicant cannot have a monopoly over such an element in respect of the goods at issue in this case and oppose an application for registration of a Community trade mark including such an element.

32 As regards the argument concerning the Third Board of Appeal's decision in *FLEXICON* v *FLEXON*, the Office accepts that, at first sight, the positions of the two Boards of Appeal vary. None the less, while following the Community case-law, the issue of a likelihood of confusion must be resolved on a case-by-case basis. In that regard, the Office draws attention to an important difference between *FLEXICON* v *FLEXON* and this case: whereas in the former case the first parts ('flex') and the final parts ('on') were identical, in this case only the first part, 'chuf', is common.

33 Finally, the Office rejects the applicant's assertion that the goods in question (fresh nuts, processed nuts and tiger nut cordial) are major consumer goods or, at least, are comparable to beer, wine or other alcoholic drinks. According to the Office, the consumer will not find a specialised line for the goods in question. In any event, the Office maintains that the average reasonably observant and circumspect consumer, having taken the decision to buy the goods in question, will be able to distinguish between the two marks. Faced with those two weak marks, the consumer will associate the element 'chuf' with the ingredient 'chufa', rather than with one of the two marks. According to the Office, to assert the contrary is tantamount to granting the owner of a trade mark such as 'CHUFI', which is descriptive of the product 'chufa', and which enjoys only the minimum of distinctiveness required to overcome the examination of the absolute grounds for refusal, a monopoly over any other mark containing the element 'chuf', designating the ingredient 'chufa'.

34 The other parties before the Office raise doubts as to the identical nature of the goods in question. On the other hand, they refer to the entirety of the Office's arguments as regards the comparison of the competing signs.

Findings of the Court

35 It must first of all be recalled that, under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied

for is not to be registered 'if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the 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'. It is also stated that 'the likelihood of confusion includes the likelihood of association with the earlier trade mark'.

36 In this case, it is common ground that the earlier trade marks are registered in Spain. Accordingly, it is appropriate to take into account, for the purposes of assessing the conditions set forth in the preceding paragraph, the point of view of the public in that Member State. Therefore, the relevant public is, essentially, Spanish speaking.

37 It is also important to make clear that, according to the case-law of the Court of Justice concerning the interpretation of 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) and that of the Court of First Instance on 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; Case T-104/01 *Oberhauser* v *OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 25; and Case T-311/01 *Éditions Albert René* v *OHIM — Trucco (Starix)* [2003] ECR II-4625, paragraph 39).

38 The 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 (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Canon*, cited above, paragraph 16; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 18; Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40; *Fifties*, cited above, paragraph 26; and *Starix*, cited above, paragraph 40).

39 This global assessment implies some interdependence between the relevant factors and, in particular, between the similarity between the trade marks and the similarity between the goods or services concerned. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly referred to in the seventh recital in the preamble to 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 on a variety of factors which include recognition of the trade mark on the market, the association which may be made of it with the sign as used or registered, and the degree of similarity between the mark and the sign and between the goods or services identified (*Starix*, paragraph 41).

40 Finally, 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 appreciation 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*, cited above, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). For the purposes of that global appreciation, the average consumer of the goods 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 must 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).

41 As regards the reference consumer, since the goods covered by the Community trade mark applied for are foodstuffs of daily consumption, in particular the essential ingredient of tiger nut cordial ('horchata' in Spanish), and since the applicant's earlier marks are protected in Spain, the target public by reference to which the likelihood of confusion must be analysed consists of average consumers in that Member State.

42 In that regard, the Court cannot agree with the applicant's complaint that the Board of Appeal did not, in the contested decision, take account of the reference consumer's low level of attention. Even if the Board of Appeal did not state whether the goods in question belonged to the category of major consumer goods, as the applicant maintains, it none the less found, in paragraph 20 of the contested decision, that the signs were sufficiently different so as to prevent any confusion arising, even in the mind of the inattentive consumer. Accordingly, in its global examination of the likelihood of confusion between the competing signs, the Board of Appeal did refer to the consumer with a low level of attention in order to determine whether there could exist a likelihood of confusion in the mind of such a consumer.

43 So far as concerns the comparison of the goods, it is necessary to state that, in this case, the goods covered by the mark applied for, namely 'processed nuts' and 'fresh nuts', which come respectively within Classes 29 and 31, form part of the wider category of goods covered by the earlier marks and coming within the same classes. In addition, the applicant does not dispute the Board of Appeal's assessment (in paragraphs 12 and 13 of the contested decision) as regards the identical nature of the goods covered by the Community trade mark application and of the goods protected by the earlier marks. It must therefore be held that the goods in question are identical.

44 As regards the comparison of the competing signs, it is clear from the case-law of the Court of Justice and of the Court of First Instance that the global assessment of the likelihood of confusion, as far as the visual, aural or conceptual similarity of the marks in question is concerned, must be based on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (*SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; and Case T-292/01 *Philips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47).

45 In this case, the Board of Appeal compared the word mark applied for with the applicant's earlier word mark registered under No 1 778 419 and limited its examination of the likelihood of confusion between the word mark applied for and the applicant's figurative mark (registered under No 2 063 328) to the word element of that mark. That approach is correct. The word element of the applicant's earlier figurative mark appears as the dominant element of that sign, likely, by itself, to give the image of that mark which the target public keeps in mind, with the result that the other components of the mark, that is to say, in this case, the representation of a tall glass in the middle of the letter 'u' in the figurative mark, are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33). It must also be pointed out that neither the applicant nor the other parties before the Office have challenged the approach adopted by the Board of Appeal.

46 That being the case, it is appropriate to consider whether the Board of Appeal was right to exclude any likelihood of confusion between the marks in question, by making a visual, phonetic and conceptual comparison of the competing signs.

47 The Board of Appeal carried out the visual and phonetic comparison of the competing signs concurrently. It stated:

'[W]hilst it is true that visually and phonetically they share a common first syllable "CHU", the marks "CHUFI" and "CHUFAFIT" overall are visually dissimilar: they are spelt differently: the opposing mark has two syllables whilst the mark applied for has three. They have a quite different pronunciation, the opposing mark being shorter, and overall softer in sound — with the two vowels "U-I" dominating —, than the mark applied for, which begins softly but ends quite abruptly with "FIT" and which extends over three vowels producing broadly the sound "U-A-I".'

48 As regards the visual comparison, it must be stated that the competing signs share not only the prefix 'chuf', but also a common letter, 'i'. Those signs have, therefore, five letters in common, four of which form their initial part. However, the competing signs present several visual differences on which the consumer's attention may focus just as much as on the initial part, in view of the limited length of those signs. The signs are spelt differently and are composed of a different number of letters, namely five letters for the applicant's earlier marks and eight letters for the Community mark applied for, and thus have a different syllabic structure, the structure of the applicant's earlier marks being particularly short. In addition, the central position of the combination of the letters 'f', 'a' and 'f' in the Community mark applied for, 'CHUFAFIT', and the presence of the final letter 't' contribute to producing a different visual impression of the mark applied for in comparison with the applicant's earlier marks. Therefore, in the overall visual assessment of the signs, those differences, although slight, are none the less sufficient to rule out any visual similarity between the competing signs.

49 As regards the phonetic comparison, the Board of Appeal's analysis is correct. Admittedly, it must be noted that the competing signs possess first an identical syllable, 'chu', and second a fairly similar suffix, namely 'fi' for the earlier marks, and 'fit' for the sign 'CHUFAFIT'. However, it is important to observe that the syllabic structure of the competing signs is different, the earlier marks having two syllables ('chu' and 'fi') and the Community mark applied for having three ('chu', 'fa' and 'fit'). According to the rules of accentuation particular to the Spanish language, as the Board of Appeal and the Office have pointed out, the last syllable 'fit' of the mark applied for ends abruptly with the letter 't', which forms part of that accented syllable and receives, as a result, all the force of the tonic accent. That accentuation thus leads to a pronounced phonetic difference in comparison with the last syllable 'fi' of the earlier marks. Furthermore, while the sign 'CHUFI' is completely included in the sign 'CHUFAFIT', that reproduction is however truncated, since the two syllables making up the earlier mark 'CHUFI' are separated, in the sign 'CHUFAFIT', by the letters 'f' and 'a'. The interpolation of those letters between the first common syllable and the suffixes of the competing signs leads to a different phonetic impression from that of the earlier marks. It follows from all of those phonetic differences that the truncated reproduction of the sign 'CHUFI' in the sign which is the subject of the trade mark application does not mean that the competing signs are phonetically similar.

50 As regards the conceptual comparison, the Board of Appeal held, in essence, that the element 'chuf', common to the competing signs, which evokes the tiger nut ('chufa' in Spanish), is descriptive of the product from which the drink 'horchata' (tiger nut syrup) is made and cannot therefore serve to distinguish the marks. The Board of Appeal accepted that that was a weakness common to the two marks and held that, in the overall comparison of the competing signs, the initial part of the marks was therefore less important than their final parts, which will enable the consumer to perceive that those terms are trade marks and not descriptive words.

51 The Court notes in that regard that the target public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (see, to that effect, *BUDMEN*, cited above, paragraph 53; see, also, Case T-10/03 *Koubi* v *OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraph 60).

52 In this case, while in its written pleadings the applicant accepted that its 'CHUFI' marks conceptually evoked the tiger nut ('chufa' in Spanish), it none the less maintained that its marks were able to have distinctive character because of the alleged reputation and/or alleged renown which they have acquired in Spain. However, as stated in paragraph 24 above, the applicant abandoned, at the hearing, any reliance on the alleged reputation and/or the alleged renown of its trade marks.

53 The Court finds that the prefix 'chuf', which is common to the competing signs, designates the tiger nut (or rush nut), whose Spanish name is 'chufa' and which, in this case, is used to make the popular drink known under the name 'horchata' (tiger nut cordial) which is particularly marketed in Spain by the applicant. Consequently, in the overall impression conveyed by the competing signs, the target public will perceive the element 'chuf' as a descriptive element of the goods designated by the competing signs and not as an element enabling the commercial origin of those goods to be distinguished. The element 'chuf' is therefore devoid of distinctive character and cannot be regarded as the dominant element of the overall impression conveyed by the competing signs.

54 On the other hand, as the Office has correctly observed, in the global impression conveyed by the competing signs, it is the final parts of those signs which will enable the target public to perceive the signs as imaginary words and not as words which are solely descriptive. However, it is important to note that, from the conceptual point of view, neither the suffix 'fit', so far as the Community mark applied for is concerned, nor the letter 'i', as regards the applicant's earlier marks, has any particular meaning in Spanish. On the conceptual level, the comparison of those elements is therefore irrelevant. The fact remains that the visual and phonetic differences between those elements are sufficient to enable, in the overall assessment of the competing signs, any likelihood of confusion between those signs to be ruled out on the part of the target public. Furthermore, even supposing, as the applicant argued for the first time at the hearing, that the suffix 'fit' of the mark applied for refers to the word 'fit' in English, one of the various meanings of which evokes a person in good physical shape, and that a significant part of the target public has sufficient knowledge of English to understand such an evocation, which has moreover not been demonstrated by the applicant, the Court considers that such evocation is not necessarily descriptive of a characteristic of the goods covered by the trade mark applied for and that, besides, it is only likely to rule out further any likelihood of confusion between the competing signs. In any event, such an argument, which seeks to deny the distinctive character of the Community trade mark applied for, does not form part of the subject-matter of these proceedings, which, as follows from the findings in paragraphs 22 and 23 to 25 above, relate solely to the existence of a relative ground for refusal, namely the likelihood of confusion between the competing signs.

55 The Board of Appeal therefore correctly found that, in the overall assessment of the competing signs, the differences between those signs were sufficient to rule out any likelihood of confusion on the part of the target public.

56 That conclusion cannot be gainsaid by the various arguments deployed by the applicant.

57 As regards, first, the Office's allegedly divergent practice in decisions and the references to Spanish national decisions concerning signs and national registrations other than those in this case, it must be observed, first, that the legality of decisions of the Boards of Appeal is to be assessed purely by reference to Regulation No 40/94, as interpreted by the Community judicature, and not the Office's practice in its earlier decisions (Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraph 47; Case T-130/01 *Sykes Enterprises* v *OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179, paragraph 31; and *BUDMEN*, paragraph 61). Accordingly, the argument alleging the possible inconsistency of the contested decision with the decision of the Office's Third Board of Appeal in *FLEXICON* v *FLEXON* cannot be upheld. Second, so far as the references to Spanish national decisions are concerned, an identical conclusion is inescapable (Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraph 53, and Case T-85/02 *Díaz* v *OHIM — Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 37).

58 Secondly, it is also necessary to reject the applicant's argument based on the trade practice of proprietors of well-known marks, according to which they use the first parts of their trade marks to conceive derived marks containing those same parts. First, the applicant cannot invoke the alleged renown of its earlier marks, reliance upon which it abandoned at the hearing, as stated in paragraph 24 above. Second, as the Office has argued, the applicant cannot claim to oppose the use by the other parties before the Office of the element 'chuf' for the goods within the relevant territory, since, as has already been held in paragraph 54 above, that element cannot be perceived by the target public as enabling the commercial origin of the goods protected by the applicant's earlier marks to be distinguished.

59 Finally, as regards the applicant's remarks concerning the likelihood of association between the competing signs because of the use of a common prefix 'chuf', it should be noted that that likelihood is a specific case of the likelihood of confusion, which is characterised by the fact that the marks in question, whilst not likely to be directly confused by the target public, could be perceived as being two marks belonging to

the same holder (Case T-224/01 *Durferrit* v *OHIM — Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 60, and the case-law cited). While that may be the case, in particular, where the two marks appear to belong to a series of marks based on a common core element (*NU-TRIDE*, cited above, paragraph 61), it must be stated that that cannot be the case here, since the prefix 'chuf' has a descriptive character which, as a result, is not apt to create, on the part of the target public, a likelihood of association between the competing signs.

60 It follows from the foregoing that, even if, in this case, the goods covered by the competing signs are identical, the differences between those signs are sufficient to rule out the existence of a likelihood of confusion in the target public's perception.

61 Consequently, the single plea in law alleging infringement of Article 8(1)(b) of Regulation No 40/94 must be rejected and the application must be dismissed in its entirety.

Costs

62 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, and the Office and the other parties before the Office have applied for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (First Chamber)

hereby:

1. Dismisses the application;

2. Orders the applicant to pay the costs.

Vesterdorf Mengozzi Martins Ribeiro

Delivered in open court in Luxembourg on 6 July 2004.

H. Jung
Registrar

B. Vesterdorf
President