JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

18 October 2007 *

In Case T-28/05,

Ekabe International SCA, established in Luxembourg (Luxembourg), represented by C. de Haas, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

* Language of the case: French.

Ebro Puleva SA, established in Madrid (Spain), represented by P. Casamitjana Lleonart, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 6 October 2004 (Case R 117/2001-4), relating to opposition proceedings between Puleva SA (now Ebro Puleva SA) and Ekabe International SCA,

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

composed of M. Vilaras, President, F. Dehousse and D. Šváby, Judges,

Registrar: K. Pocheć, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 17 January 2005,

having regard to the response of OHIM lodged at the Court Registry on 4 August 2005,

having regard to the response of the intervener lodged at the Court Registry on 28 July 2005,

further to the hearing on 9 November 2006,

gives the following

Judgment

Background to the dispute

1 On 17 April 1998, the company Cema filed an application for a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The coloured figurative mark for which registration was sought is the following:



3 The product in respect of which trade mark registration was sought is in Class 29 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 corresponds to the following description: 'Margarine'.

4 The trade mark application was published in the *Community Trade Marks Bulletin* on 11 January 1999.

5 On 12 April 1999, the intervener Puleva SA (now Ebro Puleva SA) filed a notice of opposition to registration of the trade mark applied for, under Article 8(1)(b) of Regulation No 40/94.

6 The ground relied on in support of the opposition was a likelihood of confusion between the trade mark applied for and the intervener's earlier national word mark PULEVA-OMEGA3, registered in Spain on 22 March 1999 under number 2140889 for goods in Class 29 of the Nice Agreement and corresponding to the following description: 'Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs; edible oils and fats; prepared dishes made from meat, fish or vegetables and especially milk and milk products'.

7 The intervener and Cema submitted observations on 7 February and 10 May 2000 respectively.

8 By decision of 24 November 2000, the Opposition Division upheld the opposition on the ground that the goods and signs in question were similar and that there was therefore a likelihood of confusion on the part of the Spanish public.

9 On 26 January 2001, Cema filed a notice of appeal against the decision of the Opposition Division.

10 On 6 April 2001, the intervener submitted its observations to the Board of Appeal.

11 On 28 August 2002, Cema transferred its Community trade mark application to Primalliance SAS.

12 On 30 August 2004, Primalliance transferred the Community trade mark application to the applicant, Ekabe International, SCA.

13 The Fourth Board of Appeal of OHIM, by decision of 6 October 2004 ('the contested decision'), dismissed the appeal and upheld the Opposition Division's decision on the ground that the goods in question were similar or identical and that there was a certain degree of similarity between the signs.

14 With regard to the comparison of the goods, the Board of Appeal stated, at point 11 of the contested decision, that the product covered by the trade mark applied for, namely margarine, was to a considerable degree similar to or identical with the goods covered by the earlier mark, that is edible oils, fats and milk products.

15 With regard to the comparison between the signs, the Board of Appeal considered, at point 14 of the contested decision, that the element 'omega 3' possessed a low degree of distinctiveness with regard to the goods covered by the application and that, accordingly, it had to be disregarded when comparing the conflicting marks. The Board of Appeal stated that, at the time when the trade mark application was made, the average Spanish consumer did not perceive that element to be descriptive of essential characteristics of the goods concerned, on the ground that it was

unlikely that the average Spanish consumer associated the element 'omega 3' with polyunsaturated fatty acids, the nutritional value of which helps to prevent cardiovascular diseases. As for the extracts from various websites produced by the applicant which refer to the element 'omega 3', the Board of Appeal stated that, upon close examination, these did not support the applicant's argument that the element 'omega 3' is part of everyday language and that a substantial part of the public in Spain is aware of its medicinal or nutritional properties.

16 The Board of Appeal stated, at points 15 and 16 of the contested decision, that, visually, the element 'omega 3' was the main component of the trade mark applied for, whereas the figurative element undoubtedly appeared less important and added little to the distinctiveness of the trade mark applied for. Neither the presence of the word 'puleva' in the earlier mark nor the figurative elements of the trade mark applied for will enable consumers adequately to distinguish the conflicting signs from each other. From an aural point of view, the Board of Appeal stated, at point 17 of the contested decision, that the conflicting marks were similar in so far as they had the element 'omega 3' in common but were different in length and rhythm as a result of the presence of the word 'puleva' in the earlier mark. The Board of Appeal stated, at point 18 of the contested decision, that from a conceptual point of view, the average consumer will be unable to establish a conceptual link between the word element 'omega 3' and the kind of polyunsaturated fatty acids of the same name known for its medicinal properties and that, at the very most, he will be able to identify the word 'omega' as the last letter of the Greek alphabet. With regard to the word 'puleva' in the earlier mark, the Board of Appeal stated that it was a fanciful word which had no connotation in Spanish.

17 The Board of Appeal concluded that there was therefore a likelihood of confusion between the conflicting marks for consumers in Spain, within the meaning of Article 8(1)(b) of Regulation No 40/94.

Forms of order sought by the parties

18 The applicant claims that the Court should:

— annul and alter the contested decision;

— order OHIM to pay the costs.

19 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs;

— order each of the parties before the Court to bear its own costs if the application is allowed.

20 The intervener contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

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

Arguments of the parties

22 The applicant takes the view that there is no likelihood of confusion between the conflicting marks since the Spanish consumer will retain from the two signs at issue only the word 'puleva' in the earlier mark and the graphic representation and particular colours of the element 'omega 3' in the trade mark applied for.

23 Firstly, the applicant submits that the element 'omega 3' is descriptive and is normally used to designate food products of which this kind of polyunsaturated fatty acids forms a chemical component. In support of that argument, the applicant produces documents relating to the existence of food products on the Spanish market highlighting the element 'omega 3' and to the existence of trade marks filed in Spain including that element. It is, moreover, apparent from newspaper articles distributed in Spain and from the extracts from websites produced by the applicant as annexes to its application that the average Spanish consumer is well aware of the beneficial properties of omega 3-type polyunsaturated fatty acids and does not in any way regard that element as constituting a distinctive sign. The fact that, for the Spanish public, the element 'omega 3' is descriptive or normal in relation to food products has, moreover, been recognised by the Oficina Española de Patentes y Marcas (Spanish Patents and Trade Marks Office) and confirmed on appeal by the Tribunales Superiores de Justicia (High Courts of Justice) in cases concerning similar opposition proceedings. The applicant therefore considers that it is wrong to state that the element 'omega 3' is dominant within the two conflicting marks. The reasoning of the Board of Appeal is, moreover, contradictory since, in order to justify a conceptual similarity between the conflicting marks, it took the view that the Spanish consumer would be sufficiently familiar with the element 'omega 3'.

24 Secondly, the applicant submits that only the element 'puleva' in the earlier mark is unusual and has a distinctive character. The fact that that element is the company name of the proprietor of the earlier mark does not make that word a secondary feature of that mark. The applicant maintains that either the element 'puleva' is to some extent well known among the Spanish public, in which case the earlier mark is well known and will hold the public's attention, or the element 'puleva' is not particularly well known, in which case it should be regarded as arbitrary and therefore distinctive in relation to the goods concerned. According to the applicant, the purpose of the word 'puleva' is specifically to guarantee the origin of the goods and it therefore enables consumers to distinguish the intervener's goods from those of its competitors. The applicant adds that the word 'puleva', placed at the top of the earlier mark, is its dominant element visually, since the consumer reads it first, and is the dominant feature aurally, since the syllables 'pu' and 'va' are clearly audible. Moreover, the letter 'p' is a very distinctly pronounced consonant which holds the consumer's attention. In addition, the word 'puleva' does not have any meaning, whereas the Spanish consumer will have at least an approximate idea that omega 3-type polyunsaturated fatty acids have beneficial properties in relation to cardiovascular diseases.

25 Thirdly, the applicant observes that the figurative element of the trade mark applied for is highly distinctive. The applicant observes that the element 'omega 3' is stylised in such a way that the figure '3' appears to be attached to the letter 'a' of the word 'omega'. The trade mark applied for is, furthermore, depicted in very bright colours, namely green, yellow, blue and red, which hold the consumer's attention. According to the applicant, the figurative element of the trade mark applied for, that is, a blue, yellow and green rainbow emerging from a red heart, which is placed between the letters 'o' and 'm' of the word 'omega', is also a distinctive feature.

26 Fourthly, the applicant states that Spanish consumers will be able to make a direct comparison between the goods covered by the conflicting marks. According to the applicant, it is not a question of comparing margarine with all of the food products in Class 29 but only of comparing it with milk and milk products and with edible oils and fats. The Spanish consumer is able to compare directly, for example, all of the

milk beverages displayed next to each other on the shelves and to make his choice on the basis of the trade mark or the price of the product.

27 Lastly, the applicant observes that, to give a trade mark such as the earlier mark, which consists of the element 'puleva-omega3', a monopoly on the element 'omega 3' would create highly damaging legal uncertainty, whereas it should be possible for that word to be freely used (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25).

28 OHIM replies that, since the applicant has failed to demonstrate in sufficient time that the element 'omega 3' could be perceived as descriptive by the relevant Spanish public, the Board of Appeal correctly found that that element was as distinctive and dominant within the earlier mark as the element 'puleva'. According to OHIM, the overall similarities between the conflicting signs lend support to the conclusion that they are similar. Since the goods concerned are identical or very similar, a finding that there is a likelihood of confusion between the conflicting marks in Spain is justified.

29 With regard to the documents produced before the Court by the applicant, OHIM observes that these were not produced before the Board of Appeal and that they are therefore, as a matter of principle, inadmissible.

30 First of all, the intervener submits that the element 'omega 3' is in itself dominant and distinctive and is not descriptive or normal. According to the intervener, the element 'omega 3' may be known by a certain specialist public but it is not known by the general public and in particular not by the average non-specialist Spanish consumer.

31 Next, the intervener submits that there is a clear similarity between the two conflicting marks. According to the intervener, the element 'omega 3' is the predominant element in each of the conflicting marks, given that this word element is the one which the average consumer will retain from the outset, both visually and aurally. The fact that the trade mark applied for contains a figurative element is of no importance in view of the fact that the word element prevails over the figurative element.

32 Moreover, the intervener observes that the applicant restricts the comparison of the goods covered by the conflicting marks to the milk products, oils and fats sector. According to the intervener, irrespective of the fact that there are other trade marks containing the element 'omega 3' on the market, there is a great similarity between the goods covered by the signs in question.

33 Lastly, the intervener observes that the applicant's arguments would result in an absolute refusal to register the trade mark applied for. Thus, the Oficina Española de Patentes y Marcas refused to register the word mark OMEGA 3 for goods in Class 30, which the intervener had applied for, on the ground that the sign in question consisted exclusively of indicators which were descriptive of characteristics of the goods.

Findings of the Court

The admissibility of a number of documents produced before the Court by the applicant

34 The applicant produces, at Annexes 4 to 21, 24 to 27 and 33 to its application, facts which were not produced before OHIM, as is apparent from a perusal of the file relating to the proceedings before the Board of Appeal, which was forwarded to the

Court pursuant to Article 133(3) of its Rules of Procedure. The Court finds that only the extracts from websites which the applicant produces at Annex 30 to its application were produced in the course of the proceedings before OHIM.

35 It should be noted at this point that, according to settled case-law, the purpose of actions brought before the Court of First Instance is to review the legality of decisions of the Boards of Appeal within the meaning of Article 63 of Regulation No 40/94. Facts which are pleaded before the Court without previously having been brought before the departments of OHIM can affect the legality of such a decision only if OHIM should have taken them into account of its own motion. It follows from the concluding words of Article 74(1) of Regulation No 40/94, according to which, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought, that OHIM is not required to take account of its own motion of facts which have not been put forward by the parties. Therefore, such facts cannot affect the legality of a decision of the Board of Appeal (see, to that effect, Case T-115/03 *Samar* v *OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13, and Case T-269/02 *PepsiCo* v *OHIM — Intersnack Knabber-Gebäck (RUFFLES)* [2005] ECR II-1341, paragraph 35).

36 It follows that the documents produced by the applicant at Annexes 4 to 21, 24 to 27 and 33 must be excluded, without it being necessary to assess their probative value.

Whether the plea alleging infringement of Article 8(1)(b) of Regulation No 40/94 is well founded

37 Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

38 Under Article 8(2)(a)(ii) of Regulation No 40/94, 'earlier trade marks' means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

39 In the present case, the earlier trade mark on which the opposition is based is registered and protected in Spain. Therefore, in order to establish whether there may be a likelihood of confusion between the conflicting marks, account must be taken of the point of view of the relevant public in Spain.

40 According to established case-law, 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. According to that same line of case-law, the likelihood of confusion must be assessed globally according to the relevant public's perception of the signs and the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence of the similarity between the signs and between the goods or services (Case T-162/01 *Laboratorios RTB* v *OHIM — Giorgio Beverley Hills (GIORGIO BEVERLEY HILLS)* [2003] ECR II-2821, paragraphs 30 to 32 and the case-law cited).

41 It must be noted that the applicant does not challenge the Board of Appeal's conclusion in the contested decision concerning the similarity or identity of the

goods designated by the conflicting signs. The only disputed issue between the parties is whether the Board of Appeal was entitled to consider that the conflicting signs are broadly similar.

42 It is therefore necessary to consider whether the conflicting signs are similar.

43 According to established case-law, a compound trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the compound mark, unless that component forms the dominant element within the overall impression created by the compound mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord* v *OHIM — Hukla Germany (MATRATZEN)*[2002] ECR II-4335, paragraph 33, and Case T-359/02 *Chum* v *OHIM — Star TV (STAR TV)* [2005] ECR II-1515, paragraph 44).

44 The applicant submits that the Board of Appeal was wrong to conclude in the contested decision that there was a likelihood of confusion between the conflicting marks on the ground that they have the word element 'omega 3' in common. According to the applicant, contrary to the finding in the contested decision, the element 'omega 3' must be regarded as descriptive of characteristics of the goods in question and, for that reason, it is the word 'puleva' which is the dominant element of the earlier trade mark. Therefore, in the present case there is no likelihood of confusion between the two conflicting marks.

45 According to the case-law, if, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, a component which is devoid of any distinctive character is the dominant element of that mark, whereas the other

figurative and graphic elements of which it is composed are ancillary and do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, which would allow that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application, then the trade mark applied for as a whole is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 and must be refused registration (see, to that effect, Case C-37/03 P *BioID* v *OHIM* [2005] ECR I-7975, paragraphs 73 to 75).

46 The same conclusion can be drawn with regard to a trade mark applied for, the dominant element of which, in the overall impression conveyed to the relevant public, consists of a word element that is wholly descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, where the figurative elements which that mark contains do not have sufficient impact on the minds of the relevant public to keep their attention, to the detriment of the descriptive word element, or to bestow a distinctive effect on the overall sign in question (see, to that effect, the Opinion of Advocate General Léger in *BioID* v *OHIM*, point 75).

47 Furthermore, while, on the one hand, the applicant for a Community trade mark cannot in opposition proceedings challenge the validity of the earlier mark put forward in opposition, on the ground that its registration would be contrary to Article 7 of Regulation No 40/94 (see, to that effect, Case T-186/02 *BMI Bertollo* v *OHIM — Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 71), on the other hand, where an absolute ground of refusal precludes registration of the Community trade mark applied for, OHIM has the power, in tandem with the opposition proceedings, to reopen the examination procedure in order to determine whether there may be such a ground (see, to that effect, Case T-224/01 *Durferrit* v *OHIM — Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 73).

48 In the light of those considerations, the Court considers that it is necessary in the present case to examine, first of all, whether, in the overall impression conveyed by the trade mark applied for to the relevant public, the word element 'omega 3' is the dominant element of that compound mark, irrespective of whether that element is descriptive.

49 Contrary to what is claimed by the applicant, the Board of Appeal was entitled to consider, at point 15 of the contested decision, that the word element 'omega 3', written in large green characters shadowed in yellow, is the dominant element of the trade mark applied for in that it will catch the consumer's attention first as a result of its position in the centre of the mark in question. By contrast, the figurative element of that mark, namely the blue, yellow and green rainbow which arches over the 'omega 3' element and emerges from a red heart, which is placed between the letters 'o' and 'm' of the word 'omega, is considerably smaller in size and therefore adds little to the distinctive character of that mark.

50 In those circumstances, the single plea in law put forward by the applicant must be rejected without it being necessary for the Court to rule on whether, with regard to the goods covered by the conflicting marks, the dominant word element 'omega 3' is descriptive for the Spanish public. Even if that element were descriptive, as the applicant claims, annulment of the contested decision on that ground would necessarily lead OHIM, which is required to draw the appropriate inferences from the operative part of the Court's judgment and the grounds on which it is based (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-388/00 *Institut für Lernsysteme* v *OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 19), to reopen the procedure for the examination of the applicant's Community trade mark application and to reject it on the basis of the considerations set out at paragraphs 45 to 49 above.

51 Applicants have no legitimate interest in the annulment of a decision where that annulment can only lead to the adoption of another decision having the same effect as the decision annulled (see, to that effect, Case T-16/02 *Audi* v *OHIM (TDI)* [2003] ECR II-5167, paragraph 97 and the case-law cited).

52 On the other hand, if the 'omega 3' element cannot be regarded as descriptive, the Board of Appeal was correct to conclude in the contested decision that there was a likelihood of confusion between the conflicting marks in view of the dominant nature of the word element 'omega 3' in the trade mark applied for.

53 It must be stated, in that case, that the applicant has not put forward precise arguments to challenge the decision of the Board of Appeal on its merits.

54 It should be pointed out, in general terms, that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (*MATRATZEN*, paragraph 30). According to the case-law of the Court of Justice, the visual, aural and conceptual aspects are relevant. Furthermore, the assessment of the similarity between two trade marks must be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1998] ECR I-3819, paragraph 25).

55 In that regard, by way of initial analysis, the Court considers that it must be concluded that, where the only dominant word element of a compound trade mark is identical, visually and aurally, to one of the only two elements of which an earlier

word mark is composed and where those elements, taken together or separately, do not have any meaning from the conceptual point of view for the relevant public, the trade marks in question, each considered as a whole, are normally to be regarded as similar within the meaning of Article 8(1)(b) of Regulation No 40/94.

56 In the present case, visually and aurally, the 'omega 3' element is at the same time the second of the two elements of which the earlier trade mark is composed (the first being the element 'puleva') and the only word element of the trade mark applied for, of which it is the dominant component (see paragraph 49 above).

57 If the target public does not consider the 'omega 3' element to be descriptive of the goods concerned, that element will be perceived by the relevant public as fanciful and intrinsically distinctive.

58 Given that the same applies to the element 'puleva', both of those elements must be regarded as having an equal power of attraction for the relevant public and, as they appear side by side in the expression 'puleva-omega3', they will be perceived by that public as equally dominant, without the 'omega 3' element losing its distinctive character.

59 Accordingly, the Board of Appeal was entitled to conclude that the conflicting marks, each considered as a whole and bearing in mind in particular their distinctive and dominant features, were similar.

60 In view of the foregoing, the relevant public is likely to think that the food products covered by the trade mark applied for may come from the undertaking of the proprietor of the earlier trade mark. Consequently, the degree of similarity between the conflicting marks is sufficient to support the finding that there is a likelihood of confusion between them.

61 With regard to the applicant's submission that the Spanish consumer will be able directly to compare the goods covered by the conflicting marks, that cannot rule out the likelihood of confusion thus established. There is no ground for the assertion that the applicant's goods and those of the intervener would be offered for sale, as the applicant maintains, side by side. On the contrary, the Court considers that it is correct to find, as did the Board of Appeal in the contested decision, that the average consumer of food products only rarely has the opportunity to make a direct comparison of the different trade marks. Thus, the consumer looking at food products takes into account and retains the predominant feature of the sign, which enables him when making a further purchase to repeat the experience. Where the target public will come across goods covered by the trade mark applied for, the dominant feature of which is identical to one of the two components of the earlier mark, it is highly likely that it will attribute the same commercial origin to the goods in question.

62 Accordingly, the single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94, must be rejected.

63 The action must therefore be dismissed.

Costs

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

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. Dismisses the action;

2. Orders Ekabe International SCA to pay the costs.

Vilaras Dehousse Šváby

Delivered in open court in Luxembourg on 18 October 2007.

E. Coulon M. Vilaras

Registrar President