

OPINION OF ADVOCATE GENERAL

RUIZ-JARABO COLOMER

delivered on 8 September 2005¹

1. The appeal is against the judgment of the Court of First Instance (Second Chamber) of 22 June 2004,² which dismissed the action for annulment of the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM'), which had in turn rejected the opposition raised by the proprietors of the word mark PICASSO, who are the appellants in the present appeal proceedings, against registration of the word sign PICARO in respect of vehicles.

2. The case is set against the background of the ongoing debate about likelihood of confusion and, as such, it concerns the application of Article 8(1)(b) of the Community Trade Mark Regulation.³ A single plea in law, divided into four different parts, has been put forward in support of the appeal. The first part relates to statements by the Court of First Instance to the effect that, in assessing similarity, the conceptual aspect can outweigh any graphic and phonetic

similarities; the second part concerns the special protection given to trade marks which have a greater degree of distinctiveness; the third and fourth parts relate in different ways to the possibility that the consumer may become confused once the sale has taken place.

3. First of all, it is surprising to come across the name Pablo Ruiz Picasso involved in legal proceedings, far removed from his achievements as a painter and sculptor,⁴ and associated with mundane litigation about the use of his second surname, a name now so closely linked with his art and with which he signed most of his works. It is sad to note that the most outstanding mythical figure of the 20th century, part of the common heritage of mankind, has been reduced to

1 — Original language: Spanish.

2 — Case T-185/02 *Ruiz-Picasso and Others v OHIM — Daimler-Chrysler (PICARO)* [2004] ECR II-1739.

3 — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), amended by Council Regulation (EC) No 3288/94 of 22 December 1994 for the implementation of the agreements concluded in the framework of the Uruguay Round (OJ 1994 L 349, p. 83).

4 — Although the prodigious artist Pablo Picasso (1881–1973) is best known for his work in these two plastic arts, his forays into literature, and specifically into playwriting, although less successful, should also be mentioned. These resulted in *Les quatre petites filles*, a play in six acts written in 1948 but not published by Gallimard until 1969. The Spanish version, entitled *Las cuatro niñas*, translated by María Teresa León, was published in Madrid by Aguilar in 1973. His poetic side, to which he turned in moments of less frenzied painting and sculpture or during difficult times in his private life, is the subject of an essay by Gustavino, M. and Michaël, A., 'L'écriture n'est pas un jeu', in the collection *Picasso, l'objet du mythe*, École Nationale Supérieure des Beaux Arts de Paris, Paris, 2005, pp. 109 et seq.

an article of commerce, a piece of merchandise. Of course, it is perfectly legitimate to protect such a name against harmful attacks, but its widespread use for purely commercial ends outside the field in which gained its renown could be detrimental to the respect which his extraordinary personality deserves.

6. Article 8 lists the relative grounds for refusal, Article 8(1)(b) providing that:

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

(a) ... ;

I — The Community Trade Mark Regulation

4. Regulation No 40/94 sets out the provisions applicable to the dispute.

(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.

...'

5. Article 4 provides that: 'A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

II — Background to the appeal

A — The facts of the case

7. On 11 September 1998 DaimlerChrysler AG, the intervener in the first instance

proceedings, filed an application with OHIM for a Community trade mark for the sign PICARO.

the Nice Agreement, described as follows: 'vehicles; apparatus for locomotion by land, air or water, motor cars, motor coaches, trucks, vans, caravans, trailers'.

8. The application was in respect of 'vehicles and parts therefor; omnibuses' corresponding to Class 12 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.

9. Following publication of the application in the Community Trade Marks Bulletin, the 'Picasso estate'⁵ entered an opposition under Article 42(1) of Regulation No 40/94 for all classes of goods referred to in the application, on the grounds of the likelihood of confusion referred to in Article 8(1)(b) of Regulation No 40/94.

10. The basis of the action taken under Article 42 was that Community trade mark No 614 867 had already been registered in the name of the artist's estate. The word mark PICASSO was registered on 26 April 1999 in respect of goods within class 12 of

11. The relevant division of the OHIM granted the registration sought on the grounds that there was no likelihood of confusion between the marks at issue. The Picasso estate appealed against this decision to the OHIM Board of Appeal pursuant to Article 59 of Regulation No 40/94, seeking that the decision be set aside and the application be rejected.

12. By a decision of 18 March 2002,⁶ the Third Board of Appeal rejected this argument, considering that, in view of the high degree of attention of the relevant public, the marks at issue were not phonetically or visually similar. It further considered that the conceptual impact of the earlier mark was such as to counteract any phonetic or visual resemblance between them.

5 — This term designates a group of people, all members of the painter's family, who make up an estate in co-ownership under Article 815 et seq. of the French Civil Code, the co-owners being the appellants.

6 — Case R 247/2001-3.

13. On 13 June 2002 the Picasso estate lodged an application with the Registry of the Court of First Instance claiming that the decision of the Third Board of Appeal should be set aside.

criteria established in *Laboratorios RTB v OHIM*,⁷ pointing out that the goods designated by the two trade marks are partly identical and partly similar.⁸

B — *The judgment under appeal*

14. The applicants put forward two pleas in law, the first based on infringement of Article 8(1)(b) of Regulation No 40/94 and the second on the allegation that the Board of Appeal had gone beyond the bounds of the dispute between the parties to the opposition proceedings.

15. As the appeal is not against the judgment of the Court of First Instance in relation to the second plea, there is no need to comment further on this.

16. In connection with the infringement of Article 8(1)(b), the Court of First Instance first carried out a global assessment of the likelihood of confusion in the light of the

17. Basing itself on previous rulings,⁹ the Court then proceeded to look at the degree of similarity between the two signs. It concluded that, although there were visual and phonetic similarities, the degree of similarity in the latter case was low. In connection with the conceptual similarity between the marks in question, the Court of First Instance referred to the obvious differences between, on the one hand, the name of the famous painter¹⁰ and, on the other, the word 'pícaro', pointing out that, outside the Spanish-speaking world, the latter has no

7 — Case T-162/01 *Laboratorios RTB v OHIM* [2003] ECR II-2821.

8 — Paragraphs 49 to 52 of the judgment under appeal.

9 — In particular Case T-292/01 *Phillips-Van Heusen Corp. v OHIM* [2003] ECR II-4335.

10 — It is generally accepted that the artist's second surname is of Italian origin, but the Picasso family had been living in Andalusia for several generations by the time he was born. He dropped his father's surname, 'Ruiz', when he went to live in Paris; when he lived in Spain his paintings and drawings always bore the three-part signature Pablo Ruiz Picasso, P. Ruiz Picasso or P. R. P. It seems very likely that the problems experienced by the French in pronouncing his first surname led to its being dropped. The word Picasso, on the other hand, with no stumbling blocks and the stress on the final syllable, posed no problems in the language of Molière. Lafuente Ferrari, E., 'Prólogo', in Huelin y Ruiz-Blasco, R., *Pablo Ruiz Picasso*, Biblioteca de la Revista de Occidente, Madrid, 1976, p. 12.

meaning,¹¹ although it did not go into its origins.¹²

18. These conceptual differences and the clear semantic content of Picasso as the name of the painter of *Les demoiselles d'Avignon*,¹³ led the Court to the view that the meaning of the word as a mark for motor

vehicles could not override that of the painter of *Guernica*¹⁴ in the perception of the average consumer, who would never, as an initial reaction, associate that name with a mark of motor vehicles. Hence the conclusion of the Court of First Instance that the complete conceptual disparity between the signs at issue outweighs the visual and phonetic similarities.¹⁵

11 — Paragraphs 53 to 55 of the judgment under appeal. According to the dictionary of the Spanish language published by the Real Academia Española (*Diccionario de la lengua española*, 21st edition, Real Academia Española, Madrid, 1992), 'pícaro' means, in particular, a cheeky, roguish, comical, low-life character, not without a certain appeal, featuring in great works of the genre of Spanish literature known as picaresque. This was at its height in novels such as the anonymous *La vida de Lazarillo de Tormes*, first published in 1554, *Guzmán de Alfarache*, by Mateo Alemán (1604), and *El Buscón* (1604, first published in 1620) by Francisco de Quevedo. R. Menéndez Pidal, in his *Antología de prosistas castellanos*, Madrid, 1917, p. 117, has made the point that the last third of the 16th and the first two decades of the 17th centuries represented the high point of the greatness of Spanish prose, both in terms of beauty and in terms of its diffusion throughout the civilised world. It was highly original in two very different genres, namely the most sublime mystical language, capable of expressing all the secrets of the philosophy of divine love, and the sauciest of picaresque, merciless in its satirical portrayal of a vast underclass of idle and poverty-stricken characters. The word 'pícaro' might be better understood outside Hispanic culture if Hergé, the creator of 'Tintin', had seen fit to explain it in his book of adventures of this comic-book hero, *Tintin and the Pícaros* (*Tintin et les Pícaros*, Casterman, Tournai, 1976). By not doing so he failed to transmit to his English-, German- and French-speaking readers, in whose languages the word pícaro is retained, its true meaning and they probably associate it with guerrilla warfare, and more particularly with the band of guerrillas led in the book by General Alcázar.

12 — The etymology of the word 'pícaro' is unclear. It is first mentioned in the farce *Custodia del hombre* by Bartolomé Palau, written between 1541 and 1547. According to J. Corominas in *Diccionario crítico etimológico de la lengua castellana*, Gredos, Madrid, 1974, volume III, p. 768, 'pícaro' and its archaic synonym 'picaño' may be slang-type words deriving from the verb 'picar' (meaning, inter alia, to sting, to bite, to punch holes and to chop) and referring to the various types of jobs that picaros used to do (kitchen hand, or picador in the bullfighting sense, for example). There was also a later influence by the French word 'picard', which gave rise to the term 'picardía', alluding to the French region of Picardy, many of whose inhabitants at that time, soldiers in the main, had a relaxed, carefree and bohemian lifestyle. The term passed into common use before taking on a literary meaning.

13 — This painting, executed in 1907 and originally entitled *Bordel philosophique*, marks the birth of cubism, a style which reduces figures to their primary forms, representing them using its own geometric vocabulary. Brihuega Sierra, J., 'Die spanische Kunst zwischen 1900 und 1939', in *Die Geschichte der spanischen Kunst*, the German version of *Historia del arte de España*, Lunewerg Editores, 1996, published by Könneman, Cologne, 1997, p. 438.

19. The great painter's estate argued that, as the name PICASSO is well known, it should have the broader protection accorded by the case-law to marks which have a highly distinctive character.¹⁶ This was rejected by the Court of First Instance, which took the view that the fact that the artist is well known was not capable of heightening the likelihood of confusion in respect of the goods concerned.¹⁷

20. Lastly, the Court looked at the degree of attention of the relevant public at the time of purchase, taking into account the level of technological development and the price of goods of this type, and concluded that it was particularly high. It did not, however, take into account the perception of the public at

14 — This painting captured the horror of the bombardment by Hitler's air force on 26 April 1937 of the city which gave the painting its name. Over and above its purely artistic merit, it represents a demonstration of the painter's commitment to history in the sense of leaving his ivory tower and standing shoulder to shoulder with humanity. Brihuega Sierra, J., op. cit., p. 460.

15 — Paragraphs 56 to 58 of the judgment under appeal.

16 — Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 24; Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 18.

17 — Paragraph 61 of the judgment under appeal.

times other than the moment of purchase, in particular subsequent to purchase, which may be relevant in an assessment of the likelihood of post-sale confusion.¹⁸

— set aside the decision of the Third Board of Appeal of OHIM of 18 March 2002 in Case R 247/2001-3 in so far as it rejected the opposition entered by the appellant against the application lodged by DaimlerChrysler for registration as a Community trade mark of the word mark PICARO;

III — Proceedings before the Court of Justice and arguments of the parties

21. The appeal brought by the Picasso estate was filed at the Registry of the Court of Justice on 19 August 2004 and a response was entered by OHIM on 6 December. No reply or rejoinder was entered.

— order OHIM to bear both its own costs and those incurred by the appellant at first instance and in the appeal proceedings.

22. The hearing took place on 14 July 2005 and was attended by the representatives of both parties and of DaimlerChrysler, which intervened at first instance and on appeal.

24. OHIM requests that the Court:

— dismiss the appeal;

23. The appellants claim that the Court should:

— order the appellants to pay the costs.

— quash the judgment of the Court of First Instance of 22 June 2004 in Case T-185/02;

25. The intervener supports the claims of OHIM.

¹⁸ — Paragraphs 59 and 60 of the judgment under appeal.

IV — Analysis of the ground of appeal

26. The appellants have put forward only one ground of appeal, divided into four parts, based on a breach of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark.

A — Part 1 of the ground of appeal

27. The Picasso estate is contesting paragraphs 56 to 58 of the judgment of the Court of First Instance, which state that conceptual differences can largely counteract graphic and phonetic similarities. The Picasso estate argues that, for such purposes, it would not be necessary for at least one of the marks in question to have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.¹⁹

28. It claims that it is not correct to express the rule in these terms, even if some specific cases do conform to it. It does not accept that the fact that a mark acquires a precise

meaning outside the context of the designated goods means that the conceptual differences with other signs are thereby increased, without any consideration being given in such cases to whether this has occurred to a sufficient degree.

29. Moreover, in the view of the Picasso estate, it would not be logical for conceptual differences to cancel out graphic and phonetic similarities solely on the basis of the reputation of the Malaga painter,²⁰ without reference to the goods for which the signs are used, which is contrary to the statements of the Court of Justice in the *Lloyd Schuhfabrik Meyer* judgment.²¹

30. In OHIM's submission, only the appellant's argument relating to the failure to give due consideration to the connection between the sign and the items to which it refers is legally relevant in the context of the appeal. On this point it claims that, in assessing similarity of the marks, the goods and services protected are only material in so far as they have a decisive effect on the mind of the consumer.

19 — *Phillips-Van Heusen Corp. v OHIM*, previously cited, paragraph 54; and Case T-355/02 *Mühlens v OHIM* [2004] ECR II-791, pending appeal.

20 — This reference is to be understood as a neutral statement referring only to the proven place of origin of the painter and not as supporting one side or the other in the sterile and artificial debate about whether he was French or Spanish.

21 — Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819.

31. OHIM disputes that there is any basis whatsoever for limiting the semantic comparison of the marks to their meanings in relation to the goods, given that the object is to achieve an overall view. It therefore considers that the judgment contested by the Picasso estate is simply expressing the idea that the trade mark creates a global impression in the mind of the public.

32. DaimlerChrysler denies any likelihood of confusion arising from the particular ideological content of the word PICASSO, and further claims that the name was used deliberately in order to create just such a perceptible link in the mind of consumers between the vehicles and the artist.

33. This is the first time that the question of the legality of this rule for assessing likelihood of confusion has arisen before the Court and it is therefore appropriate to refer briefly to the relevant case-law. In *SABEL*, the Court stated that all the factors relevant to the circumstances of the case must be taken into account,²² and further indicated that, as far as the graphic, phonetic or conceptual similarity of the marks in question is concerned, the global appreciation must be based on the overall impression

given by the marks,²³ bearing in mind, in particular, their distinctive and dominant components.²⁴

34. This assessment of the graphic, phonetic or conceptual components which can be said to be 'dominant' is, in each individual case, a matter for the court before which the proceedings have been brought. I have made clear elsewhere²⁵ my views on the widening of the powers of review of the Court of Justice in this area. Suffice it to say that, in accordance with Article 58 of the Court's Statute, it cannot review a question of fact.

35. Such powers of review would only come into play if the rule in question were applied in an absolute and precipitate manner, that is to say without first having carried out the separate analysis of the various elements. This would amount to an automatic application in clear contradiction of the case-law of the Court referred to above.

36. Paragraphs 54 and 55 of the judgment under appeal weighed up all the elements in accordance with this case-law, before focusing on the one which it considered to be decisive, that is, the conceptual element.

²³ — *SABEL*, paragraph 23.

²⁴ — See also *Lloyd Schuhfabrik Meyer*, previously cited, paragraph 25.

²⁵ — Opinion delivered on 14 May 2002 in Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561, points 58 to 60.

²² — Previously cited, paragraph 22.

37. The outcome reached comes as no surprise as legal writers had already suggested that, although the similarity of one of the elements is sufficient for there to be a likelihood of confusion,²⁶ the conceptual comparison of two names can lead in two diametrically opposed directions: either giving rise to the likelihood of confusion or cancelling out the likelihood of confusion resulting from the phonetic assessment of the marks being compared.²⁷

38. The appellants allege that the Court of First Instance, in making its decision, failed to take into account the goods and the market in question, as required by the *Lloyd Schuhfabrik Meyer* case. However, paragraph 27 of that judgment only requires these factors to be taken into account when the relevant court finds that there is a certain degree of graphic, phonetic and conceptual similarity. The contested decision did not, however, find this to be the case, and consequently the Court was not required to evaluate its importance taking into account the category of goods or services in question and the conditions in which they are marketed.

39. It follows, therefore, that the judgment subject to appeal did not infringe Article

8(1)(b) of Regulation No 40/94 and that the first part of the ground of appeal is unfounded and should be rejected.

B — Part 2 of the ground of appeal

40. In the second part of the single ground of appeal the estate of one of the fathers of cubism²⁸ criticises the Court of First Instance for failing to respect either the case-law of the Court of Justice to the effect that the more distinctive the earlier mark the greater the likelihood of confusion²⁹ or that which confirms that marks that are highly distinctive, either per se or because of the recognition they possess on the market, enjoy a higher level of protection.³⁰

41. In the opinion of the appellants, the fact that the word PICASSO has this inherently distinctive nature and is not remotely

26 — This is the view of, for example, Bender, A., 'Relative Eintragungshindernisse', in Ekey, F./Klippel, D., *Markenrecht*, Heidelberg, 2003, pp. 930 and 931; also *Lloyd Schuhfabrik Meyer*, cited above, paragraph 28.

27 — Fernández-Nóvoa, C., *Tratado sobre derecho de marcas*, 2nd edition, Madrid, 2004, p. 301.

28 — It is difficult to establish the exact origin of this artistic movement, although the idea of translating nature into cubes, cones and cylinders arose from advice given by Cézanne in a letter to a young painter, perhaps in an attempt to explain that he should keep these basic shapes in mind when organising his pictures. Gombrich, E.H., *Historia del arte*, Spanish version by Rafael Santos Torroella, Alianza, 5th reprint, Madrid, 1987, p. 481.

29 — *SABEL*, cited above, paragraph 24.

30 — *Lloyd Schuhfabrik Meyer*, cited above, paragraph 20.

descriptive of vehicles was not reflected in the decision at first instance.

42. OHIM argues that the Court of First Instance did not disregard the abovementioned rule established in the *SABEL* judgment, since it in fact found that the sign in question did not have a distinctive character.

43. That is a question of fact which the Court of Justice is not permitted to evaluate, and this makes the appellant's argument inadmissible. It would only be possible to acknowledge an error on the part of the Court of First Instance if there were a legal rule stating that the use of a widely recognised name gives it a highly distinctive character. However, no such rule has been asserted in Community case-law.³¹

44. The intervener maintains that the name PICASSO does not have this distinctive character in the context of vehicles and, consequently, such character cannot be diminished.

45. If this part of the plea were taken as a criticism of the Court of First Instance for failing to acknowledge the distinctive nature of the PICASSO mark, then it would be inadmissible, as OHIM suggests, on the grounds that it presupposes an assessment of the facts which is outside the competence of the Court of Justice.

46. Nevertheless, the actual wording of the notice of appeal does indicate that the appellant considers that the Court of First Instance was wrong not to have applied the rule giving greater protection to marks which have a highly distinctive character.

47. However, paragraphs 55, 57 and 61 of the judgment under appeal, read together, suggest that the word sign PICASSO had no such character as a mark of vehicles and should therefore not be given this broader protection by virtue of being the name of a famous painter.

48. It follows that there is no reason to consider that the judgment under appeal infringes Article 8(1)(b) and, consequently, the second part of the ground of appeal should be dismissed on the basis that it is unfounded.

³¹ — In connection with the criteria to be applied in assessing the distinctive character of a mark, OHIM refers to the Court's judgments in Joined Cases C-108/97 and C-109/97 *Wind-surfing Chiemsee* [1999] ECR I-2779, paragraph 51 and *Lloyd Schuhfabrik Meyer*, cited above, paragraph 23.

C — Part 3 of the ground of appeal

49. In this part of the ground of appeal the appellant is challenging the method used by the Court of First Instance for assessing the likelihood of confusion, which is based on the degree of attention of the average consumer at the time of preparing and making his choice. The appellant considers that this is too restrictive since customers come across the goods even when they do not have to make the decision to purchase and, on the other hand, according to the *Arsenal Football Club* judgment,³² marks also have a post-sale purpose.

50. Therefore, according to the Picasso estate, the fact that the judgment under appeal looks at the attention of the average consumer only at the moment when that choice is made breaches Article 8(1)(b) of Regulation No 40/94 because it does not take into account the rule that the owner of a trade mark must be protected against any confusion both before and after purchase.

51. OHIM argues that in some circumstances it makes sense to look at the attention of consumers subsequent to the sale, for example when purchasing packaged

goods. In general, however, consumer interest should be gauged at the moment of opting for a particular product.

52. DaimlerChrysler relies on the views expressed in the judgment under appeal to support its contention that the degree of attention of consumers is particularly high at the time of purchasing a vehicle. On the other hand, it denies that any confusion can arise once the transaction has been completed and further contends that the purchaser is particularly careful and observant when taking the decision and that therefore the assessment of the likelihood of confusion must focus on that moment.

53. As this part of the ground of appeal is based on the *Arsenal* judgment, it is important to look at what that judgment says. Paragraph 57 admits the possibility that some consumers may interpret the sign as designating Arsenal FC as the undertaking of origin of the goods, particularly once the goods have been sold by Mr Reed and are no longer on the stall where the notice stating that they are not officially endorsed by the club is displayed. Beyond that it does not establish any general rule that the purpose of a trade mark continues after the sale of the items of which it forms part.

54. As OHIM notes in its response, the Court simply used the post-sale confusion argument to confirm that there was a breach

32 — Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273 ('the *Arsenal* judgment'), paragraph 57.

of trade mark rights, notwithstanding the wording that Mr Reed displayed on his stall stating that the goods did not come from Arsenal FC. Furthermore, most writers do not accept that post-sale confusion is relevant when analysing the likelihood of confusion.³³

55. In the light of the above analysis, no breach of Article 8(1)(b) of Regulation No 40/94 seems to have occurred here and consequently the third part of the ground of appeal should also be dismissed as unfounded.

D — *Part 4 of the ground of appeal*

56. The fourth part of the ground of appeal challenges the distinction drawn in paragraph 60 of the judgment under appeal according to whether the likelihood of confusion is being assessed in the context of opposition proceedings [under Article 8(1)(b) of the Regulation] or in that of an infringement of trade mark rights [under Article 9(1)(b)], contrary to the ruling of the Court in the *Arsenal* judgment.

57. In the opinion of the appellants, this difference in treatment is not justified either by the wording of Regulation No 40/94 or by its underlying structure, since both situations demand an analysis of post-sale confusion, particularly in the case of goods such as motor vehicles which are permanently on public view on the roads and in media advertising.

58. OHIM highlights the clear disparity between the facts of the *Arsenal* judgment and those of the contested decision, both in terms of type of proceedings, being in the one case an alleged infringement and in the other an opposition, and in terms of the subject-matter, which in the first case relates to identical goods and signs and in the second to similar goods and signs. Seen against this background, the *Arsenal* judgment was not about likelihood of confusion under Article 5(1)(b) of Directive 89/104/EEC,³⁴ but about whether the use complained of fell within that provision.

59. The intervener argues that this paragraph of the judgment under appeal simply means that matters may have an importance

33 — Baudenbacher, C., and Naumann, A., 'Neuste Entwicklungen in der immaterialgüterrechtlichen Rechtsprechung der Europäischen Gerichtshöfe', in Baudenbacher, C., and Simon, J., *Neueste Entwicklungen im Europäischen und internationalen Immaterialgüterrecht*, Basle, 2003, pp. 1 et seq., in particular p. 47.

34 — 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).

in infringement proceedings which they do not have in opposition proceedings.

60. Paragraph 60 of the contested decision tells us that the question of the degree of attention of the relevant public for the purpose of assessing the likelihood of confusion is different from the question of whether circumstances subsequent to the purchase may be relevant when examining whether there has been a breach of trade mark rights, as was accepted in the *Arsenal* judgment in relation to the use of an identical symbol.

61. In this context, that statement only highlights the distinction between, on the one hand, gauging the degree of attention of the public in order to assess the likelihood of confusion between two signs which are inevitably similar, because if they were identical it would be a case of breach of trade mark rights, and, on the other hand, weighing up the importance of particular circumstances subsequent to sale with a view to ascertaining whether there has been a breach of the industrial property right in question. Paragraph 60 shows that at no time did the Court of First Instance refer to any difference in the analysis of the likelihood of confusion depending on whether the context involves opposition proceedings or infringement proceedings.

62. Therefore, the fourth part of the ground of appeal should also be considered unfounded.

63. As all of the arguments put forward in the single ground of appeal have been rejected as unfounded, there is no alternative but to dismiss the appeal.

V — A brief final aside

64. The legal representative of the Picasso estate has taken the opportunity of the appeal proceedings to comment on the extent and frequency of the use as trade marks of the proper names of people who enjoy a high reputation or are very popular, mentioning such famous historical figures as Napoleon, Churchill or Gorbachov; designers such as Christian Dior or Alessi; sportsmen such as Boris Becker or Tiger Woods; and composers such as Mozart. He made reference to the part played by merchandising, especially as regards signs which are already well-known, in promoting other goods which no longer bear any relation to the original goods,³⁵ such as: Coca-Cola (soft drinks), for clothing and stationery items; Marlboro (cigarettes), for clothing; Davidoff (cigars), for luxury cosmetics. This leads me to make a few observations.

³⁵ — On the *Arsenal* judgment, cited above, see Kilbey, I., 'The ironies of *Arsenal v Reed*', in *European Intellectual Property Review*, 2004, pp. 479 et seq.

65. Firstly, the fact that the Picasso estate licensed the name to the motor manufacturer Citroën for use on one of the Xsara models has given rise to criticism, notably from the Director of the Picasso Museum in Paris, who feared that the image of the genius would be irreversibly damaged³⁶ and that, in the third millennium, Picasso would be nothing but a brand of cars.

66. Although Community legislation allows proper names to be registered as trade marks for use on a wide range of goods and services, the degree of protection which they merit, or which they have acquired, should vary in the light of the essential function of this type of industrial property right.

67. I have made clear elsewhere what I consider to be the essential purpose of trade mark law: to protect the accuracy of the information which the registered sign pro-

vides about the commercial origin of specific goods,³⁷ notwithstanding the existence of other functions.³⁸

68. I have also previously indicated³⁹ that ownership of a trade mark confers a monopoly on its owner, so that, in principle and as a general rule, he is able to prevent its use by others. Such legal protection is even more justified in the case of a proper name since anybody can be taken advantage of.⁴⁰

69. However, it is worth making two points about the legitimate protection of names which have earned their owners prestige. In the first place, when such a name is allowed to be used in a completely different context to that in which its reputation was earned, the greater protection which must be given to marks with a highly distinctive character cannot automatically be claimed. The simple reason for this is that, in that other context, it is very doubtful whether the name gives any information about the commercial origin of the goods or services, at least initially. Secondly, there is a certain general interest in protecting the names of great artists, which

36 — *EL Mundo*, Thursday 6 January 2000, which can be accessed at <http://www.elmundo.es/papel/hemeroteca/2000/01/06/cultura/793771.html>

37 — Opinion in Case C-23/01 *Robelco* [2002] ECR I-10913, at point 26.

38 — Such as, for example, in sales promotion or as a strategy tool: Grynfogel, C., 'Le risque de confusion, une notion à géométrie variable en droit communautaire des marques', in *Revue de Jurisprudence de Droit des Affaires*, No 6/2000, pp. 494 et seq., in particular p. 500. See also my Opinion delivered on 13 June 2002 in connection with the *Arsenal* judgment, cited above, in particular points 43 and 46 to 49.

39 — Opinion in Case C-283/01 *Shield Mark* [2003] ECR I-14313, at point 50.

40 — As was the case with the Brazilian footballer known as Pelé, whose pseudonym has even been registered in respect of clothes and sports items, apparently without any kind of licence; Decision No 490/1999 of the Opposition Division of OHIM of 20 July 1999, *Pellet v Pelé*.

represent a universal cultural heritage, from insatiable commercial greed, in order to safeguard their work from trivialisation. It is sad to think that the averagely informed, reasonably aware and perceptive consumer, who no longer links names such as Opel, Renault, Ford or Porsche with the outstanding engineers whose products were named after them, will, unfortunately, in the not-too-distant future be subjected to the same process in relation to the name Picasso.

VI — Costs

70. Under Article 122, in conjunction with Article 69(2) of the Rules of Procedure, applicable to the procedure on appeal by virtue of Article 118, the unsuccessful party is to be ordered to pay the costs. Consequently, if, as I recommend, the appellant's plea is rejected, the appellant should be ordered to pay the costs of the appeal.

VII — Conclusion

71. In the light of the foregoing I propose that the Court should dismiss the appeal lodged by the Picasso estate against the judgment of the Court of First Instance of 22 June 2004 in Case T-185/02 and order the appellants to pay the costs incurred in connection with it.