

Case T-396/04

Soffass SpA

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Opposition proceedings — Application for Community figurative mark containing the verbal element ‘NICKY’ — Earlier national figurative marks containing the verbal element ‘NOKY’ — Rejection of opposition for absence of likelihood of confusion — Annulment by the Board of Appeal — Remittal to the Opposition Division to examine whether the goods are similar and the proof of use — Article 8(1)(b) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (First Chamber), 23 November 2005 II - 4791

Summary of the Judgment

- 1. Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Signs totally different — Signs slightly similar
(Council Regulation No 40/94, Art. 8(1)(b))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Figurative marks containing verbal elements 'NICKY' and 'NOKY' (Council Regulation No 40/94, Art. 8(1)(b))*

1. It is clear from Article 8(1)(b) of Regulation No 40/94 on the Community trade mark that the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered by the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative. Therefore, if the signs at issue are completely different it is possible in principle, without examining the goods in question, to take the view that there is no likelihood of confusion. However, where the marks are not clearly dissimilar, but have a number of similar factors together with certain components capable of distinguishing them, the assessment of the respective importance of those components must not be carried out in isolation, but in an overall assessment of the likelihood of confusion, taking account of all the relevant factors, in particular the interdependence between similarity of the signs and similarity of the goods or services designated.
2. For the French public there are visual and phonetic similarities between the figurative mark including the verbal element 'NICKY', for which registration as a Community trade mark is sought in respect of goods in Class 16 of the Nice Agreement, and the figurative marks containing the verbal element 'NOKY' previously registered in France for goods in the same class, so that it is appropriate to carry out a comparison of the goods in order to make an overall assessment of the likelihood of confusion.

(see paras 26-27, 29, 39)

(see paras 34-35, 38)