

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

6 October 2004\*

In Case T-356/02,

**Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG**, established in Bremen (Germany), represented by U. Sander, lawyer,

applicant,

v

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

defendant,

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

\* Language of the case: German.

**Krafft, SA**, established in Andoain (Spain), represented by P. Koch Moreno, lawyer,

APPEAL against the decision of the Fourth Board of Appeal of OHIM of 4 September 2002 (Joined Cases R 506/2000-4 and R 581/2000-4) in opposition proceedings between Krafft, SA, and Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG,

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

composed of: J. Pirrung, President, A.W.H. Meij and N.J. Forwood, Judges,

Registrar: B. Pastor, Deputy Registrar

having regard to the application lodged at the Court Registry on 29 November 2002,

having regard to OHIM's response lodged at the Court Registry on 25 April 2003,

having regard to the intervener's response lodged at the Court Registry on 10 April 2003,

further to the hearing on 5 May 2004,

gives the following

## Judgment

### Background to the dispute

- 1 On 5 June 1996, the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) ('the Office') pursuant to 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 word sign VITAKRAFT.
- 3 The goods in respect of which registration of the sign was sought are in Classes 1, 3, 4, 12 and 19 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 for each class to the following descriptions:
  - Class 1: 'Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry, in particular chemicals and filter material of chemical, mineral, vegetable materials, unprocessed plastic materials or ceramic particles for water treatment, in particular for aquaria and garden

ponds; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry’;

- Class 3: ‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, in particular sand paper for animal cages; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices’;
  
- Class 4: ‘Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks’;
  
- Class 12: ‘Vehicles; apparatus for locomotion by land, air or water’;
  
- Class 19: ‘Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal’.

4 The trade mark application was published in *Community Trade Marks Bulletin* No 30/98 of 27 April 1998.

5 On 27 July 1998, the intervener brought opposition proceedings on the basis of Article 42 of Regulation No 40/94.

6 The opposition was based on the figurative marks reproduced below:

A



B



C



7 Those marks have been registered in Spain as follows:

- Registration No 1924081 (of sign A) of 5 May 1995 for the following goods included in Class 1: 'Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry and specially, antifreezes, refrigerating liquids, adhesives and sealing used in industry, dismoulding and agglomerating chemical products' (hereinafter the 'earlier mark A1');
  
- Registration No 1924082 (of sign A) of 5 May 1995 for the following goods included in Class 3: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices, and specially products for

cleaning vehicle motors and carburettors; wax and products for polishing vehicles, shampoo for washing vehicles, shampoo for cleaning the upholstery of vehicles, products for cleaning and polishing chromium-plated products, wax polishes and shine-renewing products, vehicle air fresheners' (hereinafter the 'earlier mark A2');

- Registration No 1160484 (of sign B) of 5 September 1987 for the following goods included in Class 4: 'Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks' (hereinafter the 'earlier mark B');
  
- Registration No 1042443 (of sign C) of 20 February 1984 for goods included in Class 12: 'Vehicles; apparatus for locomotion by land, air or water; motors for land vehicles' (hereinafter the 'earlier mark C1');
  
- Registration No 1052802 (of sign C) of 20 July 1984 for goods included in Class 19: 'Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal' (hereinafter the 'earlier sign C2').

The applicant requested that the intervener prove that the earlier marks B, C1 and C2 were put to genuine use in accordance with Article 43(2) and (3) of Regulation No 40/94. Following that request, the intervener produced 18 catalogues relating to various products from its range.

- 9 By Decision No 317/2000 of 24 February 2000, the Opposition Division partially upheld the opposition after establishing the identity of the goods and services included in Classes 1 and 3, then recognised the similarity of the signs and consequently found that there was a likelihood of confusion. However, it rejected the opposition in so far as it related to goods in Classes 4, 12 and 19 on the ground that the intervener had not provided sufficient proof of use of the earlier marks B, C1 and C2 and, in particular, of the extent and duration of that use.
- 10 On 26 April 2000, the intervener appealed against the decision of the Opposition Division, claiming principally that the Opposition Division had erred in finding that the proof of use of the earlier marks for the goods in Classes 4, 12 and 19 was insufficient. Furthermore, the intervener, pointing out the similarity between the goods in Classes 1 and 3 covered by the earlier marks and the contested goods in Classes 4, 12 and 19 as specified in the application for registration, requested that that application be rejected in respect also of the goods in Classes 4, 12 and 19.
- 11 By letter of 5 May 2000, the applicant appealed against the decision of the Opposition Division, its main complaint being that the Opposition Division had held that there was similarity between the signs.
- 12 By decision of 4 September 2002 in Joined Cases R 506/2000-4 and R 581/2000-4 ('the contested decision'), the Fourth Board of Appeal of the Office, considering that genuine use of marks B and C2 by the intervener had been proved for part of the goods, namely for 'lubricants, greases, motor oils' included in Class 4 and for 'mortar and levelling paste for construction' included in Class 19, partially annulled the decision of the Opposition Division. It held that there was a similarity between the goods 'industrial oils and greases; lubricants; fuels (including motor spirit) and illuminants' in Class 4, referred to in the application for the mark, and the goods for which use of the earlier mark B had been proved. Furthermore, the Board of Appeal found that there was a similarity between 'cleaning preparations' in Class 3 and

covered by the earlier mark A2 and 'dust absorbing, wetting and binding compositions' in Class 4, referred to in the application for registration. It found also that there was a similarity between the goods 'building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen' covered by the mark applied for and 'mortar and levelling paste for construction' in respect of which the intervener had proved use of the earlier mark C2. Taking the view that the decision of the Opposition Division was correct in its finding that there was a likelihood of confusion owing to the similarity between the signs and goods in question, the Board of Appeal dismissed the applicant's appeal in its entirety. It also partially dismissed the intervener's appeal, firstly on the ground that the intervener had not proved genuine use of the earlier mark C1 or of earlier marks B and C2 in respect of goods other than 'industrial oils and greases; lubricants' (Class 4) and 'mortar and levelling paste for construction' (Class 19) and, secondly, that certain disputed goods in Classes 4, 12 and 19 were not similar to the goods and services covered by the earlier marks A1, A2 and C2, in Classes 1, 3 and 19. Essentially, registration of the Community trade mark was refused for the following goods included in the Community trade mark application: all goods in Classes 1 and 3 of the Nice Agreement and 'industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants' (Class 4) and 'building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen' (Class 19).

### **Procedure and forms of order sought by the parties**

13 On 8 January 2003, the intervener requested that English be designated the language of the case. As the application and the application for registration were in German, that request was refused and, in accordance with Article 131(1) and the third subparagraph of Article 131(2) of the Rules of Procedure of the Court of First Instance, German became the language of the case.

- 14 The applicant claims that the Court of First Instance should:
- partially annul the contested decision in so far as the appeal of Krafft, SA was allowed and in so far as the applicant's appeal was not allowed;
  
  - order the Office to pay the costs.

- 15 The Office and the intervener contend that the Court of First Instance should:

- dismiss the action;
  
- order the applicant to pay the costs.

## **Law**

- 16 In support of its action, the applicant puts forward two pleas in law. The first plea in law alleges infringement of Article 43(2) and (3) of Regulation No 40/94 and of Rule 22(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1); the second plea in law alleges infringement of Article 8(1)(b) of Regulation No 40/94.

*The first plea in law, alleging infringement of Article 43(2) and (3) of Regulation No 40/94 and of Rule 22(2) of Regulation No 2868/95*

## Arguments of the parties

17 The applicant claims that the intervener has not proved that the earlier marks were put to genuine use in respect of the products ‘greases and motor oils; lubricants’ and ‘mortar and levelling paste for construction’.

18 With regard to the catalogue relating to motor oils supposedly printed in 1992, this is not within the material period which runs from 28 April 1993 to 28 April 1998.

19 By contrast, the catalogues supposedly printed in 1993, 1994 and 1996 do not, according to the applicant, contain anything relating to the use of the earlier marks for the products ‘motor oils and greases’ in Class 4 or for ‘mortar and levelling paste for construction’ in Class 19.

20 The applicant concedes that the catalogues in question contain certain indications relating to ‘lubricants’. However, it points out that those indications do not meet the requirements of Rule 22(2) of Regulation No 2868/95. The evidence relates only to the years 1993 to 1996 and not to 1997 and 1998. The applicant considers that, where proof of use of the mark relates only to part of the material period, it is essential that the holder of the earlier marks should at least show that, during that period, the use was extensive. The intervener has furnished no viable evidence regarding the extent of the use of the earlier marks.

21 The Office notes that four of the catalogues produced by the intervener during the opposition proceedings enable conclusions to be drawn regarding the duration, nature and place of the use, namely:

- Catalogue 1, entitled ‘Emergiendo con fuerza’, relating to motor oils, printed in 1992, which indicates that the prices mentioned apply only with effect from January 1993;
- Catalogue 2, entitled ‘Lubricantes para automoción’, concerning lubricants, which was published in 1993;
- Catalogue 3, entitled ‘Lubricantes automoción’, concerning greases and lubricants;
- Catalogue 4, entitled ‘Suelos industriales’, from 1997, relating to mortars and levelling pastes for construction.

22 The Office doubts, however, that the catalogues in question contain any useful indications as to the extent of the use of the earlier marks, such indications being required under Rule 22(2) of Regulation No 2868/95 in order to distinguish genuine use of the marks from purely fictitious use. In the Office’s view, the production of advertising material may, in principle, constitute sufficient proof. The Office wonders, however, whether it is necessary to give indications regarding the extent of the circulation of the advertising materials. It recognises that, in the present case, such indications are not available.

- 23 The intervener concurs with the reasoning given by the Board of Appeal. It considers, in particular, that the requirements of Rule 22(2) of Regulation No 2868/95 were met. The indication and proof of the place of use is clear from the indication of the intervener's representatives in various towns in Spain. The duration of the use is indicated and proved by the dates of printing of the catalogues. As regards the nature of the use, the catalogues show the goods bearing the earlier marks B and C2.
- 24 The intervener conceded, at the hearing, that the catalogues did not contain any indication relating to the extent of the use. Furthermore, it did not maintain the argument that proof of use follows from the fact that its marks were known on the Spanish market. However, it points out that it is required to show only that the use made of the earlier marks B and C2 is not a fictitious use intended only to keep them on the register. The intervener added, also at the hearing, that, according to the Office's practice, objective proof should be furnished, such as, for example, catalogues or invoices. It explained that its invoices showed only the names of the goods, without indicating the mark, because it sold only goods bearing the Krafft mark, so that the mark does not distinguish the various products in its range. The intervener therefore opted to show the use of the earlier marks by way of the advertising material which it produced at the time of the OHIM proceedings.

## Findings of the Court

- 25 As is apparent from the ninth recital in the preamble to Regulation No 40/94, the legislature considered that there is no justification for protecting earlier trade marks except where the marks are actually used. Consistent with that recital, Article 43(2) and (3) of Regulation No 40/94 provides that an applicant for a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory where it is protected during the period of five years preceding the date of

publication of the trade mark application against which an opposition has been filed (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 34).

- 26 As is apparent from the judgment in Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43, there is ‘genuine use’ of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (see *Ansul*, paragraph 37, and Case T-174/01 *Goulbourn v OHIM — Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 39).
- 27 Pursuant to Rule 22(2) of Regulation No 2868/95, proof of use must relate to the place, time, extent and nature of the use made of the earlier mark.
- 28 Furthermore, the Court of First Instance has held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*HIWATT*, cited above, paragraph 47).
- 29 It is in the light of those considerations that the Court must assess whether, in the present case, the Board of Appeal did not err in law in considering that the intervener had provided proof of genuine use of the earlier marks B and C2 for the products ‘motor oils and greases; lubricants’ (Class 4) and for the products ‘mortar and levelling paste for construction’ (Class 19). The Court notes, in that regard, that the intervener has not complained that the Board of Appeal regarded those earlier

marks as being registered only for the goods in respect of which, in the view of the Board of Appeal, the intervener had given concrete proof of use and not for the entire category to which those goods belong and for which those earlier marks were registered. With regard to the earlier mark C1 and the other goods covered by the earlier marks B and C2, as the intervener did not contest the findings of the Board of Appeal that the use of the marks in connection with them had not been shown, those findings do not form part of the present dispute.

30 Firstly, it should be noted that, as the application for the Community trade mark was published on 27 April 1998, the period of five years runs from 27 April 1993 to 26 April 1998. Secondly, since the earlier marks B and C2 are protected by Spanish registration, the relevant territory is that of Spain. It follows that the intervener is required to show that its earlier marks were used on the Spanish market between 27 April 1993 and 26 April 1998.

31 The Board of Appeal considered, in paragraph 14 of the contested decision, that it had no reason to doubt that the catalogues produced by the intervener reflected the marketing during the relevant period of time of the products represented in those catalogues under the depicted mark. Furthermore, it considered, in paragraph 16 of the contested decision, that catalogues that bear dates included within the relevant period, that represent the opponent's products, that show the opponent's trade mark used in the same form as registered, that show how the mark is applied on the products, that list wholesalers in a wide range of places within the territory concerned and that clearly associate the opponent with its mark do show satisfactorily, for the purposes of Article 43(2) of Regulation No 40/94, that the earlier mark was put to genuine use.

32 That reasoning is erroneous in that it is based upon presumptions.

- 33 It follows from the case-law cited in paragraph 26 above that it is appropriate to examine whether the intervener has shown, in the proceedings before the Office, that its earlier marks B and C2, as protected, were used on the relevant territory publicly and outwardly for the purpose of creating or preserving an outlet for those goods or services covered by the marks. Pursuant to Rule 22(2) of Regulation No 2868/95, that proof must relate in particular to the extent of that use. Finally, it is not sufficient for genuine use to appear probable or credible; actual proof of that use must be given.
- 34 In the present case, the catalogues submitted to the Board of Appeal establish neither the fact that they were distributed to a potential Spanish clientele, nor the extent of any distribution, nor the number of sales made of goods protected by the mark. The intervener has provided no indication supported by evidence to enable any useful conclusions to be drawn in that regard. The mere existence of those catalogues could, at most, make it probable or credible that goods protected by the earlier marks were sold or, at least, offered for sale within the relevant territory, but it cannot prove that fact.
- 35 It must therefore be found that the Board of Appeal erred in law by regarding the catalogues produced by the intervener as sufficient proof, without its being necessary to ascertain whether the catalogues contain satisfactory indications concerning the goods 'motor oils and greases' and 'mortar and levelling paste for construction', or concerning the duration of the use.
- 36 Consequently, the first plea in law of the applicant is well founded. The Board of Appeal was therefore wrong to allow in part the intervener's appeal against the decision of the Opposition Division. It follows that the contested decision should be annulled in so far as it allowed the intervener's appeal before the Board of Appeal concerning the goods 'industrial oils and greases; lubricants; fuels (including motor

spirit) and illuminants' (Class 4) and the goods 'building materials (not metallic); non-metallic rigid pipes for building, asphalt, pitch and bitumen' (Class 19) included in the Community trade mark application.

*The second plea in law, alleging infringement of Article 8(1)(b) of Regulation No 40/94*

### Arguments of the parties

37 The applicant considers that the Board of Appeal made an incorrect comparative analysis of the two signs at issue.

38 Firstly, the earlier marks are both word and figurative marks, consisting of a rectangle of the colours red, blue and white, divided into two equal parts, the upper part of which bears the inscription 'krafft' in white on a red background and the lower part of which is a blue area. Although the applicant concedes that the distinctive and dominant element of the earlier marks is the name 'Krafft', it maintains that the Board of Appeal erred in considering that that graphic element would be totally ignored and forgotten by the average consumer.

39 Secondly, the applicant points out that, according to case-law, the mark is normally perceived as a whole. The average consumer does not undertake an analysis of its various details. The applicant therefore contests the view of the Board of Appeal that a Spanish consumer would decompose the mark applied for into 'vita' and 'kraft'. Furthermore, even assuming that the consumer did undertake such an analysis, he would not be likely to omit the term 'vita' and retain only the term 'kraft'. In that regard, the applicant points out that the word 'vita' is not descriptive of the goods

intended to be covered by the requested mark. It submits that although it is true that the part of a complex mark which is descriptive of the goods and services covered cannot in principle be regarded as the dominant element of the mark, that argument does not apply to the present case. On that basis, the word 'vita' is not of secondary importance. It follows, in the applicant's view, that the conflicting marks display, from the point of view of their graphic and verbal elements, sufficient differences to make them distinctive.

40 Thirdly, the applicant considers that the conflicting signs are sufficiently different on an auditory level since the requested sign will be pronounced 'vitakraft' whilst the verbal element of the earlier signs is pronounced 'krafft'.

41 Finally, the applicant considers that there is also an obvious conceptual difference between the signs at issue. The earlier signs will be perceived, by a Spanish consumer, as simply an invented term. By contrast, the requested sign evokes the idea of vitality ('vitalidad' in Spanish), or even the adjective 'vital' ('vital' in Spanish).

42 The Office and the intervener agree entirely with the reasoning of the Board of Appeal.

43 The intervener notes, in particular, that the prefix 'vita' is an everyday concept which is not very distinctive and that, in Spanish, the main stress, in the pronunciation of 'vitakraft', falls on the syllable 'kraft'.

## Findings of the Court

- 44 Since the applicant's first plea in law is well founded, it is necessary only to assess the likelihood of confusion between the requested sign and the earlier marks A1 and A2 ('the earlier marks') which are not subject to the requirement of proof that they have been put to genuine use because, at the date of publication of the Community trade mark application, they had been registered for less than five years (Article 43(2) and (3) of Regulation No 40/94).
- 45 Within the meaning of 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.
- 46 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.
- 47 According to the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception that the relevant public has of the signs and the products or services at issue, and taking into account all factors relevant to the circumstances of the case, in particular the interdependence of the similarity between the signs and the similarity between the goods or services covered (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 31 to 33, and the case-law cited).

- 48 It should be noted that the findings of the Board of Appeal relating to the similarity between the products were not contested by the applicant or the intervener. The outcome of the appeal depends, therefore, on whether there is a likelihood of confusion because of a similarity between the signs. The products involved in the assessment of the similarity between the signs are all those in Classes 1 and 3 of the Nice Agreement mentioned in the Community trade mark application and the 'dust absorbing, wetting and binding compositions' (Class 4) which the Board of Appeal considered similar to 'cleaning, polishing, scouring and abrasive preparations' protected by the earlier mark A2 and included in Class 3.
- 49 It is clear from established case-law that the global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the conflicting marks, must be based on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (see judgment of 14 October 2003 in Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47, and the case-law cited).
- 50 As regards, firstly, the visual aspect of the earlier marks, the Board of Appeal rightly held that the dominant element of those marks, despite their figurative nature, consists of the word 'Krafft'. The figurative elements of the earlier signs, namely the graphics of the work 'Krafft', on the one hand, and the blue and red rectangles, on the other hand, are not sufficiently large to make a greater impression on the consumer than their verbal element.
- 51 The requested sign consists, for a Spanish-speaking consumer, of a word composed of two elements, the first of which is the term 'vita' and the second the term 'krafft'. The Board of Appeal rightly held that a consumer, perceiving a verbal sign, will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him. Thus the term 'vita' will be perceived, by a Spanish-

speaking consumer, as alluding to words such as ‘vitality’ or ‘vital’ (‘vitalidad’ or ‘vital’ in Spanish). However, although the term ‘kraft’ means ‘strength’ in certain languages, including German, it has no concrete meaning in the Spanish language.

52 The Court notes that, as a general rule, an invented word is more likely to draw the attention of the consumer (see, to that effect, Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 43, upheld by order of the Court of Justice of 28 April 2004 in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657). The Court of First Instance has also observed that the 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 (judgment of 3 July 2003 in Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 53). Analogous considerations apply to elements which have a very general meaning suggesting a positive quality attributable to a large range of different goods or services. The Court of First Instance considers that, for the Spanish public, the word ‘vita’ would be included in that category of elements.

53 It follows that, in Spanish, the dominant element of the sign requested is the second part, ‘kraft’, because it is an invented term and because, for the target public, the first part of the sign, ‘vita’, is less distinctive.

54 With regard to the phonetic aspect, the earlier marks are pronounced ‘Krafft’. By contrast, the sign requested comprises three syllables, (‘vi’, ‘ta’ and ‘kraft’). For the reasons set out in paragraphs 52 and 53 above, the target public will perceive the last syllable of the sign requested, namely the word ‘kraft’, as the preponderant element of the word sign VITAKRAFT.

- 55 It follows, both from the visual and auditory points of view, that the preponderant element of the sign requested, 'kraft', and the verbal element of the earlier marks, 'Krafft', are very similar, if not identical, the two 'f's in the word 'Krafft' making no perceptible phonetic difference or sufficient visual difference to dissipate the elements of similarity set out above.
- 56 With regard to the conceptual aspect, although it is true that the word 'vita' evokes the notion of 'vitality' or the adjective 'vital', none the less the sign VITAKRAFT has no specific meaning in the Spanish language. Given that neither the mark requested nor the earlier marks have any concrete meaning in that language, no sufficient conceptual difference between the signs is apparent.
- 57 It follows that, for the target public, consisting of Spanish-speaking consumers, the signs at issue are similar on the visual and phonetic levels. Since the goods covered by the marks at issue are identical or very similar, the Board of Appeal did not err in law in finding that there was a likelihood of confusion between the earlier marks including the element 'Krafft' and the mark requested, VITAKRAFT, in respect of all the goods in Classes 1 and 3 mentioned in the Community trade mark application and the 'dust absorbing, wetting and binding compositions' in Class 4.
- 58 Consequently, the applicant's second plea in law must be rejected.
- 59 It follows that the action is well founded only in so far as the Board of Appeal held, wrongly, that the intervener had provided proof of genuine use of the earlier marks B for the goods 'motor oils and greases; lubricants' (Class 4) and C2 for the goods 'mortar and levelling paste for construction' (Class 19). Consequently, the contested decision should be annulled in so far as it allowed the intervener's appeal before the Board of Appeal concerning the goods 'industrial oils and greases; lubricants; fuels

(including motor spirit) and illuminants' (Class 4) and the goods 'building materials (not metallic); non-metallic rigid pipes for building, asphalt, pitch and bitumen' (Class 19) contained in the Community trade mark application. The remainder of the action must be dismissed.

## Costs

60 Pursuant to Article 87(3) of the Rules of Procedure, the Court of First Instance may order that the costs be shared or that each party bear its own costs where each party succeeds on some and fails on other heads.

61 In the present case, the applicant, the Office and the intervener all failed in part of their claims. Consequently, it is appropriate to order each party to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of**

**4 September 2002 (Joined Cases R 506/2000-4 and R 581/2000-4) in so far as it allowed the intervener's appeal before the Board of Appeal concerning the goods 'industrial oils and greases; lubricants; fuels (including motor spirit) and illuminants' (Class 4) and the goods 'building materials (not metallic); non-metallic rigid pipes for building, asphalt, pitch and bitumen' (Class 19) contained in the Community trade mark application;**

**2. Dismisses the remainder of the action;**

**3. Orders the parties to bear their own costs.**

Pirrung

Meij

Forwood

Delivered in open court in Luxembourg on 6 October 2004.

H. Jung

J. Pirrung

Registrar

President