

Case T-194/03

Il Ponte Finanziaria SpA

v

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

(Community trade mark — Opposition proceedings — Application for a figurative Community trade mark including the word element ‘Bainbridge’ — Earlier national word, figurative and three-dimensional trade marks including the word element ‘Bridge’ — Proof of use — Use in a different form — ‘Defensive’ marks — Family of marks)

Judgment of the Court of First Instance (Fourth Chamber), 23 February 2006 II - 450

Summary of the Judgment

1. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark*
(Council Regulation No 40/94, Arts 15(1), 43(2) and (3), 50(1)(a), and 56(2))

2. *Community trade mark — Observations of third parties and opposition — Examination of the opposition — Proof of use of the earlier mark*
(Council Regulation No 40/94, Art. 15(2)(a))
3. *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*
(Council Regulation No 40/94, Art. 8(1)(b))
4. *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*
(Council Regulation No 40/94, Art. 8(1)(b))

1. Within the scheme of Regulation No 40/94 on the Community trade mark, actual use of a sign in trade in connection with the goods or services in respect of which that sign has been registered is an essential condition for the conferment on its proprietor of the exclusive rights which constitute the subject-matter of the protection granted to trade marks. Thus, Articles 15(1), 50(1)(a), 43(2) and (3) and 56(2) of Regulation No 40/94 impose on the proprietor of a trade mark the obligation to use it or the obligation, in opposition proceedings or proceedings in relation to revocation or invalidity, to furnish proof of its genuine use.

It is true that those provisions provide for an exception under which the proprietor of the trade mark avoids the consequences of infringement of such obligations where there are 'proper

reasons' for non-use. However, the concept of 'proper reasons' mentioned in those provisions refers to reasons based on the existence of obstacles to use of the trade mark or to situations in which its commercial exploitation proves, in the light of all the relevant circumstances of the case, to be excessively onerous. Such obstacles may result from national rules imposing, for example, restrictions on the marketing of the goods covered by the trade mark, so that such rules may be relied on as a proper reason for non-use of the mark. However, a holder of a national registration who opposes a Community trade mark application cannot, in order to avoid the burden of proof which rests upon him under Article 43(2) and (3) of Regulation No 40/94, rely on a national provision which allows the registration as trade marks of signs not intended to be used in trade on account of their purely defensive function in relation to another sign which is being commercially exploited. Such registrations are not compatible with the rules governing the Community trade mark, as they result from Regulation No 40/94, and

their recognition at national level cannot constitute a 'proper reason', within the meaning of Article 43(2) and (3) of that regulation, for non-use of an earlier trade mark cited as justification for opposition to a Community trade mark.

(see paras 43, 46)

mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade. However, Article 15(2)(a) of that regulation does not allow the proprietor of a registered trade mark to avoid his obligation to use that mark by relying in his favour on the use of a similar mark covered by a separate registration.

2. Article 15(2)(a) of Regulation No 40/94 on the Community trade mark relates to a situation where a national or Community registered trade mark is used in trade in a form slightly different from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same

(see para. 50)

3. There is, for the average Italian consumer, no likelihood of confusion between, on the one hand, the figurative sign containing the word element 'Bainbridge', for which registration as a Community trade mark is sought in respect of 'Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery' and

'Clothing, footwear, headgear' in Classes 18 and 25 respectively of the Nice Agreement and, on the other hand, the word marks FOOTBRIDGE, OVER THE BRIDGE and THE BRIDGE, the complex mark containing the word element 'the bridge wayfarer' and the three-dimensional mark showing the phrase 'the bridge', registered earlier in Italy in respect of identical goods in the same classes, despite the highly distinctive character of the earlier marks and the identity of the goods in question, since the conflicting signs are not semantically similar and the visual comparison between the conflicting signs reveals strong dissimilarities between them, such as to enable the only common element, consisting of the sequence of six letters forming the word 'bridge', to be regarded as insufficient to establish, as between the marks in question, having regard to the overall impression created by them, a significant degree of visual similarity for the purpose of assessing the likelihood of confusion. As regards the aural similarity between the conflicting signs, it is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods.

(see paras 101, 114, 116)

4. When the opposition to a Community trade mark application is based on several earlier marks, the fact that those marks display characteristics which give grounds for regarding them as forming part of a single 'series' or 'family', which may be the case, *inter alia*, either when they reproduce in full a single distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of a single prefix or suffix taken from an original mark, constitutes a relevant factor for the purpose of assessing whether there is a likelihood of confusion.

In such circumstances, a likelihood of confusion may be created by the possibility of association between the trade mark applied for and the earlier marks forming part of the series where the trade mark applied for displays such similarities to those marks as might lead the consumer to believe that it forms part of that same series and therefore that the goods covered by it have the same commercial origin as those covered by the earlier marks, or a related origin. Such a likelihood of association between the trade mark applied for and the earlier marks in a series, which could give rise to confusion as to the commercial origin of the goods identified by the conflicting signs, may exist even where the comparison between the trade mark applied for and the earlier marks, each taken individually, does not prove the existence of a likelihood of direct con-

fusion. In such a case, the likelihood that the consumer may mistake the commercial origin of the goods or services in question does not result from the possibility of his confusing the trade mark applied for with one of the earlier marks in a series, but from the possibility of his considering that the trade mark applied for forms part of the same series.

However, the likelihood of association may be invoked only if two conditions are cumulatively satisfied. Firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the

very least, of a number of marks capable of constituting a 'series'. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That could not be the case where, for example, the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content.

(see paras 123-127)