

JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

15 June 2005 *

In Case T-7/04,

Shaker di L. Laudato & C. Sas, established in Vietri sul Mare (Italy), represented by
F. Sciaudone, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by M. Capostagno, acting as Agent,

defendant,

* Language of the case: Italian.

the other party to the proceedings before the Board of Appeal of OHIM having been

Limiñana y Botella, SL, established in Monforte del Cid (Spain),

ACTION brought against the decision of the Second Board of Appeal of OHIM of 24 October 2003 (Case R 933/2002-2), relating to opposition proceedings between Limiñana y Botella, SL and Shaker di L. Laudato & C. Sas,

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

composed of M. Jaeger, President, J. Azizi and E. Cremona, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Court Registry on 7 January 2004,

having regard to the response lodged at the Court Registry on 24 May 2004,

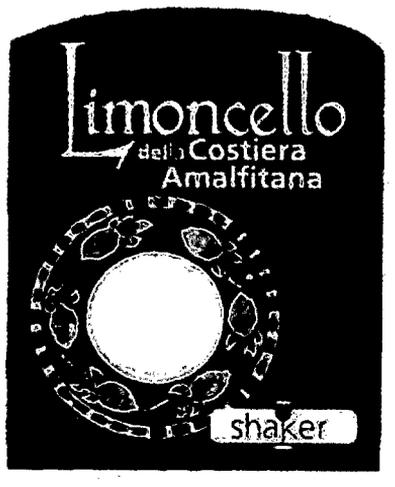
further to the hearing on 20 January 2005,

gives the following

Judgment

Facts

- 1 On 20 October 1999 the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), 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 ('Regulation No 40/94').
- 2 The trade mark for which registration has been sought is the figurative sign reproduced below:



- 3 The goods in respect of which registration has been sought fall within Classes 29, 32 and 33 of the Nice Agreement concerning the Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement') and correspond to the following descriptions for each of those classes:
- Class 29: 'Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats';

 - Class 32: 'Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages';

 - Class 33: 'Alcoholic beverages (except beers)'.
- 4 By letter of 23 November 1999, OHIM requested the applicant to restrict its application for registration, as it considered it to be in part ineligible for registration on account of Article 7(1)(g) of Regulation No 40/94.
- 5 More specifically, OHIM requested withdrawal of the application for registration for goods belonging to Class 32, non-alcoholic drinks, since, in its view, if the indication 'limoncello della costiera amalfitana' was used to designate both goods in that class and goods in Class 33 covering alcoholic drinks, it would be liable to mislead the consumer by giving him to believe that a bottle designated thus contained the well-known liqueur 'limoncello' when that was not the case. OHIM also asked the

applicant to restrict the list of goods in Class 33 to ‘lemon liqueurs from the Amalfi Coast’, since the trade mark would be misleading if the liqueur in question had a different origin, regard being had to the fact that Sorrento and the surrounding area enjoyed a reputation linked to the specific product and that consequently the origin of the product was decisive in the consumer’s choice.

- 6 Following the action taken by OHIM, the applicant limited its application, as regards goods in Class 33, to lemon liqueurs from the Amalfi Coast.

- 7 The application for a Community trade mark was published in *Community Trade Marks Bulletin* No 30/00 on 17 April 2000.

- 8 On 1 June 2000 Limiñana y Botella, SL (‘the opponent’) filed a notice of opposition pursuant to Article 42(1) of Regulation No 40/94 against the registration of the mark applied for.

- 9 The ground relied on in support of the opposition was the likelihood of confusion provided for by Article 8(1)(b) of Regulation No 40/94, as between, on the one hand, the mark applied for in so far as it concerns goods in Class 33 of the Nice Agreement and, on the other hand, the opponent’s word mark also pertaining to goods in Class 33, registered in 1996 at the Oficina Española de Patentes y Marcas of the Ministerio de ciencia y tecnología (Spanish patents and trade marks office):

‘LIMONCHELO’

- 10 By decision of 9 September 2002, the OHIM Opposition Division upheld the opposition and consequently refused registration of the mark claimed.
- 11 The Opposition Division justified its decision by stating, in essence, that there was a likelihood of confusion on the Spanish market, within the meaning of Article 8(1)(b) of Regulation No 40/94, as between the trade mark applied for and the earlier mark, given the identity of the goods in question and the similarity between the marks. The Opposition Division concluded that the marks at issue were similar following an assessment of their visual, phonetic and conceptual similarities, from which it was clear, in OHIM's view, that there were visual and phonetic similarities between the dominant element of the mark claimed, which consists of the term 'limoncello', and the earlier trade mark.
- 12 On 7 November 2002 the applicant filed an appeal at OHIM under Articles 57 to 62 of Regulation No 40/94 against the Opposition Division's decision.
- 13 By decision of 24 October 2003 ('the contested decision'), the Second Board of Appeal dismissed the applicant's appeal. In essence, the Board of Appeal found, having stated that the goods covered by the earlier mark encompassed those covered by the mark claimed, that the dominant element of the mark claimed was the word 'limoncello' and that the trade mark claimed and the earlier trade mark were visually and phonetically very close to one another and that there was consequently a likelihood of confusion between the two marks.

Forms of order sought

- 14 The applicant claims that the Court should:
- annul the contested decision and/or alter it so that the opposition is rejected and the applicant's application for registration is granted;

 - order OHIM to pay the costs.
- 15 The defendant contends that the Court should:
- dismiss the action;

 - order the applicant to pay the costs.
- 16 At the hearing, the applicant stated that in asking the Court 'to annul and/or alter the contested decision', it was actually seeking just as much the annulment as the alteration of the contested decision.

Law

- 17 The applicant puts forward three pleas in law in support of its claims. It submits that OHIM, in the contested decision, first, infringed Article 8(1)(b) of Regulation No 40/94, second, misused its powers and, third, was in breach of its obligation to state reasons for its decisions. The defendant challenges each of those pleas.

I — *First plea alleging infringement of Article 8(1)(b) of Regulation No 40/94*

A — *Arguments of the parties*

1. Applicant's arguments

(a) General

- 18 The applicant submits that, contrary to OHIM's contention, there are not sufficient similarities between the earlier trade mark and its own trade mark. Consequently, there is no likelihood of confusion between the trade marks and its mark cannot therefore be refused registration on the basis of Article 8(1)(b) of Regulation No 40/94.

19 The applicant supports its arguments by maintaining that in this instance the earlier mark lacks distinctiveness and that there is no similarity between the marks at issue.

(b) Distinctiveness of the earlier trade mark

20 The applicant maintains in essence that the earlier trade mark lacked any distinctive character of its own and that the product which is the subject-matter of these proceedings was particularly well known. However, neither of those factors was taken into account by OHIM.

21 The applicant supports its claim by relying on the fact that, in common usage, the word 'limoncello' designates in Spain, in Italy and in the rest of the world the liqueur from the Amalfi Coast, prepared with lemon zest, and not exclusively the beverage manufactured by the opponent. The applicant produces in that connection extracts from internet sites and submits that both the opponent, in its observations of 11 April 2003, and OHIM, in its letter of 23 November 1999, accepted that customary usage.

22 Thus, contrary to what is stated in the opponent's observations of 11 April 2003, 'limonchelo' is no more than the translation into Spanish of 'limoncello', which describes generally the liqueur prepared with lemon zest and alcohol. The applicant refers in that regard to the results of internet searches based on the word 'limonchelo' and to the existence of countless similar trade marks in Spain, as the opponent recognised.

- 23 The applicant concludes that in the present case the earlier trade mark has a low degree of distinctiveness and accordingly entails little likelihood of confusion, which means that OHIM must carry out an extremely rigorous analysis of the elements which may establish that the two marks in question are identical or similar.

(c) Similarity of the trade marks in issue

- 24 As regards a visual comparison, the applicant submits, in essence, that there are significant visual differences between its trade mark and the earlier mark. It refers in particular to the use of Italian, to the letters following the letters 'limonc', to the word elements 'della costiera amalfitana' and 'shaker', to the graphic representation, to the numerous typographical differences and to the colours used.
- 25 The applicant's principal submission in relation to the phonetic comparison is that the Board of Appeal wrongly placed importance solely on the word 'limoncello' and considered the words 'della costiera amalfitana' to be verbal elements which were neither dominant nor essential, thereby failing to follow the case-law or OHIM's previous practice in taking decisions, by virtue of which all relevant factors must be taken into consideration when an assessment is made of the likelihood of confusion on the part of consumers.
- 26 The applicant also submits that the comparison of the two trade marks shows that the only phonetic elements common to both signs are the first two syllables 'li' and 'mon', whilst the next syllables 'chelo' and 'cello' and the words 'della costiera amalfitana' are not phonetically similar.

- 27 As to a comparison from the conceptual point of view, the applicant maintains, first, that OHIM should have examined the particular renown of the area from which its product comes, namely the Amalfi Coast. The applicant mentions in that regard the judgment in Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, and points out that OHIM, in its letter of 23 November 1999, emphasised the decisive role played by the geographic origin of the product in the consumer's choice.
- 28 'Limonchelo' and 'limoncello della costiera amalfitana' evoke for the average consumer images which are undoubtedly different. The words 'della costiera amalfitana' relate to a specific geographical location which is well known to Spanish consumers, with the result that those consumers could not think that the product concerned comes from the same undertaking and from the same geographical area as the product manufactured under the LIMONCHELO trade mark. Accordingly, the words 'della costiera amalfitana', when added to the word 'limoncello', form, in the applicant's submission, a very different logical whole from the earlier trade mark.
- 29 Second, OHIM should have examined the objective conditions under which the marks may be in opposition on the market (Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57). The Spanish consumer will not be misled into thinking that the product bearing the LIMONCHELO trade mark, whose label, in addition to three lemons, features the logo of Distileria Toris, and the product bearing the label 'limoncello della costiera amalfitana' actually come from the same undertaking.
- 30 Referring to the judgment in Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54, the applicant submits that any obvious visual and phonetic similarity can be neutralised when at least one of the marks has a clear and specific meaning from the point of view of the relevant public. In this instance, the average Spanish consumer will

immediately perceive that the applicant's product is an Italian liqueur, indeed the typical Italian liqueur, made with lemons from the Amalfi Coast and manufactured in Italy.

- 31 Accordingly, on the basis of all of the foregoing considerations, the applicant submits that, even though there is similarity in part between the expressions of which the trade marks in issue are composed, the low degree of distinctiveness of the word 'limoncello' and of its Spanish translation 'limonchelo', together with the many visual, phonetic and conceptual differences between the trade marks in issue, preclude a likelihood of confusion on the part of the relevant public. The decision refusing to register the applicant's trade mark is therefore unlawful.

2. OHIM's arguments

- 32 OHIM refutes the arguments advanced by the applicant in support of its claims and contends that the comparative analysis underlying the assessment of the likelihood of confusion, as carried out by the Board of Appeal and by the Opposition Division, is well founded.

- 33 The Board of Appeal rightly pointed out that 'limoncello' constituted the dominant part of the trade mark claimed. That word is, in the defendant's submission, the element which identifies and distinguishes that mark from the point of view of average Spanish consumers, who are the reference public in the present case. OHIM points in that regard to the prominent central position and the larger size of the word 'limoncello' in relation to the other elements of the trade mark claimed.

- 34 OHIM therefore considers it obvious that 'limoncello', pertaining to the trade mark claimed, and 'limonchelo', derived from the earlier mark, may be perceived by the average Spanish consumer as almost identical in visual and phonetic terms. Both words are composed of ten letters, nine of which are the same; only the letters 'l' and 'h' are different, and, since they fall in the middle of the words, they have a limited impact so far as their ability to distinguish the marks is concerned. Further, the fact that the Spanish pronunciation of the earlier mark LIMONCHELO is almost wholly identical to the correct pronunciation of the Italian word 'limoncello' entails a high degree of phonetic similarity.
- 35 OHIM is fully aware of the meaning of the word 'limoncello' in Italian, but in this instance that does not undermine the inherent distinctiveness of the word from the point of view of the Spanish public. There is currently nothing definite to suggest that the average Spanish consumer attributes a precise and specific semantic value to the word 'limoncello'.
- 36 OHIM therefore refutes the applicant's argument that the word 'limonchelo' is the Spanish version of the Italian term 'limoncello', which, for its part, is recognised worldwide, including in Spain, as a generic term defining a particular type of liqueur. According to OHIM, there is no objective evidence to support the arguments of the other party. Furthermore, under Article 74 of Regulation No 40/94, it is not within the scope of OHIM's powers to substitute itself for the parties in securing proof to establish that 'limoncello' has been or has become, in its possible accepted spellings (see, for example 'limonchelo'), a generic term in the Spanish public's perception. In that regard, OHIM observes that the material provided by the applicant, consisting of extracts from internet sites, in no instance refers to the Spanish public and that the letter of 23 November 1999 is based on matters of fact and law which are distinct from those concerning the assessment of the likelihood of confusion as between trade marks.

37 In the present case, the earlier mark is sufficiently distinctive given that it is registered as a national trade mark. Consequently, OHIM contends that it must confine itself to considering the earlier mark as warranting, as such, protection with regard to a later trade mark which reproduces its distinctive and dominant element.

38 OHIM also invokes the significant similarities between this case and Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335.

39 In that case the Court of First Instance drew attention to the importance of assessing the likelihood of confusion by reference to the relevant public and, more specifically, to the perception of the marks in issue which the reference consumer will have from his own basic linguistic knowledge. It follows that, even if a term has a particular meaning in one language which, however, is not the reference consumer's basic language, and there is nothing to establish that the consumer concerned understands that meaning of the term, that term can certainly be the dominant component, as regards distinctiveness, of the mark of which it forms part.

40 On the basis of the foregoing, OHIM considers the contested decision to be well founded. Relying on the principle of interdependence between the signs and the products in the assessment of the likelihood of confusion, the Board of Appeal could legitimately take the view that, since the products at issue were identical (which the applicant does not dispute), the similarities identified between the trade marks (and noticeable, in particular, in the near identity of the words 'limonchelo' and 'limoncello') could entail a likelihood of confusion on the Spanish market. The Board of Appeal was thus right to confirm the decision upholding the opposition, on the ground that there was a likelihood of confusion, as referred to in Article 8(1)(b) of Regulation No 40/94.

B — Findings of the Court

1. Preliminary considerations

- 41 In the words of Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, a trade mark 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 two trade marks, there is a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 42 Moreover, 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.
- 43 According to settled 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 (Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraph 30, and the case-law cited).
- 44 According to the same line of case-law, the likelihood of confusion must be assessed globally by reference to the perception which the relevant public has of the signs and goods in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see the judgment in *GIORGIO BEVERLY HILLS*, cited at paragraph 43 above, paragraphs 31 to 33, and the case-law cited).

45 In this instance, the earlier trade mark is a word mark which is registered and protected in Spain. Furthermore, the goods in issue are goods intended for everyday consumption. Accordingly, account must be taken, for the purposes of the assessment of whether there is a likelihood of confusion in this case, of the perception of the relevant public, which consists of average Spanish consumers.

46 Since the relevant public has been defined, a comparison must be made, first, of the goods concerned and, second, of the signs at issue.

2. Comparison of the goods

47 In relation to the comparison of the relevant goods, the Board of Appeal held that the goods covered by the earlier trade mark encompassed the goods to which the trade mark application related: that was not disputed by the parties. It must therefore be stated that the goods are identical.

3. Comparison of the signs

(a) Preliminary considerations

48 As regards the comparison between the trade marks in issue, it is necessary to point out, first of all, that in this case the trade mark claimed is a complex mark composed of verbal and figurative elements, whilst the earlier trade mark is purely a word mark.

- 49 Further, the Court recalls that, concerning the similarity of conflicting signs, it is clear from the case-law that the global assessment of the likelihood of confusion must, as far as concerns the visual, phonetic or conceptual similarity of the signs in question, be based on the overall impression given by the signs, bearing in mind, *inter alia*, their distinctive and dominant components (*BASS*, cited at paragraph 30 above, paragraph 47, and the cases cited).
- 50 Consequently, it must be held that a complex trade mark, one of whose components is identical or similar to another mark, cannot be regarded as being similar to that other mark, unless that component forms the dominant element within the overall impression created by the complex 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 (*MATRATZEN*, cited at paragraph 38 above, paragraph 33, confirmed on appeal 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).
- 51 That assessment does not amount to taking into consideration only one component of the complex trade mark and comparing it with another mark. On the contrary, a comparison of the marks concerned must be made by examining them, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components (*MATRATZEN*, paragraph 38 above, paragraph 34).
- 52 In the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark (*MATRATZEN*, cited at paragraph 38 above, paragraph 35).

53 Specifically, that means that the Board of Appeal had to consider which component of the trade mark claimed was apt, by virtue of its visual, phonetic or conceptual characteristics, to convey, by itself, an impression of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible in that respect. As stated at paragraphs 51 and 52 above, the outcome of that examination may be that a number of components must be regarded as dominant.

54 However, if the trade mark claimed is a complex mark which is visual in nature, the assessment of the overall impression created by that mark and the determination as to whether there is any dominant element must be carried out on the basis of a visual analysis. Accordingly, in such a case, it is only to the extent to which a potentially dominant element includes non-visual semantic aspects that it may become necessary to compare that element with the earlier mark, also taking into account those other semantic aspects, such as for example phonetic factors or relevant abstract concepts.

(b) Dominant component

(i) Description of the components of the trade mark claimed on the basis of a visual appreciation

55 The Court observes that the components of the trade mark claimed are the word 'limoncello' written in large white letters, the words 'della costiera amalfitana' written in smaller yellow letters, the word 'shaker' in smaller blue letters in a box against a white background and the 'k' of which represents a glass and, finally, the figurative representation of a large round dish whose centre is white and whose

border is decorated with yellow lemons on a dark background and an alternating turquoise and white band. All these components of the trade mark are set against a dark blue background.

(ii) Dominance of the round dish decorated with lemons in the mark claimed

56 The figurative component of the mark claimed, consisting of a round dish decorated with lemons, in addition to its realistic representation of a dish, is made distinctive by its contrasting colours, its large size and the realistic depictions of lemons on its border, the whole giving this representation a quite particular visual attraction.

57 The round dish decorated with lemons has, by virtue of its intrinsic qualities, a high degree of distinctiveness as compared with the other components of the mark claimed and in particular as compared with the word 'limoncello'. It is therefore dominant in relation to the other elements of the mark claimed.

58 As an ancillary matter, it should be observed that, in spite of its slightly off-centre position, the figurative representation of the dish is in the lower two thirds of the mark claimed and covers most of that area, whilst the word 'limoncello' covers only a large part of the upper third of the mark claimed.

59 It follows that the representation of the round dish decorated with lemons must be regarded as being clearly the dominant component of the mark claimed.

(iii) Assessment of the other elements of the mark claimed

— ‘Limoncello’

- 60 In this instance the Court cannot concur with the point of view of the Board of Appeal which held, at paragraph 20 of the contested decision, that the word ‘limoncello’ was the dominant element of the mark claimed, on account essentially of its large lettering and its prominent position, and went on to find, at paragraph 21 of the contested decision, that the marks at issue were visually and phonetically almost identical.
- 61 The Court notes that, although it is true that the word ‘limoncello’ is shown in larger lettering than the other verbal components of the mark claimed, its visual impact is none the less markedly less striking than that of the round dish decorated with lemons. The word ‘limoncello’ is also smaller in relation to the figurative component consisting of the round dish decorated with lemons.
- 62 For those reasons alone and without it being necessary to examine the phonetic or conceptual features of that term, it must be stated that the word ‘limoncello’ is not the dominant component of the mark claimed.

— ‘Della costiera amalfitana’

- 63 The Court notes that, on the basis of a visual assessment, the words ‘della costiera amalfitana’ are written in smaller lettering than the word ‘limoncello’ and that they

are descriptive of the geographic origin of the product in question. In addition, those words are markedly smaller than, and their colours form less of a contrast by comparison with, the figurative representation of the round dish decorated with lemons. The Court finds that there is no need to examine the phonetic or conceptual features of this component and that it cannot be regarded as a dominant element of the mark claimed, regard being had in particular to its small size.

— ‘Shaker’

64 On the basis of a visual assessment, it is evident that, despite the white background and the figurative element consisting of the shape of a glass in the letter ‘k’, ‘shaker’ and its figurative element are smaller than the round dish decorated with lemons and the word ‘limoncello’ in the mark concerned. Furthermore, ‘shaker’ lacks the contrasting colours of the round dish decorated with lemons. Consequently, the Court finds that there is no need to examine the phonetic or conceptual features of that term and that it cannot be regarded as a dominant element of the mark claimed.

(c) Global assessment of the likelihood of confusion

65 The figurative representation of a round dish decorated with lemons is the dominant component of the mark claimed: it has nothing in common with the earlier trade mark, which is purely a word mark.

66 There is therefore no likelihood of confusion between the trade marks in question. The dominance of the figurative representation of a round dish decorated with

lemons in comparison with the other components of the mark claimed prevents any likelihood of confusion arising from visual, phonetic or conceptual similarities between the words 'limonchelo' and 'limoncello' which appear in the marks at issue.

- 67 In the context of the global assessment of the likelihood of confusion, it should also be observed that the average consumer has only occasionally the opportunity to carry out a direct comparison of the various trade marks but must rely on his imperfect mental image of them (see, by analogy, Case C-342/987 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). The fact that the average consumer retains only an imperfect mental image of the trade mark renders the dominant element of the mark in question of major importance (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 47). Thus, the dominant element of the trade mark claimed (the round dish decorated with lemons) is of major importance in the overall assessment of the sign because the consumer looking at a label for a strong alcoholic drink takes notice of, and remembers, the dominant element of the sign, which enables him to repeat the experience on the occasion of a subsequent purchase.
- 68 The dominance of the figurative component (a round dish decorated with lemons) in the mark claimed means that in this instance the assessment of the distinctive elements of the earlier trade mark does not affect the application of Article 8(1)(b) of Regulation No 40/94. Although the degree of distinctiveness of an earlier word mark may affect the assessment of the likelihood of confusion (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 24), that requires that there be, at the very least, some likelihood of confusion between the earlier trade mark and the mark claimed. However, it is clear from the overall assessment of the likelihood of confusion between the trade marks at issue that the dominance, in the case of the mark claimed, of a round dish decorated with lemons prevents there being any likelihood of confusion with the earlier trade mark. Consequently, there is no need to adjudicate on the distinctiveness of the earlier trade mark (see, to that effect, Case T-110/01 *Vedial v OHIM — France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 64 and 65, upheld on appeal in Case C-106/03 P *Vedial v OHIM* [2004]

ECR I-9573, paragraph 54; Case T-311/01 *Éditions Albert René v OHIM — Trucco (Starix)* [2003] ECR II-4625, paragraph 61, and Case T-317/01 *M+M v OHIM — Mediametrie (M+M EUROdata)* [2004] ECR II-1817, paragraphs 74 and 75).

- 69 In the light of those considerations, the Court must hold that, notwithstanding the fact that the goods concerned are identical, there is not a sufficiently high degree of similarity between the trade marks in question for a finding that the Spanish reference public might believe that the goods in question come from the same undertaking or, as the case may be, from economically-linked undertakings. Accordingly, contrary to OHIM's finding in the contested decision, there is no likelihood of confusion between them within the meaning of Article 8(1)(b) of Regulation No 40/94.
- 70 Therefore, the applicant's first plea must be accepted.

II — The second and third pleas in law alleging misuse of powers and failure to state reasons

- 71 Since the first plea in law must be accepted, there is no longer any need to consider the applicant's other pleas.
- 72 Therefore, in accordance with Article 63(3) of Regulation No 40/94 the contested decision must be annulled and altered so that the appeal brought by the applicant before the Board of Appeal is well founded and, consequently, the opposition must be rejected.

Costs

- 73 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 defendant has been unsuccessful and the applicant has asked for costs, the defendant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 24 October 2003 (Case R 933/2002-2) and alters it so that the appeal brought before OHIM by the applicant is well founded and consequently the opposition must be rejected;**
- 2. Orders OHIM to pay the costs.**

Jaeger

Azizi

Cremona

Delivered in open court in Luxembourg on 15 June 2005.

H. Jung

M. Jaeger

Registrar

President