

Case T-7/04

Shaker di L. Laudato & C. Sas

v

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

(Community trade mark — Application for figurative Community trade mark
Limoncello della Costiera Amalfitana shaker — Earlier national word mark
LIMONCHELO — Likelihood of confusion — Article 8(1)(b)
of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Third Chamber), 15 June 2005 . . . II - 2309

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 — Similarity of the marks concerned — Criteria for assessment — Complex mark
(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 — Similarity of the marks concerned — Criteria for assessment — Complex mark — Determination of dominant component(s) — Visually complex mark*
(Council Regulation No 40/94, Art. 8(1)(b))

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 — Likelihood of confusion with earlier mark — Figurative mark Limoncello della Costiera Amalfitana shaker and word mark LIMONCHELO*
(Council Regulation No 40/94, Art. 8(1)(b))

1. Even if, in the context of applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the assessment of the similarity between a complex mark and another mark does not amount to taking into consideration only one component of the complex trade mark and comparing it with the other mark, and even if, on the contrary, a comparison of the marks concerned must be made by examining them, each considered as a whole, that does not mean however 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.

2. In the context of applying Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, 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.

(see para. 51)

Specifically, that means that it is a question of examining which component of the trade mark claimed is 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. The outcome of that examination may be that a number of components must be regarded as dominant.

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 proceed to the comparison of that element, on the one hand, with the earlier mark, on the other hand, also taking into account those other semantic aspects, such as for example phonetic factors or relevant abstract concepts.

(see paras 52-54)

3. For the average Spanish consumer there is no likelihood of confusion between on

the one hand the figurative sign which corresponds visually to this description:

‘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’.

which is the sign of which registration is claimed as a Community trade mark for the ‘lemon liqueur from the Amalfi Coast’ and which falls within Class 33 of the Nice Agreement, and on the other hand the word mark LIMONCHELO earlier registered in Spain for goods falling within the same Class, since the figurative representation of a round dish decorated with lemons is the dominant component of the mark claimed and has

nothing in common with the earlier mark which is purely a word mark, and since the dominance of that figurative representation in comparison with the other components of the mark claimed prevents any likelihood of confusion arising from visual phonetic or concep-

tual similarities between the words 'limonchelo' and 'limoncello' which appear in the marks in issue.

(see paras 65-66, 69)