

Case T-104/01

Claudia Oberhauser

v

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

(Community trade mark — Opposition — Earlier figurative mark containing the term ‘miss fifties’ — Application for Community word mark ‘Fifties’ — Relative ground for refusal — Likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 23 October
2002 II-4362

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 identical or similar earlier mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Assessment criteria (Council Regulation No 40/94, Art 8(1)(b) and 2(a)(ii))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an identical or similar earlier mark registered for identical or similar goods or services — Similarity between the goods or services and between the marks in question — Assessment criteria*

(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 identical or similar earlier mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — ‘Fifties’ word mark and figurative mark containing the words ‘miss fifties’*

(Council Regulation No 40/94, Art. 8(1)(b))

1. Article 8(1)(b) of Regulation No 40/94 on the Community trade mark provides that, 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark’. Article 8(2)(a)(ii) of Regulation No 40/94 provides that an earlier trade mark is a trade mark 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.

come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion and must be assessed globally, taking into account all factors relevant to the circumstances of the case. That global assessment implies some interdependence between the factors taken into account, and in particular similarity between the trade marks and between the goods or services, and, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

(see paras 24-27)

The risk that the public might believe that the goods or services in question

2. When considering an opposition brought by the owner of an earlier mark under Article 8(1)(b) of Regulation No 40/94 on the Community

trade mark, and when assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

As regards comparison of the opposing signs, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. It is possible that mere aural similarity between trade marks may create a likelihood of confusion.

(see paras 31, 34)

3. For the Spanish-speaking public there is aural and conceptual similarity between the word mark 'Fifties', in respect of which registration as a Community trade mark was sought for 'Denim clothing' in Class 25 of the Nice Agreement and the mark consisting of the composite colour word and figurative sign with 'miss fifties' as its dominant word component, previously registered in Spain for 'clothing, footwear, headgear' in the same class.

Having regard to the aural and conceptual similarities, attributable to the dominant word component 'fifties', and the identity of the goods designated by the conflicting marks, the visual differences between the signs referred to above are not such as to dispel a likelihood of confusion in the mind of the targeted public, and the mark sought accordingly falls within the scope of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark.

(see paras 40, 45-46, 52)