

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

23 February 2006 *

In Case T-194/03,

Il Ponte Finanziaria SpA, established in Scandicci, Italy, represented by P.L. Roncaglia, A. Torrigiani Malaspina and M. Boletto, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by M. Buffolo and O. Montalto, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervening before the Court of First Instance, being

* Language of the case: Italian.

Marine Enterprise Projects — Società Unipersonale di Alberto Fiorenzi Srl,
established in Numana (Italy), represented by D. Marchi, lawyer,

intervener,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 17 March 2003 (Case R 1015/2001-4) concerning opposition proceedings between Il Ponte Finanziaria SpA and Marine Enterprise Projects — Società Unipersonale di Alberto Fiorenzi Srl,

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

composed of H. Legal, President, P. Mengozzi and I. Wiszniewska-Białecka, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 30 May 2003,

having regard to the response lodged at the Registry of the Court of First Instance on 1 October 2003,

having regard to the response of the intervener, lodged at the Registry of the Court of First Instance on 29 September 2003,

further to the hearing on 26 October 2005,

gives the following

Judgment

Legal context

- ¹ Article 15(1) and (2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, provides:

'1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:

- (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

...'

2 Article 43(2) and (3) of Regulation No 40/94 is worded as follows:

‘2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2) (a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.’

3 Rule 22 (‘Proof of use’) (1) to (3) 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) provides:

‘(1) Where, pursuant to Article 43(2) or (3) of the Regulation, the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

(2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.

(3) The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) of the Regulation.'

Background to the dispute

- 4 On 24 September 1998, Marine Enterprise Projects, Società Unipersonale di Alberto Fiorenzi Srl ('the intervener') submitted an application for a Community trade mark to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Regulation No 40/94.
- 5 The trade mark for which registration was sought is the figurative sign reproduced below:



6 The goods in respect of which registration was sought are in Classes 18 and 25 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 of those classes, to the following descriptions:

— Class 18: ‘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’;

— Class 25: ‘Clothing, footwear, headgear’.

7 That application was published in *Community Trade Marks Bulletin* No 47/99 of 14 June 1999.

8 On 7 September 1999, Il Ponte Finanziaria SpA (‘the applicant’) gave notice of opposition to the registration of the trade mark applied for under Article 8(1)(b) of Regulation No 40/94.

9 The opposition was based on the following earlier national registrations:

- Italian registration No 370836, with effect from 11 May 1979, in respect of goods corresponding to the description 'clothing', included in Class 25, of the figurative sign reproduced below:

Bridge

- Italian registration No 704338, with effect from 15 July 1964, in respect of goods corresponding to the description 'clothing, including boots, shoes and slippers', included in Class 25, of the figurative sign reproduced below:



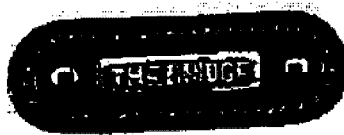
- Italian registration No 606709, with effect from 22 October 1990, in respect of goods corresponding to the description 'socks and ties', included in Class 25, of the figurative sign reproduced below:



- Italian registration No 593651, with effect from 12 June 1990, in respect of goods corresponding to the description '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', included in Class 18, and in respect of goods corresponding to the description 'clothing, footwear, headgear', included in Class 25, of the figurative sign reproduced below:



- Italian registration No 642952, with effect from 14 June 1994, in respect of goods corresponding to the description ‘clothing, footwear, headgear’, included in Class 25, of the word sign THE BRIDGE;
- Italian registration No 704372, with effect from 22 June 1994, in respect of goods corresponding to the description ‘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’, included in Class 18, and in respect of goods corresponding to the description ‘clothing, footwear, headgear’, included in Class 25, of the three-dimensional sign reproduced below:



- Italian registration No 633349, with effect from 22 June 1994, in respect of goods corresponding to the description ‘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’, included in Class 18, and in respect of goods corresponding to the description ‘clothing, footwear, headgear’, included in Class 25, of the three-dimensional sign reproduced below:



- Italian registration No 710102, with effect from 7 December 1994, in respect of goods corresponding to the description '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', included in Class 18, and in respect of goods corresponding to the description 'clothing, footwear, headgear', included in Class 25, of the word sign FOOTBRIDGE;

- Italian registration No 721569, with effect from 28 February 1996, in respect of goods corresponding to the description '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', included in Class 18, and in respect of goods corresponding to the description 'clothing, footwear, headgear', included in Class 25, of the figurative sign reproduced below:



- Italian registration No 630763, with effect from 24 December 1991, in respect of goods corresponding to the description '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', included in Class 18, and in respect of goods corresponding to the description 'clothing, footwear, headgear', included in Class 25, of the word sign OVER THE BRIDGE;

- Italian registration No 642953, with effect from 26 October 1994, in respect of goods corresponding to the description ‘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’, included in Class 18, of the word sign THE BRIDGE.
- 10 By decision of 15 November 2001, the Opposition Division of OHIM rejected the opposition, taking the view that, despite the interdependence between the degree of similarity of the goods concerned and the degree of similarity of the conflicting signs, any likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, could reasonably be ruled out in view of the aural and visual dissimilarities between the signs.
- 11 On 3 December 2001, the applicant filed notice of appeal against the decision of the Opposition Division.
- 12 By decision of 17 March 2003, the Fourth Board of Appeal of OHIM rejected the appeal (‘the contested decision’). First of all, it excluded from its assessment the earlier registrations Nos 370836, 704338, 606709 and 593651, on the ground that use of the corresponding marks had not been established (contested decision, paragraphs 12 and 13). It also excluded the earlier registration No 642952, on the ground of insufficiency of the evidence of use of the corresponding trade mark produced by the opponent (contested decision, paragraph 14). The Board of Appeal then compared the other six earlier marks, covered by registrations Nos 704372, 633349, 710102, 721569, 630763 and 642953, with the trade mark applied for and decided that there was no conceptual, visual or aural similarity between them (contested decision, paragraph 16 et seq.). It therefore concluded that there was no likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, between the conflicting trade marks, deeming the principle of interdependence between similarity of the goods and similarity of the signs to be irrelevant in this case, in view of the absence as between the conflicting marks of the minimum degree of similarity required in order to justify the application of that principle (contested decision, paragraph 25).

Forms of order sought by the parties

13 In its application, the applicant claims that the Court should:

- annul the contested decision;

- instruct OHIM to reject the intervener's application for registration;

- order OHIM to pay the costs.

14 At the hearing, the applicant declared that it was withdrawing its second head of claim, formal note of which was taken in the minutes of the hearing.

15 OHIM and the intervener contend that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

- 16 The complaints put forward by the applicant in support of its claim for annulment can be grouped together into two pleas alleging, firstly, infringement of Article 8(1)(b) of Regulation No 40/94 and, secondly, infringement of Articles 15(2)(a) and 43(2) and (3) of Regulation No 40/94 and infringement of Rule 22 of Regulation No 2868/95.

The plea alleging infringement of Articles 15(2)(a) and 43(2) and (3) of Regulation 40/94 and infringement of Rule 22 of Regulation No 2868/95

Arguments of the parties

- 17 In the first place, the applicant claims that the Board of Appeal was wrong in basing its assessment relating to the likelihood of confusion solely on the earlier trade marks THE BRIDGE and THE BRIDGE WAYFARER, excluding from it the other trade marks owned by the applicant and ruling out in respect of all the earlier trade marks the specific protection appertaining to 'marks in a series'. The applicant points out that the earlier marks which were excluded by the Board of Appeal were registered less than five years before the notice of opposition was filed and that they are therefore not subject to proof of use within the meaning of Article 43 of Regulation No 40/94. Consequently, those earlier marks, by the mere fact of their registration, should have been taken into account by the Board of Appeal.
- 18 In the second place, the applicant maintains that it was contrary to Rule 22 of Regulation No 2868/95 for the Board of Appeal to exclude from its assessment of the likelihood of confusion the word mark THE BRIDGE for Class 25, covered by

registration No 642952, on the ground that its use had not been sufficiently established. The applicant points out, in that regard, that the abovementioned rule includes catalogues and advertisements among the supporting documents and items which may be produced in order to prove use of a trade mark. In order to prove genuine and actual use of that mark, it produced before the Board of Appeal, in accordance with the abovementioned rule, several advertisements as well as its catalogues. Those supporting documents and items were wrongly regarded as insufficient by the Board of Appeal. For whatever purpose it may serve, the applicant has produced before the Court further documents concerning use of the mark in question.

- 19 In the third place, the applicant asserts that the Board of Appeal wrongly excluded from its assessment of the likelihood of confusion the earlier figurative marks covered by registrations Nos 370836, 704338, 606709 and 593651, on the ground that their use had not been proved. In the applicant's view, the earlier marks in question are to be classified as 'defensive trade marks' for the purposes of Italian Royal Decree No 929 of 21 June 1942, as amended ('the Italian Law on trade marks'), and are excluded, under Article 42(4) of that law, from revocation for non-use. The applicant points out that the purpose of 'defensive' marks is to widen the scope of protection of the principal trade mark against likelihood of confusion by allowing their proprietor to oppose the registration of any trade mark similar or identical to them but which would not, in itself, be sufficiently similar to the principal trade mark to establish the existence of a likelihood of confusion. In the applicant's view, the Board of Appeal wrongly held that the earlier marks in question did not constitute 'defensive trade marks' since they had not been registered at the same time as or later than the principal earlier mark. In that regard, the applicant observes, firstly, that the Board of Appeal failed to take account of the fact that the applicant had registrations Nos 704338 and 607909 transferred to it by third parties precisely with a view to using them as 'defensive trade marks' and, secondly, that the registrations of all the trade marks whose 'defensive' character is pleaded by the applicant are, in any event, later than both the Italian registration of the trade mark THE BRIDGE MADE IN ITALY, dating back to 1975, on which the opposition was not based, and the actual use of the earlier mark THE BRIDGE, dating back to the 1970s.

- 20 Finally, as regards, *inter alia*, registration No 370836, the applicant maintains that the evidence of use of the earlier mark THE BRIDGE must be regarded as capable of proving also use of the earlier mark covered by that registration, which differs from the trade mark THE BRIDGE only in a negligible variation. In that regard, the applicant notes that, under Article 15(2)(a) of Regulation No 40/94, use of a Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered is deemed to constitute use of that mark. It was therefore contrary to Article 15(2)(a) of Regulation No 40/94, in the applicant's view, for the Board of Appeal to exclude the earlier mark THE BRIDGE from its assessment of the likelihood of confusion, on the ground that its use had not been proved.
- 21 As regards the applicant's first complaint, OHIM replies that, in order to be able to rely on the concept of 'marks in a series', the applicant should have produced proof of use of all its trade marks, which it did not do.
- 22 With regard to the second complaint, OHIM contends that the Board of Appeal correctly assessed the items of evidence submitted by the applicant by considering that they were insufficient to prove use of the word mark THE BRIDGE covered by registration No 642952.
- 23 Finally, so far as concerns the applicant's third complaint, OHIM points out that, under Article 43(2) of Regulation No 40/94, use of the earlier trade mark is a necessary condition for the opposition to registration of a later Community trade mark to be upheld. OHIM further notes that protection of the 'defensive mark' is not required by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40,

p. 1), and that its recognition is not compatible with the Community trade mark legislation.

24 In the first place, the intervener points out that the applicant was required to prove use of all its trade marks in order to substantiate its claim to be the proprietor of 'marks in a series'.

25 In the second place, the intervener submits that the Board of Appeal correctly excluded from its assessment the earlier trade mark THE BRIDGE protected by registration No 642952. In that regard, it points out that the information relating to goods covered by a trade mark, contained in catalogues or advertisements, does not, in itself, furnish any indication concerning the quantitative extent of use of that mark, since it must be supplemented by other documents capable of proving extensive and significant distribution of the trade mark within the relevant territory. In this case, in the view of the intervener, the Board of Appeal probably took account of the fact that the applicant had produced only a single 1994/95 autumn/winter catalogue and a few advertisements from 1995, from which it was reasonably entitled to conclude that the trade mark in question had been put to purely symbolic use.

26 Finally, as regards the applicant's complaint concerning infringement of its 'defensive trade marks', the intervener replies that the widening of the protection of a trade mark by means of 'defensive trade marks' presupposes the existence of a principal trade mark, so that, in order to be classified as 'defensive', a trade mark must be applied for at the same time as or after the application for the principal trade mark and not at an earlier date. The intervener also points out, firstly, that the earlier registrations Nos 370836 and 704338 were obtained for goods in Class 25 even though the bulk of the applicant's trade is in goods included in Class 18 and, secondly, that 'defensive trade marks' must, as a general rule, display only slight

variation from the principal trade mark whereas the earlier marks which the applicant relies on as 'defensive' differ significantly from the principal earlier mark THE BRIDGE.

Findings of the Court

²⁷ With regard to the applicant's first complaint, it should be noted that, contrary to what the applicant claims, the Board of Appeal based its assessment of the likelihood of confusion on the comparison between the trade mark applied for and six earlier marks corresponding to registrations Nos 704372, 633349, 710102, 721569, 630763 and 642953. In paragraph 11 of the contested decision, the Board of Appeal expressly affirmed that the earlier marks in question were not subject to proof of use in accordance with Article 43 of Regulation No 40/94 because the period of five years following their registration had not yet expired. It therefore concluded that the abovementioned six marks had to be taken into consideration for the purpose of assessing the existence of a likelihood of confusion with the trade mark applied for, in respect of all the goods for which they had been registered. That conclusion was confirmed in paragraph 15 of the contested decision.

²⁸ It was only when it examined the applicant's argument that the earlier trade marks were to be regarded as forming part of a 'family of marks' and must therefore, in that respect, enjoy extended protection that the Board of Appeal found, on the basis of its assessment of the evidence adduced by the applicant, that the various products marketed by the latter 'were promoted and sold mainly under the trade mark THE BRIDGE and, to a lesser extent, under the figurative trade mark THE BRIDGE WAYFARER', so that the Italian consumer was actually confronted on the market only with those two earlier marks (paragraph 22 of the contested decision). Taking that finding as its basis, the Board of Appeal concluded that the extended protection pleaded by the applicant, connected with the existence of an alleged 'family of

marks', was not justified in this case, since the mere registration of numerous trade marks, unaccompanied by their use on the market, was insufficient to establish such a concept.

- 29 The complaint in question is actually intended to dispute that conclusion of the Board of Appeal and the finding on which it is based. Since it calls in question assessments made by the Board of Appeal in the context of the analysis on the substance of the existence of a likelihood of confusion between the conflicting signs, this complaint will have to be considered in the context of the analysis of the plea alleging infringement of Article 8(1)(b) of Regulation No 40/94.
- 30 By its second complaint, the applicant maintains that it was contrary to Rule 22 of Regulation No 2868/95 for the Board of Appeal to exclude from its assessment of the likelihood of confusion the word mark THE BRIDGE, covered by registration No 642952, on the ground that its use had not been sufficiently established.
- 31 Under Article 43(2) read in conjunction with Article 43(3) of Regulation No 40/94, if the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition must furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier national trade mark has been put to genuine use in the Member State in which it is protected in connection with the goods or services in respect of which it is registered. As provided in Rule 22(2) of Regulation No 2868/95, 'the indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based'. Catalogues and newspaper advertisements are among the supporting documents and items which may be produced as proof of use pursuant to Rule 22(3).

- 32 It is relevant that genuine use implies real use of the mark on the market concerned for the purpose of identifying goods or services. Genuine use is therefore to be regarded as excluding minimal or insufficient use for the purpose of determining that a mark is being put to real, effective use on a given market. In that regard, even if it is the owner's intention to make real use of his trade mark, if the trade mark is not objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign, so that it cannot be perceived by consumers as an indication of the origin of the goods or services in question, there is no genuine use of the trade mark (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM — Harrison (HIWATT)* [2002] ECR II-5233, paragraph 36, and Case T-156/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO AIRE)* [2003] ECR II-2789, paragraph 35).
- 33 In this case, the applicant had to demonstrate use in Italy of the word mark THE BRIDGE, registered in respect of goods corresponding to the description 'clothing, footwear, headgear', falling within Class 25. In addition, that proof was to be established for the period of five years which preceded the date of publication of the trade mark application, that is to say, for the period from 14 June 1994 to 14 June 1999.
- 34 It is apparent from the analysis of the documentation contained in OHIM's file forwarded to the Court that the only evidence produced by the applicant concerning the use made of the earlier word mark THE BRIDGE in connection with goods in Class 25 consists of a 1994/95 autumn/winter catalogue and of advertisements published in 1995. The other catalogues produced by the applicant are not dated.
- 35 It must be observed that the evidence adduced by the applicant is very limited with regard to 1994 and non-existent for the period from 1996 to 1999.

- 36 In those circumstances, the evidence submitted by the applicant, irrespective of whether it is capable of furnishing indications concerning the quantitative extent of use of the trade mark in question, does not demonstrate that the latter was consistently present on the Italian market, in connection with the goods in respect of which it was registered, during the period which preceded the date of publication of the trade mark application, contrary to the requirements of Article 43(2) read in conjunction with Article 43(3) of Regulation No 40/94.
- 37 It follows that the Board of Appeal was fully entitled to take the view that genuine use of that trade mark in connection with the goods in question had not been proved.
- 38 Moreover, the documents produced by the applicant for the first time before the Court are inadmissible and must therefore be disregarded. According to the Court's settled case-law, the purpose of the action before it is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94. It is therefore not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it (Case T-128/01 *DaimlerChrysler v OHIM (Grille)* [2003] ECR II-701, paragraph 18; Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67; Case T-85/02 *Diaz v OHIM — Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 46; Case T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13, and Case T-57/03 *SPAG v OHIM — Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 20; see, to that effect, Case T-237/01 *Alcon v OHIM — Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraphs 61 and 62, confirmed by order of the Court of Justice in Case C-192/03 P *Alcon v OHIM* [2004] ECR I-8993).

39 It follows from the foregoing that the second complaint in this plea must be rejected as unfounded.

40 By its third complaint, the applicant claims, firstly, that the Board of Appeal was wrong in excluding from its assessment of the likelihood of confusion registrations Nos 370836, 704338, 606709 and 593651, on the ground that use of the corresponding trade marks had not been proved. The applicant maintains that the abovementioned marks are 'defensive trade marks' which, as such, are exempt from proof of use under the Italian Law on trade marks.

41 In paragraph 12 of the contested decision, the Board of Appeal, finding that the four abovementioned earlier trade marks did not appear in any of the catalogues or advertisements produced by the applicant, concluded that the documentation adduced during the opposition proceedings did not prove the presence of those trade marks on the market. In the following paragraph, the Board of Appeal disregarded the applicant's argument that the trade marks in question benefited, as 'defensive trade marks', from use of the earlier mark THE BRIDGE. In that regard, it first pointed out that 'defensive trade marks' are auxiliary in nature, being registered not in order to be used on the market, but for the purpose of extending the protection of the principal trade mark, and that it follows logically from their nature that they must be registered at the same time as or after the principal trade mark. It then found that the registrations of the four trade marks in question were earlier than the trade mark THE BRIDGE. It therefore concluded that those trade marks could not be regarded as 'defensive trade marks'. Since their use had not been proved, they therefore had to be excluded from the assessment relating to the existence of a likelihood of confusion with the trade mark applied for.

42 It should be pointed out that while, in Italian law, Article 42(4) of the Law on trade marks provides for an exception to the rule that a trade mark must be revoked for non-use over a five-year period, as laid down in Article 42(1), where ‘the proprietor of the unused trade mark is, at the same time, the proprietor of another, similar trade mark or several other, similar trade marks still in force, at least one of which is used to identify the same goods or services’, there is, by contrast, no concept of ‘defensive trade mark’ in the system of protection of the Community trade mark.

43 In that regard, it should be noted that, within the scheme of Regulation No 40/94, 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, Article 15(1) of Regulation No 40/94 provides that ‘if, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use’. Under Article 50(1)(a), the rights of the proprietor of a Community trade mark are to be revoked if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use. Article 43(2) and (3) of Regulation No 40/94 provides that the opposition to a Community trade mark application must be rejected if the proprietor of an earlier Community or national trade mark who has given notice of opposition does not furnish, if the applicant so requests, proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier trade mark has been put to genuine use in the Community or in the Member State in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use. A similar provision is laid down in Article 56(2) of Regulation No 40/94 in the case of the submission of an application for revocation of rights or for a declaration of invalidity.

- 44 The central role which the obligation to use the trade mark assumes within the scheme of Regulation No 40/94 is confirmed in the ninth recital in the preamble to that regulation, which states that ‘there is no justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used’.
- 45 It follows that the taking into account of so-called ‘defensive’ registrations is not compatible with the system of protection of the Community trade mark intended by Regulation No 40/94.
- 46 It is true that the provisions of that regulation which 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 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, as is the case with Article 42(4) of the Italian Law on trade marks, 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. As was held in paragraph 45 above, 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.

47 For the foregoing reasons, the third complaint in the present plea must therefore be rejected in so far as it is based on the allegedly defensive nature, under the Italian Law on trade marks, of certain earlier trade marks disregarded by the Board of Appeal.

48 In its third complaint, the applicant maintains, secondly, that the numerous items of evidence which it produced during the proceedings before OHIM in order to prove use of the earlier trade mark THE BRIDGE also prove genuine use of the trade mark covered by registration No 370836, which differs from the trade mark THE BRIDGE only in negligible variations. In that regard, the applicant refers both to Article 15(2)(a) of Regulation No 40/94, under which use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered is deemed to constitute use of that mark, and to Article 42(2) of the Italian Law on trade marks, which contains a similar provision.

49 That argument must be rejected.

50 Article 15(2)(a) of Regulation No 40/94, to which the applicant refers, 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 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) 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.

51 In this case, the applicant is in fact attempting to prove use of the trade mark covered by registration No 370836 by relying on the same evidence produced before OHIM concerning use of the mark THE BRIDGE covered by separate registrations. In those circumstances, for the reasons which have been set out above and without there being any need to consider whether the trade mark covered by registration No 370836 can be regarded as broadly equivalent to the mark THE BRIDGE, it must be held that the conditions for the application of Article 15(2)(a) of Regulation No 40/94 are not satisfied in this case.

52 In the light of all the foregoing considerations, the third complaint in the present plea must be rejected as unfounded.

53 It follows that the present plea must be rejected in its entirety.

The plea alleging infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

54 Firstly, the applicant points out that it is the proprietor of numerous trade marks containing the term 'bridge', constituting a 'family' of marks or 'marks in a series'. That circumstance, which is such as to increase the likelihood of confusion between the conflicting marks, was disregarded by the Board of Appeal on the basis of a misinterpretation of the provisions of Regulation No 40/94 relating to proof of use of trade marks.

55 The applicant also claims that the trade marks owned by it are complex marks, all having one term in common, the English word 'bridge', accompanied by other word or figurative signs. None of the elements of which those marks consist have any connection with the goods identified by the marks. Consequently, those marks have a very strong inherent distinctive character, which is enhanced, in the case of the word mark THE BRIDGE, by the massive use which has been made of it and which is substantiated by the very voluminous documentation produced by the applicant before the Board of Appeal. The applicant points out that both Italian and Community case-law afford extensive protection to marks of that type. In that regard, the applicant recalls that, in Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 18, the Court of Justice held that 'marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character'.

- 56 The applicant points out that both the Opposition Division and the Board of Appeal accepted that the trade mark THE BRIDGE expresses a concept which has no connection with the goods in respect of which it is registered and that, consequently, it has inherent distinctive character. The Board of Appeal also acknowledged the well-known character of the trade mark THE BRIDGE, yet without drawing from that the appropriate conclusions so far as the assessment of the likelihood of confusion is concerned.
- 57 Secondly, the applicant complains that the Board of Appeal failed to take account, in its assessment of the likelihood of confusion, of the principle of interdependence between the similarity of the trade marks and that of the goods. Referring to Community case-law, and in particular to the judgment of the Court of Justice in Case C-251/95 *SABEL* [1997] ECR I-6191, it points out that the likelihood of confusion must be assessed globally, taking into account all factors relevant to the circumstances of the case, which must be regarded as interdependent.
- 58 Thirdly, with regard to the comparison between the conflicting signs, the applicant maintains that the Board of Appeal was wrong in holding that the earlier marks and the trade mark applied for were not similar.
- 59 With regard to the visual comparison, the applicant submits that, contrary to what is stated in the contested decision, the presence in the trade mark concerned, next to the word element 'bainbridge', of a design showing a roll of sailcloth unrolling to the point of taking on the shape of a sail, merely increases the likelihood of confusion between that mark and the earlier figurative marks, given that the latter also consist

of a word element containing the word 'bridge' and of graphic elements. That circumstance would lead the public to believe that the goods identified by the trade mark applied for come from the applicant and that they constitute a line of goods specifically intended for people interested in the world of sailing and water sports. That impression is subsequently reinforced by the fact that the figurative element of the earlier trade mark covered by registration No 721569 shows the design of a compass card, the nautical symbol par excellence.

60 The applicant also points out that the trade mark applied for and the earlier figurative mark covered by registration No 370836 are very similar graphically.

61 As regards the conceptual comparison of the signs, the applicant submits that the Board of Appeal made an error of assessment in so far as it took the view that the average Italian consumer has a knowledge of foreign languages enabling him to grasp the alleged conceptual difference between the conflicting marks.

62 In that regard, the applicant maintains that the Board of Appeal's conjecture that the consumer in question is able to understand the meaning of the English word 'bridge' is incorrect. It points out that that word has no assonance with the corresponding Italian word, 'ponte', and that the term 'bridge' is commonly used in Italian to denote a card game.

63 Moreover, even if the conclusion that the English term 'bridge' is intelligible to the average Italian consumer is correct, it should in any event have led the Board of

Appeal to accept that there is a similarity between the conflicting marks in so far as they all contain that term. On the contrary, the Board of Appeal took the view that the average Italian consumer, although capable of understanding the meaning of the word 'bridge' when used in the applicant's trade marks, would not be able to distinguish that same term in the trade mark applied for, since it is used there in conjunction with another term, 'bain', which has no meaning in English, so that the trade mark applied for would appear to the eyes of the relevant public as a homogeneous and indivisible whole with no obvious meaning.

64 The applicant disputes that assessment, adding that, if, as the Board of Appeal maintains, the average Italian consumer has a sufficient knowledge of foreign languages to enable him to grasp the meaning of the English word 'bridge', he will also be able to understand, in the trade mark applied for, the French word 'bain' and will be led to dissect the term 'bainbridge' into two words. It points out that the intervener's argument, according to which the consumer in question will perceive the trade mark applied for as a patronymic or as a geographical indication, is not credible.

65 In the applicant's view, either the average Italian consumer will be unlikely to understand any of the foreign words of which the conflicting marks consist or he will recognise only the word 'bridge', which he will identify in all the marks in question. In both cases, the likelihood of confusion is obvious. In support of its claims, the applicant cites a number of OHIM decisions in which the existence of a likelihood of confusion was accepted without any reference to the intelligibility of the marks in question to the relevant consumer.

66 Finally, the applicant refers to a series of decisions, given in cases bearing strong similarities to the present case, in which the organs of OHIM accepted the existence of a likelihood of confusion between the conflicting marks.

67 OHIM submits that the Board of Appeal's assessment is correct.

68 With regard, first of all, to the applicant's assertion that the Board of Appeal did not take account of the fact that the applicant is the proprietor of a series of trade marks with the common element 'bridge', OHIM contends that the Community system does not grant any abstract legal protection to 'marks in a series', since each earlier sign must be considered individually in the assessment of any likelihood of confusion with the Community trade mark applied for. To that effect, the concept of 'marks in a series' is relevant in such an assessment only if the relevant consumer has been confronted with each of the earlier marks which has actually been used, so that he derives from them the impression that there exists between them a link such as to attribute the same origin to them all. Consequently, the concept of 'marks in a series' or 'family of marks' has relevance only when each mark has been put to genuine use.

69 Secondly, as regards the applicant's argument that the Board of Appeal did not take account in its assessment either of the interdependence between the similarity of the goods concerned and the similarity of the signs in question or of the alleged reputation of the earlier marks, OHIM points out that the existence of a minimal degree of similarity between the conflicting signs is an essential condition for acceptance of a likelihood of confusion, failing which it is no longer necessary to examine the other circumstances which play a part in the global assessment of likelihood of confusion, such as the inherent distinctive character and reputation of the earlier mark or the possible similarity between the goods. In this case, such a minimal degree of similarity between the conflicting signs cannot be discerned.

70 OHIM, like the Board of Appeal, takes the view that it is only in the earlier trade marks that the word 'bridge' lends itself to detachment from the whole of which it

forms part. By contrast, the trade mark applied for constitutes a homogeneous and indivisible whole, with no obvious meaning, in which the word element 'bridge' loses all individual character and merges into another word which is clearly distinct from its constituent elements. In OHIM's view, common experience shows that words can lose or acquire their meaning if they are separated from or combined with other words, as is the case with the Italian word 'bella' when it is reproduced in the word 'isabella'.

71 In addition, OHIM points out that, visually, the conflicting signs are clearly different on account of their length or of the graphic object represented.

72 The intervener shares OHIM's assessments with regard to the applicant's complaints alleging the existence of 'marks in a series' and infringement of the principle of interdependence between the similarity of the signs and the similarity of the goods. As regards the first complaint, the intervener adds that the concept of 'marks in a series' presupposes that the trade marks under consideration share a common matrix, which is not the case with the earlier marks.

73 As regards the comparison between the conflicting marks, the intervener points out, with regard to the visual elements, that the trade mark applied for is a complex figurative and word mark which includes a design of great distinctiveness, capable of capturing the consumer's attention and of identifying the nautical origin of both the mark and the goods covered by it. The intervener also draws attention to the particular graphic representation of the word element 'bainbridge'. The trade mark applied for and the earlier marks are also different aurally.

74 Conceptually, the intervener points out that the term ‘bainbridge’ is a very common patronymic in the United States. In this case, it is the name of one of the two founders of the American company Bainbridge Aquabatten Inc., a manufacturer of sailcloths, of which the intervener is the sole distributor in Italy. The term in question is also a toponym, being the name of a small town in Washington State and a small island on one of the lakes in Georgia State. Consequently, in the intervener’s view, the term ‘bainbridge’ should not be regarded as a compound word, but as a single name which has no conceptual link with the earlier trade marks, which refer to the concept of a bridge.

Findings of the Court

75 Article 8(1)(b) of Regulation No 40/94 provides that, ‘upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not 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’ and that ‘the likelihood of confusion includes the likelihood of association with the earlier trade mark’.

76 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.

77 According to the same line of case-law, the likelihood of confusion on the part of the public must be assessed globally, 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 identified (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* ECR II-2821, paragraphs 31 to 33, and the case-law cited).

78 In this case, given the nature of the goods concerned, the description of which is reproduced in paragraphs 6 and 9 above, the targeted public in relation to which the analysis of the likelihood of confusion must be carried out consists, for all the goods in question, of the average consumers of the Member State in which the earlier trade marks are protected, namely, Italy.

79 In accordance with Article 8(1)(b) of Regulation No 40/94 and in the light of the foregoing considerations, a comparison must therefore be made between, firstly, the goods concerned and, secondly, the conflicting signs.

— The goods in question

80 According to the case-law, in assessing the similarity of the goods or services concerned, all the relevant factors pertaining to the relationship between those goods or services are to 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 one another or are complementary (Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 51).

81 In this case, the opposition is based on the earlier trade marks registered in respect of goods in Classes 18 and 25 or in one of those two classes and is directed against registration of the trade mark applied for in respect of goods in those same classes.

82 As to assessing the degree of similarity between the goods, it is therefore sufficient to note that, as is apparent from the descriptions reproduced in paragraphs 6 and 9 above, on which moreover the parties agree, the goods covered by the trade mark application and those covered by the earlier marks are identical.

— The signs in question

83 In paragraph 11 of the contested decision, the Board of Appeal took the view that only six of the eleven earlier marks, namely the three-dimensional marks including the word element ‘the bridge’ (registrations Nos 704372 and 633349), the word mark FOOTBRIDGE (registration No 710102), the figurative mark including the word element ‘the bridge wayfarer’ (registration No 721579), the word mark OVER THE BRIDGE (registration No 630763) and the word mark THE BRIDGE (registration No 642953), could be taken into consideration in the assessment of the existence of a likelihood of confusion.

84 Since none of the complaints put forward by the applicant against that conclusion of the Board of Appeal and examined in the analysis of the first plea has been upheld, the analysis concerning similarity of the conflicting signs must be limited to a comparison between the trade mark applied for and the six earlier marks listed in paragraph 11 of the contested decision (‘the relevant earlier marks’).

- 85 It is first necessary to compare the trade mark applied for with each of the relevant earlier marks taken individually and then, in the context of the analysis of the likelihood of confusion, to examine the applicant's argument based on the existence of an alleged 'family' or 'series' of earlier marks.
- 86 It is settled case-law that the global assessment of the likelihood of confusion, which must take into account all the relevant factors, must, as regards the visual, aural or conceptual similarity of the conflicting signs, be based on the overall impression created by the signs, bearing in mind, in particular, their distinctive and dominant components (*SABEL*, paragraph 23, and *ELS*, paragraph 62). The average consumer of the type of goods or services in question, whose perception of the marks plays a decisive role in the global assessment of the likelihood of confusion, normally perceives a mark as a whole and does not proceed to analyse its various details (*SABEL*, paragraph 23).
- 87 In this case, the relevant earlier marks consist of word signs, complex figurative and word signs and three-dimensional signs, all including a common word element, namely the English word 'bridge' preceded, in the majority of the signs, by the definite article 'the'. The trade mark applied for is a complex sign consisting of a black and white rectangular label in which the design of a roll of sailcloth, unrolling to the point of assuming the shape of a sail, is reproduced. On the right-hand side of the design is the word 'bainbridge', in cursive black letters, spread out horizontally over two-thirds of the length of the label and underlined with a black line extending across the whole of the label.
- 88 As a preliminary point, it should be noted, as the Board of Appeal did in paragraph 23 of the contested decision, that the earlier trade marks have a high degree of inherent distinctiveness in so far as they consist of complex and three-dimensional

word signs, the elements of which, considered individually or as a whole, have no link with the goods identified by the trade marks. With regard, inter alia, to the earlier marks including the word element 'the bridge', that character is subsequently enhanced by the intensive use made of it. According to the case-law of the Court of Justice, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (*SABEL*, paragraph 24, and *Canon*, paragraph 18).

89 However, as regards the applicant's claim that the Board of Appeal accepted that the earlier marks were well known, it is sufficient to note that such a claim cannot be substantiated by any passage of the contested decision.

90 It is therefore necessary to examine whether the Board of Appeal was entitled, without making errors of assessment, to conclude that there are no visual, aural or conceptual similarities between the conflicting signs.

91 Those signs must first of all be compared visually.

92 In that regard, the relevant earlier marks must be divided into three categories, depending on whether they are word signs, complex signs, that is, consisting of figurative and word elements, or three-dimensional signs.

93 The first category includes the earlier marks FOOTBRIDGE (registration No 710102), OVER THE BRIDGE (registration No 630763) and THE BRIDGE (registration No 642953).

94 The Court has held that a complex word and figurative trade mark cannot be regarded as being similar to another trade mark which is similar or identical to one of the components of the complex 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. (Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).

95 In this case, even if the word element 'bainbridge' of the trade mark applied for could be regarded as the element likely to attract the consumer's attention more than the other elements, it is clear that the visual similarities between that element and the three earlier marks in question concern only a sequence of six letters forming the English word 'bridge'. That word is accompanied, in the trade mark applied for, by the prefix 'bain' and, in the earlier marks, by the separate words 'over the' and 'the' and the prefix 'foot'.

96 Moreover, the word 'bainbridge' is accompanied in the trade mark applied for by figurative elements, the significance of which, although it may be described as lesser, is nevertheless not negligible within the overall impression created by that sign.

97 In the light of the abovementioned dissimilarities between the three earlier marks in question and the word element of the trade mark applied for, and in view of the

other differentiating factor constituted by the figurative elements which characterise the latter mark, the similarity between the conflicting signs, noted in paragraph 95 above, is not such as to constitute the decisive factor in a global assessment of the conflicting signs from a visual perspective.

98 The second category includes only the complex mark containing the word element ‘the bridge wayfarer’ (registration No 721579). That mark shows the black and white design of a compass card with a black horizontal line passing through it. The figurative element in question is positioned between the words ‘the bridge’, in bold black characters, and the word ‘wayfarer’, in smaller black characters.

99 It must be stated that the earlier mark in question differs substantially in visual terms from the trade mark applied for. The only element common to the conflicting signs, namely the sequence of six letters forming the word ‘bridge’, appears in this instance to be almost imperceptible within the overall impression created by the signs, which is very much affected by the figurative elements, including, apart from the designs, the graphic reproduction of the word elements which are there in addition to the abovementioned word, namely the prefix ‘bain’ in the trade mark applied for and the separate words ‘the’ and ‘wayfarer’ in the earlier mark in question.

100 As regards, finally, the third category of relevant earlier marks, consisting of three-dimensional labels showing the phrase ‘the bridge’, it must be stated that the differences arising from the very nature of those marks are sufficient to rule out any visual similarity to the trade mark applied for.

101 In conclusion, 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.

102 The conflicting signs must then be compared aurally.

103 In that regard, it must be pointed out that the aural similarities between the conflicting signs are quite weak if the trade mark applied for is compared with the earlier mark including the word element 'the bridge wayfarer' and the earlier word mark OVER THE BRIDGE, although they are more marked when such a comparison relates to the earlier word marks THE BRIDGE and FOOTBRIDGE and to the three-dimensional earlier marks including the word element 'the bridge'.

104 In that regard, the argument set out by the Board of Appeal in paragraph 21 of the contested decision, according to which the aural differences 'largely reflect the conceptual differences ..., given that the pronunciation of the various marks will be different depending on the meaning of the words of which they consist', fails to convince.

105 On the other hand, the Italian consumer will probably pronounce the above-mentioned four earlier marks and the trade mark applied for in such a way that the word 'bridge' is stressed in every case, notably because of the arrangement of the letters and the juxtaposition of the consonants 'd' and 'g', which does not occur in the Italian language. Moreover, the aural similarity between the earlier word marks THE BRIDGE and FOOTBRIDGE and the earlier three-dimensional marks including the word element 'the bridge', on the one hand, and the trade mark

applied for including the word element 'bainbridge', on the other, is all the more marked because the word 'bridge' appears in all those marks in the same position. However, that similarity is weakened by the presence of the words 'the' and the prefix 'foot' in the earlier marks and the prefix 'bain' in the trade mark applied for.

106 In the light of the foregoing considerations, it must therefore be accepted that there is some aural similarity between the trade mark applied for and, at the very least, the abovementioned four earlier marks.

107 Finally, the conflicting signs must be compared conceptually.

108 The starting point of the Board of Appeal's analysis concerning the semantic content of the marks in question lies in the assumption, disputed by the applicant, that the average Italian consumer has a knowledge of the English language sufficient to enable him to recognise the meaning of the term 'bridge' and to link it with the corresponding Italian word, 'ponte' (paragraph 17 of the contested decision).

109 Such a premise cannot be called in question. As the intervener correctly points out, the word 'bridge' forms part of the elementary vocabulary of the English language, knowledge of which corresponds, in Italy, to an average level of school education. The same applies to the English terms 'the' and 'foot' and the expression 'over the', which are included in the earlier marks.

110 The Board of Appeal continues its reasoning by arguing that the Italian consumer is able to understand the word 'bridge' in its meaning of 'ponte' only when he is

confronted with the earlier marks, since it is only in those marks that the term in question is used in conjunction with the article 'the' or with other English words such as 'foot', which are easily understood. However, that is not the case with regard to the trade mark applied for, since the word 'bridge' is preceded in that mark by the prefix 'bain' which, in itself, is devoid of any meaning (paragraph 18 of the contested decision). Thus, in the view of the Board of Appeal, 'while, in the earlier marks, the word "bridge" could notionally be detached from the whole of which it forms part, the mark BAINBRIDGE constitutes a homogeneous and indivisible whole, with no obvious meaning, unless as a fanciful sign, patronymic or geographical indication, in which the word "bridge", although present, has no independent meaning' (paragraph 19 of the contested decision).

111 The Board of Appeal's reasoning appears in that regard to be free from errors of assessment.

112 The fact that the word 'bridge' is preceded, in the trade mark applied for, by the prefix 'bain', which has no meaning in the English language, is such as to weaken the directness of the semantic link between the word in question and the concept on which it is based in that language. Thus, the whole consisting of the term 'bainbridge' could easily be perceived by the Italian consumer as a fanciful word or, having regard also to the fact that, in the graphic representation of the mark, that term begins with a capital letter, as a geographical indication, identifying a town or region with a river flowing through it, along the lines of, for example, the word Cambridge, or as a family name. Moreover, the graphic representation of the sign contains nothing which could evoke the idea of a bridge. On the other hand, the design showing a sail could lead the consumer to think that the indication 'bainbridge' identifies a seaside locality where water sports are practised. Such an association of ideas could be further reinforced in the mind of the average Italian consumer if it is assumed that, as the applicant suggests, he is able to understand the meaning of the French word 'bain', which appears as a prefix in the term 'bainbridge'.

113 By contrast, when it is used in the relevant earlier marks, the word ‘bridge’ immediately evokes the concept of a bridge. That directness of the semantic link is reinforced by various elements, such as the use of the article ‘the’, or of other English words as adjectives (‘foot’).

114 In the light of the considerations set out above, it must therefore be held that the Board of Appeal did not make any errors of assessment when it concluded that the conflicting signs were not semantically similar and, consequently, that it cannot be stated that the trade mark applied for makes illegal use of the concept of ‘bridge’ expressed by the relevant earlier marks (paragraph 20 of the contested decision).

— The likelihood of confusion

115 It is apparent from the foregoing considerations that the conflicting signs display significant similarities only aurally.

116 Despite the highly distinctive character of the relevant earlier marks and the identity of the goods covered by them and by the trade mark applied for, it cannot be concluded that there is a likelihood of confusion solely on the basis of the aural similarities between the conflicting signs. In that regard, it must be pointed out that the degree of aural similarity between two marks 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 (Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335 and Case T-301/03 *Canali Ireland v OHIM — Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479). That is the case with respect to the goods in question here.

- 117 In the light of all the foregoing considerations, it must be concluded that the Board of Appeal did not make any errors of assessment in concluding that there was no likelihood of confusion on the part of the consumer between the trade mark applied for and the six relevant earlier marks considered individually.
- 118 It remains necessary, at this stage, to consider applicant's argument that the earlier trade marks, all characterised by the presence of the same word component, 'bridge', constitute a 'family of marks' or 'marks in a series'. In its view, such a circumstance is liable to give rise to an objective likelihood of confusion in so far as the consumer, when confronted with the trade mark applied for, containing the same word component as the earlier marks, will be led to believe that the goods identified by that mark also come from the applicant.
- 119 As a preliminary point, it should be noted that the concept of 'marks in a series' is not referred to by Regulation No 40/94.
- 120 Such a finding does not, however, give grounds for automatically disregarding the applicant's argument.
- 121 In order to assess the validity of such an argument, it must first be recalled that, under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not 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 on the part of the public a likelihood of confusion which 'includes the likelihood of association with the earlier trade mark'. Moreover, the seventh recital in the preamble to Regulation No 40/94 states that 'the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the

recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection’.

122 It should then be recalled that, according to the case-law mentioned in paragraph 77 above, the likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the goods or services in question, and taking into account all factors relevant to the circumstances of the case.

123 It must be held that, when the opposition to a Community trade mark application is based on several earlier marks and 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, such a circumstance constitutes a relevant factor for the purpose of assessing whether there is a likelihood of confusion.

124 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, as in this case, 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 confusion. 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.

¹²⁵ However, the likelihood of association described above may be invoked only if two conditions are cumulatively satisfied.

¹²⁶ 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'. For there to be a likelihood of the public's being mistaken as to whether the trade mark applied for belongs to the series, the earlier marks forming part of that series must necessarily be present on the market. Since taking into account the serial nature of the earlier marks would entail widening the scope of protection of the trade marks forming part of the series, considered individually, any assessment in the abstract of the likelihood of confusion, based solely on the existence of several registrations covering marks reproducing, as in this case, the same distinctive element, and in the absence of any actual use of the marks, must be regarded as excluded. Consequently, failing proof of such use, any likelihood of confusion entailed by the appearance on the market of the trade mark applied for will have to be assessed by comparing each of the earlier marks, taken individually, with the trade mark applied for.

¹²⁷ 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.

128 In this case, it must be held that, at the very least, the first of the abovementioned conditions is not satisfied. As was stated by the Board of Appeal and as the file shows, the only evidence produced by the applicant during the opposition proceedings refers to use of the trade mark THE BRIDGE and, to a lesser extent, of the trade mark THE BRIDGE WAYFARER. Since those two marks are the only earlier marks whose presence on the market the applicant has proved, the Board of Appeal was right to disregard the arguments by which the applicant claimed the protection due to 'marks in a series'.

129 In the light of all the foregoing considerations, it must be concluded that the Board of Appeal made no errors of assessment or errors of law in ruling out the existence of a likelihood of confusion between the conflicting signs.

130 It follows that the plea alleging infringement of Article 8(1)(b) of Regulation No 40/94 must also be rejected.

131 The action must therefore be dismissed in its entirety.

Costs

132 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, 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 applicant has been unsuccessful, it must be ordered to pay the costs, as applied for by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs.**

Legal

Mengozi

Wiszniewska-Białecka

Delivered in open court in Luxembourg on 23 February 2006.

E. Coulon

H. Legal

Registrar

President