

Case T-85/02

Pedro Díaz SA

v

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

(Community trade mark — Opposition procedure — Application for
Community word mark CASTILLO — Earlier national figurative mark
EL CASTILLO — Likelihood of confusion — Similar marks already on the
relevant market)

Judgment of the Court of First Instance (Second Chamber), 4 November
2003 II-4838

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*

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or similar earlier mark registered for identical or similar products or services — Similarity between the products in question — Assessment criteria — Complementary nature of the products — Fact that products belong to a single product family — Relevance

(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 identical or similar earlier mark registered for identical or similar products or services — Likelihood of confusion with the earlier mark — Distinctive character or reputation of the earlier mark — Relevance*

(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 products or services — Likelihood of confusion with the earlier mark — Word mark 'CASTILLO' and word and figurative mark containing the word 'EL CASTILLO'*

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

1. Two products are similar within the meaning of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark when, in the eyes of the relevant public, they belong to a single product family and are therefore complementary.

products are both within the milk-products family and may therefore have the same commercial origin.

In that regard, it is irrelevant that the two products are consumed in different ways, since they may easily be regarded as components of a general range of products.

Thus, products such as cheese, on the one hand, and condensed milk, on the other, must be regarded as similar for the purposes of Article 8(1)(b), since the public is aware of the fact that the

(see paras 33, 36, 38)

2. In the application of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the distinctive character of an earlier trade mark, which derives from the qualities inherent in the mark or from its reputation, must be taken into account when determining whether the similarity between the products or services covered by the two trade marks is sufficient to give rise to a likelihood of confusion.
3. There exists, on the part of the Spanish public, a likelihood of confusion between the word mark 'CASTILLO', for which registration as a Community trade mark is sought for 'cheese', in Class 29 of the Nice Agreement, and the word and figurative mark containing the words 'EL CASTILLO', an earlier Spanish registration for 'condensed milk', also in Class 29, since, in the eyes of the relevant public, the products concerned may be perceived as having a common commercial origin and must therefore be regarded as similar for the purposes of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark and since, in view of the fact that (i) in the earlier trade mark, the component 'EL CASTILLO' must be regarded as dominant both aurally and conceptually and (ii) the word 'CASTILLO' constitutes the mark applied for, the conflicting signs are, at the very least, similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

If it appears that the positive reputation of an earlier mark may, at least in some cases, contribute to the highly distinctive character of a trade mark and, therefore, may increase the likelihood of confusion between that mark and a mark applied for, the coexistence on the market on which the earlier trade mark is registered of national or Community trade marks consisting of, or including, a verbal element common to the earlier trade mark and the Community trade mark applied for is not sufficient, by itself, to prove that there is no likelihood of confusion between the conflicting marks.

(see paras 43-45)

(see paras 38, 40, 48)