

# Case T-434/07

## Volvo Trademark Holding AB

v

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

(Community trade mark — Opposition proceedings — Application for the Community figurative mark SOLVO — Earlier Community and national word and figurative marks VOLVO — Relative ground for refusal — Article 8(1)(b) and (5) of Regulation (EC) No 40/94 (now Article 8(1)(b) and (5) of Regulation (EC) No 207/2009)

Judgment of the General Court (Sixth Chamber), 2 December 2009 . . . . II - 4419

### 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 — Visual similarity between a complex figurative mark and a word mark — Criteria for assessment*  
(Council Regulation No 40/94, Art. 8(1)(b))
2. *Community trade mark — Procedural provisions — Examination of the facts of the Office's own motion*  
(Council Regulation No 40/94, Arts 8(1)(b) and 74(1))

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 the earlier mark*

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

4. *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 the earlier mark*

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

1. The examination of the similarity between a complex figurative mark and an earlier word mark for the purposes of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of groups of words, written in printed characters in normal font, without any specific figurative element. The protection which results from registration of a word mark relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. The graphic form which the earlier word sign might have in the future must not, therefore, be taken into account for the purposes of the examination of similarity of the marks at issue.
2. The legality of a Community measure must be assessed on the basis of the elements of fact and of law existing at the time when the measure was adopted. In this respect, it is not possible to take the view that the issue of the definition of the relevant public, in the assessment of the similarity of the signs at issue for the purposes of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, is a legal requirement that can be examined by the Court of its own motion and for the first time. The definition of the relevant public is based on facts which must be assessed in the first place by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in compliance with Article 74(1) of that regulation, and which may, in some circumstances, be subject to a review of legality by the Community Courts in the light of the arguments and evidence put forward by the parties.

(see para. 37)

(see paras 46-47)

3. Although the analysis of the similarity between the signs in question for the purposes of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, which constitutes an essential element of the global assessment of the likelihood of confusion, must, like that assessment, be done in relation to the perception of the relevant public, that applies essentially only to the extent that the specific nature of the consumers in question might influence their perception of the similarity of the signs at issue. That is thus *inter alia* the case as regards the perception of the degree of phonetic and conceptual similarity, which is likely to vary according to the language and the cultural context of those consumers, or according to their level of knowledge of certain specialist terms, which is sometimes determined by whether they are members of a professional public.

On the other hand, in so far as it might have an influence on whether there is a likelihood of confusion, that is to say on whether the goods or services in question are ascribed to the same undertaking or to economically-linked undertakings, the perception of the target public must be taken into consideration at the stage of the global assessment of the likelihood of confusion. That is the case *inter alia* as regards the higher degree of attention normally displayed by the professional public.

(see paras 48-49)

4. ‘There is phonetic similarity between the figurative mark SOLVO, for which registration as a Community trade mark is sought for’ computer programs for warehouse management systems and computer programs for container terminal systems’ in Class 9 of the Nice Agreement, and the word mark VOLVO, registered previously in the United Kingdom for, amongst other goods and services, ‘computer software’ in Class 9 of that agreement, and thus also for goods identical to those covered by the mark applied for.

Although the difference in the first letter of the signs at issue creates a phonetic dissimilarity, the pronunciation of the group of the following four letters, ‘olvo’, remains strictly identical and thus necessarily maintains a degree of similarity.

Although it is correct that the beginning of a sign is of importance in the global impression created by that sign, it cannot be denied in the present case that there is a degree of similarity, in view of the identical pronunciation to which a very large part of each of the signs at issue gives rise, namely four of their five letters.

The existence of a degree of similarity between the signs at issue as regards one of the relevant aspects examined, namely

phonetic similarity, precludes the conclusion that one of the essential conditions for the application of Article 8(1)(b) of Regulation No 40/94 on the Community trademark is lacking. In those circumstances, it is necessary to carry out a global assessment of the likelihood of confusion, in order to determine whether, in view of the degree of phonetic similarity found between the signs at issue, of the identity of the goods covered

and of the reputation of the earlier sign, the public at which the goods in question are aimed might believe that those goods come from the same undertaking or from economically-linked undertakings.

(see paras 28, 39-40, 50)