



## Reports of Cases

OPINION OF ADVOCATE GENERAL  
MENGOZZI  
delivered on 23 January 2014<sup>1</sup>

**Case C-591/12 P**

**Bimbo SA**

**v**

**OHIM**

(Appeal — Community trade mark — Opposition proceedings — Application for Community word mark BIMBO DOUGHNUTS — Earlier word mark DOGHNUTS — Article 8(1)(b) of Regulation (EC) No 207/2009)

1. By its appeal in the present case, Bimbo SA seeks the setting aside of the judgment of 10 October 2012 in *Bimbo v OHIM – Panrico (BIMBO DOUGHNUTS)*<sup>2</sup> ('the judgment under appeal'), by which the General Court dismissed Bimbo's action against the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 7 October 2010<sup>3</sup> concerning opposition proceedings between Bimbo and Panrico SA ('the contested decision').

### **I – Background to the appeal**

2. The background to the present proceedings, as set out in the judgment under appeal, is summarised below.

3. On 25 May 2006, Bimbo filed an application with OHIM under Regulation (EC) No 40/94, as subsequently amended,<sup>4</sup> for registration of the word sign BIMBO DOUGHNUTS as a Community trade mark. The goods in respect of which registration was sought are in Class 30 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 to the following description: 'pastry and bakery products, specially doughnuts'. The application was published in the *Community Trade Marks Bulletin* on 16 October 2006.

1 — Original language: Italian.

2 — Case T-569/10 (ECR).

3 — Case R 838/2009-4.

4 — Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). With effect from 13 April 2009, Regulation No 40/94 has been replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

4. On 16 January 2007, Panrico filed a notice of opposition, pursuant to Article 42 of Regulation No 40/94, to registration of the mark applied for. The opposition was based on a number of earlier national and international word and figurative marks, one of which was the Spanish word mark DOGHNUTS, registered on 18 June 1994 for goods in Class 30 corresponding to the following description: ‘pastry products and preparations ...; ... round-shaped dough biscuits ...’. The grounds raised in support of the opposition were those set out in Article 8(1)(b) and Article 8(5) of Regulation No 40/94.

5. On 25 May 2009, the Opposition Division of OHIM upheld the opposition. By the contested decision, the Fourth Board of Appeal of OHIM upheld the analysis made by the Opposition Division.

## II – Procedure before the General Court and the judgment under appeal

6. By application lodged at the Registry of the General Court on 13 December 2010, Bimbo claimed that the Court should alter the contested decision and grant the application for registration of the mark applied for, failing which it should annul that decision. In support of its action, Bimbo raised two pleas in law, the second of which alleged infringement of Article 8(1)(b) of Regulation No 207/2009. In the judgment under appeal, after rejecting as inadmissible the claims for alteration of the contested decision and registration of the mark applied for, together with both the related pleas in law, the General Court dismissed the action and ordered Bimbo to bear its own costs and to pay those incurred by OHIM. As regards the second plea in law, by which Bimbo challenged the Board of Appeal’s assessment of the likelihood of confusion, the General Court first confirmed that the relevant public for the purposes of that assessment was the average Spanish consumer and that the goods in question were identical. Secondly, in its comparison of the signs, the General Court rejected Bimbo’s argument that the word ‘doughnuts’ in the mark applied for had to be regarded as descriptive and, therefore, as lacking distinctive character for the Spanish public (paragraphs 57 to 74) and its assertion that the word ‘bimbo’ was dominant within that trade mark, because that mark is widely known in Spain (paragraphs 75 to 80). In that regard, the General Court explained that even if it had been established that BIMBO was a trade mark with a reputation and, accordingly, that the element which reproduced that trade mark played a more important role within the sign, that would not in itself mean that the similarity of the signs at issue could be assessed solely on the basis of that element, given that the word ‘doughnuts’ could not be regarded as negligible in the overall impression created by the mark applied for. Thirdly, the General Court upheld the Board of Appeal’s finding that there was an average degree of visual and phonetic similarity between the signs at issue and that a conceptual comparison was not possible. Lastly, in its overall assessment of the likelihood of confusion, the General Court responded to Bimbo’s argument that ‘bimbo’ was the dominant element in the mark applied for by referring to the judgment of the Court of Justice in *Medion*<sup>5</sup> and stating, in paragraph 96 of the judgment under appeal, that ‘where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein’. The General Court went on to find that the ‘doughnuts’ element played an independent distinctive role within the mark applied for, as it had ‘average distinctive character for the part of the relevant public which is not familiar with English’ and that, since it was wholly meaningless for such consumers, it did not combine with the ‘bimbo’ element in the mark applied for to form an independent ‘unitary whole’ or ‘logical unit’ that would be capable of identifying the goods in question as ‘doughnuts produced by the undertaking Bimbo’ (paragraph 97). On the basis of those findings and taking account, in particular, of the fact that the goods in question

<sup>5</sup> — Case C-120/04 *Medion* [2005] ECR I-8551.

were identical, of the consumer's lower attention level because of the nature of those goods, and of the visual and phonetic similarities between the signs at issue, the General Court concluded that the Board of Appeal had been right to find that there was a likelihood of confusion in the circumstances of the case.

### III – Procedure before the Court and forms of order sought

7. By application lodged at the Registry of the Court of Justice on 14 December 2012, Bimbo lodged an appeal against that judgment. It claims that the Court should set aside the judgment under appeal, allowing the form of order sought at first instance in relation to annulment of the contested decision for infringement of Article 8(1)(b) of Regulation No 207/2009 and the award of costs against OHIM. For their part, OHIM and Panrico contend that the Court should dismiss the appeal and order Bimbo to pay the costs. The representatives of the parties were heard at the hearing on 7 November 2013.

### IV – The appeal

8. Bimbo raises a single ground of appeal, alleging infringement of Article 8(1)(b) of Regulation No 207/2009. That ground of appeal is divided into two parts, respectively alleging: (i) error of law on the part of the General Court in attributing an independent distinctive role within the mark applied for to the 'doughnuts' element of that mark and in misinterpreting and misapplying the case-law of the Court, especially *Medion*; and (ii) failure by the General Court to take account, in its overall assessment of the likelihood of confusion, of all the relevant aspects of the case.

*A – First part of the single ground of appeal: error in attributing an independent distinctive role within the mark applied for to the 'doughnuts' element of that mark*

#### 1. Arguments of the parties

9. Bimbo argues that, from the fact that the 'doughnuts' element has an average distinctive character and is wholly meaningless for the average Spanish consumer, the General Court wrongly drew the – virtually automatic – inference that that element plays an independent distinctive role within the mark applied for. In so doing, the General Court confused the 'distinctiveness' and the 'lack of ... meaning' of one of the elements of a composite mark with that element's 'independent distinctive role' within that mark, converting into a general rule the ruling made by the Court in *Medion* by way of an exception. According to Bimbo, the existence of such an 'independent distinctive role' must be established on a case-by-case basis, with due regard – as suggested by the use of the word 'role' – for the characteristics of the other elements making up the composite mark and in the light of all the relevant facts of the individual case. The judgment under appeal, however, contains no such assessment. On the contrary, the General Court's reasoning automatically leads to the finding that any trade mark composed of two elements, one of which is a trade mark with a reputation and the other a trade mark with an average distinctive character and wholly meaningless for the relevant public, cannot be a 'unitary whole' or 'a logical unit'. That finding automatically results in an 'independent distinctive role' being attributed to the second element. Bimbo submits, however, that the terms 'unitary whole' and 'logical unit' as used in the judgment under appeal have not been explained by the General Court and remain unclear. If, by its use of those terms, the General Court intended to highlight the fact that there was no connection between the elements of the mark applied for, Bimbo would argue that the mere fact that one or more elements of a composite mark have no connection with the other elements going to make up that mark does not necessarily mean that those elements play an independent distinctive role.

10. According to OHIM and Panrico, this part of the single ground of appeal should be rejected as unfounded and, in part, as manifestly inadmissible since it is intended to obtain from the Court a fresh assessment of the facts of the case.

## 2. Analysis

11. It seems to me that, in essence, Bimbo's arguments – which are not framed with conspicuous clarity – raise two interrelated complaints. The first is that, by concluding that one of the elements of a composite mark enjoys a distinctive independent position within that mark, simply because that element is distinctive and because, as it does not combine with the other elements to form a conceptually distinct whole, it retains an independent existence, the General Court – wrongly – proceeded by a series of automatic inferences rather than through an appraisal of all the circumstances of the case. The second complaint is that, by adopting that approach, the General Court attributed to *Medion* a generality of scope which belies the actual terms of the judgment in that case.

12. In order to examine those complaints, it is first of all necessary to summarise the Court's findings in *Medion*, which – in part, at least – the parties to the present proceedings have interpreted in different ways (Section (a)). Next, I shall illustrate how that judgment has been interpreted and applied in the subsequent case-law of the Court of Justice and the General Court (Section (b)), before attempting to delimit its precise implications (Section (c)). Lastly, I shall examine the arguments raised by Bimbo (Section (d)).

### a) The judgment in *Medion*

13. In the reference for a preliminary ruling which gave rise to the judgment in *Medion*, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) ('the referring court') asked the Court, in essence, whether Article 5(1)(b) of Directive No 89/104/EEC,<sup>6</sup> which has the same content as Article 8(1)(b) of Regulation No 207/2009, is to be interpreted as meaning that, where the goods or services are identical, there may be a likelihood of confusion between an earlier word mark with normal distinctiveness and a later composite word (or word and figurative) sign belonging to a third party in which the company name of that third party is placed before the earlier trade mark and the latter, although it does not dominate the overall impression conveyed by the composite sign, retains an independent distinctive role. When asking that question, the referring court stated that, according to the case-law of the Bundesgerichtshof (Federal Court of Justice), which is based on 'Prägetheorie' (theory of the impression conveyed), it is necessary, in order to assess the similarity of the signs at issue, to consider the overall impression conveyed by each of the two signs and to ascertain whether the common element characterises the composite sign to the extent that the other elements are largely secondary to that overall impression. On the basis of that theory, there will be no likelihood of confusion if the common element merely contributes to the overall impression of the composite sign, even if it retains an independent distinctive role within that sign. The applicant in the main proceedings (the proprietor of the earlier trade mark LIFE, registered in respect of leisure electronic devices) claimed that the company Thomson should be prevented from using the sign THOMSON LIFE in respect of the same goods. The referring court pointed out that – essentially owing to the fact that, in the sector of the goods at issue, prominence is generally given to the name of the manufacturer – the 'thomson' element contributed in an essential manner to the overall impression conveyed by the sign THOMSON LIFE, despite the normal distinctive character of the 'life' element.

6 — 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).

14. After explaining that Article 5(1)(b) of Directive No 89/104 is ‘designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, there exists a likelihood of confusion on the part of the public’ and having observed that 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 for the purposes of that provision,<sup>7</sup> the Court recalled the case-law to the effect that the existence of a likelihood of confusion on the part of the public must be assessed globally, and such an assessment, ‘in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by [those] marks, bearing in mind, in particular, their distinctive and dominant components ...’<sup>8</sup> The Court went on to recall that, according to settled case-law, the perception of the marks by the average consumer of the goods or services in question ‘plays a decisive role in the global appreciation of that likelihood of confusion’ and the average consumer ‘normally perceives a mark as a whole and does not proceed to analyse its various details’.<sup>9</sup> It also stated that, when considering the likelihood of confusion, ‘assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark’ since, on the contrary, the comparison must be made by ‘examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components’.

15. Against that background, the Court’s findings in paragraph 30 of *Medion* were as follows:

‘30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element’.

16. According to the Court, in such cases the public may be led to believe that the goods or services at issue derive from companies which are linked economically, at the very least, which is sufficient to establish a likelihood of confusion.<sup>10</sup> The Court added that making the finding that there is a likelihood of confusion subject to the condition that the overall impression produced by the composite sign be dominated by the element which represents the earlier mark would deprive the owner of the earlier mark of the exclusive right conferred by Article 5(1) of Directive No 89/104 whenever a third party makes use of a composite sign comprising that mark and the company name or trade mark with a reputation of that third party since, more often than not, such components would dominate the overall impression conveyed by that sign.<sup>11</sup>

7 — Paragraphs 25 to 27.

8 — Paragraphs 27 and 28.

9 — The Court was citing, in particular, Case C-251/95 *SABEL* [1997] ECR I-6191; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819; and the Order in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657.

10 — Paragraphs 31 and 36.

11 — Paragraphs 32 to 34.



b) Subsequent application of *Medion*

17. An analysis of the subsequent case-law reveals, above all, that the first section of the grounds of *Medion* – that is to say, paragraphs 27 to 29, as summarised in point 14 above – has been almost constantly cited as a demonstration of the methodology to be used when assessing whether a likelihood of confusion exists where one or both of the marks at issue are composite signs.<sup>12</sup> In that context, *Medion* has been construed as (i) reaffirming the principle that the existence of a likelihood of confusion must be established by means of an overall assessment in which the benchmark for appraising the similarity of the signs at issue is the *overall impression* conveyed by those signs, and (ii) upholding the earlier findings of the General Court and the Court of Justice in the *Matratzen* cases, namely, that the need to examine each of the marks at issue as a whole ‘does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components’.<sup>13</sup>

18. Various judgments, especially judgments of the General Court, have then referred to the findings in paragraphs 30 to 37 of *Medion* – as summarised in points 15 and 16 above – and to the concept of ‘an independent distinctive role’. The first point to emerge from an analysis of those judgments is that they tend to extend the scope of that section of the grounds of *Medion* beyond the few situations expressly contemplated in that judgment, which relate, as has been shown, to the use by a third party, where *the goods are identical*, of a composite sign in which *a reproduction* of an earlier trade mark of *independent distinctiveness* is juxtaposed with the *company name* of that third party or a *mark* belonging to that third party.<sup>14</sup> Notwithstanding a number of judgments to the contrary,<sup>15</sup> the

12 — See, inter alia, Case C-655/11 P *Seven for all mankind v Seven* [2013] ECR, paragraphs 71 and 72; Case C-254/09 P *Calvin Klein Trademark Trust v OHIM* [2010] ECR I-7989, paragraphs 43 to 45; Joined Cases C-202/08 P and C-208/08 P *American Clothing Associates v OHIM* and *OHIM v American Clothing Associates* [2009] ECR I-6933, paragraph 61; and Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraphs 33, 35 and 41. See also the Order in Case C-67/11 P *DTL v OHIM* [2011] ECR I-156, paragraphs 39 to 41; the Order in Case C-579/08 P *Messer Group v Air Products and Chemicals* [2010] ECR I-2, paragraph 71; and the Order in Case C-210/08 P *Sebirán v OHIM and El Coto De Rioja* [2009] ECR I-6, paragraph 35. As regards the General Court, see, inter alia, its judgment of 16 May 2007 in Case T-491/04 *Merant v OHIM – Focus Magazin verlag (FOCUS)*, not published in the ECR, paragraphs 43 and 44.

13 — Case T-6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 34; Order in *Matratzen Concord v OHIM*, paragraph 32; and *Medion*, paragraph 29. See, to that effect, Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraph 42, and *OHIM v Shaker*, paragraph 41.

14 — As I have already emphasised in point 16 above, in paragraph 34 of *Medion* the Court expressly refers not only to a situation where an earlier trade mark is combined with the company name of a third party in a later composite sign, but also to a situation where the second component added is a mark (with a reputation) owned by that third party.

15 — See the judgment of the General Court of 29 September 2011 in Case T-107/10 *Procter & Gamble Manufacturing Cologne v OHIM – Natura Cosméticos (NATURAVIVA)*, not published in the ECR, paragraph 43, and the judgment of the General Court of 13 September 2010 in Case T-366/07 *Procter & Gamble v OHIM – Prestige Cosmetics (P&G PRESTIGE BEAUTE)*, not published in the ECR, paragraph 82.

approach which has prevailed – initially in the case-law of the General Court<sup>16</sup> and subsequently in the case-law of the Court of Justice<sup>17</sup> – is that, by analogy, a ‘rule’ can be inferred from those paragraphs of *Medion* which can then be applied to all situations in which an earlier trade mark<sup>18</sup> appears as one of the elements of a later composite sign, even if it is not reproduced identically in that sign.<sup>19</sup>

19. In the same way, the concept of ‘an independent distinctive role’ has also been interpreted more broadly and applied in circumstances other than those of relevance to the main proceedings in *Medion*, for example where there is an earlier figurative mark.<sup>20</sup> Although no definition of that concept is to be found in the case-law, it has sometimes been linked to the ‘perceptibility’ or ‘recognisability’ of the earlier trade mark in the mark applied for, in which the former trade mark or an element<sup>21</sup> of that trade mark is reproduced.<sup>22</sup> In other cases, by contrast, it has been acknowledged as applying to an ‘eye-catching, independent central’ element,<sup>23</sup> to an element which has ‘its own distinctive character’<sup>24</sup> or is ‘sufficiently attractive’,<sup>25</sup> or an independent distinctive role has been inferred from the fact that the element is ‘not negligible’ in the overall impression created by the composite sign.<sup>26</sup> On the subject of the degree of distinctiveness needed to establish such a role, the case-law is particularly fickle. In some judgments, the possibility that reproduction of the earlier trade mark in a later composite sign can have an independent distinctive role within that sign is regarded as inconceivable if that earlier trade mark (or, more accurately, the component of the later sign which reproduces that mark) is descriptive<sup>27</sup> or has a weak distinctive character.<sup>28</sup> In other judgments, by

16 — See, to that effect, Case T-109/07 *L'Oréal v OHIM - Spa Monopole (SPA THERAPY)* [2009] ECR II-675, paragraph 19; Case T-247/11 *FairWild Foundation v OHIM - Wild (FAIRWILD)* [2013] ECR, paragraph 49; Case T-348/10 *Panzeri v OHIM - Royal Trophy (Royal Veste e premia lo sport)* [2012] ECR, paragraph 33; Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM - Master Beverage Industries (Golden Eagle)* [2010] ECR II-1177, paragraph 60; judgment of the General Court of 18 May 2011 in Case T-376/09 *Glenton España v OHIM - Polo/Lauren (POLO SANTA MARIA)*, not published in the ECR, paragraph 34; Case T-169/10 *Grupo Osborne v OHIM - Industria Licorera Quezalteca (TORO XL)* [2012] ECR, paragraph 27; Case T-231/12 *Rocket Dog Brands v OHIM - Julius K9 (JULIUS K9)* [2013] ECR, paragraph 30; Case T-212/07 *Harman International Industries v OHIM - Becker (Barbara Becker)* [2008] ECR II-3431, paragraphs 37 and 41; and Case T-460/07 *Nokia v OHIM - Medion (LIFE BLOG)* [2010] ECR II-89, paragraph 73.

17 — See the Order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* [2010] ECR I-7, paragraph 45, and the Order in Case C-353/09 P *Perfetti Van Melle SpA v OHIM* [2011] ECR I-12, paragraph 34. In that regard, although Advocate General Cruz Villalon interprets paragraph 30 et seq. of *Medion* as an exception to the principle that a consumer perceives a mark as a whole, he has come to the same conclusion in his Opinion in Case C-51/09 P *Becker v Harman International Industries* [2010] ECR I-5805, points 53, 55 and 56: see also, by implication, paragraphs 34 to 39 of the judgment in that case.

18 — Reproduced in every aspect; see *Rocket Dog Brands v OHIM - Julius K9 (JULIUS K9)*, paragraph 31, and *Focus Magazin Verlag v OHIM - Editorial Planeta (FOCUS Radio)*, paragraph 40. See, by way of (implied) contrast, the judgment of the General Court of 16 September 2009 in Joined Cases T-305/07 and T-306/07 *Offshore Legends v OHIM - Acteon (OFFSHORE LEGENDS in black and white and OFFSHORE LEGENDS in blue, black and green)*, not published in the ECR, paragraph 86.

19 — See *Panzeri v OHIM*, paragraph 33; *Nestlé v OHIM - Master Beverage Industries (Golden Eagle)*, paragraph 60; *Glenton España v OHIM - Polo/Lauren (POLO SANTA MARIA)*, paragraph 34; and *Grupo Osborne v OHIM - Industria Licorera Quezalteca (TORO XL)*, paragraph 27. See, by way of contrast, the judgment of the General Court of 14 July 2011 in Case T-160/09 *Winzer Pharma v OHIM - Alcon (OFTAL CUSI)*, not published in the ECR.

20 — See *Glenton España v OHIM - Polo/Lauren (POLO SANTA MARIA)*, paragraph 54. See also, to that effect, Case T-99/06 *Phildar v OHIM - Comercial Jacinto Parera (FILDOR)* [2009] ECR, paragraph 43, in which the General Court confirmed that the Board of Appeal was right to use that concept in order to determine the prominence of the figurative component in the overall impression given by the earlier trade mark.

21 — See the judgment of the General Court of 13 April 2011 in Case T-228/09 *United States Polo Association v OHIM - Textiles CMG (U.S. POLO ASSN.)*, not published in the ECR, paragraph 38, upheld in Case C-327/11 P *United States Polo Association v OHIM* [2012] ECR, in which the Court states, in paragraph 52, that the General Court had not applied *Medion* in *United States Polo Association v OHIM - Textiles CMG (U.S. POLO ASSN.)*.

22 — See, for example, *Harman International Industries v OHIM - Becker (Barbara Becker)*, paragraph 37, and *FairWild Foundation v OHIM - Wild (FAIRWILD)*, paragraph 50.

23 — See *Glenton España v OHIM - Polo/Lauren (POLO SANTA MARIA)*, paragraph 54.

24 — See the Order in *Perfetti Van Melle v OHIM*, paragraph 37.

25 — *Grupo Osborne v OHIM - Industria Licorera Quezalteca (TORO XL)*, paragraph 42.

26 — See, for example, *Nestlé v OHIM - Master Beverage Industries (Golden Eagle)*, paragraphs 60 to 63, and *Offshore Legends v OHIM - Acteon (OFFSHORE LEGENDS in black and white and OFFSHORE LEGENDS in blue, black and green)*, paragraphs 82 to 86.

27 — See, for example, the judgment of the General Court of 27 November 2007 in Case T-434/05 *Gateway v OHIM - Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraph 49, upheld in Case C-57/08 P *Gateway v OHIM and Fujitsu Siemens Computers* [2008] ECR I-188 (summary publication), and Case T-10/09 *Formula One Licensing v OHIM - Global Sports Media (F1 - LIVE)* [2011] ECR II-427, paragraph 51; its finding relating to the descriptive character of the component corresponding to the earlier trade mark was set aside by the Court of Justice (see Case C-196/11 P *Formula One Licensing v OHIM* [2012] ECR).

28 — See, for example, *Grupo Osborne v OHIM - Industria Licorera Quezalteca (TORO XL)*, paragraph 42.

contrast, the opposite conclusion has been reached.<sup>29</sup> However, the case-law has consistently stated that the element of the later sign which reproduces the earlier trade mark cannot have an independent distinctive role when that element combines with the other elements of that sign to form an independent logical unit, since in that situation its own conceptual independence is lost.<sup>30</sup>

20. As regards the implications of a finding that the earlier trade mark retains an independent distinctive role within the later sign, there are various judgments in which the inference is automatically drawn from such a finding that the two signs at issue are *visually similar*.<sup>31</sup> However, a more cautious approach is taken in the overall assessment of the existence of a likelihood of confusion. In that regard, it has been stated that a likelihood of confusion cannot be inferred from the mere fact that the earlier mark has a distinctive role – albeit not a dominant one – within the later mark;<sup>32</sup> rather, it must be established on the basis of all the relevant aspects of the particular case.<sup>33</sup>

21. Lastly, I detect some uncertainty in the case-law as regards the importance to be attached to the presence of the manufacturer's name in a trade mark. Although it has been stated in *Medion* and subsequent judgments that, given that it serves to identify the origin of the product, a component of that kind cannot be regarded as negligible<sup>34</sup> and, accordingly, it has been acknowledged as a potentially dominant element,<sup>35</sup> there are other judgments in which it has been stated that, precisely because of that function, a component of that kind is of secondary importance.<sup>36</sup>

### c) Scope of *Medion*

22. The synopsis of the case-law set out above shows that there is some difficulty in defining the actual scope of *Medion* and in fleshing out the concept of 'an independent distinctive role' as referred to in paragraph 30 of that judgment. Although the terminology used by the Court in that paragraph gives the impression that the Court intended to introduce an exception to the well-established principles of the case-law of the European Union relating to the assessment of the likelihood of confusion, such an interpretation does not seem to me to be satisfactory. In my view, there is no plausible justification for basing the assessment of the similarity of marks on different sets of criteria, in such a way as to entail, for an isolated category of composite marks, a derogation from the rules relating to the perception of marks by the public. In particular, the need – which the Court highlights in paragraphs 33 to 35 of

29 — See, for example, Case T-63/09 *Volkswagen v OHIM - Suzuki Motor (SWIFT GTi)* [2012] ECR, paragraph 111; *Offshore Legends v OHIM - Acteon (OFFSHORE LEGENDS in black and white and OFFSHORE LEGENDS in blue, black and green)*, paragraph 82; and, by implication, the Order in Case C-235/05 P *L'Oréal v OHIM* [2006] ECR I-57, paragraph 32).

30 — See, for example, *Procter & Gamble Manufacturing Cologne v OHIM - Natura Cosméticos (NATURAVIVA)*, paragraph 43; *Grupo Osborne v OHIM - Industria Licorera Quezalteca (TORO XL)*, paragraph 40; judgment of the General Court of 19 May 2010 in Case T-243/08 *Ravensburger v OHIM - Educa Borrás (EDUCA Memory game)*, not published in the ECR, paragraphs 33 to 42, upheld in the Order in Case C-370/10 P *Ravensburger v OHIM* [2011] ECR I-27; see also, by way of contrast, the judgment of the General Court of 1 July 2009 in Case T-16/08 *Perfetti Van Melle v OHIM - Cloetta Fazer (CENTER SHOCK)*, not published in the ECR, paragraphs 44 to 48, upheld in the Order in *Perfetti Van Melle v OHIM*, paragraph 37.

31 — *Panzeri v OHIM - Royal Trophy (Royal Veste e premia lo sport)*, paragraph 33; *Nestlé v OHIM - Master Beverage Industries (Golden Eagle)*, paragraph 60; and *Glenton España v OHIM - Polo/Lauren (POLO SANTA MARIA)*, paragraph 34.

32 — *Volkswagen v OHIM - Suzuki Motor (SWIFT GTi)*, paragraph 109; *Gateway v OHIM - Fujitsu Siemens Computers (ACTIVY Media Gateway)*, paragraph 49; judgment of the General Court of 9 September 2011 in Case T-197/10 *BVR v OHIM - Austria Leasing (Austria Leasing Gesellschaft m.b.H. Mitglied der Raiffeisen-Bankengruppe Österreich)*, not published in the ECR, paragraph 61; and judgment of the General Court of 9 September 2011 in Case T-199/10 *DRV v OHIM - Austria Leasing (Austria Leasing Gesellschaft m.b.H. Mitglied der Raiffeisen-Bankengruppe Österreich)*, not published in the ECR, paragraph 61.

33 — Case T-385/09 *Anmco v OHIM - Freche et fils (ANN TAYLOR LOFT)* [2011] ECR II-455, paragraphs 49 and 50, and *Volkswagen v OHIM - Suzuki Motor (SWIFT GTi)*, paragraph 113.

34 — Case T-42/09 A. *Loacker v OHIM - Editrice Quadratum (QUADRATUM)* [2012] ECR, paragraphs 34 and 35.

35 — See *Medion*, paragraph 34.

36 — See the judgment of the General Court of 30 November 2006 in Case T-43/05 *Camper v OHIM - JC (BROTHERS by CAMPER)*, not published in the ECR, paragraph 65 et seq..



*Medion* – to protect the earlier trade mark against possible appropriation by third parties cannot constitute such a justification; that need, however legitimate, has no bearing on the assessment of the likelihood of confusion and, as has already been observed by Advocate General Jacobs in his Opinion in *Medion*, must be met through laws other than those at issue in that case.<sup>37</sup>

23. To my mind, therefore, it is necessary to attempt a new interpretation of *Medion*. To that end, it is above all essential to bear in mind that *Medion* was a judgment delivered in the context of a reference for a preliminary ruling, in which any verification of fact is exclusively a matter for the referring court. In that context, the Court did not take a position on the possible existence of a likelihood of confusion in that particular case (a comparison of the marks THOMSON LIFE and LIFE), but simply answered the question referred, specifying, on the basis of the information provided by the national court, the criteria to be used as a basis for assessing the likelihood of confusion. Viewed in that context, the ruling in *Medion* merely states, in essence, that the possibility of a likelihood of confusion between an earlier trade mark, used by a third party as part of a composite sign, and that sign cannot automatically be ruled out in cases where the earlier trade mark, albeit not the dominant element of the composite sign, retains a role in that sign of such a kind that ‘the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark’.<sup>38</sup>

24. More generally – and looking beyond the facts of the case submitted to the Court – that ruling means that, whenever the element of a composite sign, identical or similar to an earlier trade mark, significantly contributes to – but does not dominate – the image of that sign which remains in the memory of the members of the relevant public, notwithstanding the fact that another element of the sign may be more prominent, the former element must be taken into consideration for the purposes of appraising the similarity between the composite sign and the earlier trade mark and is therefore relevant for the purposes of assessing the likelihood of confusion. In that way, it seems to me that, far from introducing a derogation from the principles governing such an assessment, the judgment in question was instead intended to mitigate the rigidity of certain earlier judgments, notably the judgments delivered in the *Matratzen Concord v OHIM* cases, which could have been construed as a strict application of Prägetheorie.<sup>39</sup> That reading of *Medion* is upheld in *OHIM v Shaker*,<sup>40</sup> in which the Court, with the objective – explicitly identified in Advocate General Kokott’s Opinion, to which the judgment makes reference – of resolving the apparent inconsistency between those judgments and *Medion*, stated that, while the overall impression created by a composite trade mark may, in certain circumstances, be dominated by one or more of its components, ‘it is only if all the other components of the mark are negligible that the assessment of the similarity [between the marks] can be carried out solely on the basis of the dominant element’.<sup>41</sup> That finding has been consistently repeated in subsequent case-law.<sup>42</sup>

37 — Such as national laws on unfair competition; see point 40 of Advocate General Jacobs’ Opinion.

38 — *Medion*, paragraph 36.

39 — In paragraph 33 of *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)*, as referred to by Advocate General Jacobs in his Opinion in *Medion*, the General Court found that ‘a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar 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’. However, immediately afterwards it stated that ‘that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark’, but rather that ‘such a comparison must be made by examining the marks in question, each considered as a whole’, while bearing in mind that ‘the overall impression created in the mind of the relevant public by a complex trade mark [may], in certain circumstances, be dominated by one or more of its components’ (paragraph 34).

40 — Cited in footnote 12.

41 — See paragraph 42. That principle was already implicit in the General Court’s definition of the concept of a ‘dominant element’ as provided in paragraph 34 of *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)*.

42 — See, for example, *Calvin Klein Trademark Trust v OHIM*, paragraphs 56 and 57; *Nestlé v OHIM*, paragraphs 41 to 43; and *DTL v OHIM*, paragraph 41.

25. At this point, two things have to be made clear. First, the finding that, when assessing the similarity between two marks, one of which comprises a number of elements, including a similar or identical reproduction of the single element which constitutes the other mark, account must be taken of that common element where it is not negligible in the overall impression conveyed by the composite mark, even if it does not dominate that impression, does not mean that it is permissible to derogate from the criteria relating to the perception of that mark by the relevant public, which have been recognised by case-law as true and proper legal parameters. The first of those parameters, which is laid down in settled case-law, on which *Medion* is based, is that the average consumer normally perceives a mark as a *whole* and does not proceed to analyse its various details.<sup>43</sup> It follows from that rule that the *analysis* of a mark's components and of their relative weight within that mark serves to identify, in *summary* fashion, the overall impression conveyed by the mark which is likely to remain in the mind of the consumer and to influence his subsequent purchase choices. That act of summarising is indispensable, even in the case of marks comprising a number of distinctive elements, each of which – considered separately – contributes to, but does not determine, the overall impression created by the mark. It is also necessary in the circumstances described in *Medion*, that is to say, in situations where a sign belonging to a third party combines an earlier trade mark with the company name of that third party.<sup>44</sup> More generally, the important factor is not so much the role within the later sign of the element which reproduces the earlier trade mark as the likelihood that that element will be independently perceived and remembered by the public in the context of that sign.

26. Secondly, regardless of the role of the earlier trade mark in the overall impression conveyed by the later sign, it is still necessary for the likelihood of confusion to be assessed, not in the abstract, but in the light of all of the relevant factors of the particular case, including, in particular, in addition to the visual, phonetic and conceptual similarities between the signs at issue, the nature of the goods and services in question; marketing methods; the attention level of the relevant public (whether high or low); and the habits of that public in the sector concerned.<sup>45</sup> It follows that it is not possible automatically to infer from the fact that the earlier trade mark retains an independent distinctive role within the later composite mark that there is a likelihood of confusion between the signs at issue.<sup>46</sup> In particular, the need to protect the earlier trade mark does not make it permissible to dispense with the assessment of whether such a likelihood exists, as is moreover clear, in my view, from paragraphs 31 and 36 of *Medion*.

27. I shall now, on the basis of the principles set out above, examine the complaints raised by Bimbo in the first part of its single ground of appeal.

#### d) Analysis of the complaints

28. First, Bimbo argues that the General Court did not examine all the facts of the case before concluding that the 'doughnuts' element had an independent distinctive role, as referred to in *Medion*, within the sign in respect of which registration is sought. In that regard, I note as a preliminary point that paragraphs 96 and 97 of the judgment under appeal (on which this complaint focuses) represent a response to Bimbo's argument that the 'bimbo' component is the dominant element of the mark applied for. In that context, the references made to *Medion* in those paragraphs must be regarded as references to the principle, established in that judgment, that the finding that there is a likelihood of confusion cannot be made subject to the condition that the overall impression created by the

43 — See *SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; and *Medion*, paragraph 28.

44 — See the Order in Case C-532/10 P *adp Gauselmann v OHIM* [2011] ECR I-94, paragraph 43, and the Order in Case C-204/10 P *Enercon v OHIM* [2010] ECR I-156, paragraphs 23 to 26.

45 — See *SABEL*, paragraph 22, and *Anco v OHIM – Freche et fils (ANN TAYLOR LOFT)*, paragraph 50.

46 — See, to that effect, *Anco v OHIM – Freche et fils (ANN TAYLOR LOFT)*, paragraph 49; *L'Oréal v OHIM – Spa Monopole (SPA THERAPY)*, paragraph 29; and *Volkswagen v OHIM – Suzuki Motor (SWIFT GTi)*, paragraph 113; see also *Becker v Harman International Industries*, paragraph 40.

composite sign be dominated by the part of it which is represented by the earlier trade mark.<sup>47</sup> In other words, the General Court wished to make it clear that, even if – as Bimbo maintains – the ‘bimbo’ component were the dominant element, that would not be sufficient to make it irrelevant for the purposes of assessing the likelihood of confusion with the ‘doughnuts’ component. The General Court came to a similar conclusion in paragraph 81 of the judgment under appeal, in which it stated that, since the ‘doughnuts’ element is not negligible in the overall impression created by the mark applied for, it must be taken into account in the comparison of the signs at issue.

29. That being so, I do not think that the General Court erred in law by linking, in paragraph 97 of the judgment under appeal, the independent distinctive role of the ‘doughnuts’ element within the mark applied for to the degree of distinctiveness of that component and the fact that it does not combine with the other component of that trade mark to form a conceptually distinct whole. First, that paragraph must be read in the light of the findings already made by the General Court concerning the degree to which the ‘doughnuts’ element will (i) attract the public’s attention and will therefore be independently perceived by that public and (ii) contribute to the overall impression created by the mark (see, in particular, paragraphs 79 to 81, 85, 86 and 92). Secondly, as will be seen more clearly from my examination of the second part of the single ground of appeal, the General Court did not automatically infer from the finding that the ‘doughnuts’ element had an independent distinctive role that there was a likelihood of confusion.

30. As regards the second complaint, alleging that the General Court unduly widened the scope of *Medion*, it stems from a different interpretation of that judgment to the one proposed in this Opinion and is therefore, in my view, based on a premiss that is legally incorrect.

31. On the basis of all of the foregoing, I propose that the Court reject the first part of the single ground of appeal as unfounded.

*B – Second part of the single ground of appeal: failure to take account, in the assessment of the likelihood of confusion, of all the relevant aspects*

#### 1. Arguments of the parties

32. First, Bimbo submits that the General Court based its conclusions regarding the existence of a likelihood of confusion purely on the finding – or rather, the assumption – that the ‘doughnuts’ element had an independent distinctive role and failed to take account of any other relevant factors, including, in particular: the fact that the ‘bimbo’ element is not only a company name but also a trade mark with a reputation in Spain in connection with the goods in respect of which registration has been sought; the fact that that element appears at the beginning of the mark applied for; the low level of distinctiveness of the earlier trade mark; and the fact that the earlier trade mark is not reproduced identically in the mark applied for. In particular, in Bimbo’s submission, the fact that the first element of the mark applied for is itself a trade mark with a reputation should have led the General Court to conclude that there was no likelihood of confusion between the signs at issue, as was found by the Court of Justice in *Becker v Harman International Industries*.

33. Secondly, Bimbo submits that the judgment under appeal is vitiated by failure to state adequate reasons in that the General Court did not explain why the relevant public would be minded to disregard the first element of the composite mark, which indicates the – widely known – commercial origin of the goods in question, and to believe that those goods originate from the owner of the earlier trade mark or from economically-linked undertakings.

<sup>47</sup> — See *Medion*, paragraph 32.

34. Thirdly, Bimbo emphasises that the context in which the Court delivered its judgment in *Medion* is different from the context of the present case in which – by contrast with the electronic goods sector – it is unusual for competing companies to enter into economic relations.

35. OHIM and Panrico contend that Bimbo's arguments are in part inadmissible and in part manifestly unfounded.

## 2. Analysis

36. Although I agree with Bimbo's premiss that *Medion* does not authorise either derogation from the criterion relating to the overall impression created by the composite mark or dispensing with a global assessment of the likelihood of confusion, it seems to me that the complaints which it puts forward in this part of its single ground of appeal are unfounded.

37. Indeed, from an overall reading – and not a selective reading, as proposed by Bimbo – of the judgment under appeal, it is clear that the General Court did not infer that there was a likelihood of confusion from the mere finding that the 'doughnuts' element has an independent distinctive role within the mark applied for; instead, the General Court based its finding on many factors emerging from an overall assessment undertaken in accordance with the case-law which it itself cited in paragraph 51 of that judgment.

38. Contrary to Bimbo's assertions, when comparing the marks at issue, the General Court took into account both the alleged reputation of the BIMBO trade mark and the fact that that trade mark is the first of the two elements which make up the mark applied for. As regards the former factor, while not ruling out the possibility that the fact that one element of a composite sign is a trade mark with a reputation may play a part in the appraisal of the relative weight of the various elements of that sign, the General Court none the less stated that that fact does not automatically mean that the comparison of the marks at issue must be limited to considering that element alone, if it becomes apparent that the other elements of the sign are not negligible in the overall impression created by that sign.<sup>48</sup> As regards the latter factor, the General Court held in paragraphs 80, 83 and 84 of the judgment under appeal that, although the 'doughnuts' element appears after the 'bimbo' element in the mark applied for, it is still capable of attracting the Spanish public's attention, as it is longer and the consonant sequence 'ghn' is unusual in Spanish, and must therefore be taken into account when assessing the visual similarity between the signs at issue. On that point, those factual findings cannot be reviewed by the Court of Justice on appeal.

39. Contrary to Bimbo's assertions, the General Court also took account of the fact that the earlier trade mark was not reproduced identically in the mark applied for, pointing out in paragraph 82 that the only difference between the earlier trade mark and the element reproducing it was the third letter in a relatively long word. The General Court observed that such a difference did not significantly alter either the length or the phonetic pronunciation of the word in question.

40. As regards the argument that the 'bimbo' element is not only a company name but also a trade mark with a reputation in Spain in connection with the goods in question, I note that Bimbo does not draw any specific legal conclusions from that fact. If Bimbo intends on that basis to distinguish the present case from the case before the referring court in *Medion*, I would point out that, in the scheme of the judgment delivered in that case, it is completely irrelevant whether the earlier trade mark is combined in a composite sign with the company name of a third party or with a trade mark owned by a third party: in paragraph 36 of that judgment, the Court placed the two situations on an even

<sup>48</sup> — Paragraphs 77 and 78.



footing and also it was clear from the statements made by the referring court that incorporating a company name into a trade mark was the usual practice in the sector of the goods at issue, with the result that the company name thus incorporated lost its usual role of a sign identifying a company and took on the role of a component identifying a product.<sup>49</sup>

41. In its overall assessment of the likelihood of confusion, the General Court took account of the degree of visual and phonetic similarity between the signs at issue (which was identified as being average); the identical nature of the goods (paragraph 91); the average distinctiveness of the earlier trade mark (paragraphs 92 and 95 to 97); the nature of the goods in question; and the rather low level of attention of the public when purchasing such goods (paragraph 99). Lastly, making reference to all of those factors (especially the average visual and phonetic similarities between the signs and the identical nature of the goods), the General Court found that there was a likelihood of confusion.

42. In those circumstances, I do not think the General Court can be accused of having automatically inferred from the fact that the ‘doughnuts’ element had an independent distinctive role within the mark applied for that there was a likelihood of confusion between the signs at issue; nor can it be thought to have failed to undertake an overall assessment of the likelihood of confusion.

43. The complaint that the judgment under appeal does not contain an adequate statement of reasons must also be rejected. The General Court’s reasons for rejecting Bimbo’s arguments relating to the decisive character of the alleged dominance of the word ‘bimbo’ in the mark applied for are set out in paragraphs 95 to 97 of the judgment under appeal and in paragraphs 76 to 81 of that judgment.

44. Lastly, there is no factual basis, to my way of thinking, for Bimbo’s argument that *Medion* cannot be applied to the present case in view of the differing commercial practices in the electronic entertainment goods sector and the pastry and confectionery sector. Indeed, contrary to Bimbo’s assertions, there is nothing in the judgment or the Opinion in that case to suggest that the frequency of economic relations between companies operating on the market in question formed any part of the factual context of the case as described by the referring court. Rather, as has already been highlighted in point 40 above, that court had observed that the usual practice with regard to designations in the relevant product sector was for the manufacturer’s name – which would otherwise have been of secondary importance in terms of the overall impression conveyed by a composite trade mark, given that the public usually identifies the actual product designation from another component of the sign – to predominate.<sup>50</sup> The existence of such commercial practices in the sector of the goods at issue – which, if proved, must certainly be taken into consideration as a relevant factor in the overall assessment of the likelihood of confusion – has not been established or even put forward as an argument by Bimbo.

45. On the basis of all of the foregoing, I propose that the Court also reject as unfounded the second part of the single ground of appeal.

## V – Conclusions

46. In the light of the considerations set out above, I propose that the Court dismiss the appeal and order Bimbo to pay the costs.

49 — See points 9 and 10 of Advocate General Jacobs’ Opinion.

50 — See points 8 to 10 of Advocate General Jacobs’ Opinion.