



## Reports of Cases

JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

8 July 2015\*

(Community trade mark — Invalidity proceedings — Community figurative mark Rock & Rock — Earlier national word marks MASTERROCK, FIXROCK, FLEXIROCK, COVERROCK and CEILROCK — Relative ground for refusal — Article 8(1)(b) and Article 53(1)(a) of Regulation (EC) No 207/2009)

In Case T-436/12,

**Deutsche Rockwool Mineralwoll GmbH & Co. OHG**, established in Gladbeck (Germany),  
represented by J. Krenznel, lawyer,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented  
by L. Rampini, acting as Agent,

defendant,

supported by

**Ceramicas del Foix, SA**, established in Barcelona (Spain), represented by M. Pérez Serres and  
R. Guerras Mazón, lawyers,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 10 July 2012 (Case  
R 495/2011-2) concerning invalidity proceedings between Deutsche Rockwool Mineralwoll GmbH &  
Co. OHG and Ceramicas del Foix, SA,

THE GENERAL COURT (Ninth Chamber),

composed of G. Berardis, President, O. Czúcz (Rapporteur) and A. Popescu, Judges,

Registrar: I. Drăgan, Administrator,

having regard to the application lodged at the Court Registry on 28 September 2012,

having regard to the response of OHIM lodged at the Court Registry on 9 January 2013,

having regard to the response of the intervener lodged at the Court Registry on 4 January 2013,

having regard to the reply lodged at the Court Registry on 15 April 2013,

\* Language of the case: English.

further to the hearing on 6 November 2014,

gives the following

## Judgment

### Background to the dispute

1 On 12 November 2003, the intervener, Ceramicas del Foix, SA, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The mark in respect of which registration was sought is the following figurative sign:



3 The goods in respect of which registration was sought are in, inter alia, Classes 2, 19 and 27 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 description:

- Class 2: ‘Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; dyestuffs; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists’;
- Class 19: ‘Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal. All the afore-mentioned goods with the exception of all kinds of mineral wool goods and damping materials for use in the building industry’;
- Class 27: ‘Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)’.

4 On 10 January 2008, the sign in question (‘the contested trade mark’) was registered as a Community trade mark for the goods referred to in paragraph 3 above.

5 On 14 April 2008, the applicant, Deutsche Rockwool Mineralwoll GmbH & Co. OHG, filed an application seeking a declaration of invalidity of the contested trade mark under Article 52(1)(a) of Regulation No 40/94 (now Article 53(1)(a) of Regulation No 207/2009), read in conjunction with Article 8(1)(b) of Regulation No 40/94 (now Article 8(1)(b) of Regulation No 207/2009).

6 The application for a declaration of invalidity was based, inter alia, on the following trade marks:

- the earlier word mark MASTERROCK, registered in Germany on 9 July 2002 under No 30 212 141 in respect of goods and services in Classes 17, 19 and 37;
- the earlier word mark FIXROCK, registered in Germany on 23 August 1999 under No 39 920 622 in respect of goods in Classes 6, 17 and 19;

- the earlier word mark FLEXIROCK, registered in Germany on 21 September 1994 under No 2 078 534 in respect of goods in Class 19;
  - the earlier word mark COVERROCK, registered in Germany on 17 September 1997 under No 39 732 094 in respect of goods in Classes 17 and 19;
  - the earlier word mark CEILROCK, registered in Germany on 18 June 2003 under No 30 306 452 in respect of goods in Classes 6, 17 and 19.
- 7 The goods in Classes 6, 17 and 19 covered by the earlier trade marks are building materials manufactured, for the most part, from mineral wool. In addition, the trade mark MASTERROCK also covers ‘civil engineering’ and ‘installation works’ services in Class 37.
- 8 The application for a declaration of invalidity was based on all the goods and services covered by the earlier trade marks, and was directed against all the goods covered by the contested trade mark.
- 9 By decision of 7 February 2011, the Cancellation Division rejected the application for a declaration of invalidity brought by the applicant. It held that there was an average degree of similarity between some of the goods covered by the signs at issue, while others were either dissimilar or remotely similar. In addition, in its view, there was a low degree of visual, aural and conceptual similarity between the signs at issue, with the exception of the earlier trade mark CEILROCK, which was dissimilar to the contested trade mark. In view of the relevant public’s high level of attention, the Cancellation Division concluded that there was no likelihood of confusion.
- 10 On 3 March 2011, the applicant filed a notice of appeal with OHIM against the Cancellation Division’s decision.
- 11 By decision of 10 July 2012 (‘the contested decision’), the Second Board of Appeal upheld the Cancellation Division’s decision. It found that the relevant public’s level of attention was particularly high. It also confirmed, in essence, the Cancellation Division’s findings regarding the similarity of the goods in question and the signs at issue, emphasising the descriptive nature of the shared element ‘rock’. In addition, it held that the broader protection granted to a family of trade marks was not applicable in the circumstances. Accordingly, the Board of Appeal found that there was no likelihood of confusion.

### **Procedure and forms of order sought**

- 12 The applicant claims that the Court should:
- annul the contested decision;
  - order OHIM to pay the costs.
- 13 OHIM and the intervener contend that the Court should:
- dismiss the action;
  - order the applicant to pay the costs.

## Law

- 14 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 8(1)(b) and of Article 53(1)(a) of Regulation No 207/2009.
- 15 Under those provisions, upon application by the proprietor of an earlier trade mark, a Community trade mark is to be declared invalid if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark. In addition, under Article 8(2)(a)(ii) of Regulation No 207/2009, ‘earlier trade marks’ means trade marks registered in a Member State with a date of application for registration earlier than the date of application for registration of the Community trade mark.
- 16 It is settled case-law 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. The likelihood of confusion must be assessed globally, according to the relevant public’s perception of the signs and the goods or services concerned and account being taken of 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 covered (judgments of 9 July 2003 in *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, ECR, EU:T:2003:199, paragraphs 30 to 33, and 7 November 2013 in *Three-N-Products v OHIM — Munindra (AYUR)*, T-63/13, EU:T:2013:583, paragraph 14).
- 17 In the present case, the applicant concurs with the Board of Appeal’s finding that some of the goods covered by the signs at issue are similar and the rest are either remotely similar or dissimilar. The General Court considers that analysis to be correct.

### The relevant public

- 18 According to case-law, regarding the relevant public’s degree of attentiveness, for the purposes of the global assessment of the likelihood of confusion, the average consumer of the goods or services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (see judgment of 13 February 2007 in *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, ECR, EU:T:2007:46, paragraph 42 and the case-law cited).
- 19 In the present case, the Board of Appeal found that the relevant territory was Germany, the country in which the earlier trade marks were registered and protected, and that the relevant public consisted of average German consumers and professionals in the construction sector. It held that the relevant public’s level of attention would be particularly high at the time of purchase due to the price, specialised nature and expected long durability of the goods in question.
- 20 The applicant does not challenge that reasoning.
- 21 It must be emphasised that the goods covered, the majority of which are building materials, are not intended for everyday use by average consumers. The specialised nature of those goods requires a precise, informed choice, regardless of the price and volume of goods sold. In addition, the fact that a type of product is not purchased regularly by the average consumer suggests that that consumer’s level of attention will be fairly high at the time of purchase. It should be added that, although some of the goods in question are available to the general public, it is unusual for the purchase of such goods to be carried out by ordinary consumers, who generally either entrust a professional with such a task or

seek advice from consumers whose knowledge of the subject is higher than average (see, to that effect, judgment of 13 October 2009 in *Deutsche Rockwool Mineralwoll v OHIM — Redrock Construction (REDROCK)*, T-146/08, EU:T:2009:398, paragraphs 45 and 46).

- 22 It should also be added that knowledge of the characteristics, quality and commercial origin of building materials is all the more important for the relevant public as those goods — once incorporated into a building — can often be replaced only at high cost. Moreover, poor quality building materials may cause damage to the building, which may then require expensive intervention. For these reasons, it is sensible to assume that even average consumers who do not entrust the task of selecting such goods to a professional will carry out internet searches regarding the goods concerned and that such consumers will, at all events, be interested in the background and identity of the manufacturer of those goods.
- 23 The same applies with regard to the construction services covered by the trade mark MASTERROCK, which involve a precise, informed choice and require a high level of circumspection on the part of the relevant public.
- 24 Accordingly, the Board of Appeal's finding that the relevant public's level of attention is particularly high must be upheld.

#### Comparison of the signs

- 25 The applicant accuses the Board of Appeal of erring in its assessment of the similarity of the signs at issue and the descriptive nature of the element 'rock' in the context of goods in the construction sector.
- 26 It should be borne in mind that the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the signs at issue, be based on the overall impression given by those signs, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. In that regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see judgment of 12 June 2007 in *OHIM v Shaker*, C-334/05 P, ECR, EU:C:2007:333, paragraph 35 and the case-law cited).
- 27 The 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. The comparison must rather 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 (see the judgment in *OHIM v Shaker* cited in paragraph 26 above, EU:C:2007:333, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity may be carried out solely on the basis of the dominant element (judgment in *OHIM v Shaker*, as cited in paragraph 26 above, EU:C:2007:333, paragraph 42, and judgment of 20 September 2007 in *Nestlé v OHIM*, C-193/06 P, EU:C:2007:539, paragraph 42). That could in particular be the case where that element is likely, by itself, to dominate the image that the relevant public has of the mark, with the result that all the other components of the mark are negligible within the overall impression created (judgment in *Nestlé v OHIM* as cited above, EU:C:2007:539, paragraph 43).



– Preliminary observations

- 28 According to case-law, in order to determine the distinctiveness of an element making up a mark, an assessment must be made of the greater or lesser capacity of that element to identify the goods or services for which the mark was registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken, in particular, of the inherent characteristics of the element in question in the light of whether it is at all descriptive of the goods or services for which the mark has been registered (judgments of 13 June 2006 in *Inex v OHIM — Wiseman (Representation of a cowhide)*, T-153/03, ECR, EU:T:2006:157, paragraph 35, and 27 February 2008 in *Citigroup v OHIM — Link Interchange Network (WORLDBLINK)*, T-325/04, EU:T:2008:51, paragraph 66).
- 29 In addition, identifying word elements which consumers can understand is useful for the assessment of the visual, aural and conceptual similarity between the signs at issue (see, to that effect, judgment of 25 June 2010 in *MIP Metro v OHIM — CBT Comunicación Multimedia (Metromeet)*, T-407/08, ECR, EU:T:2010:256, paragraphs 37 and 38).
- 30 In the first place, it should be borne in mind that the Board of Appeal upheld the Cancellation Division's analysis that the relevant public would identify the element 'rock' as an understandable word, along with the elements 'master', 'fix', 'flexi' and 'cover', which are part of basic English vocabulary.
- 31 That approach, endorsed by the applicant, must be upheld.
- 32 In the second place, the Board of Appeal held that the element 'rock', shared by the signs at issue, was descriptive of the goods covered by those signs, as the part of the German public interested in such goods is capable of understanding the word 'rock' as referring to, inter alia, a stone, which in turn is a reference to building materials.
- 33 The applicant disputes that reasoning and submits that the shared element 'rock' is dominant in the earlier trade marks.
- 34 First, it argues that the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) registered the German trade mark Rock under No 30 229 274, together with a large number of marks containing the element 'rock', such as MASTERROCK, FIXROCK, FLEXIROCK, COVERROCK and CEILROCK. This, for the applicant, is evidence that the German public does not understand the word 'rock' as indicating goods in the building industry, such as goods in Class 19. Similarly, OHIM published the application for trade mark No 6 885 594 concerning only the sign ROCK.
- 35 In that regard, it is sufficient to point out that the mere fact that a trade mark has been registered as a national or Community trade mark does not mean that it cannot be largely descriptive or, in other words, that it cannot have a weak inherent distinctiveness in relation to the goods and services it covers (see the judgment in *REDROCK* cited in paragraph 21 above, EU:T:2009:398, paragraph 51 and the case-law cited).
- 36 Secondly, the applicant submits that, for the relevant German-speaking public, the word 'rock' has a specific meaning, being the German word for 'skirt', or may refer to a style of music, but will not be understood to mean 'stone'.
- 37 It should be borne in mind that English is a global language which is also used in the building industry. Even if the average German consumer does not have a thorough knowledge of English, the word 'rock' is a basic English word, and professionals and consumers alike will associate that word with the word 'stone' (judgment in *REDROCK* as cited in paragraph 21 above, EU:T:2009:398, paragraph 53).

38 It should also be noted that at least some of the building materials covered by the contested trade mark and nearly all the goods covered by the earlier trade marks are manufactured from stone-based raw materials which, especially in their natural state, may easily be associated by the relevant public with the word 'rock', whether taken to mean 'rock' or 'cliff', with the result that that word is largely descriptive of those materials (judgment in *REDROCK* as cited in paragraph 21 above, EU:T:2009:398, paragraph 54).

39 That finding cannot be called in question by the applicant's assertion that the word 'rock' has other meanings in German, namely, that it refers to the name of a style of music and an item of women's clothing. In order to assess the distinctiveness or descriptiveness of a sign, account must be taken of the meaning of that sign which refers to the goods covered or designates one of their characteristics (judgment of 23 October 2003 in *OHIM v Wrigley*, C-191/01 P, ECR, EU:C:2003:579, paragraph 32, and judgment in *REDROCK* as cited in paragraph 21 above, EU:T:2009:398, paragraph 55).

40 Furthermore, in the present case, the word 'rock' also conveys a laudatory message concerning the characteristics of the goods and services covered which relate to building materials and building activity, in so far as it can be understood as alluding to the solidity and stability of rocks or rock formations. However, with regard to the goods and services covered, the inherent distinctiveness of a laudatory word relating to the characteristics of those goods or services is not high (see, to that effect, judgment of 16 January 2008 in *Inter-Ikea v OHIM — Waibel (idea)*, T-112/06, EU:T:2008:10, paragraph 51, and judgment in *REDROCK* as cited in paragraph 21 above, EU:T:2009:398, paragraph 56).

41 It follows that the shared element 'rock' is largely descriptive and/or laudatory of the goods and services covered by the signs at issue, with the result that it has only a weak inherent distinctiveness, as was rightly held by the Board of Appeal.

42 In the third place, the Board of Appeal also found that the other elements present in the earlier trade marks MASTERROCK, FIXROCK, FLEXIROCK and COVERROCK were weakly distinctive. In its view, the initial elements of those signs are mentally associated by the relevant German-speaking public with the possible characteristics of mineral wool, namely flexibility ('flexi'), ability to be quickly affixed to walls ('fix'), superior quality ('master'), or being used to cover things ('cover'). The words which correspond to those word elements are basic English words and, moreover, are similar to the German words 'fix', 'flexibel', and 'Meister'. Similarly, 'cover' is an Anglicism which has entered the German language.

43 The applicant concurs with those findings.

44 The General Court finds that the elements 'flexi', 'fix', 'master' and 'cover' will be associated by the relevant public with the physical characteristics of building materials and, more specifically, with those of mineral wool, or, in the case of the element 'cover', with their intended use. Being largely descriptive and/or laudatory, those elements are only weakly distinctive, with the result that the Board of Appeal's analysis must be upheld.

– The visual aspect of the comparison

45 In the present case, the Board of Appeal held that, despite the presence of the suffix '-rock' in each of the signs in question, the similarity between those signs was reduced twofold owing, on the one hand, to their different prefixes and, on the other, to the graphical element of the contested trade mark and its being divided by an ampersand. In terms of the overall visual impression conveyed, there was, therefore, a low degree of similarity between the signs.

46 The applicant challenges that assertion.

- 47 In the first place, it submits that the elements ‘master’, ‘fix’, ‘flexi’ and ‘cover’ are descriptive of the goods and services in question and that the graphical elements in the contested trade mark are negligible. The element ‘rock’ is therefore dominant both in the earlier trade marks MASTERROCK, FIXROCK, FLEXIROCK and COVERROCK and in the contested trade mark Rock & Rock. The dominant elements of the signs at issue being identical, the signs at issue are visually highly similar.
- 48 For the purposes of the assessment of the dominant character of one or more given components of a composite trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and as a minor point, account may be taken of the relative position of the various components within the arrangement of the mark (judgment of 23 October 2002 in *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)*, T-6/01, ECR, EU:T:2002:261, paragraph 35).
- 49 It should be borne in mind that both the word element ‘rock’ and the word elements ‘master’, ‘fix’, ‘flexi’ and ‘cover’ are largely descriptive and/or laudatory of the goods and services concerned (see paragraphs 41 and 44 above).
- 50 In addition, according to case-law, consumers normally attach more importance to the beginnings of words (judgment of 17 March 2004 in *El Corte Inglés v OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)*, T-183/02 and T-184/02, ECR, EU:T:2004:79, paragraph 81).
- 51 In the present case, the beginnings of the earlier trade marks MASTERROCK, FIXROCK, FLEXIROCK and COVERROCK are the word elements ‘master’, ‘fix’, ‘flexi’ and ‘cover’.
- 52 Accordingly, the applicant’s argument that the word element ‘rock’ is dominant in those earlier trade marks must be rejected.
- 53 As regards the earlier trade mark CEILROCK, the element ‘ceil’, unlike the element ‘rock’, has no meaning which refers to the goods concerned. Furthermore, the element ‘ceil’ appears at the beginning of that mark. Consequently, the relevant public, when perceiving the signs visually, will pay far greater attention to that element than to the shared element ‘rock’.
- 54 It follows that the applicant’s arguments relating to the dominant character of the element ‘rock’ in the earlier trade marks must be rejected.
- 55 In the second place, it should be pointed out that, given the lack of any dominant elements, the Board of Appeal carried out its comparison of the marks in question by examining each of those marks as a whole.
- 56 That approach must be upheld, in the light of the case-law cited in paragraph 27 above.
- 57 It must be held that the signs at issue are identical as regards their second word element ‘rock’, but differ as regards their initial word elements, for the contested trade mark too begins with the element ‘rock’, whereas the initial elements of the earlier trade marks are ‘master’, ‘fix’, ‘flexi’, ‘cover’ and ‘ceil’.
- 58 Moreover, although the graphical presentation of the trade mark Rock & Rock is not particularly fanciful, it none the less distinguishes the visual impression given by that mark from the visual impression given by the earlier trade marks, as was rightly held by the Board of Appeal. The same applies with regard to the ampersand that separates the two elements of the contested trade mark.
- 59 Furthermore, while it is true that the initial element of the contested trade mark is ‘rock’, which also appears at the end of the earlier trade marks, it must be emphasised that the duplication of the element ‘rock’ in that mark constitutes an unusual presentation which further distinguishes the visual



impression given by that mark from the visual impression given by the earlier trade marks. That duplication thus counteracts the fact that the prefix of the contested trade mark corresponds to the suffix of the earlier trade marks.

60 In the light of those findings, the contested decision must be upheld and it must be concluded that the visual similarity between the signs at issue is low.

– The phonetic aspect of the comparison

61 Regarding the phonetic aspect of the comparison, the Board of Appeal held that the assonance between the suffixes of the signs was diminished by their different prefixes. It also held that the prefixes of the signs in question contained different vowels, with the sole exception of the letter ‘o’ in the element ‘cover’. It therefore concluded that there was a low degree of phonetic similarity.

62 The applicant disputes that reasoning and claims that there is a high degree of phonetic similarity between the signs in question.

63 It takes the earlier trade mark COVERROCK as an example. In its view, the vowel sequences and number of sounds in COVERROCK and Rock & Rock are identical. The pronunciation of the element ‘koverrok’ will thus be highly similar to the pronunciation of the element ‘roketrok’ and it will be very difficult for the relevant public to distinguish between those marks, especially in a noisy industrial or construction environment or when the marks are pronounced over the phone.

64 It should be noted that the signs COVERROCK and Rock & Rock comprise three syllables and that the vowel sequence ‘o’ ‘e’ ‘o’ is the same in both signs if German pronunciation rules are taken into account.

65 However, the first part (‘cover’) of the earlier trade mark in question contains a consonant sequence (‘k’ ‘v’ ‘r’) which is completely different from the consonant sequence of the contested trade mark (‘r’ ‘kk’ ‘n’ ‘d’). It should be added that, according to the case-law cited in paragraph 50 above, consumers normally attach more importance to the beginnings of signs.

66 Accordingly, the signs COVERROCK and Rock & Rock are, phonetically, only slightly similar.

67 It should be added that the other earlier trade marks MASTERROCK, FIXROCK, FLEXIROCK and CEILROCK bear even less resemblance to Rock & Rock, given that their sound sequences are still further removed from the sound sequence of the contested trade mark.

68 Moreover, the applicant cannot validly invoke the environment in which the signs are used. The selection of building materials is a stage distinct from that of carrying out physical construction work, and there is nothing to suggest that the act of selecting the goods and services in question will take place on a building site or purely on the basis of information received orally. Similarly, communication via telephone will in no way prevent the relevant public from noting the marked differences in the way the signs at issue are pronounced.

69 In the light of those findings, the Board of Appeal’s conclusion that the degree of phonetic similarity between the signs at issue is low must be upheld.

– The conceptual aspect of the comparison

70 In the contested decision, the Board of Appeal called attention to the descriptive character of the components of the signs at issue, with the exception of the element ‘ceil’. It found that the shared element ‘rock’ was a reference, in the case of the earlier trade marks, to mineral wool, which is the

main raw material of the goods covered by those earlier trade marks. The elements ‘master’, ‘flexi’, ‘fix’ and ‘cover’ alluded to the characteristics or uses of mineral wool. By contrast, in the case of the contested trade mark, the element ‘rock’ alluded more to a style of music, since the relevant public would associate Rock & Rock with the expression ‘rock and roll’, and would perceive the contested trade mark as a play on words. The level of conceptual similarity was therefore low.

- 71 The applicant disputes that reasoning. It claims that the element ‘rock’ is dominant in the signs at issue and refers to the same concept, namely the meaning ‘stone’ or ‘rock’. There is therefore an average degree of conceptual similarity between those signs.
- 72 It should be borne in mind that the arguments put forward by the applicant to establish the dominant character of the element ‘rock’ have already been rejected in the light of the weak distinctiveness of that word in view of the goods and services concerned (see paragraphs 37 to 41 above).
- 73 In addition, it must be found that the prefixes ‘master’, ‘fix’, ‘flexi’ and ‘cover’, when combined with the suffix ‘rock’, will be associated by the relevant public with the physical characteristics of a ‘stone’ or a ‘rock’, or with the characteristics or intended use of mineral wool, whereas the trade mark Rock & Rock will be perceived more as a play on words based on the expression ‘rock & roll’, which is a style of music.
- 74 As regards the earlier trade mark CEILROCK, only the element ‘rock’ will be understood by the relevant public, and will have its original meaning of ‘stone’ or ‘rock’. That meaning is far removed from the conceptual value of ‘rock & rock’ described in paragraph 73 above.
- 75 The Board of Appeal was therefore right to find that the degree of conceptual similarity between the signs at issue was low.
- 76 In short, it must be concluded that the Board of Appeal correctly held that there was only a low degree of visual, phonetic and conceptual similarity between the signs at issue.

The argument based on the concept of a ‘series’ or ‘family’ of trade marks

- 77 In the contested decision, the Board of Appeal concluded that the applicant could not rely on the broader protection granted to a family of trade marks.
- 78 The applicant claims to be the proprietor of a series of German and Community trade marks containing the serial element ‘rock’ by which its marks can be recognised. Therefore, it maintains that the relevant public will associate the word ‘rock’ with its earlier trade marks, which will create a likelihood of confusion by association between the signs in question, especially since the applicant is an undertaking belonging to the world’s leading producer of mineral wool goods. It submits that the second element ‘rock’ of the contested trade mark does not appear in a different position from the position in which the element ‘rock’ appears in the family of earlier trade marks, which increases the likelihood of confusion.
- 79 It should be borne in mind that the likelihood of association is a specific case of the likelihood of confusion, which is characterised by the fact that the marks in question, whilst not likely to be directly confused by the target public, may be perceived as being two marks belonging to the same proprietor (see judgment of 9 April 2003 in *Durferrit v OHIM — Kolene (NU-TRIDE)*, T-224/01, ECR, EU:T:2003:107, paragraph 60 and the case-law cited). In order for that criterion to be taken into account, it is necessary that the application for a declaration of invalidity be based on the existence of several marks with shared characteristics enabling them to be regarded as part of the same ‘series’ or ‘family’ of trade marks (judgment of 18 December 2008 in *Les Éditions Albert René v OHIM*, C-16/06 P, ECR, EU:C:2008:739, paragraph 101). However, the fact that a trade mark is part of a

series or family of trade marks is not relevant unless the shared element is distinctive. If that element is merely descriptive, it is not capable of creating a likelihood of confusion (see, to that effect, judgment of 6 July 2004 in *Grupo El Prado Cervera v OHIM — Héritiers Debuschewitz (CHUFAFIT)*, T-117/02, ECR, EU:T:2004:208, paragraph 59).

- 80 In the first place, it should be borne in mind that the General Court has previously held that the broader protection granted to a family of trade marks could not successfully be relied on when the shared element of the earlier trade marks was largely descriptive of the goods and services covered. A word which refers to the nature of those goods and services is not capable of constituting the shared distinctive core of a family of trade marks (see, to that effect, judgment of 13 July 2012 in *Caixa Geral de Depósitos v OHIM — Caixa d'Estalvis i Pensions de Barcelona (la Caixa)*, T-255/09, EU:T:2012:383, paragraph 82).
- 81 It should be borne in mind that the element 'rock' is largely descriptive and/or laudatory of the goods and services covered by the earlier trade marks. Consequently, in accordance with the case-law cited in paragraphs 79 and 80 above, it is not capable of being the shared element of a family of trade marks.
- 82 In the second place, that finding is supported by the order of 30 January 2014 in *Industrias ALEN v The Clorox Company* (C-422/12 P, ECR, EU:C:2014:57, paragraph 45), in which the Court of Justice held that the finding that there was a likelihood of confusion between the trade marks CLOROX and CLORALEX did not amount to conferring a monopoly over the element 'clor' — which was largely descriptive of the goods in question — upon the proprietor of the earlier trade mark, given that a finding of a likelihood of confusion led solely to the protection of a certain combination of elements without, however, a descriptive element forming part of that combination being protected as such.
- 83 However, recognition of the family of trade marks containing the serial element 'rock' would lead precisely to the monopolisation of the element 'rock', which is largely descriptive and/or laudatory of the goods and services covered by the earlier trade marks. The enhanced protection resulting from the recognition of a family of trade marks would mean that, in practice, no other operator would be able to register a trade mark containing the element 'rock' and could even, depending on the circumstances, be banned from using that element in its slogans and advertising materials. Such a restriction of free competition, which would be the result of a basic English word being reserved for a single economic operator, cannot be justified by the desire to reward the creative or advertising efforts expended by the proprietor of the earlier trade marks. When there is no enhanced distinctiveness through use, the commercial value represented by that reservation is the result, not of such efforts on the part of the proprietor, but only of the meaning of the word, predetermined by the language in question, which refers to the characteristics of the goods and services concerned.
- 84 In the third place, the applicant cannot validly rely on the judgment of 27 April 2010 in *UniCredito Italiano v OHIM — Union Investment Privatfonds (UNIWEB)* (T-303/06 and T-337/06, EU:T:2010:160). In that judgment, the General Court emphasised the importance of the distinctiveness of the serial element 'uni' in relation to the services covered and held that that distinctiveness was of such a level that the element was capable in itself of giving rise to a direct association by the relevant public with the series concerned (judgment in *UNIWEB* as cited above, EU:T:2010:160, paragraphs 35, 38 and 39). However, no such level of distinctiveness exists in the present case.
- 85 The element 'uni' has, admittedly, a meaning for the average German consumer, but cannot be directly linked to the financial services, investment funds in particular, covered by the earlier trade marks at issue in the proceedings giving rise to the judgment in *UNIWEB* cited in paragraph 84 above (EU:T:2010:160). By contrast, the element 'rock' relied on in the present case refers to the characteristics of the building materials and services covered by the earlier trade marks. Accordingly, since the factual context differs on that crucial point, the solution adopted in that judgment cannot be applied by analogy to the present case.

- 86 It follows that, in the present case, since the element ‘rock’ is largely descriptive and/or laudatory of the goods and services covered by the earlier trade marks, it is not capable of constituting the shared core of a family of trade marks.
- 87 For the sake of completeness, it should be borne in mind that, according to case-law, even where a family of trade marks is involved, the broader protection designed to avoid a likelihood of association is not to be granted unless a subsequent trade mark displays characteristics capable of associating it with the series. That could not be the case when, for example, the shared element of the earlier serial marks is used in the trade mark applied for with a different semantic content (see, to that effect, judgment of 23 February 2006 in *Il Ponte Finanziaria v OHIM — Marine Enterprise Projects (BAINBRIDGE)*, T-194/03, ECR, EU:T:2006:65, paragraphs 126 and 127, and judgment in *UNIWEB* as cited in paragraph 84 above, EU:T:2010:160, paragraph 34).
- 88 In the present case, the semantic content of the element ‘rock’ in the contested trade mark Rock & Rock is different from that in the earlier trade marks, since, so far as the contested trade mark is concerned, it refers to a style of music in the context of a play on words, whereas in the earlier trade marks it alludes to a ‘stone’, a ‘rock’, or to mineral wool, with the elements ‘fix’, ‘flexi’ and ‘cover’ giving details of the physical characteristics or the intended use thereof (see paragraphs 44 and 73 above).
- 89 Accordingly, the arguments put forward by the applicant based on the broader protection granted to a series or family of trade marks must be rejected.

#### Distinctiveness of the earlier trade marks

- 90 In the contested decision, the Board of Appeal upheld the Cancellation Division’s findings that the distinctiveness of the earlier trade marks FLEXIROCK, FIXROCK, MASTERROCK and COVERROCK was weak owing to the largely descriptive nature of their elements, while the trade mark CEILROCK was fanciful.
- 91 The applicant does not put forward any particular arguments in that regard.
- 92 It is to be borne in mind that, in all the earlier trade marks, the element ‘rock’ alludes to a ‘stone’, a ‘rock’, or to mineral wool, with the elements ‘fix’, ‘flexi’ and ‘cover’ giving details of the physical characteristics or the intended use thereof (see paragraphs 44 and 73 above). In addition, the element ‘master’ has a laudatory meaning which will be connected by the relevant public to the meaning of the word ‘rock’ as mentioned in this paragraph. Accordingly, the Board of Appeal’s finding that the earlier trade marks FLEXIROCK, FIXROCK, MASTERROCK and COVERROCK are only weakly distinctive must be upheld.
- 93 Furthermore, since the relevant public will not attribute any particular meaning to the element ‘ceil’, the word combination CEILROCK is fanciful, with the result that it is averagely distinctive.

#### Likelihood of confusion

- 94 In the contested decision, the Board of Appeal held that, in view of the weak distinctiveness of the earlier trade marks (with the exception of the trade mark CEILROCK, which was fanciful), the low degree of similarity between the signs at issue and the relevant public’s particularly high level of attention, there was no likelihood of confusion between the signs at issue.
- 95 The applicant challenges that assessment, arguing that there is a likelihood of confusion.

- 96 It can be seen from the foregoing analysis that some of the goods covered by the signs at issue are similar, and the rest are either slightly similar or dissimilar. In addition, the relevant public's level of attention is particularly high and there is only a low degree of similarity between the signs at issue, which, moreover, stems from an element which is largely descriptive and/or laudatory of the goods in question and laudatory of the services covered. Lastly, it should be borne in mind that the distinctiveness of the earlier trade marks, with the exception of the trade mark CEILROCK, which is averagely distinctive, is weak.
- 97 In the context of a global assessment of the signs at issue, in view of the fact that the relevant public's level of attention is particularly high at the time of purchasing the goods covered, the visual, aural and conceptual differences separating the signs at issue are sufficient to prevent the similarities stemming from the presence of the shared element 'rock' from giving rise to a likelihood of confusion on the part of the average German consumer or of professionals from the construction sector, despite the similarities between some of the goods covered (see, to that effect, the judgment in *REDROCK* cited in paragraph 21 above, EU:T:2009:398, paragraph 86).
- 98 The applicant's single plea in law must therefore be rejected, and the action must accordingly be dismissed in its entirety.

### **Costs**

- 99 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. As the applicant has been unsuccessful, it must be ordered to pay the costs incurred by OHIM and the intervener, in accordance with the form of order sought by those parties.

On those grounds,

THE GENERAL COURT (Ninth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Deutsche Rockwool Mineralwoll GmbH & Co. OHG to pay the costs.**

Berardis

Czúcz

Popescu

Delivered in open court in Luxembourg on 8 July 2015.

[Signatures]