



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Seventh Chamber)

27 June 2019*

(EU trade mark — Opposition proceedings — Application for EU word mark Luciano Sandrone — Earlier EU word mark DON LUCIANO — Genuine use of the earlier mark — Article 47(2) and (3) of Regulation (EU) 2017/1001 — Relative ground for refusal — Article 8(1)(b) of Regulation 2017/1001 — Application for an EU word mark consisting of a first name and of a surname — Earlier mark consisting of an honorific title and a first name — Neutrality of the conceptual comparison — No likelihood of confusion)

In Case T-268/18,

Luciano Sandrone, residing in Barolo (Italy), represented by A. Borra, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by K. Kompari and H. O'Neill, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

J. García Carrión, SA, established in Jumilla (Spain),

ACTION brought against the decision of the Second Board of Appeal of EUIPO of 26 February 2018 (Case R 1207/2017-2), relating to opposition proceedings between J. García Carrión and Luciano Sandrone,

THE GENERAL COURT (Seventh Chamber),

composed of V. Tomljenović, President, E. Bieliūnas and A. Kornezov (Rapporteur), Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the application lodged at the Court Registry on 27 April 2018,

having regard to the response lodged on 1 August 2018,

further to the hearing on 28 February 2019,

gives the following

* Language of the case: English.

Judgment¹

...

Forms of order sought

13 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs.

14 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

Law

15 In support of the action, the applicant relies, in essence, on two pleas in law, alleging, first, that the Board of Appeal infringed Article 47(2) and (3) of Regulation 2017/1001 and, second, that it breached Article 8(1)(b) of that regulation.

...

The alleged infringement of Article 8(1)(b) of Regulation 2017/1001

...

The comparison of the signs

...

62 In the present case, both the earlier mark and the sign covered by the trade mark application are word marks. The Board of Appeal did not take the view, before carrying out the visual, phonetic and conceptual comparison of the signs at issue, that those signs had a dominant element. It was only in the course of that comparison that it stated, first, as regards the earlier mark, that the word ‘Luciano’ was more distinctive than the word ‘Don’ (paragraph 51 of the contested decision). Second, as regards the sign which is the subject of the trade mark application, the Board of Appeal stated that the distinctiveness of the element ‘Luciano’ is less than that of the element ‘Sandrone’, which has a higher intrinsic value for the Spanish, French, Italian and Portuguese public since it is a rare surname. However, it considered that that finding does not apply throughout the territory of the European Union, in particular in Germany and Finland, where the element ‘Luciano’ is as distinctive as the element ‘Sandrone’ (paragraphs 48 and 50 of the contested decision).

63 The applicant challenges the last of those findings.

¹ Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

64 It must therefore be ascertained whether the Board of Appeal's assessment of the distinctive and dominant elements of the signs at issue is vitiated by errors of assessment.

– *The distinctive and dominant elements of the signs at issue*

65 The sign which is the subject of the trade mark application consists of two words, one of seven letters, 'Luciano', the other of eight letters, 'Sandrone'. The earlier mark is also composed of two words, the first of three letters, 'Don', the second of seven letters, 'Luciano'.

66 As regards the earlier mark, it should be noted that the element 'Luciano' prevails over the element 'Don', if only by reason of the brevity of the latter element, but also, as the Board of Appeal stated in paragraph 51 of the contested decision, because it will be understood as a Spanish honorific title indicating 'Sir/Mister' or as an Italian title for priests which will, moreover, be understood as such by a significant part of the public of the European Union, including the German and Finnish public, in support of which the Board of Appeal referred to the German dictionary *Duden*. The Board of Appeal was therefore entitled to conclude that, for the relevant public, the element 'Luciano' was more distinctive than the element 'Don', which the applicant does not, moreover, dispute. That finding does not, however, call into question the determination of the distinctiveness of the element 'Luciano' as such (see paragraph 102 below).

67 Nevertheless, although the element 'Luciano' is more distinctive than the word 'Don', it does not render the latter element negligible.

68 As regards the sign which is the subject of the trade mark application, as the Board of Appeal correctly stated in paragraph 46 of the contested decision, the words forming that sign will probably be perceived as a combination of a first name and a surname by the relevant public throughout the European Union. It then stated that the name Sandrone would not be perceived as a common surname, even in Italy, and that the first name Luciano would, by contrast, be perceived as a very common first name in Spain, Italy and Portugal, as well as in France where the equivalent name 'Lucien' is similar (paragraph 47 of the contested decision). It therefore held, for the public in those territories, that the degree of distinctiveness of 'Luciano' is lower than that of 'Sandrone', which, as a rare surname, has a 'higher intrinsic value' (paragraph 48 of the contested decision).

69 The parties do not dispute that assessment by the Board of Appeal.

70 By contrast, according to the Board of Appeal, in Germany or Finland, the element 'Luciano' would be perceived as a rare first name. It also overturned the Opposition Division's finding that the Italian first name Luciano was familiar to the public of the European Union as a whole as a result of the celebrity of the Italian tenor Luciano Pavarotti. According to the Board of Appeal, 'to [its] knowledge', it is the surname Pavarotti which is famous rather than the full name Luciano Pavarotti and a significant part of the public in the European Union would not remember his first name (paragraph 48 of the contested decision). On that basis, the Board of Appeal concluded that both the first name Luciano and the surname Sandrone were rare for the German and Finnish public and that, for that public, the first element was therefore as distinctive as the second (paragraph 50 of the contested decision).

71 The Court observes, in that regard, that, according to the case-law, it is possible that, in a part of the European Union, a surname has as a general rule a greater degree of distinctiveness than a first name. It is necessary, however, to take account of factors specific to the case and, in particular, the fact that the surname in question is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character (judgments of 5 October 2011, *Cooperativa Vitivinícola Arousana v OHIM — Sotelo Ares (ROSALIA DE CASTRO)*, T-421/10, not published, EU:T:2011:565, paragraph 50, and of 11 July 2018, *Enoitalia v EUIPO — La Rural Viñedos y Bodegas (ANTONIO RUBINI)*, T-707/16, not published, EU:T:2018:424, paragraph 38), as well as of the possible reputation of the person

requesting that his first name and surname be taken together to be registered as a mark (judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, EU:C:2010:368, paragraphs 36 and 37).

- 72 In the present case, it must be noted, as the applicant claims, that the Board of Appeal's statement that the first name Luciano would be perceived as a rare first name in Germany or in Finland is not based on any specific evidence.
- 73 In that regard, it should be noted that the mere fact that a first name is not very common within the population of one Member State or another does not necessarily mean that that first name will be perceived by the relevant public as rare in that Member State. Indeed, a first name which is relatively well known within the European Union or internationally will not be perceived by the relevant public as rare, even in Member States where that first name is not very common.
- 74 In the present case, since the Board of Appeal was entitled to find, in paragraph 47 of the contested decision, that the first name Luciano will be perceived as a very common first name in Spain, Italy, Portugal and France, that is to say, in a substantial part of the European Union, it cannot reasonably be maintained, in view of the numerous exchanges within the European Union and of current means of electronic communication, that that first name will be perceived as rare by the relevant public of Germany and Finland. In other words, while it is well known that the first name Luciano is not very common among the population of Germany and Finland, that fact alone does not mean that that first name will be perceived as a rare first name in those Member States, as the Board of Appeal stated in paragraph 48 of the contested decision.
- 75 Accordingly, it must be concluded that, for the general public of the European Union as a whole, the most distinctive element of the sign which is the subject of the trade mark application is the element 'Sandrone', a surname which is not perceived as common, but which does not render the element 'Luciano' negligible.
- 76 After having examined the intrinsic qualities of each of the components of the signs at issue, having compared them with those of the other components, it must therefore be held that the Board of Appeal should have, before carrying out the visual, phonetic and conceptual comparison of the signs at issue, found the presence of a more distinctive element in each of the signs at issue, namely the element 'Luciano' in the earlier mark, which it was correct in finding, and the element 'Sandrone' in the sign covered by the trade mark application which it did not find with regard to a part of the relevant public. The consequences of that error will be determined below.

...

– *Conceptual comparison*

- 81 In paragraphs 52 and 53 of the contested decision, the Board of Appeal states that the relevant public will associate the sign in respect of which registration is sought with a first name and a surname, that is to say, with a specific person (imaginary or real) who has the first name Luciano and is a member of the Sandrone family, and it will also consider the earlier mark as referring to a person with the first name Luciano. The Board of Appeal therefore concluded 'thus consumers in particular in Germany and Finland might interpret the marks at issue as referring to the same person (whether virtual or real) characterised by the rare name "Luciano"'. According to the Board of Appeal, the signs at issue are therefore conceptually similar to an average degree (paragraph 53 of the contested decision).
- 82 Both the applicant and EUIPO harbour doubts in that regard. The applicant submits that the signs at issue are conceptually different, while EUIPO contends that the comparison between them is neutral in that respect. Furthermore, according to EUIPO, the case-law is unsettled on this point since, in certain

judgments, the EU Courts have held that it was possible to make a conceptual comparison between signs containing a surname or first name, while in other judgments it was held that a conceptual comparison of that type of sign was not possible.

- 83 The Court considers it therefore necessary to clarify the case-law on this point. In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the *Larousse* dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it’.
- 84 Similarly, according to the case-law, conceptual similarity means that the signs at issue convey analogous semantic content (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).
- 85 Therefore, a first name or a surname which does not convey a ‘general and abstract idea’ and which is devoid of semantic content, is lacking any ‘concept’, so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.
- 86 Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.
- 87 The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM — McKenzie (McKENZIE)*, T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM — Cortefiel (PEDRO)*, T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 65).
- 88 In the present case, the Board of Appeal did not identify any concept with which the first name and surname in question could be associated. Nor have the parties put forward any such arguments.
- 89 Therefore, the mere fact that the relevant public will associate the sign the registration of which is sought with a first name and a surname and thus with a specific, imaginary or real person, and that the earlier mark will be perceived as designating a person called Luciano is irrelevant for the purposes of a conceptual comparison of the signs at issue.
- 90 Consequently, the Board of Appeal’s assessment that the signs at issue are conceptually similar to an average degree must be overturned. As observed by EUIPO, it must be concluded that, in the present case, a conceptual comparison is not possible, since the first names and surname contained in the signs at issue do not convey any concept.
- 91 In the light of all the foregoing considerations, the Court upholds the findings set out by the Board of Appeal concerning the at-least-weak degree of visual and phonetic similarity of the signs at issue and overturns its findings as regards the average degree of conceptual similarity of those signs, since a conceptual comparison of those signs is not possible in the present case.

Global assessment of the likelihood of confusion

- 92 The applicant's argument, in paragraph 63 of the application, that the likelihood of confusion should be assessed in the light of the impression of the EU consumer and not of consumers in one or two countries of the European Union (namely Germany and Finland) must be rejected at the outset. It must be borne in mind that, for an EU trade mark to be refused registration, it is sufficient that a relative ground for refusal for the purposes of Article 8(1)(b) of Regulation 2017/1001 exists in part of the European Union (see, to that effect, judgment of 14 December 2006, *Mast-Jägermeister v OHIM — Licorera Zacapaneca (VENADO with frame and others)*, T-81/03, T-82/03 and T-103/03, EU:T:2006:397, paragraph 76 and the case-law cited). Consequently, the applicant is not justified in claiming that the Board of Appeal erred in relying on the existence of a likelihood of confusion in only two countries of the European Union in order to refuse the registration applied for, without prejudice to whether or not, in the present case, the alleged likelihood of confusion for German or Finnish consumers has been established.
- 93 As regards the assessment of the likelihood of confusion, it is clear from the case-law that that assessment implies some interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and that of the goods or services covered. Accordingly, a low degree of similarity between those goods or services may be offset by a high degree of similarity between the marks, and vice versa (judgments of 28 March 2017, *REGENT UNIVERSITY*, T-538/15, not published, EU:T:2017:226, paragraph 71, and of 8 November 2017, *IST*, T-80/17, not published, EU:T:2017:784, paragraph 64).
- 94 On the basis of the principle of interdependence referred to in paragraph 93 above, the Board of Appeal held that there was a likelihood of confusion between the signs at issue at least for the relevant German and Finnish public, given that those signs were visually and phonetically similar at least to a low degree and conceptually similar to an average degree and that the goods at issue were identical or similar to an average degree.
- 95 However, by mechanically applying the principle of interdependence, without taking account of all the relevant factors, the Board of Appeal did not carry out the global assessment of the likelihood of confusion correctly.
- 96 It must be held that, according to the case-law, whilst it is true that, by virtue of the principle of interdependence, a lesser degree of similarity between the goods or services covered may be offset by a greater degree of similarity between the marks, conversely there is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where identical goods are involved and there is a weak degree of similarity between the marks at issue (judgment of 3 June 2015, *Giovanni Cosmetics v OHIM — Vasconcelos & Gonçalves (GIOVANNI GALLI)*, T-559/13, EU:T:2015:353, paragraph 132 (not published); see also, to that effect, judgments of 12 July 2006, *Vitakraft-Werke Wührmann v OHIM — Johnson's Veterinary Products (VITACOAT)*, T-277/04, EU:T:2006:202, paragraphs 67 and 68; and of 17 February 2011, *Ancco v OHIM — Freche et fils (ANN TAYLOR LOFT)*, T-385/09, EU:T:2011:49, paragraphs 44 and 48).
- 97 In the present case, first, the Board of Appeal did not assess the similarity of the signs at issue correctly, since it wrongly concluded that the element 'Luciano' was as distinctive as the element 'Sandrone' in the sign for which registration was sought and wrongly concluded that the signs at issue were conceptually similar to an average degree (see paragraphs 75 and 90 above).
- 98 Second, the Board of Appeal did not take into account the specific qualities of the goods at issue. According to the case-law, the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (judgment of 18 September 2012, *Scandic Distilleries v OHIM — Bürgerbräu, Röhm & Söhne (BÜRGER)*, T-460/11, not published, EU:T:2012:432, paragraph 27).

- 99 In the present case, in the wine-growing world, names carry great weight, whether surnames or names of vineyards, since they are used to reference and designate wines. In general, it should be noted that consumers usually describe and recognise wines by reference to the word element which identifies them and that this element designates, in particular, the grower or the estate on which a wine is produced (judgments of 27 February 2014, *Pêra-Grave v OHIM — Fundação Eugénio de Almeida (QTA S. JOSÉ DE PERAMANCA)*, T-602/11, not published, EU:T:2014:97, paragraph 35, and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 49; see also, to that effect, judgment of 13 July 2005, *Julián Murúa Entrena*, T-40/03, EU:T:2005:285, paragraph 56). Thus, it is the distinctive element ‘Sandrone’ which will serve to identify the applicant’s wines, or the name as a whole, that is to say, ‘Luciano Sandrone’, but not the element ‘Luciano’ alone.
- 100 Third, the Board of Appeal also did not take into account the prevalence of real or assumed Spanish or Italian first names or surnames in the wine market, and the fact that consumers are used to trade marks which contain such names, so that they will not assume that every time such a first name or surname occurs in a trade mark in conjunction with other elements the goods in question all emanate from the same source (see, to that effect, judgment of 3 June 2015, *GIOVANNI GALLI*, T-559/13, EU:T:2015:353, paragraph 116 (not published) and the case-law cited).
- 101 Therefore, in the wine sector, where the use of signs consisting of surnames or first names is very common, it is implausible that the average consumer might believe that there is an economic link between the proprietors of the signs at issue merely because they share the Italian first name Luciano, which is perceived as very common, according to paragraph 47 of the contested decision, in Spain, France, Italy and Portugal, and in respect of which it has not been established that it might be perceived as rare in other countries of the European Union. It cannot be concluded from that fact alone, as far as concerns trade marks covering wines, that there is a likelihood of confusion since the relevant public will not expect only one producer to use such a common first name as an element of a trade mark (see, to that effect, judgment of 8 February 2019, *Serendipity and Others v EUIPO — CKL Holdings (CHIARA FERRAGNI)*, T-647/17, not published, EU:T:2019:73, paragraph 71; see also, by analogy, judgment of 3 June 2015, *GIOVANNI GALLI*, T-559/13, EU:T:2015:353, paragraph 117 (not published)).
- 102 Fourth, the Board of Appeal also failed to take into consideration the low degree of distinctiveness of the element common to both marks, namely ‘Luciano’, arising from the fact that that first name is likely to designate a potentially indeterminate number of persons and that therefore all of the relevant public will be able to distinguish the earlier mark from the mark for which registration is sought, since the latter also includes the element ‘Sandrone’, a surname having a higher intrinsic value (see paragraphs 68 and 69 above).
- 103 That conclusion is supported by the case-law of the Court of Justice, according to which it cannot be accepted that any surname which forms an earlier mark may be relied on effectively to oppose registration of a mark composed of a first name and that surname (see, to that effect, judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, EU:C:2010:368, paragraph 39). It cannot therefore always be held that there is a likelihood of confusion where an earlier mark consisting of a surname is included in another mark by adding a first name to it. That consideration is equally valid when the earlier trade mark consists, in particular, of a first name and the sign for which registration is sought consists of a combination of that first name and a surname (judgment of 3 June 2015, *GIOVANNI GALLI*, T-559/13, EU:T:2015:353, paragraph 125 (not published)).
- 104 In the light of all the foregoing, and having regard to the weak degree of visual and phonetic similarity between the signs at issue and to the fact that it is not possible to make a conceptual comparison of them, it must be concluded that the Board of Appeal erred in finding that there was a likelihood of confusion between the signs at issue.

105 On those grounds, the Court therefore upholds the second plea in law of the action and annuls the contested decision, without it being necessary to rule on the applicant's other arguments, alleging, first, the reputation of the sign which is the subject of the trade mark application and, second, the decision-making practice of EUIPO.

...

On those grounds,

THE GENERAL COURT (Seventh Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 26 February 2018 (Case R 1207/2017-2);**
- 2. Orders EUIPO to bear its own costs and to pay those incurred by Mr Luciano Sandrone.**

Tomljenović

Bieliūnas

Kornezov

Delivered in open court in Luxembourg on 27 June 2019.

E. Coulon
Registrar

S. Gervasoni
President