



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

11 December 2014*

(Community trade mark — Opposition proceedings — Application for Community figurative mark Master — Earlier Community figurative marks Coca-Cola and earlier national figurative mark C — Relative ground for refusal — Article 8(5) of Regulation (EC) No 207/2009 — Similarity of the signs — Evidence relating to the commercial use of the mark applied for)

In Case T-480/12,

The Coca-Cola Company, established in Atlanta, Georgia (United States), represented by S. Malynicz, Barrister, D. Stone and L. Ritchie, Solicitors, and S. Baran, Barrister,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by J. Crespo Carrillo, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Modern Industrial & Trading Investment Co. Ltd (Mitico), established in Damascus (Syria), represented by A.-I. Malami, lawyer,

ACTION brought against the decision of the Second Board of Appeal of OHIM of 29 August 2012 (Case R 2156/2011-2) concerning opposition proceedings between The Coca-Cola Company and Modern Industrial & Trading Investment Co. Ltd (Mitico),

THE GENERAL COURT (Eighth Chamber),

composed of D. Gratsias, President, M. Kancheva (Rapporteur) and C. Wetter, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 5 November 2012,

having regard to the response of OHIM lodged at the Court Registry on 22 February 2013,

having regard to the response of the intervener lodged at the Court Registry on 7 March 2013,

* Language of the case: English.

further to the hearing on 9 July 2014,
gives the following

Judgment

Background to the dispute

- 1 On 10 May 2010, the intervener — Modern Industrial & Trading Investment Co. Ltd ('Mitico') — 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 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 figurative sign reproduced below:



- 3 The goods in respect of which registration was sought are in Classes 29, 30 and 32 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 — after the restriction made during the proceedings before OHIM — to the following description:
 - Class 29: 'Yoghurt. Meat, fish, poultry and game, meat extracts. Preserved, frozen, dried and cooked fruits and vegetables. Jellies, marmalades, fruit preserve. Eggs. Preserve[s] and pickles. Salads in vinegar. Potatoes chips';
 - Class 30: 'Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, confectionery, candies, ice-creams, honey, melassa syrup, dough, flour, baker's yeast, baking-powder, salt, mustard, vinegar, pepper, sauces (condiments), spices, specifically excluding pastry and bakery products. Ice. Chocolate. Gum. All kinds of food appetizers made from corn and wheat, specifically excluding pastry and bakery products';
 - Class 32: 'Mineral and natural water, barley beverage, non-alcoholic beers, non-alcoholic aerated waters of all kinds and flavors, particularly with (cola — pineapple — mango — orange — lemon — without flavor — apples — fruit cocktail formed — tropical — energy drink — strawberry — fruits — lemonade — pomegranate ...) taste, and all types of non-alcoholic natural fruit juice drinks (apples — lemon — orange — fruit cocktail — pomegranate — pineapple — mango ...), and non-alcoholic juice concentrates and concentrates for making non-alcoholic juice in all types, powders and crushes for making non-alcoholic syrup'.

- 4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 128/2010 of 14 July 2010.
- 5 On 14 October 2010, the applicant — The Coca-Cola Company ('Coca-Cola') — filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009, to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.
- 6 The opposition was primarily based on the four earlier Coca-Cola Community figurative marks reproduced below:

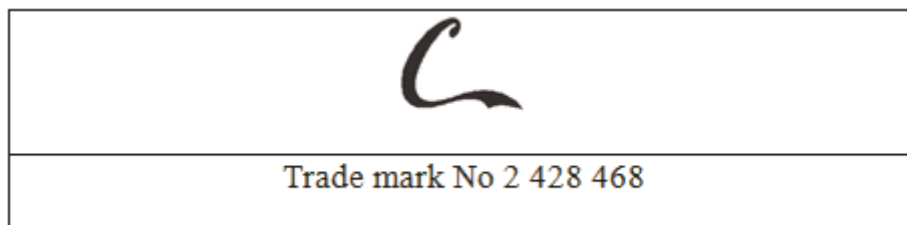
			
Trade mark No 8 792 475	Trade mark No 3 021 086	Trade mark No 2 117 828	Trade mark No 2 107 118

- 7 Those four earlier Community figurative marks respectively covered, inter alia, goods and services in: (i) Classes 30, 32 and 33; (ii) Class 32; (iii) Classes 32 and 43; and (iv) Classes 32 and 33. Those goods and services correspond, for each of those trade marks and classes, to the following description:
 - Community trade mark No 8 792 475:
 - Class 30: 'Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice';
 - Class 32: 'Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages';
 - Class 33: 'Alcoholic beverages (except beers)';
 - Community trade mark No 3 021 086:
 - Class 32: 'Beverages, namely drinking waters, flavored waters, mineral and aerated waters; and other non-alcoholic beverages, namely, soft drinks, energy drinks and sports drinks; fruit drinks and juices; syrups, concentrates and powders for making beverages, namely flavored waters, mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit drinks and juices';
 - Community trade mark No 2 117 828:
 - Class 32: 'Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages';
 - Class 43: 'Providing of food and drink; temporary accommodation';

— Community trade mark No 2 107 118:

- Class 32: ‘Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages’;
- Class 33: ‘Alcoholic beverages (except beers)’.

8 The opposition was also based on the earlier United Kingdom figurative mark C, reproduced below:



- 9 That earlier UK figurative mark covered, inter alia, goods in Class 32 corresponding to the following description: ‘Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages’.
- 10 The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and Article 8(5) of Regulation No 207/2009.
- 11 On 26 September 2011, the Opposition Division rejected the opposition in its entirety.
- 12 On 17 October 2011, Coca-Cola filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the Opposition Division’s decision.
- 13 By decision of 29 August 2012 (‘the contested decision’), the Second Board of Appeal of OHIM dismissed the appeal.
- 14 First, with regard to the ground of opposition based on Article 8(1)(b) of Regulation No 207/2009, the Board of Appeal began by defining the relevant consumer as an ordinary member of the general public of the European Union. Secondly, the Board observed that Mitico did not dispute the Opposition Division’s provisional finding that the goods covered by the marks at issue were identical. Thirdly, the Board felt that it was clear from the outset that the signs at issue were not at all similar, by reason of the fact that the word elements of those signs (‘coca-cola’ and ‘master’), which were more distinctive than their figurative elements, had practically nothing in common, apart from the ‘tail’ flowing from the letter ‘c’ and the letter ‘m’. The Board of Appeal also rejected Coca-Cola’s argument that the similarity of the signs did not hang on any perceived coincidences between the word elements, but on the special and distinctive way in which those word elements were depicted, in the same typeface, known as ‘Spenserian script’, on the ground that that particular distinctive character had to be taken into consideration as part of the assessment of the likelihood of confusion and not as part of the assessment of the similarity of the signs at issue.
- 15 Fourthly, the Board of Appeal concluded that there was no likelihood of confusion between the signs at issue on the following grounds. First, it observed that, although Coca-Cola was the proprietor of a range of highly famous and well-known Coca-Cola trade marks whose reputation was connected to their depiction in Spenserian script, that did not mean that it was the proprietor of that — undeniably elegant — script, which was freely available to be used by all. Next, the Board found that, although the goods were identical and the earlier trade marks had an undeniable reputation, it was difficult to see why a consumer would confuse the word ‘master’, combined with an Arabic word, with the earlier trade marks containing the words ‘coca-cola’ when there was no point of overlap textually. According

to the Board of Appeal, there was nothing tangible in the earlier signs which was reproduced in the sign applied for, apart from the 'tail' element of each sign, flowing from the base of the letters 'c' and 'm' respectively. However, the Board added that that element on its own, divorced from the main Coca-Cola context, was not sufficient to generate any degree of similarity between the signs, as the evidence did not show that consumers focused on that detail when it was divorced from that context. In addition, the Board held that the Spenserian script was not highly fanciful — despite its tails, flourishes and other embellishments — and not so distinctive that its appearance in trade marks other than those owned by Coca-Cola would give rise to any suspicion that those marks had the same commercial origin. Lastly, it dismissed Coca-Cola's assertion that, in practice, Mitico was supplying products bearing labels mimicking those to be found on Coca-Cola's products, on the ground that the relevant question in the case before it was whether the mark as applied for was confusingly similar to the earlier trade marks as registered, and the way in which the trade marks might be used in practice was irrelevant for the purposes of an assessment of that kind.

- 16 Next, with regard to the ground of opposition based on Article 8(5) of Regulation No 207/2009, the Board of Appeal began by stating that the first precondition for the application of that ground — namely, the existence of a link between the mark applied for and the earlier trade mark — was not satisfied, since the marks had not been found to be similar when analysed in relation to the ground of opposition alleging a likelihood of confusion (see paragraphs 14 and 15 above). In that connection, the Board added that, regardless of the strength of the earlier trade marks' reputation, the types of injury referred to by that ground were the consequence of a certain degree of similarity between the mark applied for and the earlier trade mark, by virtue of which the public concerned made a connection between them, that is to say, established a link between them. According to the Board of Appeal, that was not the position in the case before it, since there was no similarity between the marks at issue.
- 17 Secondly, the Board of Appeal rejected Coca-Cola's assertion, accompanied by evidence, that Mitico was marketing soft drinks bearing the trade mark Master (along with other elements) in such a way that the overall impression being conveyed by the packaged product was similar to that conveyed by a typical Coca-Cola product, and that Mitico had deliberately adopted the same 'get-up', imagery, stylisation, font and packaging as Coca-Cola. According to the Board, if that were proved to be true, Coca-Cola could reasonably argue that Mitico intended to take unfair advantage of the repute of the earlier trade marks, but it could not do so in the context of Article 8(5) of Regulation No 207/2009, in relation to which account must only be taken of the mark that Mitico sought to have registered.

Forms of order sought

- 18 Coca-Cola claims that the Court should:
- annul the contested decision;
 - order OHIM and Mitico to pay the costs.
- 19 OHIM and Mitico contend that the Court should:
- dismiss the action;
 - order Coca-Cola to pay the costs.

Law

- 20 In support of its action, Coca-Cola essentially raises a single plea in law, alleging infringement of Article 8(5) of Regulation No 207/2009. That plea is divided into two parts, alleging respectively: (i) OHIM conflated the assessment of the similarity of the marks at issue under Article 8(1)(b) of Regulation No 207/2009 with the assessment under Article 8(5) of that regulation as to whether there was a link between the marks; and (ii) OHIM disregarded evidence relating to the commercial use of the mark applied for, which was relevant for the purposes of demonstrating Mitico's intention of taking advantage of the earlier trade marks' reputation.
- 21 However, Coca-Cola expressly states that it does not dispute the Board of Appeal's finding that there is no likelihood of confusion between the marks at issue for the purposes of Article 8(1)(b) of Regulation No 207/2009.
- 22 It should also be noted that the parties do not dispute the findings of the Board of Appeal regarding the relevant public or the fact that the goods covered by the marks at issue are identical. Accordingly, it is common ground that the mark applied for, like the earlier trade marks, covers (inter alia) non-alcoholic drinks in Class 32, including colas (see paragraph 3 above).

The first part

- 23 By the first part of its single plea in law, Coca-Cola claims that the Board of Appeal wrongly conflated the matter of the similarity of the marks at issue under Article 8(1)(b) of Regulation No 207/2009 with the matter of the link between those marks under Article 8(5) of that regulation. This part of the plea is divided in essence into two complaints: by the first it is alleged that, although the similarity of the marks, if shown, is a factor that must be taken into account in assessing whether there is a link between those marks for the purposes of Article 8(5) of Regulation No 207/2009, it is not a precondition for the application of that provision; and, by the second, that there is a certain degree of similarity between the marks.
- 24 As a preliminary point, it should be borne in mind that, under Article 8(5) of Regulation No 207/2009, '... upon opposition by the proprietor of an earlier trade mark within the meaning of [Article 8(2)], the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.
- 25 It is clear from the wording of Article 8(5) of Regulation No 207/2009 that the application of that provision is subject to the following conditions: first, that the marks at issue are identical or similar; secondly, that the earlier mark cited in opposition has a reputation; and, thirdly, that there is a risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those conditions are cumulative and failure to satisfy one of them is sufficient to render that provision inapplicable (see, to that effect, judgments of 25 May 2005 in *Spa Monopole v OHIM — Spa-Finders Travel Arrangements (SPA-FINDERS)*, T-67/04, ECR, EU:T:2005:179, paragraph 30; of 22 March 2007 in *Sigla v OHIM — Elleni Holding (VIPS)*, T-215/03, ECR, EU:T:2007:93, paragraph 34; and of 29 March 2012 in *You-Q v OHIM — Apple Corps (BEATLE)*, T-369/10, EU:T:2012:177, paragraph 25).

- 26 According to settled case-law, the types of injury referred to in Article 8(5) of Regulation No 207/2009 are the consequence of a certain degree of similarity between the earlier mark and the mark applied for, by virtue of which the relevant section of the public makes a connection between those marks, that is to say, establishes a link between them even though it does not necessarily confuse them. The existence of a link between the mark applied for and the earlier mark with a reputation, which must be assessed globally, account being taken of all factors relevant to the circumstances of the case, is therefore an essential precondition for the application of that provision (judgments in *SPA-FINDERS*, paragraph 25 above, EU:T:2005:179, paragraph 41; of 10 May 2007 in *Antartica v OHIM — Nasdaq Stock Market (nasdaq)*, T-47/06, EU:T:2007:131, paragraph 53; and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 46; see also, by analogy, judgments of 23 October 2003 in *Adidas-Salomon and Adidas Benelux*, C-408/01, ECR, EU:C:2003:582, paragraphs 29, 30 and 38, and of 27 November 2008 in *Intel Corporation*, C-252/07, ECR, EU:C:2008:655, paragraphs 30, 41, 57, 58 and 66).
- 27 Those factors include, first, the degree of similarity between the signs at issue, second, the nature of the goods or services for which the signs at issue are registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public, third, the strength of the earlier mark's reputation, fourth, the degree of the earlier mark's distinctive character, whether inherent or acquired through use and, fifth, the existence of a likelihood of confusion on the part of the public (judgment in *Intel Corporation*, paragraph 26 above, EU:C:2008:655, paragraph 42, and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 47).
- 28 It is in the light of those preliminary considerations that the two complaints raised by Coca-Cola in support of the first part of its single plea in law should be examined.
- 29 By its first complaint, Coca-Cola submits, in essence, that the Board of Appeal erred in inferring — solely from its conclusion that there was no similarity between those marks, a finding made in the context of its assessment of the likelihood of confusion between them for the purposes of Article 8(1)(b) of that regulation — that there was no link between the marks at issue for the purposes of Article 8(5) of Regulation No 207/2009 and in thus disregarding the case-law of the Court of Justice, pursuant to which the existence of such a link must be assessed globally, account being taken of all factors relevant to the circumstances of the case. Coca-Cola argues that the Board of Appeal should not, in its assessment relating to Article 8(5) of Regulation No 207/2009, have taken a 'shortcut' by relying wholly on its findings relating to the similarities between the signs, but instead, on the basis of the criteria laid down in the case-law, should have found that the application of most of those criteria led to the conclusion that the public would establish a link between the marks at issue.
- 30 OHIM and Mitico contend that the existence of a similarity between the marks at issue is a precondition for the application both of Article 8(1)(b) of Regulation No 207/2009 and of Article 8(5) of that regulation, and must be assessed in the same way in relation to both those provisions. Since, in the present case, the Board of Appeal found that those marks were not similar but different, it was right — according to OHIM and Mitico — in concluding, without examining the other factors listed in the case-law, that Article 8(5) of that regulation was not applicable.
- 31 According to the case-law of the Court of Justice, the existence of a similarity between the marks at issue is a precondition for the application both of Article 8(1)(b) of Regulation No 207/2009 and of Article 8(5) of that regulation. In the context of both those provisions, that condition relating to similarity between the marks at issue requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, to that effect, judgment of 24 March 2011 in *Ferrero v OHIM*, C-552/09 P, ECR, EU:C:2011:177, paragraphs 51 and 52).
- 32 It is true that those provisions differ in terms of the degree of similarity required: whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 207/2009 is conditional upon a finding of such similarity between the marks at issue that there exists a likelihood of confusion between them on the part of the relevant section of the public, by contrast, for the

protection conferred by Article 8(5) of that regulation, the existence of such a likelihood is not necessary. Accordingly, the types of injury referred to in Article 8(5) may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see, to that effect and by analogy, judgments in *Adidas-Salomon and Adidas Benelux*, paragraph 26 above, EU:C:2003:582, paragraphs 27, 29 and 31, and *Intel Corporation*, paragraph 26 above, EU:C:2008:655, paragraphs 57, 58 and 66). On the other hand, it does not appear either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way depending on whether the assessment is carried out under Article 8(1)(b) or under Article 8(5) of Regulation No 207/2009 (judgment in *Ferrero v OHIM*, paragraph 31 above, EU:C:2011:177, paragraphs 53 and 54).

- 33 Although the global assessment of whether a link exists between the marks at issue for the purposes of Article 8(5) of Regulation No 207/2009 implies some interdependence between the relevant factors and, accordingly, a low degree of similarity between the marks may be offset by the strong distinctiveness of the earlier mark, the fact remains that, where there is no similarity between the marks at issue, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services concerned are identical or similar are not sufficient grounds for finding that there is a likelihood of confusion between the marks at issue or that the relevant public will make a link between them. As has been stated in paragraph 31 above, it is a necessary precondition for the application of both Article 8(1)(b) and Article 8(5) of Regulation No 207/2009 that the marks at issue be identical or similar. Consequently, those provisions are manifestly inapplicable where the General Court has ruled out any similarity between the marks at issue (see, to that effect, judgment of 24 March 2011 in *Calvin Klein Trademark Trust v OHIM*, C-254/09 P, ECR, EU:C:2010:488, paragraph 68). It is only if there is some similarity, however faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public (judgment in *Ferrero v OHIM*, paragraph 31 above, EU:C:2011:177, paragraphs 65 and 66).
- 34 It can be clearly seen from that case-law of the Court of Justice that the identical nature of the marks at issue or their similarity — however faint — is a precondition for the application of Article 8(5) of Regulation No 207/2009 and not merely a factor to be taken into consideration when assessing whether there is a link between those marks for the purposes of that provision. Furthermore, that conclusion stems directly from the following phrasing, used in the provision in question: ‘where [the mark applied for] is identical with, or similar to, the earlier trade mark’.
- 35 Accordingly, the Court notes that, while it is true that the degree of similarity between the signs at issue is among the factors relevant to the overall assessment under Article 8(5) of Regulation No 207/2009 as to whether a link exists between those signs (see paragraph 27 above), the fact remains that the existence of a similarity between those signs, of whatever strength, is a precondition for the application of that provision. Accordingly, that provision cannot be applied unless such a similarity exists — however faint, so long as it is consistent with the case-law cited in paragraph 33 above.
- 36 The Board of Appeal was therefore right to find that, if the marks at issue were not similar, but different, it could immediately conclude, without examining the factors listed in the case-law as relevant for the purposes of establishing the existence of a link between those marks as referred to in Article 8(5) of Regulation No 207/2009, that that provision was not applicable.
- 37 Consequently, the first complaint must be rejected.

- 38 By its second complaint, Coca-Cola submits, in essence, that the Board of Appeal erred in concluding that there was no similarity between the signs at issue, even though the Board had itself acknowledged that there was, at the very least, a certain degree of similarity between them, owing to the similar ‘tail’ of the letters ‘c’ and ‘m’ and the fact that the signs both used a similar Spenserian script. In particular, Coca-Cola submits that, by asserting in paragraph 29 of the contested decision that ‘this element [(that is, the Spenserian script)] on its own, divorced from a “COCA-COLA” context, [was] not sufficient to generate any degree of similarity between the signs’, the Board of Appeal wrongly isolated the Spenserian script from the words ‘coca-cola’ and ‘master’ instead of considering the way the trade marks were depicted as a whole.
- 39 OHIM and Mitico emphasise that, by dint of the overall lack of similarity between the signs at issue and the absence of a link between the mark applied for and the earlier trade marks, Article 8(5) of Regulation No 207/2009 is not applicable. They contend that the differences between the word elements ‘coca-cola’ and ‘master’, or the Arabic script in the mark applied for, will have a far greater impact on the relevant consumers’ perception of the signs than the points of similarity between them, including the ‘tail’. In particular, after observing that, in paragraph 29 of the contested decision, ‘this element on its own’ refers to the ‘tail’ and not to ‘the Spenserian script’, OHIM argues that it was not the Board of Appeal’s intention to divorce that ‘tail’ from a Coca-Cola context in the earlier trade marks, but that the Board was noting that the only tangible element of the earlier trade marks reproduced in the mark applied for was that specific element.
- 40 It is settled case-law that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, that is, as regards their visual, aural and conceptual aspects (see, to that effect, judgments of 23 October 2002 in *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)*, T-6/01, ECR, EU:T:2002:261, paragraph 30; of 31 January 2012 in *Spar v OHIM — Spa Group Europe (SPA GROUP)*, T-378/09, EU:T:2012:34, paragraph 27; and of 31 January 2013 in *K2 Sports Europe v OHIM — Karhu Sport Iberica (SPORT)*, T-54/12, EU:T:2013:50, paragraph 22 and the case-law cited).
- 41 The global assessment to determine whether there is a link between the marks in question must, so far as the visual, aural or conceptual similarity of the marks at issue is concerned, be based on the overall impression given by those marks, account being taken, in particular, of their distinctive and dominant elements. 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 that link. In that regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, judgments of 16 May 2007 in *La Perla v OHIM — Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, T-137/05, EU:T:2007:142, paragraph 35, and of 9 March 2012 in *Ella Valley Vineyards v OHIM — HFP (ELLA VALLEY VINEYARDS)*, T-32/10, ECR, EU:T:2012:118, paragraph 38; see also, by analogy, judgment of 12 June 2007 in *OHIM v Shaker*, C-334/05 P, ECR, EU:C:2007:333, paragraph 35).
- 42 In the present case, it must be held, as a preliminary point and contrary to the assertions made by Coca-Cola, that the Board of Appeal did not omit to take trade marks No 3 021 086 and No 2 107 118 into account in its assessment, but implicitly took them into consideration as part of the homogenous group of four earlier Community figurative marks, each of which contains the element ‘coca-cola’ in Spenserian script (see paragraph 6 above), while focusing, from among those four marks, on the trade mark which in its view was closest to the mark applied for, namely, trade mark No 2 117 828. In any event, if the point of reference had instead been trade mark No 2 107 118 — which, in Coca-Cola’s view, is visually closer to the mark applied for — the Board of Appeal’s assessment would not have been substantially different.
- 43 It should next be noted that Coca-Cola does not dispute the findings of the adjudication bodies of OHIM to the effect that the signs at issue are aurally and conceptually dissimilar and that it confirmed at the hearing that the dispute concerned only the visual similarity of those signs.

- 44 Accordingly, in assessing the legality of the contested decision, it is necessary to focus on: (i) the visual comparison of the signs at issue; (ii) the global assessment of the similarity of those signs, account being taken of their aural and conceptual differences; and (iii) the consequences of that assessment for the application, in the circumstances, of Article 8(5) of Regulation No 207/2009.
- 45 First, as regards the visual comparison of the signs at issue, it is appropriate to confirm the finding made in paragraph 20 of the contested decision to the effect that the earlier signs consist of the stylised words ‘coca-cola’, or the stylised letter ‘c’, and the later sign consists of the stylised word ‘master’ with an Arabic word above it. In that connection, it should nevertheless be pointed out that, given its unintelligibility for the relevant consumer — an ordinary member of the general public of the European Union (see paragraph 14 above) — that Arabic element in the mark applied for is of secondary importance as compared with the dominant element ‘master’ (see, to that effect, judgment of 18 April 2007 in *House of Donuts v OHIM — Panrico (House of donuts)*, T-333/04 and T-334/04, EU:T:2007:105, paragraph 32).
- 46 Admittedly, it should be noted, as OHIM and Mitico have observed, that there are clear visual differences between the signs at issue, owing to the number of word elements, the beginnings of those elements, the lack of a common letter in the same position in those word elements and, to a lesser extent, the form of the figurative elements.
- 47 However, it should also be noted that there are elements of visual similarity between the signs at issue.
- 48 First, as the Board of Appeal observed in paragraph 20 of the contested decision, after rightly finding that there was no textual overlap between the word elements ‘coca-cola’ — or ‘c’ — and ‘master’, it is common ground that the signs at issue each have a ‘tail’ flowing from their first letters — ‘c’ and ‘m’, respectively — in a signature flourish.
- 49 In that regard, it is true that the Board of Appeal was right to refer, in paragraph 20 of the contested decision, to the case-law by virtue of which, where a trade mark is composed of verbal and figurative elements, the former should in principle be considered more distinctive than the latter, because the average consumer will more easily refer to the product in question by quoting the name of the trade mark than by describing its figurative element (judgment of 14 July 2005 in *Wassen International v OHIM — Stroschein Gesundkost (SELENIUM-ACE)*, T-312/03, ECR, EU:T:2005:289, paragraph 37).
- 50 However, it should be borne in mind that that principle is subject to exceptions, depending on the circumstances. For example, it has been found that food products in Classes 29 and 30 are normally purchased in supermarkets or similar establishments and are thus selected from the shelf by consumers directly, rather than being asked for orally. Similarly, in such establishments, consumers lose little time between successive purchases and often do not read all the information on the various products, letting themselves be guided more by the overall visual impression produced by the labels or packaging. In those circumstances, for the purposes of assessing whether there is a likelihood of confusion or a link between the signs in question, the result of the analysis of the visual similarity between those signs becomes of greater importance than the result of the analysis of their aural and conceptual similarities. Moreover, in that assessment, the figurative elements of a mark are deemed to play a more important role than its word elements from the relevant consumer’s point of view (see, to that effect, judgments of 12 September 2007 in *Koipe v OHIM — Aceites del Sur (La Española)*, T-363/04, ECR, EU:T:2007:264, paragraph 109, and of 2 December 2008 in *Ebro Puleva v OHIM — Berenguel (BRILLO’S)*, T-275/07, EU:T:2008:545, paragraph 24).
- 51 In the present case concerning food products in Classes 29, 30 and 32, and non-alcoholic drinks in particular, it must be held, taking account of the exceptions, established by the case-law, to the principle mentioned by the Board of Appeal, that, visually, the figurative elements of the marks at issue play a role which is at least as important as that of their word elements from the relevant consumer’s overall point of view.

- 52 It follows that, for the purposes of assessing whether the signs at issue are similar and, if so, to what degree, the presence of a common figurative element consisting in a ‘tail’ flowing from the first letters of those signs (‘c’ and ‘m’, respectively) in a signature flourish is at least as important as the finding that there is no textual overlap between their word elements.
- 53 Second, as the Board of Appeal observed in paragraph 21 of the contested decision, Coca-Cola is arguing that the similarities between the signs at issue — at least as far as the four earlier Coca-Cola Community figurative marks and the Master trade mark applied for are concerned — stem, inter alia, from the special and distinctive way in which they are depicted in the same font (namely, ‘Spenserian script’).
- 54 In that regard, it is true that the Board of Appeal was right to state in paragraph 22 of the contested decision that the reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks at issue, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 19 May 2010 in *Ravensburger v OHIM — Educa Borrás (EDUCA Memory game)*, T-243/08, EU:T:2010:210, paragraph 27 and the case-law cited).
- 55 However, that case-law does not offer sufficient grounds for disregarding Coca-Cola’s arguments in the present case. Quite apart from the particular distinctive character of the Spenserian script, with its elegant flourishes and other embellishments, the fact remains that the use, by the signs at issue, of the same font — which, moreover, is not commonly used in contemporary business life — is a relevant factor in determining whether there is a visual similarity between them.
- 56 Thus, in another case, the General Court found that two different word elements nevertheless had a certain degree of visual similarity, since they were both short words written in a font which resembled a child’s handwriting, and concluded that, notwithstanding the significant visual differences between the marks at issue, it could not be denied that there was a low degree of visual similarity between them (see, to that effect, judgment of 5 July 2012 in *Comercial Losan v OHIM — McDonald’s International Property (Mc. Baby)*, T-466/09, EU:T:2012:346, paragraphs 33 and 35).
- 57 In the present case, it must be found that, despite their differences, there is a certain degree of visual similarity between the signs at issue — when they are perceived as a whole, in accordance with the case-law cited in paragraph 41 above, rather than on the basis of an analytical dissection of their word or figurative elements — owing to their shared use of a font which is not commonly used in contemporary business life, namely, Spenserian script.
- 58 However, the Board of Appeal — in its assessment of the likelihood of confusion rather than its assessment of the similarity of the signs — held in paragraph 29 of the contested decision that ‘[t]here [was] nothing tangible in [Coca-Cola]’s sign which [was] reproduced in [Mitico]’s sign apart from the “tail” element flowing from the base of the letter [“c”] in [Coca-Cola]’s sign and the letter [“m”] in [Mitico]’s. However, this element on its own, divorced from a “COCA-COLA” context, [was] not sufficient to generate any degree of similarity between the signs. The evidence [did] not show that consumers [focused] on this detail when it [was] divorced from the main “COCA-COLA” context’.
- 59 In that connection, it is appropriate to accept Coca-Cola’s argument that the Board of Appeal thus wrongly isolated the Spenserian script from the words ‘coca-cola’ and ‘master’, instead of considering the way in which the trade marks were depicted as a whole. Although, of course, it should be noted that — as OHIM has observed — it can be seen from the structure of paragraph 29 of the contested decision, mentioned above, that ‘this element on its own’ refers to the ‘tail’ and not to ‘the Spenserian script’, the fact remains that, in focusing its analysis of the similarity of the signs on the ‘tail’ element and in divorcing that element from the context of the word ‘coca-cola’ in the earlier trade marks, the

Board of Appeal failed to carry out a global assessment of the signs at issue *qua* two signs both written in Spenserian script, and accordingly failed to establish that element of visual similarity between the signs at issue.

- 60 The Board of Appeal — again in its assessment of the likelihood of confusion rather than its assessment of the similarity of the signs — also held, in paragraphs 27 and 29 of the contested decision, that Coca-Cola ‘[was] not the proprietor of the [Spenserian] script’ and that ‘[t]he Spenserian script, like any other script, [was] freely available to be used by all’.
- 61 On the assumption that the Board of Appeal believed those findings to be relevant for the purposes of concluding that there was no similarity between the signs, it would be necessary for the Court to uphold Coca-Cola’s contention that the Board of Appeal erred in taking that view. The only possible relevance of such findings is for the purposes of undertaking a global analysis to determine whether there is a likelihood of confusion, or a link made by the relevant consumer, as referred to in Article 8(1)(b) and Article 8(5) of Regulation No 207/2009 respectively: they cannot be relevant for the purposes of an objective analysis of similarities between the signs. Accordingly, it must be found that the public interest in the Spenserian script (like any other script) being freely available for use by all cannot, in itself, be relied upon as an answer to the argument that the Spenserian script is an element of similarity between the signs at issue from the relevant consumer’s point of view.
- 62 Furthermore, it should be noted that any attempt by an operator on the market to monopolise a particular font conflicts with the strict conditions for applying the grounds for refusal set out in Article 8(1)(b) and Article 8(5) of Regulation No 207/2009, such as the existence of a likelihood of confusion between the signs at issue or the existence of a risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark (see paragraph 25 above).
- 63 In that regard, it is appropriate to accept Coca-Cola’s argument that it is not seeking to monopolise the Spenserian script for all goods and services, but arguing that, because of the similarity between the scripts and other presentational features of the marks at issue, including the long ‘tail’ under the letters ‘c’ and ‘m’, consumers will establish a link or connection between those marks when they are used to market the goods covered by the mark applied for and, in particular, when they are used for non-alcoholic drinks such as colas. Mitico is therefore wrong in its assertion that a decision accepting that the marks being compared are similar or that there is a link between them would not only result in Coca-Cola assuming a monopoly on the use of that script, thereby preventing any other operator from using it for the labels of non-alcoholic drinks or in connection with other goods and services, but would also be liable to pave the way for other proprietors of well-known trade marks to monopolise other types of script.
- 64 It follows from the foregoing that, visually, the signs at issue do not only have clear differences, but also elements of similarity, owing not only to the ‘tail’ flowing from their first letters (‘c’ and ‘m’ respectively) in a signature flourish but also to their shared use of a font which is not commonly used in contemporary business life (Spenserian script), which will be perceived by the relevant consumer as a whole.
- 65 It can be seen from a global assessment of those visual similarities and differences that there is a low degree of visual similarity between the signs at issue — or, at least, between the four earlier Coca-Cola Community figurative marks and the Master trade mark applied for — since differences in their details are partly offset by their overall similarities. By contrast, the earlier British trade mark C, especially because of its brevity, is visually dissimilar to the mark applied for.

- 66 Secondly, as regards the global assessment of the similarity of the signs at issue, it is necessary to determine whether the aural and conceptual differences between those signs — which are not disputed by Coca-Cola — are of such a kind as to preclude any similarity between the signs at issue, or whether those differences are instead cancelled out by the low degree of visual similarity between the signs.
- 67 According to the case-law, in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, account being taken of the category of goods or services in question and the circumstances in which they are marketed, as part of a global assessment (judgment in *Ferrero v OHIM*, paragraph 31 above, EU:C:2011:177, paragraphs 85 and 86; see also, by analogy, judgment in *OHIM v Shaker*, paragraph 41 above, EU:C:2007:333, paragraph 36).
- 68 In that regard, it should be borne in mind that the visual, aural and conceptual aspects of the signs at issue do not always have the same weight. The importance of elements of similarity or dissimilarity between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by those signs are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the goods themselves and must therefore rely primarily on the image of the trade mark applied to the goods, the visual similarity between the signs will, as a general rule, be more important. If, on the other hand, the goods covered are primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs. Accordingly, the degree of aural similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives the mark designating those goods visually (judgment of 21 February 2013 in *Esge v OHIM — De'Longhi Benelux (KMIX)*, T-444/10, EU:T:2013:89, paragraphs 36 and 37 and the case-law cited; see also, to that effect, judgments in *La Española*, paragraph 50 above, EU:T:2007:264, paragraph 109, and *BRILLO'S*, paragraph 50 above, EU:T:2008:545, paragraph 24).
- 69 In the present case, therefore, as regards the goods in Classes 29, 30 and 32 which are usually sold in self-service stores, the elements of visual similarity and dissimilarity between the signs at issue are of greater importance than the elements of aural and conceptual similarity and dissimilarity between those signs.
- 70 It can be seen from a global assessment of those elements of similarity and dissimilarity that there is a low degree of similarity between the signs at issue — or, at least, between the four earlier Coca-Cola Community figurative marks and the Master trade mark applied for — since, despite the elements of visual dissimilarity, their aural and conceptual differences are cancelled out by the elements of overall visual similarity, which are of greater importance. By contrast, the earlier British trade mark C, especially because of its brevity, is dissimilar to the mark applied for.
- 71 Furthermore, that global assessment is consistent with the case-law to the effect that certain marks with visual, aural and conceptual differences nonetheless, when assessed as a whole, had a low or very low degree of similarity (see, to that effect, judgment of 23 September 2009 in *Arcandor v OHIM — dm drogerie markt (S-HE)*, T-391/06, EU:T:2009:348, paragraph 54, and *SPA GROUP*, paragraph 40 above, EU:T:2012:34, paragraph 54).
- 72 Thirdly and lastly, it is necessary to identify the consequences of that global assessment of similarity for the application of Article 8(5) of Regulation No 207/2009 in the present case.
- 73 It follows from the case-law cited in paragraphs 26, 27 and 31 to 33 above that the existence of a similarity, however faint, between the signs at issue is a precondition for the application of Article 8(5) of Regulation No 207/2009 and that the degree of similarity is a relevant factor in determining whether there is a link between those signs.

- 74 In the present case, the global assessment under Article 8(5) of Regulation No 207/2009, to determine whether the relevant public makes a link between the marks at issue, leads to the conclusion that, given the degree of similarity, however faint, between those marks, there is a risk that the relevant public might establish such a link. Although the signs at issue are only slightly similar, it is not altogether inconceivable that the relevant public could make a link between them and, even if there is no likelihood of confusion, be led to transfer the image and the values of the earlier marks to the goods bearing the mark applied for (see, to that effect, judgment in *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 71). Thus, contrary to the Board of Appeal's conclusion in paragraph 33 of the contested decision, there is a sufficient degree of similarity between the signs at issue, for the purposes of the case-law cited in paragraph 32 above, for the relevant public to make a connection between the mark applied for and the earlier Community trade marks, that is to say, to establish a link between them for the purposes of that provision.
- 75 It follows that the Board of Appeal should have examined the other conditions for applying Article 8(5) of Regulation No 207/2009 (see paragraph 25 above). However, although the Board found that the earlier marks cited in opposition were highly reputed, it did not give a ruling on whether there was a risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of those earlier trade marks. Since that question was not examined by the Board of Appeal, it is not for the Court to give a ruling on it, for the first time, in its review of the legality of the contested decision (see, to that effect, judgments of 5 July 2011 in *Edwin v OHIM*, C-263/09 P, ECR, EU:C:2011:452, paragraphs 72 and 73; of 14 December 2011 in *Völkl v OHIM — Marker Völkl (VÖLKL)*, T-504/09, ECR, EU:T:2011:739, paragraph 63; and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 75 and the case-law cited).
- 76 It will therefore be for the Board of Appeal to examine those conditions for the application of Article 8(5) of Regulation No 207/2009, taking into account the degree of similarity between the signs at issue, which, while low, is nonetheless sufficient for the relevant public to make a connection between the mark applied for and the earlier Community trade marks, that is to say, to establish a link between them for the purposes of that provision.
- 77 Accordingly, the second complaint must be upheld.
- 78 Consequently, the first part of the single plea in law must be upheld as well founded.
- 79 The Court additionally considers it appropriate to examine the second part of the single plea in law, in order to settle the present dispute as regards the evidence to be taken into consideration when examining the conditions for applying Article 8(5) of Regulation No 207/2009.

The second part

- 80 By the second part of its single plea in law, Coca-Cola submits that the Board of Appeal erred in refusing to take into consideration, in its assessment under Article 8(5) of Regulation No 207/2009, the evidence relating to the way in which Mitico markets its goods in practice and in which — it may be presumed — it intends to use the mark applied for, that is to say, on a product mimicking the image of the earlier trade marks and the visual cues of Coca-Cola's drinks. In that regard, Coca-Cola argues that the assessment of 'unfair advantage', according to the case-law relating to that provision, is not confined to the mark applied for, but must be based on all the circumstances of the case, including any indications of Mitico's intentions.

- 81 OHIM and Mitico contest Coca-Cola's arguments. In particular, Mitico contends that the evidence produced by Coca-Cola concerning the commercial use of the mark applied for is irrelevant in the circumstances and was rightly disregarded by the Board of Appeal, given that an assessment under Article 8(5) of Regulation No 207/2009 must only take into consideration the mark in respect of which registration is sought.
- 82 The first point to note is that unfair advantage has been taken of the distinctive character or the repute of the earlier mark where there is an attempt at clear exploitation and free-riding on the coat-tails of a famous mark (judgments in *SPA-FINDERS*, paragraph 25 above, EU:T:2005:179, paragraph 51; *nasdaq*, paragraph 26 above, EU:T:2007:131, paragraph 55; and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 63) and that taking unfair advantage of that distinctive character or repute is, therefore, behind the idea of 'the risk of free-riding'. In other words, the risk of free-riding is the risk that the image of the mark with a reputation or the characteristics which it projects will be transferred to the goods covered by the mark applied for, with the result that the marketing of those goods will be made easier by that association with the earlier mark with a reputation (*VIPS*, paragraph 25 above, EU:T:2007:93, paragraph 40, and judgment of 22 May 2012 in *Environmental Manufacturing v OHIM — Wolf (Representation of a wolf's head)*, T-570/10, ECR, EU:T:2012:250, paragraph 27).
- 83 The risk of free-riding is different from 'the risk of dilution' — the notion that detriment to the distinctive character of the earlier mark is usually established where the use of the mark applied for would have the effect that the earlier mark would no longer be capable of arousing immediate association with the goods for which it is registered and used — and 'the risk of tarnishment' — the notion that detriment to the repute of the earlier mark is usually established where the goods for which the mark applied for is used would appeal to the public's senses in such a way that the earlier mark's power of attraction would be diminished thereby (see, to that effect, judgments in *SPA-FINDERS*, paragraph 25 above, EU:T:2005:179, paragraphs 43 and 46; *nasdaq*, paragraph 26 above, EU:T:2007:131, paragraph 55; and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 63).
- 84 According to settled case-law, a finding of a risk of free-riding may, like a finding of a risk of dilution or a risk of tarnishment, be established, in particular, on the basis of logical deductions resulting from an analysis of the probabilities — so long as they are not mere suppositions — and by taking account of the usual practices in the relevant commercial sector as well as all the other circumstances of the case (see, to that effect, judgments in *nasdaq*, paragraph 26 above, EU:T:2007:131, paragraph 54; *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 62; and *Representation of a wolf's head*, paragraph 82 above, EU:T:2012:250, paragraph 52, confirmed, in this respect, by judgment of 14 November 2013 in *Environmental Manufacturing v OHIM*, C-383/12 P, ECR, EU:C:2013:741, paragraph 43).
- 85 In particular, the Court of Justice has ruled that, in the general assessment intended to determine whether unfair advantage was being taken of the distinctive character or the repute of an earlier trade mark, it was necessary, in particular, to take account of the fact that the use of packaging and bottles similar to those of the fragrances that were being imitated was intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances were marketed. The Court also stated that, where a third party was attempting, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of the mark with a reputation in order to create and maintain the image of that mark, the advantage resulting from such use had to be considered to be an advantage that had been unfairly taken of the distinctive character or the repute of the earlier trade mark (judgment of 18 June 2009 in *L'Oréal and Others*, C-487/07, ECR, EU:C:2009:378, paragraphs 48 and 49).

- 86 In the present case, it is common ground that, during the opposition proceedings, Coca-Cola provided evidence relating to Mitico's commercial use of the mark in respect of which registration was sought. That evidence included a witness statement by L. Ritchie, Coca-Cola's lawyer, dated 23 February 2011, to which she appended screen shots of Mitico's website, www.mastercola.com, printed on 16 February 2011. Those screen shots were intended to show that Mitico was using the mark applied for in the course of trade in the form shown below:



- 87 In paragraph 34 of the contested decision, the Board of Appeal stated that, if, on the basis of that evidence, it were proved to be true that Mitico had 'deliberately adopted the same get-up, imagery, stylisation and font and packaging' as Coca-Cola, then the latter 'could reasonably argue that [Mitico] intended to illegitimately take advantage of the repute of the earlier trade marks. However, it could not do so in the context of the specific provision of Article 8(5) [of Regulation No 207/2009], which must only take into account [Mitico]'s mark for which registration is sought'.
- 88 It must be pointed out that the above assessment by the Board of Appeal departs from the case-law cited in paragraphs 82 to 85 above, pursuant to which, in essence, a finding of a risk of free-riding made on the basis of Article 8(5) of Regulation No 207/2009 may be established, in particular, on the basis of logical deductions resulting from an analysis of the probabilities and by taking account of the usual practices in the relevant commercial sector as well as all the other circumstances of the case, including the use, by the proprietor of the mark applied for, of packaging similar to that of the goods of the proprietor of the earlier trade marks. That case-law therefore in no way limits to the mark applied for the relevant evidence to be taken into consideration for the purposes of establishing a risk of free-riding (the risk that unfair advantage will be taken of the distinctive character or the repute of the earlier trade marks), but allows account also to be taken of any evidence intended to facilitate that analysis of the probabilities as regards the intentions of the proprietor of the trade mark applied for, and — *a fortiori* — any evidence relating to the actual commercial use of the mark applied for.
- 89 As it is, the evidence relating to the commercial use of the mark applied for, as produced by Coca-Cola during the opposition proceedings, manifestly constitutes relevant evidence for the purposes of establishing such a risk of free-riding in the present case.
- 90 It must therefore be found that the Board of Appeal erred in disregarding that evidence when applying Article 8(5) of Regulation No 207/2009 in this case.
- 91 That finding cannot be undermined by OHIM's assertion that it was possible for Coca-Cola to make use of that evidence in the context of infringement proceedings based on Article 9(1)(c) of Regulation No 207/2009. That assertion disregards the scheme of that regulation and the purpose of opposition proceedings established in Article 8 thereof, which is to ensure, for reasons of legal certainty and sound administration, that trade marks whose use could successfully be challenged downstream before the courts are not registered upstream (see, to that effect, judgments of 29 September 1998 in *Canon*,

C-39/97, ECR, EU:C:1998:442, paragraph 21; of 6 May 2003 in *Libertel*, C-104/01, ECR, EU:C:2003:244, paragraph 59; and of 13 March 2007 in *OHIM v Kaul*, C-29/05 P, ECR, EU:C:2007:162, paragraph 48).

- 92 However, as has been observed in paragraph 75 above, since the question whether unfair advantage would be taken of the distinctive character or the repute of the earlier trade marks was not examined by the Board of Appeal, it is not for the Court to give a ruling on it, for the first time, in its review of the legality of the contested decision (see, to that effect, judgments in *Edwin v OHIM*, paragraph 75 above, EU:C:2011:452, paragraphs 72 and 73; *VÖLKL*, paragraph 75 above, EU:T:2011:739, paragraph 63; and *BEATLE*, paragraph 25 above, EU:T:2012:177, paragraph 75 and the case-law cited).
- 93 It will therefore be for the Board of Appeal, when examining the conditions for applying Article 8(5) of Regulation No 207/2009 (see paragraph 76 above), to take into consideration the evidence relating to the commercial use of the mark applied for, as produced by Coca-Cola during the opposition proceedings.
- 94 Consequently, the second part of the single plea in law must be upheld as well founded.
- 95 In the light of all of the foregoing, the contested decision must be annulled on the basis of both the first and the second part of the single plea in law.

Costs

- 96 Under Article 87(2) 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.
- 97 Since OHIM and Mitico have been unsuccessful, OHIM must, in accordance with the form of order sought by Coca-Cola, be ordered to bear its own costs and to pay the costs incurred by that company, while Mitico must be ordered to bear its own costs.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

- 1. Annuls the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 29 August 2012 (Case R 2156/2011-2);**
- 2. Orders OHIM to bear its own costs and to pay those incurred by The Coca-Cola Company;**
- 3. Orders Modern Industrial & Trading Investment Co. Ltd (Mitico) to bear its own costs.**

Gratsias

Kancheva

Wetter

Delivered in open court in Luxembourg on 11 December 2014.

[Signatures]