

JUDGMENT OF THE COURT OF FIRST INSTANCE (First Chamber)

2 December 2008 *

In Case T-212/07,

Harman International Industries, Inc., established in Northridge, California (United States), represented by M. Vanhegan, Barrister,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by G. Schneider, acting as Agent,

defendant,

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

Barbara Becker, residing in Miami, Florida (United States), represented by P. Baronikians, lawyer,

* Language of the case: English.

ACTION brought against the decision of the First Board of Appeal of OHIM of 7 March 2007 (Case R 502/2006-1) relating to opposition proceedings between Harman International Industries, Inc. and Barbara Becker,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (First Chamber),

composed of V. Tiili, President, F. Dehousse and I. Wiszniewska-Białecka (Rapporteur), Judges,

Registrar: N. Rosner, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 15 June 2007,

having regard to the response of OHIM lodged at the Registry on 1 October 2007,

having regard to the response of the intervener lodged at the Registry on 14 September 2007,

further to the hearing on 24 June 2008,

gives the following

Judgment

Background to the dispute

- ¹ On 19 November 2002 the intervener, Ms Barbara Becker, filed an application at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) for registration of the Community word mark Barbara Becker 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.
- ² The goods in respect of which registration of the mark was sought are in Class 9 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 have the following description: ‘Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers’.
- ³ The trade mark application was published in *Community Trade Marks Bulletin* No 13/2004 of 29 March 2004.

- 4 On 24 June 2004 the applicant, Harman International Industries, Inc., filed an opposition against registration of the trade mark applied for, for all the goods referred to in the application, pursuant to Article 8(1)(b) and (5) of Regulation No 40/94. The opposition was based on the Community word mark BECKER ONLINE PRO No 1 823 228, registered on 1 July 2002, and on the application for a Community word mark BECKER No 1 944 578 of 2 November 2000, registered on 17 September 2004.
- 5 The goods covered by the earlier trade marks are in Class 9 of the Nice Agreement, and have the following description: ‘electric and electronic apparatus and instruments; apparatus for recording, transmission or reproduction of sound and/or images; magnetic data-carriers; recording discs; data processing equipment; teaching and instructional equipment; computers; computer software; computer hardware; computer peripherals; apparatus and instruments, all for recording, producing, transmitting, editing or processing audio and/or video signals; audio processing apparatus; high fidelity sound and video equipment; loudspeakers, transducers, radios, navigation systems and telematics; in-car audio apparatus and instruments; in-car radios incorporating telephone, navigation systems, telematics (electronic link between motor vehicle and satellite), CD players, MP3 players and/or Internet access; signal processing equipment; digital signal processing equipment; digital voice signal processors; sound processors, amplifiers, pre-amplifiers, power-amplifiers, receivers, audio video receivers; tuners; home cinema processors, DVD players, compact disc players, compact disc and DVD transports, optical disc players and transports; MP3 players; remote controls, sub woofers, microphones, headphones, integrated sound systems, televisions, video monitors, home theatre systems; audio mixing consoles; audio compressors and processors; equalisers; telephones; parts and fittings for all the aforesaid goods; none of the aforesaid goods being cables or parts and fittings for cables’.
- 6 By decision of 15 February 2005, the Opposition Division upheld the opposition on the ground that there was a likelihood of confusion between the marks at issue. It considered that the goods covered by the marks were identical and that the marks were

similar overall, in that, they had an average degree of visual and phonetic similarity and were identical at a conceptual level in so far as they refer to the same surname.

- 7 On 11 April 2006 the intervener filed an appeal with OHIM against the decision of the Opposition Division.
- 8 By decision of 7 March 2007 ('the contested decision'), the First Board of Appeal of OHIM upheld the appeal and annulled the decision of the Opposition Division. The Board of Appeal held that the goods covered by the marks at issue were partly identical and partly similar. It found that the relevant public differed according to the goods concerned, that is to say according to whether they were directed at the general public, directed at professionals, or constituted an intermediate category of goods which may or may not be directed at the general public and professionals depending upon their nature and their subject-matter.
- 9 As regards the signs at issue, the Board of Appeal took into account for reasons of procedural economy, first, the earlier word mark BECKER and, second, the word mark Barbara Becker for which registration was sought. The Board of Appeal found that the signs at issue were visually and phonetically similar only to some extent, given that the first name Barbara is placed at the start of the trade mark applied for. Conceptually, the Board of Appeal considered that the signs at issue were clearly distinct in Germany and the other countries of the European Union. The Board of Appeal considered that the surname Becker was not the dominant and distinctive element of the trade mark applied for, on account of the fact that the relevant public would perceive the mark in its entirety, that is to say Barbara Becker, rather than as a combination of 'Barbara' and 'Becker'. It also noted that Barbara Becker was a celebrity in Germany while the name Becker was generally recognised as an ordinary and widespread surname. Therefore, the Board of Appeal concluded that the differences between the signs at issue were sufficiently significant to rule out a likelihood of confusion.

- 10 In addition, the Board of Appeal found that the condition established in the case-law for the application of Article 8(5) of Regulation No 40/94 — that the degree of similarity between the conflicting marks has to be such that the relevant public establishes a link between them — was not met in the present case.

Forms of order sought

- 11 The applicant claims that the Court should:

- annul the contested decision;
- order the application for the Community trade mark Barbara Becker to be rejected;
- order OHIM to pay the costs.

- 12 OHIM and the intervener contend that the Court should:

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

Law

¹³ At the outset, it should be noted that, by its second head of claim, the applicant requests the Court to order the application for the Community trade mark Barbara Becker to be rejected. However, Article 63(6) of Regulation No 40/94 requires OHIM to take the measures necessary to comply with a judgment of the Community judicature. According to settled case-law, the Court of First Instance cannot issue directions to OHIM (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-277/04 *Vitakraft-Werke Wührmann v OHIM — Johnson's Veterinary Products (VITACOAT)* [2006] ECR II-2211, paragraph 74; and Case T-420/03 *El Corte Inglés v OHIM — Abril Sánchez and Ricote Saugar (Boomerang^{TV})* [2008] ECR II-837, paragraph 31). The applicant's second head of claim is therefore inadmissible.

¹⁴ In support of its action, the applicant relies on two pleas in law, alleging an infringement of Article 8(1)(b) of Regulation No 40/94 and an infringement of Article 8(5) of that regulation.

The first plea in law, alleging an infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

¹⁵ The applicant claims that the name Becker is the dominant and distinctive component in the mark Barbara Becker or, in any event, plays an independent, distinctive role in that mark, and that the marks at issue are conceptually similar since they are based on

the surname Becker without there being any apparent connection between that name and the goods covered. Applying the case-law, it should be held, in the present case, that there is a likelihood of confusion on the ground that, having regard to the identical nature of the goods which the conflicting marks cover, the differences between those marks are not sufficient to prevent a likelihood of confusion. The average consumer would consider that the goods in question bearing the trade mark applied for came from an entity economically linked with the entity from which the goods covered by the earlier trade mark came.

¹⁶ OHIM contends that, according to the case-law, a composite mark, one of whose components is identical or similar to that of another mark, cannot be regarded as similar to that other mark unless that component forms the dominant element within the overall impression created by the composite mark.

¹⁷ There is no general rule that, in cases where a mark applied for consists of two components, one of which is identical to the earlier trade mark comprising a single component, those marks are normally to be regarded as similar. It is necessary that that component has at least an independent distinctive role in the composite trade mark in order to establish the existence of a likelihood of confusion. In the present case the relevant public would not dissect the trade mark applied for but would rather perceive it in its entirety as the name of a woman, Barbara Becker, and neither of its components would have an independent distinctive role or would constitute the dominant element.

¹⁸ Furthermore, the consumer will, as a general rule, pay more attention to the beginning of marks. The first name Barbara contains resonant and broad vowels which, compared with the short vowels of the surname Becker, constitute an individual creation.

19 The Board of Appeal was therefore right to find that, in the present case, there was no likelihood of confusion.

20 The intervener argues that there is a conceptual dissimilarity between the conflicting marks. Accordingly, the applicant cannot rely on the principle that two marks are similar where they have an identical component. That principle applies only where the identical components have no conceptual meaning for the relevant public.

21 Nor can the applicant rely on the case-law according to which it can be assumed that a mark constitutes a variant of an earlier trade mark where it is a combination of the earlier trade mark and a new component, given that, in the present case, in contrast to the circumstances which gave rise to that case-law, the trade mark applied for consists not of the combination of a name of a company and another element, but consists of a proper name. The relevant public will perceive the marks at issue as two different marks that are not related.

Findings of the Court

22 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered 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. In addition, under Article 8(2)(a)(i) of Regulation No 40/94, earlier trade marks means

Community trade marks with a date of application for registration which is earlier than the date of application for registration of the Community trade mark applied for.

23 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. The likelihood of confusion must be assessed globally, according to the perception which the relevant public has of the signs and the goods or services in question, taking into account all factors relevant to the circumstances of the case (Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 and 31, and Case T-112/06 *Inter-Ikea v OHIM — Waibel (idea)*, not published in the ECR, paragraph 32).

24 For the purposes of that global assessment, the perception in the mind of the average consumer of the goods or services in question plays a decisive role. Account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (Case T-355/02 *Mülhens v OHIM — Zirh International (ZIRH)* [2004] ECR II-791, paragraph 41). In addition, the average consumer's level of attention is likely to vary according to the category of goods or services in question (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case T-153/03 *Inex v OHIM — Wiseman (Representation of a cowhide)* [2006] ECR II-1677, paragraph 24). When the average consumer of the goods in question is a specialist, he is likely to take greater care than the average consumer in making his selection (see, to that effect, Case T-211/03 *Faber Chimica v OHIM — Nabersa (Faber)* [2005] ECR II-1297, paragraph 24).

25 In the present case, the protection of the earlier trade mark extends throughout the Community. It is thus the perception of the marks at issue by the consumer of the goods in question in that territory which must be examined. However, it should be borne in mind that, to refuse registration of a Community trade mark, it is sufficient that a

relative ground for refusal, within the meaning of Article 8(1)(b) of Regulation No 40/94, obtains in only part of the Community (*ZIRH*, cited in paragraph 24 above, paragraph 36).

26 In addition, it is not in dispute that the goods in question, intended in part for the general public, in part for professionals, and in part for both the general public and professionals, are goods of a technical nature. Therefore, the public will have a relatively high level of attention.

27 As the identical or similar nature of the goods in question is not in dispute, it is necessary only to proceed to the comparison of the marks at issue.

28 According to the case-law, 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 (Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30, and Case T-317/03 *Volkswagen v OHIM — Nacional Motor (Variant)*, not published in the ECR, paragraph 46).

29 The global assessment of the likelihood of confusion, as far as concerns the visual, phonetic or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 47, and *Representation of a Cowhide*, cited in paragraph 24 above, paragraph 26).

- 30 Where one of the two words which alone constitute a word mark is identical, both visually and phonetically, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen* v *OHIM — Mou Dybfrost (KIAP MOU)* [2003] ECR II-4953, paragraph 39, and Case T-22/04 *Reemark* v *OHIM — Bluenet (Westlife)* [2005] ECR II-1559, paragraph 37).
- 31 In the present case, the earlier word mark BECKER and the trade mark applied for Barbara Becker are in conflict.
- 32 The component 'becker' is both the single constituent component of the mark BECKER and the second of the two components which comprise the mark Barbara Becker. The component 'becker' is thus common to the two marks.
- 33 Visually and phonetically, the marks at issue are of different length and consist of a different number of words. However, the overall impression produced by those marks leads to the finding that they have a certain similarity visually and phonetically on account of their common component, as the Board of Appeal correctly held.
- 34 Conceptually, the Board of Appeal also held, correctly, that the earlier trade mark BECKER will be perceived by the relevant public as a surname and that the mark Barbara Becker will be perceived by the relevant public as a person's name consisting of a first name and a surname, the latter being identical to the surname which comprises

the earlier mark. However, the Board of Appeal's assessment of the relative importance of the component 'becker' compared to the component 'barbara', in the mark Barbara Becker, cannot be upheld.

35 Even if the perception of marks consisting of peoples' names can vary in the different countries in the Community, the case-law states that, at least in Italy, consumers generally attribute greater distinctiveness to the surname than to the forename contained in trade marks (see, to that effect, Case T-185/03 *Fusco v OHIM — Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). It follows that the surname Becker is likely to have attributed to it a stronger distinctive character than the first name Barbara in the mark Barbara Becker.

36 Moreover, the fact that Barbara Becker enjoys celebrity status in Germany as the former wife of Boris Becker does not mean that, conceptually, the marks at issue are not similar. The earlier trade mark BECKER, and the mark Barbara Becker, refer to the same surname Becker. They are thus similar, and all the more so since in a part of the Community the component 'becker' of the trade mark applied for is, as a surname, likely to be attributed a stronger distinctive character than the component 'barbara', which is simply a first name. In that regard, it should be recalled that the relevant public keeps an imperfect picture of the marks at issue in its mind.

37 In addition, according to the case-law, when a composite mark consists of one component juxtaposed to another trade mark, that latter mark, even where it is not the dominant component in the composite mark, may still have an independent distinctive role in the composite mark. In such a case, the composite mark and the other mark can be regarded as similar (see, to that effect, Case C-120/04 *Medion* [2005] ECR I-8551, paragraphs 30 and 37). In the present case, it is clear that the component 'becker' will be

perceived as a surname, which is commonly used to describe a person. It must be held that that component retains an independent distinctive role in the mark Barbara Becker.

38 It follows that, assessing globally the marks at issue and comparing them visually, phonetically and conceptually, the conflicting marks must be held to be similar.

39 Therefore, the Board of Appeal wrongly held that the conflicting marks were clearly distinct.

40 As regards the likelihood of confusion, it should be borne in mind that the identical or similar nature of the goods covered by the marks at issue is not contested and that the mark Barbara Becker and the mark BECKER have visual, phonetic and conceptual similarities. Even if the goods in question were intended for a public with a relatively high level of attention, that public might believe that those goods come from the same undertaking or economically linked undertakings. Therefore, it must be held that there is a likelihood of confusion between the marks at issue.

41 That finding is not invalidated by OHIM's argument that a composite mark and another mark can be considered to be similar only if the common component constitutes the dominant component in the overall impression created by the composite mark. Where a word mark consists of two components, one of which is the single component comprising another word mark, it is not necessary that the common component of the conflicting marks is the dominant component in the overall impression created by the composite mark to find a likelihood of confusion. If such a condition were imposed, even though the common component has an independent distinctive role in the composite mark, the owner of the earlier mark would be deprived of the exclusive right

conferred by that mark (see, to that effect, *Medion*, cited in paragraph 37 above, paragraphs 32 and 33). Since the component 'becker' retains an independent distinctive position in the mark Barbara Becker, it cannot be required, for a finding of a likelihood of confusion, that that component is the dominant component in the overall impression created by that mark.

⁴² The intervener's argument that the case-law on composite marks is not applicable in the present case because the trade mark applied for consists of a first name and a surname also cannot be accepted. The criteria for assessment of a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, where trade marks constituted by a personal name are at issue, are the same as those applicable to the other categories of trade marks. Thus, a sign containing the first name and surname of a natural person may not be registered as a Community trade mark where this is precluded by a relative ground for refusal of registration following a notice of opposition lodged by the proprietor of an earlier trade mark (Case T-40/03 *Murúa Entrena v OHIM — Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 49 and 50).

⁴³ In the light of the foregoing, it must be held that the Board of Appeal erred in law in finding no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. Consequently, the first plea in law raised by the applicant, alleging an infringement of Article 8(1)(b) of Regulation No 40/94, must be sustained.

⁴⁴ Since there is, in the present case, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 and since, to refuse registration of a trade mark, it is sufficient that a relative ground for refusal within the meaning of Article 8 of Regulation No 40/94 exists, the contested decision must be annulled and it is not

necessary to examine whether another relative ground for refusal exists. Therefore, it is not necessary for the Court to examine the applicant's second plea in law.

Costs

⁴⁵ Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. As OHIM has been unsuccessful it must be ordered to pay the applicant's costs, in accordance with the form or order sought by the applicant. As the intervener has been unsuccessful it shall bear its own costs, in accordance with the third paragraph of Article 87(4) of the Rules of Procedure.

On those grounds,

THE COURT OF FIRST INSTANCE (First Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 7 March 2007 (Case R 502/2006-1);**

- 2. Dismisses as inadmissible the application of Harman International Industries, Inc., requesting that the application for registration of Barbara Becker as a Community trade mark be rejected;**
- 3. Orders OHIM to bear its own costs and pay the costs of Harman International Industries;**
- 4. Orders Barbara Becker to bear her own costs.**

Tiili

Dehousse

Wiszniewska-Białecka

Delivered in open court in Luxembourg on 2 December 2008.

[Signatures]