

JUDGMENT OF THE GENERAL COURT (First Chamber)

12 July 2023 (\*)

(EU trade mark – Opposition proceedings – Application for EU figurative mark representing two black geometrical shapes – Earlier EU and national figurative marks mó – Relative ground for refusal – No damage to reputation – Non-similarity of the signs – Article 8(5) of Regulation (EU) 2017/1001)

In Case T- 487/22,

**Multiópticas S. Coop.**, established in Madrid (Spain), represented by M. López Camba and A. Lyubomirova Geleva, lawyers,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by E. Markakis, acting as Agent,

defendant,

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

**Nike Innovate CV**, established in Beaverton, Oregon (United States),

THE GENERAL COURT (First Chamber),

composed of D. Spielmann, President, V. Valančius (Rapporteur) and I. Gâlea, Judges,

Registrar: V. Di Bucci,

having regard to the written part of the procedure,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

**Judgment**

1 By its action under Article 263 TFEU, the applicant, Multiópticas S. Coop., seeks the annulment of the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 2 June 2022 (Case R 1762/2021-4) ('the contested decision').

**Background to the dispute**

2 On 19 November 2019, the other party to the proceedings before the Board of Appeal of EUIPO, Nike Innovate CV, filed an application for registration of an EU trade mark with EUIPO in respect of the following figurative sign:



3 The services in respect of which registration was sought are in Class 35 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Retail store services in relation to eyewear; and online retail ordering services by means of a global computer network in relation to eyewear’.

4 On 15 April 2020, the applicant filed a notice of opposition to registration of the mark applied for in respect of the services referred to in paragraph 3 above.

5 The opposition was based on the following earlier marks:

– the EU figurative mark registered on 29 July 2009 under No 7491095 and covering, inter alia, the services in Class 35 referred to in paragraph 3 above, reproduced below:

– the EU figurative mark registered on 29 July 2009 under No 7490923 and covering, inter alia, the services in Class 35 referred to in paragraph 3 above, reproduced below:

– the EU figurative mark registered on 7 October 2013 under No 11810595 and covering, inter alia, the services in Class 35 referred to in paragraph 3 above, reproduced below:



- the Spanish figurative mark registered on 14 June 2013 under reference M 3066116 and designating, inter alia, the services in Class 35 referred to in paragraph 3 above, reproduced below:

**mó**

6 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) and (5) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

7 Following the request made by the other party to the proceedings before the Board of Appeal of EUIPO, the latter requested the applicant to furnish proof of genuine use of the earlier mark relied on in support of the opposition. The applicant did so within the prescribed period.

8 On 7 September 2021, the Opposition Division rejected the opposition on the basis of Article 8(1)(b) and (5) of Regulation 2017/1001.

9 On 13 October 2021, the applicant filed an appeal with EUIPO against the decision of the Opposition Division.

10 By the contested decision, the Board of Appeal dismissed the appeal. In essence, it upheld the Opposition Division's decision, holding that the signs at issue were not similar. It thus rejected the opposition on the basis of Article 8(1)(b) of Regulation 2017/1001. Having recalled that the conditions set out in Article 8(5) of Regulation 2017/1001 were cumulative and that one of them, in the present case the similarity of the signs at issue, was not satisfied, it also rejected the opposition on the basis of that provision.

#### **Forms of order sought**

11 The applicant claims that the Court should:

- annul the contested decision;

- order EUIPO to pay the costs;
- order Nike Innovate to pay the costs.

12 EUIPO contends that the Court should:

- dismiss the application;
- order the applicant to pay the costs in the event that a hearing is organised.

## **Law**

13 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 8(5) of Regulation 2017/1001, claiming, in essence, that there is a certain similarity between the signs at issue, with the consequence that the Board of Appeal should have assessed whether the other conditions set out in that provision were satisfied.

14 Under Article 8(5) of Regulation 2017/1001, upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2 of that article, the trade mark applied for is not to be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the European Union or, 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.

15 For an earlier trade mark to be afforded the broader protection under Article 8(5) of Regulation 2017/1001, a number of conditions must, therefore, be satisfied. First, the earlier trade mark which is claimed to have a reputation must be registered. Second, that mark and the mark applied for must be identical or similar. Third, it must have a reputation in the European Union, in the case of an earlier EU trade mark, or in the Member State concerned, in the case of an earlier national trade mark. Fourth, the use without due cause of the mark applied for must lead to the risk that unfair advantage might be taken of the distinctive character or the repute of the earlier trade mark or that it might be detrimental to the distinctive character or the repute of the earlier trade mark. As those conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (see judgments of 22 March 2007, *Sigla v OHIM – Elleni Holding (VIPS)*, T- 215/03, EU:T:2007:93, paragraphs 34 and 35 and the case-law cited, and of 31 May 2017, *Alma-The Soul of Italian Wine v EUIPO – Miguel Torres (SOTTO IL SOLE ITALIANO SOTTO il SOLE)*, T- 637/15, EU:T:2017:371, paragraph 29 and the case-law cited).

16 According to the case-law, the concept of similarity between the marks at issue and the criteria to be taken into consideration when assessing the similarity between the marks at issue are the same in the case of a refusal to register a mark applied for because of a likelihood of confusion, pursuant to Article 8(1)(b) of Regulation 2017/1001, and in the case of refusal because of damage to the reputation of an earlier mark, under Article 8(5) of Regulation 2017/1001. In those two situations allowing registration of the mark applied for to be refused, the condition relating to similarity between the mark and the sign requires the existence, in particular, of elements of visual, aural or

conceptual similarity, so that, from the point of view of the relevant public, the marks at issue are at least partially identical as regards one or more relevant aspects (judgment of 27 September 2011, *El Jirari Bouzekri v OHIM – Nike International (NC NICKOL)*, T- 207/09, not published, EU:T:2011:537, paragraph 31; see also judgment of 12 November 2014, *Volvo Trademark v OHIM – Hebei Aulion Heavy Industries (LOVOL)*, T- 524/11, EU:T:2014:944, paragraph 21 and the case-law cited).

17 It is in the light of those considerations that it must be examined whether the Board of Appeal was correct in finding that the signs at issue were not similar and, consequently, rejecting the opposition on the basis of Article 8(5) of Regulation 2017/1001.

18 In the contested decision, the Board of Appeal, as a preliminary point, found that the relevant public was the general public of the European Union, which the applicant does not dispute.

19 Furthermore, the Board of Appeal made a detailed comparison of the signs at issue in the context of the examination of the ground for refusal of registration referred to in Article 8(1)(b) of Regulation 2017/1001. In the context of the examination of the ground referred to in Article 8(5) of Regulation 2017/1001, it based itself on the conclusion from the comparison of the signs carried out in the context of the examination of the first ground for refusal.

20 In that regard, the Board of Appeal upheld the decision of the Opposition Division by holding that the signs at issue were not similar, but dissimilar.

21 In the application, the applicant does not dispute the Board of Appeal's assessments regarding the lack of similarity of the signs at issue under Article 8(1)(b) of Regulation 2017/1001, but rather those under Article 8(5) of Regulation 2017/1001.

22 It submits in that regard that the degree of similarity required in the context of each of those provisions is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation 2017/1001 is conditional upon a finding of a degree of similarity between the signs at issue such that there exists a likelihood of confusion between them on the part of the relevant public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) thereof.

23 Accordingly, in the applicant's submission, the types of damage referred to in Article 8(5) of Regulation 2017/1001 may be the consequence of a lower degree of similarity between the signs at issue, provided that it is sufficient for the relevant public to make a connection between those signs, that is to say, to establish a link between them.

24 In that regard, suffice it to recall that, according to the case-law cited in paragraph 16 above, the concept of similarity between the marks at issue and the criteria to be taken into consideration when assessing the similarity between the marks at issue are the same in the case of a refusal to register a mark applied for because of a likelihood of confusion, pursuant to Article 8(1)(b) of Regulation 2017/1001, and in the case of refusal because of damage to the reputation of an earlier mark, under Article 8(5) of Regulation 2017/1001.

25 Furthermore, in the present case, the applicant claims that there is a certain degree of similarity between the signs at issue.

26 In the context of its assessment of the signs at issue in the contested decision, the Board of Appeal upheld the Opposition Division's decision as regards the mark applied for, in holding that, in view of the principle that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the mark applied for will be perceived as a combination of two interrelated black geometrical shapes, with the result that the relevant public will simply perceive that mark as a fanciful figurative device which does not convey any clear concept.

27 The Board of Appeal also upheld the Opposition Division's findings as regards the earlier marks relied on in support of the opposition, finding, in essence, that, subject to certain incidental typographical nuances, all those earlier marks would be perceived as the letters 'm' and 'o', with an accent on the letter 'o'.

28 The Board of Appeal concluded, first of all, that the signs at issue did not have any element in common, with the result that they were visually dissimilar.

29 Next, the Board of Appeal found that the signs at issue were not phonetically similar, since the mark applied for, which is purely figurative, would not be pronounced.

30 Lastly, the Board of Appeal found that no conceptual comparison of the signs at issue was possible, as neither of the signs conveyed any clear concept.

31 In the applicant's submission, the earlier marks are not mere representations of the letters 'm' and 'o', but, in essence, signs with stylised word elements which may take different forms, with a characteristic font of a certain thickness and black in colour.

32 The applicant disputes the Board of Appeal's findings that the mark applied for will not be perceived by the relevant public as including letters, since it is a fanciful figurative sign without any hidden concept. It submits that the similarity of the signs at issue, even if low, will lead the relevant public to make a connection between the mark applied for and the earlier marks, that is to say, establish a link between them.

33 The applicant claims that the first element of the mark applied for, in particular if it is seen from a certain distance, such as a sign on the entrance to an optician's shop, could be taken not only for the letter 'n', but also for a letter 'm' in lower case, and the circle for a letter 'o', both represented in a relatively bold typeface, consisting of very thick lines in black, which are the main characteristics associated with the earlier marks. Since those marks also form a family of marks, the relevant public could expect them to fit different shapes on the basis of those common elements, namely the letters 'm' and 'o', the bold typeface and the black colour.

34 In support of its line of argument, first, the applicant produces in the application a set of photographs showing in two respects a representation of the signs at issue in the same optician's shop.

35 Second, it claims that consumers will refer to trade marks appearing in opticians' shops in a verbal manner, that is to say, in the present case, by pronouncing the signs at issue 'mo' or 'no'.

36 Third, the applicant relies on information in EUIPO's register relating to the mark applied for, in particular the information in the application for registration of that mark and its treatment by

EUIPO, namely a figurative mark containing word elements. Those elements were referred to by the other party before the Board of Appeal of EUIPO using the word ‘no’ and that party continued to refer to the mark applied for in that manner during the proceedings before the Opposition Division and before the Board of Appeal.

37 Thus, the mark applied for could be perceived by the relevant public as a word element represented with a particular stylisation, in view of the fact that, at one time or another, the other party before the Board of Appeal of EUIPO and EUIPO itself reasoned on the basis of that assumption.

38 Thus, in the applicant’s submission, whether the mark applied for is perceived as ‘no’ or as ‘mo’, there is a certain visual similarity, in that the stylisation of the characters making up that mark resembles that of the earlier marks on which the opposition is based, consisting of a relatively bold typeface, with very thick black lines. The mark applied for is also phonetically similar in that it retains the pronunciation of the average Spanish consumer, namely ‘no’ or ‘mo’.

39 EUIPO disputes the applicant’s arguments.

40 In that regard, it should be borne in mind that the assessment of the visual, phonetic and conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components and that, in that regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, since the assessment of the similarity between two marks does not amount to taking into consideration only one component of a composite mark and comparing it with another mark but, on the contrary, making such a comparison by examining each of the marks in question as a whole (see, to that effect, order of 28 April 2004, *Matratzen Concord v OHIM*, C- 3/03 P, EU:C:2004:233, paragraph 32, and judgment of 6 October 2005, *Medion*, C- 120/04, EU:C:2005:594, paragraphs 28 and 29).

41 In the present case, it must be held, visually, that the mark applied for is characterised as a whole by a juxtaposition of two black geometrical shapes, consisting in a square the upper part of which is rounded and a basic circle to the right, both solid black.

42 As the Board of Appeal correctly found, since no line or clear outline is likely to be perceived as representing letters, the mark applied for is purely figurative.

43 Thus, the relevant public will not associate the combination of the basic geometrical shapes that form the mark applied for with any combination of letters. The applicant has not established that that public would try even to identify a letter in the sign, which would require too many mental steps. Thus, that public will simply perceive the mark applied for as a fanciful figurative device without any word element.

44 By contrast, the earlier marks relied on in support of the opposition all clearly show word elements, namely the letter ‘m’ juxtaposed with the letter ‘o’ with an accent.

45 Thus, even if the word elements of the earlier marks are not devoid of a certain stylisation, in particular as regards the thickness and colour of the font, which varies very slightly depending on those marks, the relevant public will immediately perceive those word elements as such.



46 Furthermore, the set of photographs produced by the applicant in the application, showing in two respects a representation of the signs at issue in the same optician's shop, cannot succeed in establishing a visual similarity between the signs at issue.

47 Whilst it is true that that arrangement establishes – fictitiously – that two opticians' shops are identical, it cannot establish even a low degree of similarity between the signs at issue.

48 Therefore, the Board of Appeal did not make an error of assessment in finding that the signs at issue were visually dissimilar.

49 As regards the phonetic aspects, the applicant's argument based on the word description of the signs at issue by the relevant public is not convincing.

50 A phonetic comparison is not relevant in the context of the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, judgments of 25 March 2010, *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)*, T- 5/08 to T- 7/08, EU:T:2010:123, paragraph 67, and of 7 February 2012, *Dosenbach-Ochsner v OHIM – Sisma (Representation of elephants in a rectangle)*, T- 424/10, EU:T:2012:58, paragraph 45). In that regard, a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks (judgment of 7 February 2012, *Representation of elephants in a rectangle*, T- 424/10, EU:T:2012:58, paragraph 46).

51 In the present case, since the relevant public will not recognise the letters 'n' and 'o' in the mark applied for, it will not describe it by pronouncing those letters, with the result that a phonetic comparison of the signs at issue is not relevant.

52 The transcription of the mark applied for within EUIPO's services in the context of the application for registration and the proceedings before the Opposition Division and the Board of Appeal are not relevant for the purposes of determining the perception of the signs at issue by the relevant public.

53 It is apparent from the case-law that the description given by Nike Innovate in its application for registration or the way in which that mark is designated by EUIPO is not decisive, since the similarity of the marks at issue must be assessed in relation to how the relevant public perceives those marks (see, to that effect, judgments of 22 March 2011, *Ford Motor Company v OHIM – Alkar Automotive (CA)*, T- 486/07, not published, EU:T:2011:104, paragraph 58, and of 12 September 2012, *Duscholux Ibérica v OHIM – Duschprodukter i Skandinavien (duschy)*, T- 295/11, not published, EU:T:2012:420, paragraph 71).

54 Therefore, since the Board of Appeal correctly decided that the mark applied for was purely figurative, it cannot be criticised for not having found any phonetic similarity, since it was unable to pronounce that mark.



55 Conceptually, nor can the Board of Appeal be criticised for having found that there was no conceptual similarity between the signs at issue, since neither of them conveys a clear concept.

56 Where neither of the signs at issue has a meaning taken as a whole, it must be held that a conceptual comparison is not possible (see, to that effect, judgments of 21 September 2017, *Novartis v EUIPO – Meda (Zymara)*, T- 214/15, not published, EU:T:2017:637, paragraph 149, and of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T- 36/17, not published, EU:T:2017:690, paragraph 96).

57 It follows from the foregoing considerations that the Board of Appeal was correct in upholding the Opposition Division’s decision by holding that the signs at issue were not similar, but dissimilar.

58 Pursuant to Article 8(5) of Regulation 2017/1001 and as the applicant has rightly argued, the types of damage referred to in Article 8(5) of Regulation 2017/1001 may of course result from a lower degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant public to make a connection between those marks, that is to say, to establish a link between them (see judgment of 6 July 2022, *ALO Jewelry CZ v EUIPO – Cartier International (ALove)*, T- 288/21, not published, EU:T:2022:420, paragraph 40 and the case-law cited).

59 The fact remains that it is not apparent either from the wording of Article 8(1)(b) and (5) of Regulation 2017/1001 or from the case-law that the similarity between the signs at issue must be assessed in a different way, according to whether the assessment is carried out under one or other of those provisions (see judgment of 6 July 2022, *ALove*, T- 288/21, not published, EU:T:2022:420, paragraph 40 and the case-law cited).

60 In the present case, it is apparent from paragraphs 40 to 57 above that the signs at issue are not similar, but dissimilar, with the result that no – not even a lower degree of – similarity between the signs at issue can be established.

61 The Board of Appeal was therefore correct in holding that the signs at issue were not similar, but dissimilar, under Article 8(5) of Regulation 2017/1001.

62 It should be borne in mind in that regard that the conditions laid down in Article 8(5) of Regulation 2017/1001 are cumulative, with the result that failure to satisfy one of them is sufficient to render that provision inapplicable (see, to that effect, judgment of 28 June 2018, *EUIPO v Puma*, C- 564/16 P, EU:C:2018:509, paragraph 54 and the case-law cited).

63 In the present case, it has been held in paragraphs 40 to 57 above that the Board of Appeal was correct in holding that the signs at issue were not similar, but dissimilar, with the result that one of the cumulative conditions set out in Article 8(5) of Regulation 2017/1001 was not satisfied.

64 Therefore, the Board of Appeal was correct in upholding the Opposition Division’s decision by rejecting the opposition proceedings lodged by the applicant on the basis of Article 8(5) of Regulation 2017/1001, without considering whether the other conditions set out in that provision were satisfied.

65 Accordingly, the single plea in law, alleging infringement of Article 8(5) of Regulation 2017/1001, must be rejected and the action dismissed in its entirety.

### Costs

66 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

67 In the present case, although the applicant has been unsuccessful, EUIPO has applied for the applicant to be ordered to pay the costs only in the event that the parties are summoned to attend an oral hearing. Since no such hearing was held in the present case, it is appropriate to order each party to bear its own costs.

68 The applicant's claim seeking to have Nike Innovate ordered to pay the costs is rejected as manifestly devoid of purpose, inasmuch as the latter is not a party to the proceedings before the Court.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders Multiópticas S. Coop. and the European Union Intellectual Property Office (EUIPO) to bear their own costs.**

Spielmann

Valančius

Gâlea

Delivered in open court in Luxembourg on 12 July 2023.

V. Di Bucci

S. Papasavvas

Registrar

President

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\* Language of the case: English.