

DECISION
of the Fourth Board of Appeal
of 14 December 2022

In case R 1037/2022-4

TUI AG

Hannover, Germany

IR Holder / Appellant

represented by Fischer, Hannover, Germany

v

Planete Tortue

Aix-en-Provence Cedex 3, France

Opponent / Defendant

represented by T Mark Conseils, Paris, France

APPEAL relating to Opposition Proceedings No B 3 069 700 (International Registration No 1 414 450 designating the European Union)

THE FOURTH BOARD OF APPEAL

composed of N. Korjus (Chairperson), C. Govers (Rapporteur) and L. Marijnissen (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 21 December 2017, TUI AG ('the IR holder') designated the European Union in its international registration for the word mark

Captain T

('the IR') for the following list of goods, inasmuch as they are relevant in the present appeal:

Class 25: Clothing, in particular tee-shirts, trousers, gloves [clothing], shirts, blouses, money belts [clothing], belts [clothing]; headgear, in particular hats, caps [headwear], shower caps; scarves; ties [clothing], combinations [clothing]; raincoats; shawls; socks; headbands [clothing]; sweaters; swimsuits; bathing trunks; bathrobes; footwear, in particular sandals, bathing shoes, sports shoes; pockets for clothing; wet suits for water-skiing; aprons [clothing]; masquerade costumes; ski gloves;

Class 28: Games; playthings; parlour games; inflatable plastic toys, in particular in the form of planes and animals; gymnastic and sporting articles; playing cards; scale model toys and their parts; scale model toys, in particular of vehicles, air planes, railways and ships as well as accessories therefor; scale model kits [toys]; golf bags, with or without wheels; golf clubs; golf gloves; divot repair tools [golf accessories]; pitch forks [golf accessories]; landing nets for anglers; ornaments for Christmas trees, except illumination articles and confectionery; candle holders for Christmas trees; confetti; puppets; plush toys; rattles [playthings]; scooters [toys]; roller skates; balls for games; play balloons; jigsaw puzzles; video game machines; portable games with liquid crystal displays; apparatus for games; water wings.

- 2 On 27 July 2018, the mark applied for was republished by the Office.
- 3 On 27 November 2018, Planete Tortue ('the opponent') filed an opposition against the international registration for part of the goods and services, namely against all the goods in Classes 25 and 28 listed in paragraph 1.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 5 The opposition was based on the following earlier rights:



- a) International trade mark registration No 1 204 974, designating, among other territories, Spain, registered on 27 December 2013 for the following list of goods and services:

Class 18: Leather and imitation leather; animal skins, pelts and hides; trunks and suitcases; attaché cases; rucksacks, handbags, school bags, sports bags; beach bags, travel bags, shopping bags, travelling trunks and cases, school satchels; wallets, briefcases, purses not of precious metal, key cases (leather goods); briefcases (leather goods), card holders (wallets); umbrellas, parasols and walking sticks, walking stick seats; bags (envelopes, pouches) of leather for packaging; sling bags for carrying infants; slings for carrying infants;

Class 25: Clothing; footwear (except orthopedic footwear); headgear; underclothing, underwear, dressing gowns, bath robes, bathing suits, pyjamas, dressing gowns (robes), sweaters, skirts, dresses, trousers, tee-shirts, pullovers, jackets, coats, shirts, layettes, neckties, caps, scarves, shawls, belts (clothing), gloves (clothing); sashes for wear, vests, waterproof clothing, hats, caps, socks, stockings, tights, sandals, slippers, boots; suits; clothing of leather; clothing of imitation leather;

Class 35: Advertising; publication of advertising texts; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); bill-posting; rental of advertising time on all communication media; arranging newspaper subscription services; electronic newspaper subscription services; mobile telephone and paging subscription services; services for subscribing to telecommunication services, a global telecommunication network (the Internet) or private access networks (intranets), a provider of computer telecommunications network or data transmissions network access; arranging subscriptions to a database or multimedia server center; arranging subscriptions to telematic services, to data transmission services by telematic means; subscription to a supplier of access to a computer network for telecommunication or data transmission; administrative management and supervision of multimedia and telecommunications networks; import-export agencies; business information agencies; auctions; demonstration of products; presentation of goods on all communication media for retail purposes namely sales promotion; commercial information and advice for consumers (consumer advice shop); administrative processing of purchase orders; organization of exhibitions and trade fairs for commercial or advertising purposes; collection and systematization of data in a central file; retail services, by mail order, by electronic means, via the Internet of clothing and leather goods; the bringing together, for the benefit of others (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, large-scale consumption items in the fields of clothing, jewellery, timepieces, design of interior and exterior decor, interior design and household equipment, beauty and care products, sports articles, games and toys, leather goods, stationery, textile goods, haberdashery articles, printed matter; organization of fashion shows for promotional purposes; arranging business introductions relating to the purchase and sale of products.



- b) French trade mark registration No 4 035 300 for the figurative mark filed on 26 September 2013 and registered on 14 November 2014 for the following list of goods and services:

Class 18: Leather and imitation leather; animal skins, pelts and hides; trunks and suitcases; attaché cases; rucksacks, handbags, school bags, sports bags; beach bags, travel bags, shopping bags, travelling trunks and cases, school satchels; wallets, briefcases, purses not of precious metal, key cases (leather goods); briefcases (leather goods), card holders (wallets); umbrellas, parasols and walking sticks, walking stick seats; bags (envelopes, pouches) of leather for packaging; sling bags for carrying infants; slings for carrying infants;

Class 25: Clothing; footwear (except orthopedic footwear); headgear; underclothing, underwear, dressing gowns, bath robes, bathing suits, pajamas, dressing gowns (robes), sweaters, skirts, dresses, trousers, tee-shirts, pullovers, jackets, coats, shirts, layettes, neckties, caps, scarves, shawls, belts (clothing), gloves (clothing); sashes for wear, vests, waterproof clothing, hats, caps, socks, stockings, tights, sandals, slippers, boots; suits; clothing of leather; clothing of imitation leather;

Class 35: Advertising; publication of advertising texts; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); bill-posting; rental of advertising time on all communication media; arranging newspaper subscription services; electronic newspaper subscription services; mobile telephone and paging subscription services; services for subscribing to telecommunication services, a global telecommunication network (the Internet) or private access networks (intranets), a provider of computer telecommunications network or data transmissions network access; arranging subscriptions to a database or multimedia server center; arranging subscriptions to telematic services, to data transmission services by telematic means; subscription to a supplier of access to a computer network for telecommunication or data transmission; administrative management and supervision of multimedia and telecommunications networks; import-export agencies; business information agencies; auctions; demonstration of products; presentation of goods on all communication media for retail purposes namely sales promotion; commercial information and advice for consumers (consumer advice shop); administrative processing of purchase orders; organization of exhibitions and trade fairs for commercial or advertising purposes; collection and systematization of data in a central file; retail services, by mail order, by electronic means, via the Internet of clothing and leather goods; the bringing together, for the benefit of others (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, large-scale consumption items in the fields of clothing, jewelry, timepieces, design of interior and exterior decor, interior design and household equipment, beauty and care products, sports articles, games and toys, leather goods, stationery, textile goods, haberdashery articles, printed matter; organization of fashion shows for promotional purposes; arranging business introductions relating to the purchase and sale of products.

- 6 By decision of 11 April 2022 ('the contested decision'), the Opposition Division refused protection in the European Union of the IR for all the contested goods on the grounds that there was a likelihood of confusion. The IR holder was ordered to bear the costs of the

proceedings. The Opposition Division gave, in particular, the following grounds for its decision:

- The opposition was first examined in relation to the opponent’s international trade mark registration No 1 204 974 designating Spain.
- The contested *clothing, in particular tee-shirts, trousers, gloves [clothing], shirts, blouses, money belts [clothing], belts [clothing]; headgear, in particular hats, caps [headwear], shower caps; scarves; ties [clothing], combinations [clothing]; raincoats; shawls; socks; headbands [clothing]; sweaters; swimsuits; bathing trunks; bathrobes; footwear, in particular sandals, bathing shoes, sports shoes; wet suits for water-skiing; masquerade costumes; ski gloves* are identical to the opponent’s *clothing, footwear, headgear*, either because they are identically contained in both lists or because the opponent’s goods include the contested goods.
- The contested *aprons [clothing]* are for protecting clothing while cooking and, therefore, fall outside the common definition of the opponent’s *clothing*. However, they are similar because they coincide in their method of use, relevant public, producers and distribution channels.
- The contested *pockets for clothing* are similar to at least a low degree with the opponent’s *bringing together, for the benefit of others (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, large-scale consumption items in the fields of clothing*. The contested goods are parts of clothing and usually target the professional public, such as clothing manufacturers. It should be noted that the opponent’s retail in the field of clothing covers goods that target clothing manufacturers as well as the general public. Therefore, the contested goods and the opponent’s services belong to the same market sector and coincide in their relevant public.
- The contested *games; playthings; parlour games; inflatable plastic toys, in particular in the form of planes and animals; gymnastic and sporting articles; playing cards; scale model toys and their parts; scale model toys, in particular of vehicles, air planes, railways and ships as well as accessories therefor; scale model kits [toys]; golf bags, with or without wheels; golf clubs; golf gloves; divot repair tools [golf accessories]; pitch forks [golf accessories]; puppets; plush toys; rattles [playthings]; scooters [toys]; roller skates; balls for games; play balloons; jigsaw puzzles; video game machines; portable games with liquid crystal displays; apparatus for games; water wing* are mainly games, toys and sports articles. Likewise, the contested *landing nets for anglers* are used for fishing (including recreational fishing activities), which can be considered sporting activity. These are identical to the goods which are the subject of the opponent’s retail services (i.e. sports articles, games and toys). Retail services concerning the sale of specific goods are similar to an average degree to these specific goods. Although the nature, purpose and method of use of these goods and services are not the same, they are similar because they are complementary, and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public. Therefore, these contested goods are similar to the opponent’s *the bringing together, for the benefit of others (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, large-scale consumption items in the fields of sports articles, games and toys* in Class 35.

- The contested *ornaments for Christmas trees, except illumination articles and confectionery; candle holders for Christmas trees; confetti* are decorative items for parties or specific events that target the public at large who wish to embellish their houses or parties. It is quite common to offer these goods for sale in the same specialised shops or in the same sections of department stores or supermarkets where various interior design items are sold. These goods belong to the same market sector and are of interest of the same consumers and, therefore, the contested goods are similar to the opponent's *the bringing together, for the benefit of others (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, large-scale consumption items in the fields of design of interior and exterior decor, interior design* in Class 35.
- The goods and services found to be identical or similar to varying degrees are directed at the public at large and at business customers with specific professional knowledge or expertise. The degree of attention is average.
- The relevant territory is Spain.
- The relevant public will associate the coinciding verbal element 'CAPTAIN' with the Spanish word *capitán*, which means 'a person who leads a group, navigates a ship or a troop, etc.'. Since it has no direct or otherwise weak meaning in relation to the goods in question, it is considered distinctive.
- The earlier mark's letter 'C' depicted in pink merely replicates the initial letter of the first verbal element 'CAPTAIN', especially taking into account their identical stylisation. Although the 'C' is bigger than the remaining verbal elements in the earlier mark, it does not overshadow the clearly perceptible 'CAPTAIN TORTUE' and 'GROUP'. Therefore, the word 'CAPTAIN' and the letter are intended to reinforce each other and to draw attention to the fact that they are linked. In that regard, the fact that the letter precedes the word is of no importance. Moreover, the letter that reproduces the initial letter of the word occupies only an ancillary position in relation to this word.
- The earlier mark's verbal component 'TORTUE' is meaningless for the public and, therefore, distinctive.
- The earlier mark's verbal component 'GROUP' will be perceived as designating a type of undertaking, namely a group of companies, as this word is similar to its Spanish language equivalent, *grupo* and is commonly used in the market. This element is non-distinctive as it merely refers to the corporate structure of the provider/producer of the goods and services.
- The IR's letter 'T', depicted after the coinciding verbal component, has no direct relation to the relevant goods and is, therefore, distinctive.
- The earlier mark's relatively standard fonts depicted in white and pink and the black background will be perceived as purely decorative. Therefore, they are at most weak.
- The earlier mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. The distinctiveness of the earlier mark must be seen as normal, despite the presence of a non-distinctive / at most weak element.
- The signs are visually similar to a below-average degree and aurally and conceptually similar to an average degree, on account of the coinciding verbal components

‘CAPTAIN T’. They differ in the earlier mark’s remaining components, namely the ancillary letter ‘C’, the subsequent component ‘*ORTUE’, the non-distinctive verbal component ‘GROUP’ and its at most weak fonts and background. Although these elements create some differences between the signs, due to their relevance within them, they cannot outweigh the abovementioned coincidences.

- Indeed, it is highly conceivable that the relevant consumer will perceive the IR as a sub-brand, a variation of the earlier mark, configured in a different way according to the type of goods or services that it designates.
 - In its observations, the IR holder stated that the opponent is active in the field of direct clothing sales, while the IR holder is active in the tourism industry. The particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks. Therefore, the IR holder’s argument must be set aside.
 - The IR holder also argued that there are 49 registered trade marks with the element ‘CAPTAIN’ for goods in Class 25. The existence of several trade mark registrations is not particularly conclusive per se, as it does not necessarily reflect the situation in the market. It cannot be assumed that all such trade marks have been effectively used. The evidence filed does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to, trade marks that include ‘CAPTAIN’. Under these circumstances, the IR holder’s claims must be set aside.
 - As this earlier mark leads to the success of the opposition and to the rejection of the IR for all the goods against which the opposition was directed, there is no need to examine the other earlier right invoked by the opponent.
- 7 On 10 June 2022, the IR holder filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 9 August 2022.
- 8 In its response received on 10 October 2022, the opponent requested that the appeal be dismissed.

Submissions and arguments of the parties

- 9 The arguments raised in the statement of grounds filed by IR holder may be summarised as follows:
- The IR is as pure word mark consisting of the word ‘Captain’ and the single letter ‘T’ separated by a space.
 - The pink letter ‘C’ forms an independent element within the earlier mark. The ‘C’ is therefore not merely an ornamental design element. The special size and special colouring (pink) also emphasises the letter ‘C’ in the earlier sign. The letter ‘C’ is also not a synonym for the English word ‘Captain’. It is therefore in any case an ‘eye-catcher’. Due to the fact that it has the same written design as the first letter of ‘Captain’, it is perceived as the letter ‘C’.

- The term ‘GROUP’ may be weakly distinctive and even if that element is omitted, there is no likelihood of confusion of the word elements between the conflicting signs:

C Captain Tortue

Captain T

- Visually, only the word element ‘Captain’ is identical.
- It is correct that the term *tortue* is not descriptive in relation to the goods and services of the earlier mark and therefore, it is also a distinctive element of the mark. The sign is therefore ‘Captain Tortue’.
- The signs are therefore also phonetically different. Only the element ‘Captain T’ is identical. The letter ‘T’ could stand for many things with the initial letter ‘T’ and is not limited to animal species.

10 The arguments raised in response filed by the opponent may be summarised as follows:

- The similarity of the goods and services is not being challenged. Therefore, the findings of the Opposition Division, which had concluded that the goods covered by the IR were similar to the goods and services covered by the earlier marks, have to be confirmed.
- Regarding the similarity of the signs, they present significant visual, aural and conceptual similarities
- The distinctive and dominant element of the earlier mark is ‘CAPTAIN TORTUE’: the word element ‘GROUP’ clearly lacks distinctive character: it is close to its Spanish translation ‘*grupo*’ which refers to a group of companies.
- The Opposition Division has rightly considered that ‘the earlier mark’s letter ‘C’ depicted in pink merely replicates the initial letter of the first verbal element ‘CAPTAIN’, especially taken into account the identical stylization. Although the ‘C’ is bigger than the remaining verbal elements in the earlier mark, it does not overshadow the clearly perceptible ‘CAPTAIN TORTUE’ and ‘GROUP’. The letter that reproduces the initial letter of the word occupies only an ancillary position in relation to this word (15/03/2012, C- 90/11 & C- 91/11, Natur- Aktien- Index / Multi markets Fund, EU:C:2012:147, § 32- 34 and 40).
- From a conceptual point of view, since the signs are both composed of the denomination ‘CAPTAIN’, they will convey the same meaning. The presence of the letter ‘T’ or of the element ‘TORTUE’ does not create significant conceptual differences: the main element remains ‘CAPTAIN’, the second has a secondary role.
- The Opposition Division has rightly considered that a likelihood of confusion exists between the signs.

Reasons

- 11 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 12 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Article 8(1)(b) EUTMR

- 13 Pursuant to Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not 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. The likelihood of confusion includes the likelihood of association with the earlier trade mark. In addition, under Article 8(2)(a)(ii) EUTMR, ‘earlier trade mark’ means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the EU trade mark.
- 14 According to settled case-law, the likelihood of confusion is to be understood as being the risk that the public might believe that the goods or services covered by the earlier mark and those covered by the mark applied for come from the same undertaking or, as the case may be, from economically linked undertakings. The existence of such a risk must be assessed globally, taking into account all factors relevant to the particular case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17, 18; 05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 63, 67; 11/06/2020, C-115/19 P, CCB (fig.) / CB (fig.) et al., EU:C:2020:469, § 54).
- 15 Those factors include, inter alia, the degree of similarity between the signs at issue, the goods or services in question and also the strength of the earlier mark’s reputation and its degree of distinctive character, whether inherent or acquired through use (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 64; 04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 57; 11/06/2020, C-115/19 P, CCB (fig.) / CB (fig.) et al., EU:C:2020:469, § 55).

Relevant public and territory

- 16 In the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of products concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42).
- 17 The Board endorses the findings of the contested decision as regards the relevant public and its level of attention, which findings have not been disputed by the parties. In compliance with the established case-law, the Board will assess the likelihood of confusion taking into consideration the public with the lowest level of attention (08/09/2010, T-152/08, Scorpio nexo, EU:T:2010:357, § 40; 30/05/2013, T-115/12, Roca, EU:T:2013:285, § 46). The level of attention to be taken into consideration is average.
- 18 The opposition is based on an International trade mark registration designating among other territories, Spain. The Board will follow the Opposition Division’s approach and will first examine the opposition in relation to the IR No 1 204 974 designating Spain. The relevant territory for the assessment of the likelihood of confusion is therefore Spain.

Comparison of the goods and services


- 19 The Opposition Division found that the goods at stake are identical and similar to various degrees.

- 20 The identity or similarity between the conflicting goods and services is not disputed by either party.
- 21 The Board has no reason to depart from the findings of the Opposition Division in this respect. The Board therefore refers to, and endorses, these findings, in order to avoid unnecessary repetition, bearing in mind that it may adopt the grounds of a decision taken by the Opposition Division, which thereby form an integral part of the reasons for the Board's own decision (13/09/2010, T-292/08, *Often*, EU:T:2010:399, § 48).

Comparison of the signs

- 22 The global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarities between the signs at issue and be based on the overall impression given by those signs, bearing in mind, in particular, their distinctive and dominant elements. The perception of the signs by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 23; 22/06/1999, C-342/97, *Lloyd Schuhfabrik*, EU:C:1999:323, § 25; 08/05/2014, C-591/12 P, *Bimbo Doughnuts*, EU:C:2014:305, § 21; 22/10/2015, C-20/14, *BGW / BGW*, EU:C:2015:714, § 35).
- 23 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, namely the visual, aural and conceptual aspects (23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 30; 15/12/2010, T-331/09, *Tolposan*, EU:T:2010:520, § 43; 17/03/2021, T-186/20, *The time / Timehouse*, EU:T:2021:147, § 21).
- 24 Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole. Although the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (12/06/2007, C-334/05 P, *Limoncello*, EU:C:2007:333, § 41, 42; 20/09/2007, C-193/06 P, *Quicky*, EU:C:2007:539, § 42, 43; 03/09/2009, C-498/07 P, *La Española*, EU:C:2009:503, § 61, 62; 22/10/2015, C-20/14, *BGW / BGW*, EU:C:2015:714, § 36-37). That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (20/09/2007, C-193/06 P, *Quicky*, EU:C:2007:539, § 43; 12/11/2015, T-449/13, *WISENT / ŻUBRÓWKA BISON BRAND VODKA*, EU:T:2015:839, § 56).

25 The signs to be compared are:

	<p style="text-align: center; font-size: 2em;">Captain T</p>
<p><i>Earlier mark</i></p>	<p><i>IR</i></p>

- 26 The earlier mark consists of the slightly stylised letter ‘C’ or an opened circle, depicted in pink and at the top of the earlier mark, and the verbal elements ‘CAPTAIN TORTUE’ and ‘GROUP’, written in upper-case letters, in two levels, against a black background. The words ‘CAPTAIN TORTUE’ are depicted in white and the word ‘GROUP’ is depicted in pink.
- 27 The IR is a word mark, ‘Captain T’. It must be recalled that the upper-case and lower-case used in the IR does not have any impact on the assessment of the signs’ similarity since it is a word marks and, thus, its protection relates to the word elements and not to the specific figurative or stylistic elements which the mark might have (21/09/2012, T-278/10, Western Gold, EU:T:2012:1257, § 44, 46). The IR does not have a more dominant element.
- 28 For the purpose of assessing the distinctive character of an element of a mark, an assessment must be made of the greater or lesser capacity of that element to identify the goods for which the mark was registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings. In making that assessment, it is necessary to take into account, in particular, the inherent characteristics of that element and to ask whether it is at all descriptive of the goods for which the mark has been registered (03/09/2010, T-472/08, 61 a nossa alegria, EU:T:2010:347, § 47, and the case-law cited).
- 29 The Board recalls that, as regards the figurative elements of the signs, when a trade mark is composed of verbal and figurative elements, the word elements are, in principle, more distinctive than the figurative, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 02/12/2020, T-687/19, Marq, EU:T:2020:582, § 63; 20/10/2021, T-596/20, Dormillo, EU:T:2021:721, § 77).
- 30 In the present case, the graphic features of the earlier mark are limited, so this principle applies even the more so.
- 31 Both signs contain the distinctive English word ‘CAPTAIN’, i.e. ‘a person who leads a group, navigates a ship or a troop, etc.’, which will be understood by the relevant public with the same meaning due to a very close equivalent in Spanish, *capitán*.
- 32 As regards the word element ‘TORTUE’, it does not have any meaning for the Spanish public.
- 33 The letter ‘C’ in the earlier mark, and the last letter ‘T’ in the IR, are distinctive for the relevant Spanish public as they have no descriptive connection to the relevant goods.

- 34 Nonetheless, as stated in the contested decision, the fact that the ‘C’ is bigger than the remaining verbal elements in the earlier mark and is placed at the beginning of the sign, does not mean that it overshadows the clearly perceptible verbal elements ‘CAPTAIN TORTUE’ and ‘GROUP’. In fact, the letter ‘C’ rather reinforces the word ‘CAPTAIN’. Moreover, the letter that reproduces the initial letter of the word occupies only an ancillary position in relation to this word (15/03/2012, C-90/11 & C-91/11, Natur-Aktien-Index / Multi markets Fund, EU:C:2012:147, § 32-34 and 40). Thus, the Opposition Division correctly found that the earlier mark’s overall impression is not dominated by the slightly stylized letter ‘C’.
- 35 The word ‘group’ of the earlier mark is commonly used in Spain and will be perceived as the English equivalent to the Spanish word *grupo* in the sense of ‘a commercial organization consisting of several companies under common ownership’ (www.lexico.com/en/definicion/group), due to the proximity of the terms in English and Spanish. The term ‘group’ has an inherently weak distinctiveness, since it generally serves as a designation for a corporate conglomerate and is therefore normally understood as a descriptive addition to a distinctive element (15/07/2011 T-221/09, ERGO Group, EU:T:2011:393, § 29).
- 36 According to case-law, with a view to evaluating the overall impression created by the signs at issue, the assessment of the visual similarity of those signs may take account, where they are word marks, of aspects such as their length, the letters of which they are composed and the order of those letters (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 55; 20/11/2007, T-149/06, Castellani, EU:T:2007:350, § 54, 25/03/2009, T-402/07, Arcol II, EU:T:2009:85, § 83).
- 37 Visually, the signs coincide in that they both contain the verbal element ‘CAPTAIN’, which is a normally distinctive word in relation to the goods concerned, and in the letter ‘T’. The signs however differ in their respective additional verbal elements, namely the letter ‘C’, and the terms ‘TORTUE’ and ‘GROUP’ as regards the earlier mark and the letter ‘T’ as regards the contested sign. The signs also differ in the figurative elements of the earlier mark, which have no counterpart in the IR. However, in that respect, it should be borne in mind that, when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37).
- 38 All in all, the Board finds that the signs are visually similar to an average degree.
- 39 Aurally, the signs coincide in the pronunciation of the letters /C/A/P/T/A/I/N//T/ and differ in the pronunciation of the additional terms ‘*ORTUE’ and ‘GROUP’ of the earlier mark. In addition, the pronunciation may differ in the sound of the earlier mark’s additional letter ‘C’ if it is pronounced by the relevant consumers. However, as the Opposition Division points out, consumers tend to shorten long signs when pronouncing them. Therefore, it is likely that the public will not pronounce the earlier mark’s letter ‘C’, nor its non-distinctive verbal component ‘GROUP’ (03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342; 03/06/2015, T-544/12, PENSA PHARMA, EU:T:2015:355; 03/06/2015, T-546/12, Pensa, EU:T:2015:355; 30/11/2006; T-43/05, Brothers by Camper, EU:T:2006:370, § 75). It follows that the signs are overall aurally similar to an above average degree.

- 40 Conceptually, as both signs will be associated with the Spanish word *capitán*, they are conceptually highly similar as the other elements do not convey a concept or convey a concept which cannot influence the comparison due to its non-distinctive character.

Distinctiveness of the earlier mark

- 41 The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion. The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.
- 42 Therefore, the assessment of the distinctiveness of the earlier mark rests in its inherent distinctiveness. Since the earlier mark ‘C CAPTAIN TORTUE GROUP’ as a whole does not have a meaning for the Spanish public in relation to the earlier goods, its distinctiveness must be considered normal.

Overall assessment of the likelihood of confusion

- 43 The global assessment of the likelihood of confusion implies some interdependence between the relevant factors, in particular between the similarity of the trade marks and that of the goods or services covered. Accordingly, a low degree of similarity between those goods or services may be offset by a high degree of similarity between the trade marks, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 18/12/2008, C-16/06 P, Mobilix, EU:C:2008:739, § 46; 05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 69).
- 44 It is also settled case-law that the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20).
- 45 As held above, the earlier mark has an average degree of distinctive character for the Spanish public.
- 46 The Board recalls that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place their trust in the imperfect picture of them that they have kept in mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).
- 47 In the present case it was established that the contested goods are identical and similar to different degrees to the earlier goods and services. The level of attention of the relevant public is average. The signs have been found visually similar to an average degree and aurally similar to an above average degree and conceptually highly similar.
- 48 In the overall assessment, taking into account all the relevant factors of the present case, the Board concludes that there is a risk that the relevant public might believe that the goods and services covered by the earlier mark and the goods covered by the IR come from the same undertaking or, as the case may be, from economically-linked undertakings. Therefore, a likelihood of confusion cannot be excluded, as the Opposition Division correctly found.

Conclusion

- 49 As the earlier international trade mark registration No 1 204 974 designating Spain leads to the success of the opposition and to the refusal of protection of the IR for the European Union for all the goods against which the opposition is directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).
- 50 In view of the foregoing, the contested decision is confirmed, and the IR is rejected protection for the European Union in its entirety.

Costs

- 51 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the IR holder, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.
- 52 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 53 As to the opposition proceedings, the Opposition Division ordered the IR holder to bear the opposition fee of EUR 320 and the opponent's representation costs which were fixed at EUR 300. This decision remains unaffected. The total amount for both proceedings is therefore EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the IR holder to bear the opponent's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the IR holder in the opposition and appeal proceedings is EUR 1 170.**

Signed

N. Korjus

Signed

C. Govers

Signed

L. Marijnissen

Registrar:

Signed

H. Dijkema

