

Court of Justice EU, 22 October 2015, BGW v Scholz



TRADEMARK LAW

In the *Securvita* case, there is no general rule for assessing the ancillary nature of a sequence of letters which reproduces the first letter of each of the words in the word combination with which it is juxtaposed

- Consequently, the statement in paragraph 38 of that judgment, which is referred to by the national court, that the letter sequence which reproduces the initial letters of the words comprising that word combination occupies only an ancillary position in relation to the word combination, must be read in that way and cannot be interpreted as being the expression of a general rule for assessing the ancillary nature of a sequence of letters which reproduces the first letter of each of the words in the word combination with which it is juxtaposed.

33 That statement simply makes clear, for the purposes of the application of the grounds for refusal set out in Article 3(1)(b) and (c) of Directive 2008/95, that a letter sequence, even if it is distinctive in itself, may be descriptive when it is reproduced in a composite mark in which it is combined with a descriptive principal expression of which it is perceived to be the abbreviation, which must be determined on a case-by-case basis.

The relevant public's perception varies according to whether what is being assessed is the descriptiveness of a sign or the existence of a likelihood of confusion.

- As the Advocate General stated at point 29 of his Opinion, whereas, in assessing the descriptiveness of a sign, attention is focused on the mental processes which may lead to relationships being established between the sign or its various components and the goods/and or services concerned, in assessing the likelihood of confusion, the examination relates to the processes by means of which the sign is remembered, recognised and recalled and to associative mechanisms.

In the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark of average distinctiveness, and a later mark which reproduces that letter sequence and which is added a descriptive combination of words, with the result that that sequence is perceived by that public as the acronym of that combination of words.

- Accordingly, in the circumstances of the main proceedings, the national court will have to examine, among other factors, whether the links which the relevant public may establish between the letter sequence and the word combination, in particular the possibility that the former may be perceived as an acronym of the latter, are such that that sequence may be perceived and remembered separately by the relevant public in the later mark. Likewise, it will, if necessary, have to assess whether the elements of which the later mark consists, taken as a whole, form a separate logical unit which has a different meaning from that of those elements taken separately.

- Consequently, the answer to the question referred is that Article 4(1)(b) of Directive 2008/95 must be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark consisting of a letter sequence, which is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with the result that that sequence is perceived by that public as the acronym of that combination of words.

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Court of Justice EU, 22 October 2015

(A. Tizzano, F. Biltgen, A. Borg Barthet (rapporteur), E. Levits, M. Berger)

JUDGMENT OF THE COURT (First Chamber)

22 October 2015 (*)

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Further grounds for refusal or invalidity — Word mark — Same letter sequence as an earlier trade mark — Addition of a descriptive word combination — Existence of a likelihood of confusion)

In Case C-20/14,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundespatentgericht (Federal Patents Court, Germany), made by decision of 25 April 2013, received at the Court on 17 January 2014, in the proceedings

BGW Beratungs-Gesellschaft Wirtschaft mbH, formerly BGW Marketing- & Management-Service GmbH

v

Bodo Scholz,

THE COURT (First Chamber),

composed of A. Tizzano, Vice-President of the Court, acting as President of the First Chamber, F. Biltgen, A. Borg Barthet (Rapporteur), E. Levits and M. Berger, Judges,

Advocate General: P. Mengozzi,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– the Polish Government, by B. Majczyna, acting as Agent,

– the European Commission, by G. Braun and F.W. Bulst, acting as Agents,

after hearing [the Opinion of the Advocate General](#) at the sitting on 12 March 2015

gives the following

Judgment

1. This request for a preliminary ruling concerns the interpretation of Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2. The request has been made in proceedings between BGW Beratungs-Gesellschaft Wirtschaft mbH, formerly BGW Marketings- & Management-Service GmbH ('BGW') and Mr Scholz concerning the word mark BGW Bundesverband der deutschen Gesundheitswirtschaft.

Legal context

EU law

3. Article 3 of Directive 2008/95, entitled 'Grounds for refusal or invalidity', provides in paragraph 1(b) and (c):

'1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

...
(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

...'

4. Article 4 of Directive 2008/95, entitled 'Further grounds for refusal or invalidity concerning conflicts with earlier rights', provides in paragraph 1(b):

'1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

...

(b) 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'

German law

5. Paragraph 9(1) of the Law on trade marks (Markengesetz) of 25 October 1994 (BGBl. I p. 3082; 1995 I p. 156; 1996 I p. 682) is worded as follows:

'The registration of a trade mark may be cancelled

...

2. if because of its identity with, or similarity to, a trade mark which has been applied for or registered and which has an earlier priority date 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark, ...'

The facts of the dispute in the main proceedings and the question referred for a preliminary ruling

6. On 11 December 2006, the word mark BGW Bundesverband der deutschen Gesundheitswirtschaft ('the later mark') was registered at the German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) under the number 306 33 835, inter alia for goods and services in Classes 16, 35, 41 and 43 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, corresponding to the following description:

'Class 16: Printed matter;

Class 35: Advertising; business management; business administration; office functions; professional business consultancy; business organisation consultancy; business management consultancy; organisation of exhibitions and trade fairs for commercial or advertising purposes; public relations;

Class 41: Education; providing of training; entertainment; sporting and cultural activities; organisation of exhibitions for cultural or educational purposes; leisure services; operation of health clubs; arranging and conducting of colloquiums; arranging and conducting of conferences, congresses and symposiums; providing sports facilities; rental of sports equipment; services of a sports and gymnastics instructor; arranging and conducting of seminars, workshops, lectures, discussions and courses; leisure consultancy; arranging and conducting of training courses; providing information for visitors to health resorts on sporting and cultural activities; health resort consultancy;

Class 43: Services for providing food and drink and accommodation for visitors; reservation and arrangement of accommodation for visitors, especially visitors to health resorts; services of retirement homes; operation of holiday camps.'

7. BGW brought an opposition to that registration, on the basis of the following German word and figurative mark No 304 06 837 ('the earlier mark');



8. The earlier mark has been registered since 21 July 2004 for goods and services in Classes 16, 35 and 41 of the Nice Agreement corresponding to the following description:

'Class 16: Paper, cardboard and goods made from these materials, so far as included in class 16; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging, so far as included in class 16;

Class 35: Advertising; business management; business administration; office functions;

Class 41: Education; providing of training; entertainment; sporting and cultural activities; publication and editing of newspapers, magazines and books; editing of texts; organisation of fairs and exhibitions for entertainment, cultural and sporting purposes; film production; rental of films; rental of camcorders, sound recorders, television and radio equipment; correspondence courses; arranging and conducting of conferences, congresses and symposiums; online publishing of electronic books and journals; radio entertainment; arranging and conducting of seminars and workshops; translation; instruction and education; arranging and conducting of colloquiums; scriptwriting services; video production; organisation of competitions.'

9. By decision of 2 October 2009, the German Patent and Trade Mark Office upheld the opposition brought by BGW in part and partially cancelled the registration of the later mark on account of the existence of a likelihood of confusion between the two marks at issue. Following an appeal by the proprietor of the later mark, that decision was set aside by decision of 9 January 2012, on the ground that BGW had not demonstrated use of its mark in such a way as to preserve the rights acquired.

10. BGW brought an action for annulment of that decision before the Bundespatentgericht (Federal Patents Court).

11. That court considers, on the basis of numerous documents submitted to it by BGW, that use of the earlier mark in such a way as to preserve the rights acquired has been demonstrated, at least as regards *'printed matter'* and the services of *'advertising'*, *'arranging and conducting of seminars'* and *'organisation of competitions'*, services which BGW supplies principally to undertakings in the health sector, in particular to opticians and hearing aid professionals.

The national court concludes that the marks at issue cover goods which are identical and services which are in part identical and in part similar.

12. As regards the similarity of the marks, the national court takes the view that the overall impression of the earlier mark is dominated exclusively by the sequence of letters *'BGW'*; the figurative component merely emphasises that sequence visually and is irrelevant phonetically. So far as concerns the later mark, the national court takes the view that the word combination *'Bundesverband der deutschen Gesundheitswirtschaft'* is descriptive and is devoid of any distinctive character inasmuch as it merely indicates that the goods and services at issue are provided by an association of health sector undertakings operating nationwide, without enabling the commercial origin of those goods and services to be identified precisely.

13. The national court is inclined to take the view that the overall impression of the later mark is also dominated by the sequence of letters *'BGW'*. In any event, the Bundespatentgericht (Federal Patents Court) adds that, irrespective of how the word combination is to be assessed, that sequence of letters has to be acknowledged as having at least an independent distinctive role within the later mark, in accordance with the judgment in [Medion \(C-120/04, EU:C:2005:594\)](#). Therefore, according to that court, when the relevant public is faced with the later mark, it will recognise the earlier mark, the only difference being that the acronym *'BGW'* — which is in itself meaningless — will now be clarified by the (descriptive) explanatory indication *'Bundesverband der deutschen Gesundheitswirtschaft'*.

14. Consequently, the national court, citing the judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311), takes the view that there is no doubt that, so far as the goods and services referred to in paragraph 11 of the present judgment are concerned, there is a likelihood of confusion between the marks at issue on the part of the relevant public.

15. That court, however, considers that it is not able to give a ruling to that effect on account of the Court's position in the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#), in which the Court held that Article 3(1)(b) and (c) of Directive 2008/95 is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character. Furthermore, the national court states that, in paragraph 38 of that judgment, the Court held that the letter sequence which reproduces the initial letters of the words comprising the word combination occupies only an ancillary position in relation to the word combination.

16. The national court therefore takes the view that it is not possible to state that a component of a composite mark, in this case the sequence of letters 'BGW', understood as an acronym in the later mark, has a dominant or at least independent distinctive role if such a component occupies only an ancillary position.

17. The fact that the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#) concerned the absolute grounds for refusal of registration under Article 3 of Directive 2008/95 does not, according to the Bundespatentgericht (Federal Patents Court), justify a different assessment being made in the main proceedings, which involve the further ground for refusal set out in Article 4(1)(b) of that directive, since the public's perception of a mark cannot, in principle, depend on whether it is a ground for refusal under Article 3 or Article 4 of Directive 2008/95 that is concerned.

18. In those circumstances, the Bundespatentgericht (Federal Patents Court) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

'Must Article 4(1)(b) of Directive 2008/95 be interpreted as meaning that, in the case of identical and similar goods and services, there may be taken to be a likelihood of confusion for the public if a distinctive sequence of letters which dominates the earlier word/figurative trade mark of average distinctiveness is made use of in a third party's later mark in such a way that the sequence of letters is supplemented by a descriptive combination of words relating to it which explains the sequence of letters as an abbreviation of the descriptive words?'

Consideration of the question referred

19. By its question the national court asks, in essence, whether Article 4(1)(b) of Directive 2008/95 is to be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark consisting of a letter sequence, which is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with the result that that sequence is perceived by that public as the acronym of that combination of words.

20. Since the national court has asked that question in the light of the doubts which it has as regards the application of the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#) in assessing the similarity between the marks at issue in the main proceedings, it is therefore appropriate, in the first place, to assess the scope and the relevance of that judgment.

21. In the cases in the main proceedings which gave rise to the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#), what was at issue were two word marks, one consisting of the sign 'Multi Markets Fund MMF' to designate an investment fund which invests in many financial markets and the other

of the sign 'NAI - Der Natur-Aktien-Index' to designate a share index showing the shares of ecologically-oriented undertakings. Inasmuch as, in those cases, the national court took the view that the signs 'MMF' and 'NAI', taken in isolation, were not descriptive for the purposes of Article 3(1)(c) of Directive 2008/95, it asked the Court whether the grounds for refusal under Article 3(1)(b) and/or (c) of that directive were applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is not descriptive in itself but which reproduces the initial letters of each of the words making up that word combination.

22. The question underlying the abovementioned cases therefore consisted in determining whether a composite mark consisting of a word combination attached to its acronym was capable of being registered in the light of Article 3(1)(b) and (c) of Directive 2008/95 and not in assessing, as is the case here, whether there may be a likelihood of confusion, within the meaning of Article 4(1)(b) of that directive, between an earlier mark consisting of a sequence of letters and a later mark, which reproduces that sequence juxtaposed with a word combination.

23. First, the absolute grounds for refusal of registration set out in Article 3(1)(b) and (c) of Directive 2008/95 and the relative grounds for refusal of registration set out in Article 4(1)(b) of that directive pursue different aims and are intended to protect distinct interests.

24. The general interest underlying Article 3(1)(c) of Directive 2008/95 is that of ensuring that signs which describe one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (judgment in [Strigl and Securvita, C-90/11 and C-91/11, EU:C:2012:147, paragraph 31 and the case-law cited](#)).

25. The notion of general interest underlying Article 3(1)(b) of that directive is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the product or service covered by the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see judgment in [Eurohypo v OHIM, C-304/06 P, EU:C:2008:261, paragraph 56 and the case-law cited](#)).

26. By contrast, Article 4(1)(b) of Directive 2008/95 is intended to protect the individual interests of proprietors of earlier marks that come into conflict with the sign applied for and thus guarantees the trade mark as an indication of origin if there is a likelihood of confusion (see, to that effect, judgment in [Medion, C-120/04, EU:C:2005:594, paragraphs 24 and 26 and the case-law cited](#)).

27. Although the relevant public's perception of a sign cannot be dependent on the ground for refusal of registration in question, as the national court rightly observes, the angle from which that perception is viewed, however, varies according to whether what is

being assessed is the descriptiveness of a sign or the existence of a likelihood of confusion.

28. As the Advocate General stated at [point 29 of his Opinion](#), whereas, in assessing the descriptiveness of a sign, attention is focused on the mental processes which may lead to relationships being established between the sign or its various components and the goods/and or services concerned, in assessing the likelihood of confusion, the examination relates to the processes by means of which the sign is remembered, recognised and recalled and to associative mechanisms.

29. Secondly, in paragraph 32 of the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#), the Court pointed out that the three capital letters in each of the signs, namely, 'MMF' and 'NAI', represented the initial letters of the word combinations to which they were attached and that the word combination and the letter sequence, in each case, were intended to clarify each other and to draw attention to the fact that they were linked, each letter sequence being designed to support the public's perception of the word combination, by simplifying its use and by making it easier to remember.

30. In that regard, the Court stated, in paragraphs 37 and 38 of that judgment, that, if the letter sequences at issue were perceived by the relevant public to be abbreviations of the word combinations with which they were juxtaposed, those sequences could not be more than the sum of all the elements of the mark, taken as a whole, even though they might be considered to have distinctive character in themselves. On the contrary, according to the Court, such letter sequences occupied only an 'ancillary position' in relation to the word combination to which they were attached.

31. It is apparent from the grounds of the judgment in [Strigl and Securvita, \(C-90/11 and C-91/11, EU:C:2012:147\)](#) that whether a sign consisting of a letter sequence juxtaposed with a word combination is to be refused registration under Article 3(1)(b) and (c) of Directive 2008/95 must be assessed on a case-by-case basis, according to the perception which the relevant public has of the interdependence between the various elements of the sign and of the sign as a whole.

32. Consequently, the statement in paragraph 38 of that judgment, which is referred to by the national court, that the letter sequence which reproduces the initial letters of the words comprising that word combination occupies only an ancillary position in relation to the word combination, must be read in that way and cannot be interpreted as being the expression of a general rule for assessing the ancillary nature of a sequence of letters which reproduces the first letter of each of the words in the word combination with which it is juxtaposed.

33. That statement simply makes clear, for the purposes of the application of the grounds for refusal set out in Article 3(1)(b) and (c) of Directive 2008/95, that a letter sequence, even if it is distinctive in itself, may be descriptive when it is reproduced in a composite mark in which it is combined with a descriptive principal expression of which it is perceived to be the

abbreviation, which must be determined on a case-by-case basis.

34. It follows from the foregoing that, in the light of the different legal context of the cases which gave rise to the judgment in [Strigl and Securvita \(C-90/11 and C-91/11, EU:C:2012:147\)](#) and the scope which must be attributed to that judgment, the findings in it are not capable of being applied to the main proceedings for the purposes of assessing whether there is a similarity between the two marks at issue.

35. In the second place, it is necessary to bear in mind the case-law according to which the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the marks at issue, be based on the overall impression given by the marks, bearing in mind, in particular, 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 likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (judgment in *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 21 and the case-law cited).

36. 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 (judgment in [OHIM v Shaker, C-334/05 P, EU:C:2007:333, paragraph 41](#), and judgment in [Aceites del Sur-Coosur v Koipe and OHIM, C-498/07 P, EU:C:2009:503, paragraph 61](#)).

37. 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 (judgment in [OHIM v Shaker, C-334/05 P, EU:C:2007:333, paragraphs 41 and 42](#), and judgment in *Nestlé v OHIM*, C-193/06 P, EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

38. In that regard, the Court has stated that, even if the element common to the marks at issue cannot be regarded as dominating the overall impression, it must be taken into account in the assessment of the similarity of those marks, to the extent that it constitutes in itself the earlier mark and retains an independent distinctive role in the trade mark consisting, inter alia, of that element, for which registration is sought. Where a common element retains an independent distinctive role in the composite sign, the overall impression produced by that sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case a likelihood of confusion must be held to be established (judgment in [Medion, C-120/04,](#)

[EU:C:2005:594, paragraphs 30 and 36](#), and order in *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria*, C-23/09 P, EU:C:2010:35, paragraph 45).

39. However, the Court has also stated that a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (judgment in *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 25).

40. It must also be pointed out, as the Advocate General stated at [point 40 of his Opinion](#), that, in principle, even an element which has only a weak distinctive character may dominate the overall impression of a composite mark or have an independent distinctive role in that mark within the meaning of the case-law resulting from the judgment in [Medion \(C-120/04, EU:C:2005:594\)](#), since, it may, because of, *inter alia*, its position in the sign or its size, make an impression on consumers and be remembered by them.

41. In the present case, it will be for the national court to ascertain the overall impression made on the relevant public by the later mark, by means of, *inter alia*, an analysis of the components of that mark and of their relative weight in the perception of that public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion (judgment in *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 34).

42. It is, however, important to point out that the mere fact that the later mark consists of a sign reproducing the letter sequence that constitutes the only word element of the earlier mark and of a combination of words the initial letters of which correspond to that sequence cannot, on its own, preclude a likelihood of confusion with that earlier mark.

43. Accordingly, in the circumstances of the main proceedings, the national court will have to examine, among other factors, whether the links which the relevant public may establish between the letter sequence and the word combination, in particular the possibility that the former may be perceived as an acronym of the latter, are such that that sequence may be perceived and remembered separately by the relevant public in the later mark. Likewise, it will, if necessary, have to assess whether the elements of which the later mark consists, taken as a whole, form a separate logical unit which has a different meaning from that of those elements taken separately.

44. Consequently, the answer to the question referred is that Article 4(1)(b) of Directive 2008/95 must be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark consisting of a letter sequence, which is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with

the result that that sequence is perceived by that public as the acronym of that combination of words.

Costs

45. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (First Chamber) hereby rules:

Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark consisting of a letter sequence, which is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with the result that that sequence is perceived by that public as the acronym of that combination of words.

[Signatures]

* Language of the case: German.

OPINION OF ADVOCATE GENERAL MENGIOZZI

delivered on 12 March 2015 (1)

Case C-20/14

BGW Beratungs-Gesellschaft Wirtschaft mbH,
formerly BGW Marketing- & Management-Service GmbH

v

Bodo Scholz

(Request for a preliminary ruling from the Bundespatentgericht (Germany))

(Approximation of laws — Trade marks — Directive 2008/95/EC — Article 4(1)(b) — Further grounds for refusal or invalidity — Later mark consisting of the juxtaposition of a letter sequence reproducing the word element of the earlier mark and a word combination comprising words whose initial letters use the letters of the sequence — Likelihood of confusion — Criteria for assessment)

1. The request for a preliminary ruling which forms the subject of the present case concerns the interpretation of Article 4(1)(b) of Directive 2008/95/EC (2) and has been made in proceedings concerning the dismissal of the opposition filed by the company BGW Beratungs-Gesellschaft Wirtschaft mbH, formerly BGW Marketing- & Management-Service GmbH ('BGW'), against registration by the Deutsches Patent- und Markenamt ('the DPMA') of the word mark 'BGW Bundesverband der deutschen Gesundheitswirtschaft'.

I – Legal context

2. Directive 2008/95, which entered into force on 28 November 2008, codified Directive 89/104/EEC. (3)

3. Paragraph 1(b) and (c) of Article 3 of Directive 2008/95, entitled ‘Grounds for refusal or invalidity’, provides:

‘1. *The following shall not be registered or if registered shall be liable to be declared invalid:*

...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

...

4. Article 4 of Directive 2008/95, entitled ‘Further grounds for refusal or invalidity concerning conflicts with earlier rights’, provides at paragraph 1(a) and (b):

‘1. *A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:*

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) 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, which includes the likelihood of association with the earlier trade mark.’

II – The dispute in the main proceedings, the question referred for a preliminary ruling and the procedure before the Court of Justice

5. The facts in the main proceedings, as disclosed by the order for reference, may be summarised as follows.

6. On 11 December 2006, the word mark ‘*BGW Bundesverband der deutschen Gesundheitswirtschaft*’ (‘*the later mark*’) was entered in the register of the DPMA for goods in Classes 16, 35, 41 and 43 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. (4) An opposition to registration was filed, based on the following German word and figurative mark:



which has been registered since 21 July 2004 for goods and services in Classes 16, 35 and 41 of the Nice Agreement (‘*the earlier mark*’). (5)

7. By decision of 2 October 2009, the Trade Mark Section for Class 44 of the DPMA, finding that there was a likelihood of confusion between the marks at

issue, cancelled the later mark in part and dismissed the remainder of the opposition. Following an appeal by the proprietor of the later mark, that decision was set aside by decision of 9 January 2012 of the Trade Mark Section for Class 44 of the DPMA, since use of the earlier mark in such a way as to preserve the rights acquired had not been demonstrated.

8. BGW brought an action for annulment of that decision of 9 January 2012 before the Bundespatentgericht.

9. That court has found, on the basis of the material submitted to it by BGW, that use of the earlier mark in such a way as to preserve the rights acquired has been demonstrated, at least as regards ‘*printed matter*’ and the services of ‘*advertising*’, ‘*arranging and conducting of seminars*’ and ‘*organisation of competitions*’, services which are supplied principally to undertakings in the health sector, in particular for opticians and hearing aid professionals. It is of the view that the marks at issue cover identical goods, namely printed matter, and services that are partly identical and partly similar.

10. As regards the similarity of the marks at issue, the referring court has found that the overall impression of the earlier mark is dominated entirely by the letter sequence ‘*BGW*’; visually the figurative element of that mark is negligible and orally it has no effect. The overall impression of the later mark is also dominated by the same letter sequence. According to the referring court, which relies in that regard on case-law of the Bundesgerichtshof, the word combination ‘*Bundesverband der deutschen Gesundheitswirtschaft*’ (‘*Federal Association for Undertakings in the German Healthcare Sector*’), which appears in the later mark, is descriptive and lacks any distinctive character. That word combination merely indicates that the goods and services at issue are provided by an association of health sector undertakings operating nationwide, without identifying precisely the commercial origin of those goods and services. In any event, the Bundespatentgericht has found that, irrespective of how that word combination is to be viewed, the letter sequence ‘*BGW*’ in the later mark has at least an independent distinctive role within the meaning of the judgment in *Medion* (C-120/04, EU:C:2005:594). Therefore, according to that court, when encountering that mark in the market, the relevant public will recognise the earlier mark, the only difference being that the abbreviation ‘*BGW*’ — which is in itself meaningless — will now be clarified by the (descriptive) explanatory indication ‘*Bundesverband der deutschen Gesundheitswirtschaft*’.

11. In those circumstances, the referring court has concluded, citing the judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311), that there is no doubt that, so far as the goods and services indicated in point 9 above are concerned, there is a likelihood of confusion on the part of the relevant public between the marks at issue.

12. That court considers, however, that it is prevented from giving a ruling to that effect by the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147), in which the Court of Justice held that Article 3(1)(b) and (c) of Directive 2008/95 must be interpreted as applying to a word mark consisting of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it uses the first letter of each word of that combination, and if the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations. The Bundespatentgericht notes moreover that, in paragraph 38 of that judgment, it was further stated that the letter sequence which reproduces the initial letters of the words comprising the word combination occupies only an ancillary position in relation to the word combination. In the opinion of that court, it is not possible to say that an element of a composite mark — in this case the letter sequence ‘BGW’ in the later mark, understood as an abbreviation — has a dominant, or at least an independent distinctive role, if that element has only an ancillary position within that mark.

13. The fact that the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147) concerned the grounds for refusal of registration under Article 3 of Directive 2008/95 does not, in the opinion of the Bundespatentgericht, justify a different assessment being made in the present case, which concerns instead the further ground for refusal referred to in Article 4(1)(b) of that directive. The position would be otherwise, in the view of that court, only if the fact that the earlier mark is actually used in the market could be taken into account in the assessment of the overall impression of the later mark, but the Court ruled that out, *inter alia*, in the judgments in *Calvin Klein Trademark Trust v OHIM* (C-254/09 P, EU:C:2010:488, paragraphs 53 and 58) and *Ferrero v OHIM* (C-552/09 P, EU:C:2011:177, paragraph 58).

14. In those circumstances the Bundespatentgericht decided to stay the proceedings before it and to refer the following question to the Court for a preliminary ruling:

‘Must Article 4(1)(b) of Directive 2008/95 be interpreted as meaning that, in the case of identical and similar goods and services, there may be taken to be a likelihood of confusion for the public if a distinctive sequence of letters which dominates the earlier word/figurative trade mark of average distinctiveness is made use of in a third party’s later mark in such a way that the sequence of letters is supplemented by a descriptive combination of words relating to it which explains the sequence of letters as an abbreviation of the descriptive words?’

15. Only the European Commission and the Republic of Poland have submitted written observations. Relying on broadly similar arguments, they propose that the question referred for a preliminary ruling should be answered in the affirmative.

III – Analysis

16. Since the referring court is, in essence, uncertain as to the inferences to be drawn from the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147) for the purposes of assessing the similarity of the marks at issue in the main proceedings, it is appropriate first of all to recall briefly (under A) the content of that judgment, before (under B) defining its scope and assessing its relevance for the purposes of resolving the dispute in the main proceedings. I shall then set out (under C) the criteria for assessing the similarity between the marks at issue for the purposes of establishing any likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95.

A – The judgment in *Strigl and Securvita*

17. In the joined cases that gave rise to the judgment in *Strigl and Securvita* (C-90/11 and C 91/11, EU:C:2012:147), in two requests for a preliminary ruling, referred in two proceedings: the one concerning registration of the sign ‘*Multi Markets Fund MMF*’ as a word mark and the other concerning an application for cancellation of the word mark ‘*NAI — Der Natur-Aktien-Index*’, the Bundespatentgericht asked the Court whether the grounds for refusal under Article 3(1)(b) and/or (c) of Directive 2008/95 were applicable to a word mark consisting of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself but which reproduces the initial letters of the words making up that word combination.

18. In that judgment, in respect of the findings made by the referring court, the Court observed, first of all, that the signs at issue in the main proceedings comprised, first, a word combination designating, in trade, ‘*a type of service and certain characteristics of that service*’, which should be regarded as describing characteristics of the services being offered, within the meaning of Article 3(1)(c) of Directive 2008/95, and, secondly, a letter sequence which, taken in isolation, was not descriptive within the meaning of that provision since it was not, as such, capable ‘*of designating any characteristic of the services concerned*’. (6)

19. Next, after having recalled in paragraphs 30 and 31 of that judgment the objectives pursued by the grounds for refusal of registration provided for in Article 3(1)(b) and (c) of Directive 2008/95, the Court carried out an assessment of the signs at issue in both cases taken together. In that context, it noted that the three capital letters appearing in each of those signs, that is to say, ‘*MMF*’ and ‘*NAI*’, represented the initial letters of the word combinations to which they were attached and that ‘*the word combination and the letter sequence, in each case, [were] intended to clarify each other and to draw attention to the fact that they [were] linked, each letter sequence being ‘designed to support the relevant public’s perception of the word combination, by simplifying its use and by making it easier to remember’ and the fact that the letter sequence preceded or followed the word combination was of no importance.*’ (7)

20. Lastly, the Court held that if the letter sequences at issue in the main proceedings were perceived by the relevant public to be abbreviations of the word combinations to which they were juxtaposed, they '[could not] be more than the sum of all the elements of the mark, taken as a whole, even though they [might] be considered to have distinctive character in themselves'. However, the Court, referring in that regard to point 56 of the Advocate General's Opinion, (8) held that such sequences had only an '*ancillary position*', by comparison with the word combinations to which they were attached. (9)

B – The scope of the judgment in Strigl and Securvita and its relevance for the purposes of resolving the dispute in the main proceedings

21. The referring court considers it is obliged to apply the principles laid down by the Court in the judgment in Strigl and Securvita (C-90/11 and C 91/11, EU:C:2012:147) in assessing the similarity of the marks at issue in the main proceedings. It bases that conclusion on two premisses: first, the later mark is, taken overall, descriptive and, secondly, the assessment of the overall impression a mark is likely to have on the relevant public does not change depending on whether the ground for refusing registration is absolute or relative ('*further*' in the wording of Directive 2008/95).

22. Without calling into question the validity of those premisses, I should like none the less to add the following comments.

1. The premiss that the later mark is descriptive

23. The criteria for assessing whether the ground for refusal of registration is the ground provided for in Article 3(1)(c) of Directive 2008/95 or the identical one provided for in Article 7(1)(c) of Regulation No 207/2009, (10) were laid down by the case-law of the Court of Justice and the General Court some considerable time ago in the light of the public interest underlying that ground for refusal, namely that of preventing signs or indications covered by those provisions from being reserved for a single undertaking by reason of their registration as a trade mark. (11) Thus, it has been held that the distinctiveness of a sign can only be assessed, first, in relation to the goods or services concerned and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services. (12) It has also been held that the signs and indications to which the abovementioned provisions refer are those which may serve in normal usage, from the point of view of the public targeted, to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought, (13) and that, for a sign to be caught by the prohibition set out in those provisions, there must be a sufficiently direct and specific relationship between the sign and the goods and services concerned to enable the relevant public immediately to perceive, without further thought, a description of the category of goods and services concerned or one of their characteristics. (14) Although those criteria have often been applied strictly by the EU

judicature, (15) a sign can be refused registration on the ground of its descriptiveness only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as the description of one of the '*characteristics*' of the goods or the services in respect of which registration is sought, namely '*a property, easily recognisable by the relevant class of persons*'. (16)

24. To what extent are the criteria illustrated above met by the word combination '*Bundesverband der deutschen Gesundheitswirtschaft*' contained in the later mark? In the light of the description of the products and services for which that mark was registered, (17) they appear only in part to come within the health sector understood, moreover, most commonly in the wide sense of '*fitness*' (18) or to be specifically intended for that sector, so it is legitimate to question whether the word combination at issue has '*a sufficiently direct and specific relationship*' with those goods and services, as required by the case-law referred to in the preceding point, to enable the relevant public '*immediately to perceive, without further thought*', a description of the category of goods and services concerned or one of their characteristics.

25. As I stated in point 10 above, the Bundespatentgericht takes the view that the element '*Bundesverband der deutschen Gesundheitswirtschaft*' in the later mark is descriptive, on the basis of the consideration that word combinations which merely indicate that the goods and services at issue are provided by a player in a given sector (in the case of the later mark, an association of health sector undertakings) are, by their very nature, descriptive. That conclusion — which seems, however, to result more from a generalisation than from a specific examination — must, in the scheme of the referring court's reasoning, be interpreted as referring not to all the goods and services for which the later mark was registered, as they appear in the description given in footnote 4 to the present Opinion, but only to the goods and services on which the marks at issue in the present case could actually come into contact in the market, as defined restrictively by the referring court, namely '*printed matter*' and the services '*advertising*', '*arranging and conducting of seminars*' and '*organisation of competitions*', '*supplie[d] principally to undertakings in the health sector, in particular for opticians and hearing aid professionals*'.

26. One may therefore question whether the later mark, like the marks at issue in the main proceedings in Strigl and Securvita (C-90/11 and C 91/11, EU:C:2012:147), falls within the scope of the ground for refusal to register or invalidity provided for in Article 3(1)(c) of Directive 2008/95, as interpreted and applied by the Court in that judgment. Although a negative answer to that question would not in itself exclude the relevance for the purposes of resolving the dispute in the main proceedings of the findings made by the Court in the judgment in Strigl and Securvita (C-90/11 and C 91/11, EU:C:2012:147), it would none the less militate against a full comparison between the cases in the main

proceedings giving rise to that judgment and the case pending before the referring court.

2. The premiss that the assessment of the overall impression that a mark is likely to have on the relevant public does not change depending on whether it is the existence of an absolute ground or of a relative ground for refusal of registration that needs to be established

27. It is settled case-law that both the assessment of the descriptiveness and distinctiveness of a sign and the assessment of the existence of a likelihood of confusion between signs must be made taking into account the same parameters, namely, first, the goods and/or services concerned and, secondly, the perception by the relevant public. (19) Moreover, in both cases the assessment of composite signs must be based on the overall impression given by them. (20) The examination with regard to the existence of absolute grounds for refusal and the examination concerning the existence of relative grounds for refusal, within the meaning of Article 3(1)(b) and (c) and Article 4(1)(b) of Directive 2008/95, respectively (and the corresponding provisions of Regulation No 207/2009), are, therefore, conducted on the basis of common elements.

28. It should be noted, however, first that those provisions pursue different aims and seek to protect distinct interests. Thus, with regard to Article 3(1)(c) of Directive 2008/95 (and Article 7(1)(c) of Regulation No 207/2009), the Court has held that the general interest underlying that provision is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services. (21) The notion of general interest underlying Article 3(1)(b) of the same directive (and Article 7(1)(b) of Regulation No 207/2009) is, however, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. (22) The relative grounds for refusal provided for in Article 4(1) of Directive 2008/95 (and in Article 8(1) of Regulation No 207/2009) for their part relate to cases in which there is no novelty of the sign due to the likelihood of confusion with earlier marks. Although there is a clear link between those grounds for refusal of registration and the indication of the trade mark's origin, (23) they are designed essentially to protect the individual interests of the proprietors of the earlier marks which enter into conflict with the sign sought, which is clear in particular from the fact that they are examined solely upon opposition, whereas absolute grounds for refusal are examined of the Court's own motion. (24)

29. Secondly, although — as the referring court correctly observes — the perception the relevant public has of a sign cannot depend on the ground for refusal of registration taken into account, the angle from which

that perception is viewed varies depending on whether it is a question of assessing the descriptiveness of a sign or the likelihood of confusion between two signs. Although, in the first case, attention is focused on the mental processes likely to lead to establishing a relationship between the sign or its various components and the goods and/or services concerned, in the second case, the examination relates rather to the processes of remembering, recognising and recalling the sign and the mechanisms of association. (25) For composite signs, that examination involves assessing the capacity of the sign's various components to command the attention of the public and to create the overall impression of the sign, thus influencing those mental processes and mechanisms.

30. The two perspectives recalled above are clearly not wholly independent of each other. It is settled case-law, for example, that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark. (26) They do retain their autonomy, however. Thus, despite the rule I have just noted, the General Court has held that *'the weak distinctive character of an element of a complex mark (27) does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them'*. (28)

3. The scope of the judgment in Strigl and Securvita

31. It is clear from the grounds of the judgment in Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147) that whether a sign is to be refused registration under Article 3(1)(b) and (c) of Directive 2008/95 where it is composed of a letter sequence juxtaposed to a word combination must be assessed case by case, not on the basis of objective, predetermined criteria but according to the perception that the relevant public has of the interdependence between the various elements of the sign and of the sign as a whole. Thus, in paragraphs 32 and 34 of that judgment, the Court used a number of arguments derived from an empirical analysis of the signs at issue in order to establish whether there was a link between the various components of those signs that might have a bearing on the way in which they were perceived by the relevant public and on the mental process whereby the public remembered them. That judgment therefore allows no scope for an automatic response but states that the rules of perception should apply. (29)

32. That is the way in which, in my view, it is also necessary to read the statement contained in paragraph 38 of that judgment, noted by the referring court, that *'the letter sequence which reproduces the initial letters of the words comprising that word combination occupies only an ancillary position in relation to the word combination'*. Far from being the expression of a general rule of assessment, that statement merely explains, for the purposes of applying the grounds for refusal provided for in Article 3(1)(b) and (c) of Directive 2008/95, that a letter sequence, even if it is

distinctive in itself, may be descriptive when it is included in a composite mark or is combined with a principal expression which is descriptive, or which is perceived to be an abbreviation, which must be established following an assessment case by case.

33. Furthermore, in view of the context in which it appears, that statement must be interpreted as intending to rule out the possibility that, where the relationship of interdependence described in paragraphs 32 to 35 of the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147) exists between the letter sequences concerned and the word combinations to which they are attached, the distinctiveness of those sequences taken in isolation may reflect on all the signs at issue, conferring on them, despite the descriptiveness of the word combinations, an overall distinctiveness. The reference to the *'ancillary'* nature of the sequences at issue should not therefore be interpreted as an assessment of their capacity, as elements of a composite mark, to capture the attention of the relevant public and enter into the process whereby the sign is remembered and brought to mind.

4. Conclusion as regards the relevance of the judgment in *Strigl and Securvita* for the purposes of resolving the dispute in the main proceedings

34. In view of the different factual and legal contexts of the cases giving rise to the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147) and also the essentially empirical nature of the grounds of that judgment and the scope that should be afforded it, it does not appear possible for the findings contained in it to be transposed automatically to the dispute in the main proceedings. Comparison of the signs at issue in that dispute and assessment of the likelihood of confusion must therefore be carried out according to the criteria normally applied in such matters, which are summarised below.

C – Criteria for assessing the likelihood of confusion of the marks at issue in the main proceedings

35. The likelihood of confusion is the specific condition for the protection conferred by the trade mark, in particular against use by third parties of non-identical signs. The Court has defined that condition as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings. (30)

36. According to recital 11 in the preamble to Directive 2008/95, appreciation of the existence of such a likelihood *'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified'*. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. (31)

37. 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, taking account of the category of goods or services in question and the circumstances in which they are marketed. (32)

38. The visual, aural or conceptual similarities of the signs in question must be the subject of a global appreciation, in which the perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role. (33) In that regard, according to case-law, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details. (34) Thus, that global appreciation must be based on the overall impression given by the marks at issue, bearing in mind, in particular, their distinctive and dominant components. (35) In particular, the Court has held that 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, and that, on the contrary, the comparison must be made by examining each of the marks in question as a whole. (36)

39. Although the overall impression conveyed to the relevant public by a complex 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. (37) In that regard, the Court has also held, since the judgment in *Medion* (C-120/04, EU:C:2005:594) cited by the referring court, that even if the common element of a composite mark cannot be considered as dominant it must be taken into account in the assessment of the similarity of that mark to an earlier mark, to the extent that it constitutes in itself the earlier mark and still has an independent distinctive role in the composite mark. Where a common element still has an independent distinctive role in the composite sign, the overall impression produced by that sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established. (38) The Court has also held that a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately. (39)

40. Lastly, I would point out that in principle an element that has only a weak distinctive character may dominate the overall impression of a composite mark or have an independent distinctive role in that mark within the meaning of the judgment in *Medion* (C-120/04, EU:C:2005:594), since because, in particular, of its position in the sign or its size, *'it may make an impression on consumers and be remembered by them'*. (40)

41. It is on the basis of the principles set out above that the referring court must assess whether the marks at issue are similar and whether there is any likelihood of confusion.

42. It is incumbent in particular on that court to analyse the various components of the later mark, their relative weight within that mark and their respective interactions, in order to determine, through a synthesis of those factors, the overall impression conveyed by that mark that is likely to be remembered by the relevant public. When undertaking such an examination in the circumstances of the main proceedings, where the later mark comprises a sign reproducing the letter sequence constituting the only word element of the earlier mark and a word combination, that court should take into account, among other factors: the respective positions within the sign of the letter sequence and the word combination, (41) and the length (42) and possible descriptiveness of the latter, (43) the link which the relevant public may establish between the sequence and the word combination — in particular the possibility that the former may be perceived as an abbreviation of the latter —, the immediate perception or not of such a link and the consequences of such perception on the recollection of the sign, (44) the type of goods concerned, the characteristics of the relevant public and their level of attention, and the type of recollection concerned (short-, medium- or long-term). Similarly, it will be incumbent in appropriate cases for the referring court to assess whether the fact that the elements of the later mark form a separate logical unit — because of the links which the relevant public may establish between the letter sequence and the word combination — is such as to prevent that letter sequence, which constitutes the common element of the marks at issue, being perceived and remembered separately by that public and therefore contributing significantly to the creation of the overall image of the later mark which that public remembers. In that assessment, and for purposes of evaluating the conceptual similarity between the marks at issue, it will also be necessary to take into account the likelihood that consumers who have seen the earlier mark may attribute to the letter sequence which constitutes that mark the same meaning as it has in the later mark. (45)

43. However, as I stated above, the referring court is not bound in that examination by the findings made by the Court, in a different factual and legal context, in the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147).

IV – Conclusion

44. In the light of all the above considerations, I propose that the Court's answer to the question referred by the Bundespatentgericht should be that:

Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that, in the case of identical or similar goods and services, there may be taken to be a likelihood of confusion for the public between two signs if the

sequence of letters which constitutes the only word element of the earlier sign is made use of in the later word sign and juxtaposed to a descriptive combination of words whose initials use the letters of that sequence in such a way that the latter is perceived by the relevant public as being an abbreviation of the word combination to which it is attached. The existence of a likelihood of confusion must be assessed globally, taking into account all factors relevant to the circumstances of the case.

1 – Original language: French.

2 – Directive of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

3 – Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1988 L 40, p. 1).

4 – The goods and services in question are described as follows:

- *'printed matter'*, in Class 16;
- *'Advertising; business management; business administration; office functions; professional business consultancy; business organisation consultancy; business management consultancy; organisation of exhibitions and trade fairs for commercial or advertising purposes; public relations'*, in Class 35;
- *'Education; providing of training; entertainment; sporting and cultural activities; organisation of exhibitions for cultural or educational purposes; leisure services; operation of health clubs ("Betrieb von Gesundheits-Klubs" in German); arranging and conducting of colloquiums; arranging and conducting of conferences, congresses and symposiums; providing sports facilities; rental of sports equipment; services of a sports and gymnastics instructor; arranging and conducting of seminars, workshops, lectures, discussions and courses; leisure consultancy; arranging and conducting of training courses; providing information for visitors to health resorts on sporting and cultural activities; health resort consultancy'*, in Class 41, and
- *'Services for providing food and drink and accommodation for visitors; reservation and arrangement of accommodation for visitors, especially visitors to health resorts; services of retirement homes; operation of holiday camps'*, in Class 43.

5 – The goods and services are described as follows:

- *'Paper, cardboard and goods made from these materials, so far as included in class 16; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); ...'*, in Class 16;

- 'Advertising; business management; business administration; office functions', in Class 31, and
 - 'Education; providing of training; entertainment; sporting and cultural activities; publication and editing of newspapers, magazines and books; editing of texts; organisation of fairs and exhibitions for entertainment, cultural and sporting purposes; film production; rental of films; rental of camcorders, sound recorders, television and radio equipment; correspondence courses; arranging and conducting of conferences, congresses and symposiums; online publishing of electronic books and journals; radio entertainment; arranging and conducting of seminars and workshops; translation; instruction and education; arranging and conducting colloquiums; scriptwriting services; video production; organisation of competitions', in Class 41.

6 – See paragraphs 25 to 28.
 7 – See paragraphs 32 and 33.
 8 – Opinion of Advocate General Jääskinen in Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147)

9 – See paragraphs 37 and 38.

10 – Council Regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

11 – See judgment in Eurohypo v OHIM (C-304/06 P, EU:C:2008:261, paragraphs 55 and 56 and the case-law cited).

12 – See judgments in Matratzen Concord (C-421/04, EU:C:2006:164, paragraph 24 and the case-law cited), and Eurocool Logistik v OHIM (EUROCOOL) (T-34/00, EU:T:2002:41, paragraph 38).

13 – See, inter alia, judgment in Procter & Gamble v OHIM (C-383/99 P, EU:C:2001:461, paragraph 39).

14 – See, inter alia, judgment in Metso Paper Automation v OHIM (PAPERLAB) (T-19/04, EU:T:2005:247, paragraph 25).

15 – In certain cases even a very tenuous link has been regarded as sufficient: see, inter alia, judgment in Ellos v OHIM (ELLOS) (T-219/00, EU:T:2002:44).

16 – See judgments in Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 31); Koninklijke KPN Nederland (C-363/99, EU:C:2004:86, paragraph 56); and Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraph 50).

17 – That description is given in footnote 4 to the present Opinion.

18 – At issue in 'providing information for visitors to health resorts on sporting and cultural activities', 'health resort consultancy' and 'reservation and arrangement of accommodation for visitors, especially visitors to health resorts' and 'services of retirement homes' or certain services included in Class 41 involving sport and fitness ('sporting and cultural activities'; 'operation of health clubs'; 'providing sport facilities'; 'rental of sports equipment'; 'services of a sports and gymnastic instructor').

19 – So far as assessment of the descriptiveness and distinctiveness of a sign are concerned, see point 23

above. So far as assessment of the likelihood of confusion is concerned, the Court of Justice and the General Court have repeatedly held that '*the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion*'. See, inter alia, judgment in SABEL (C-251/95, EU:C:1997:528, paragraph 23).

20 – See, inter alia, judgment in Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147, paragraph 34). See point 35 et seq. below.

21 – See judgments in Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 25); OHIM v Wrigley (C-191/01 P, EU:C:2003:579, paragraph 31); Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraph 37 and the case-law cited); Strigl and Securvita (C-90/11 and C-91/11, EU:C:2012:147, paragraph 31); and Streamserve v OHIM (STREAMSERVE) (T-106/00, EU:T:2002:43, paragraph 36).

22 – See, inter alia, judgment in Eurohypo v OHIM (C-304/06 P, EU:C:2008:261, paragraph 56 and the case-law cited).

23 – See, inter alia, judgment in Canon (C-39/97, EU:C:1998:442, paragraph 27).

24 – The judgment in adidas and adidas Benelux (C-102/07, EU:C:2008:217) illustrates well that difference in perspective, in particular between the absolute ground for refusal provided for in Article 3(1)(c) of Directive 2008/95 and the relative ground for refusal provided for in Article 4(1)(b) of the same directive. After recalling that the appreciation of the likelihood of confusion depends on numerous elements, the Court stated, in paragraph 30 of that judgment, that '*[t]he fact that there is a need for the sign to be available for other economic operators cannot be one of those relevant factors*'. The Court continued: '*as is apparent from the wording of Article 5(1)(b) of the directive and the case-law cited, the answer to the question as to whether there is a likelihood of confusion must be based on the perception by the public of the goods covered by the mark of the proprietor on the one hand and the goods covered by the sign used by the third party on the other*'.

25 – That means taking into account in particular the level of attention of the public, the types of goods, the possibility of drawing a direct comparison between the marks and therefore the ways in which they are marketed: see, for example, judgment in Lloyd Schuhfabrik Meyer (C-342/97, EU:C:1999:323, paragraphs 26 and 27).

26 – See, inter alia, judgments in Alejandro v OHIM — Anheuser-Busch (BUDMEN) (T-129/01, EU:T:2003:184, paragraph 53) and New Look v OHIM — Naulover (NLSPOORT, NLJEANS, NLACTION and NLCollection) (T-117/03 to T-119/03 and T-171/03, EU:T:2004:293, paragraph 34).

- 27 – In that case it was a figurative element consisting of a drawing of a cowhide, descriptive by inference of the goods concerned (dairy products).
- 28 – See judgments in *AVEX v OHIM — Ahlers (a)* (T-115/02, EU:T:2004:234, paragraph 20) and *Inex v OHIM — Wiseman (Representation of a cowhide)* (T-153/03, EU:T:2006:157, paragraph 32).
- 29 – To that effect, see Sandri, S., *‘Serie di lettere e serie di parole’*, *Giurisprudenza comunitaria del marchio e del design*, Commento tematico II, 2012, pp. 39 to 45.
- 30 – See, inter alia, judgments in *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 17); *Medion* (C-120/04, EU:C:2005:594, paragraphs 24 and 26); and *adidas and adidas Benelux* (C-102/07, EU:C:2008:217, paragraph 28).
- 31 – See judgments in *SABEL* (C-251/95, EU:C:1997:528, paragraph 22); *Marca Mode* (C-425/98, EU:C:2000:339, paragraph 40); *Medion* (C-120/04, EU:C:2005:594, paragraph 27); *adidas and adidas Benelux* (C-102/07, EU:C:2008:217, paragraph 29); *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraph 34); and *Nestlé v OHIM* (C-193/06 P, EU:C:2007:539, paragraph 33).
- 32 – Judgments in *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraph 36) and *Ferrero v OHIM* (C-552/09 P, EU:C:2011:177, paragraph 85).
- 33 – See, inter alia, judgment in *SABEL* (C-251/95, EU:C:1997:528, paragraph 23).
- 34 – See, inter alia, judgments in *SABEL* (EU:C:1997:528, paragraph 23); *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraph 35); and *Nestlé v OHIM* (C-193/06 P, EU:C:2007:539, paragraph 34).
- 35 – See, inter alia, judgments in *SABEL* (C-251/95, EU:C:1997:528, paragraph 23); *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 25); *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraph 35); and *Aceites del Sur-Coosur v Koipe* (C-498/07 P, EU:C:2009:503, paragraph 60).
- 36 – See, inter alia, judgments in *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraph 41) and *Aceites del Sur-Coosur v Koipe* (C-498/07 P, EU:C:2009:503, paragraph 61).
- 37 – Judgments in *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraphs 41 and 42) and *Nestlé v OHIM* (C-193/06 P, EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).
- 38 – See, for that formula, order in *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* (C-23/09 P, EU:C:2010:35, paragraph 45). See also judgment in *Medion* (C-120/04, EU:C:2005:594, paragraphs 30 and 36); order in *Perfetti Van Melle v OHIM* (C-353/09 P, EU:C:2011:73, paragraph 36); my Opinion in *Bimbo v OHIM* (C-591/12 P, EU:C:2014:34, point 24); and judgment in *Bimbo v OHIM* (C-591/12 P, EU:C:2014:305, paragraph 24).
- 39 – See, to that effect, order in *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* (C-23/09 P, EU:C:2010:35, paragraph 47); judgment in *Becker v Harman International Industries* (C-51/09 P, EU:C:2010:368, paragraphs 37 and 38); and order in *Perfetti Van Melle v OHIM* (C-353/09 P, EU:C:2011:73, paragraphs 36 and 37).
- 40 – See, to that effect, judgments in *AVEX v OHIM — Ahlers (a)* (T-115/02, EU:T:2004:234, paragraph 20) and *Inex v OHIM — Wiseman (Representation of a cowhide)* (T-153/03, EU:T:2006:157, paragraph 32).
- 41 – Notwithstanding what the Court held in paragraph 33 of the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147), the fact that a letter sequence precedes or follows the word combination does not seem to me to be necessarily irrelevant, since it may on the contrary affect the way in which the public conceptualises and remembers the sign. In that regard, see also judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311, in particular paragraph 79).
- 42 – See, for example, judgment in *Klein Trademark Trust v OHIM — Zafra Marroquinos (CK CREACIONES KENNYA)* (T-185/07, EU:T:2009:147, paragraph 42).
- 43 – See judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311, paragraph 81).
- 44 – See, so far as the phonetic aspect of the mark is concerned, judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311, paragraph 84). See also judgment in *Klein Trademark Trust v OHIM — Zafra Marroquinos (CK CREACIONES KENNYA)* (T-185/07, EU:T:2009:147, paragraphs 44 and 45).
- 45 – See judgment in *AMS v OHIM — American Medical Systems (AMS Advanced Medical Services)* (T-425/03, EU:T:2007:311, paragraph 86).