

JUDGMENT OF THE GENERAL COURT (First Chamber)

5 March 2020 (*)

(EU trade mark — Opposition proceedings — Application for the EU word mark CORNEREYE — Earlier EU word mark BACKEYE — Relative ground for refusal — Likelihood of confusion — Enhanced distinctiveness of the earlier mark acquired through use — Evidence — Article 8(1)(b) of Regulation (EU) 2017/1001 — Examination of the facts by EUIPO of its own motion — Article 95(1) of Regulation 2017/1001)

In Case T-688/18,

Exploitiemaatschappij De Berghaaf BV, established in Barneveld (Netherlands), represented by R. Pansch, S. Klopschinski and M. von Rospatt, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by A. Lukošiūtė and H. O'Neill, acting as Agents,

defendant,

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

Brigade Electronics Group plc, established in Kent (United Kingdom), represented by M. Hicks, Barrister,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 24 July 2018 (Case R 1966/2017-1), relating to opposition proceedings between Brigade Electronics Group and Exploitiemaatschappij De Berghaaf,

THE GENERAL COURT (First Chamber),

composed of V. Valančius, acting as President, P. Nihoul and U. Öberg (Rapporteur), Judges,

Registrar: A. Juhász-Tóth, Administrator,

having regard to the application lodged at the Court Registry on 21 November 2018,

having regard to the response of EUIPO lodged at the Court Registry on 19 February 2019,

having regard to the response of the intervener lodged at the Court Registry on 11 February 2019,

further to the hearing on 26 November 2019,

gives the following

Judgment

Background to the dispute

- 1 On 3 March 2016, the applicant, Exploitiemaatschappij De Berghaaf BV, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 The mark in respect of which registration was sought is the word mark CORNEREYE.
- 3 The goods in respect of which registration was sought are in Class 9 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Cameras; monitors; apparatus for the recording and reproduction of images; dataprocessing apparatus’.
- 4 The trade mark application was published in *Community Trade Marks Bulletin* No 50/2016 of 14 March 2016.
- 5 On 14 June 2016, the intervener, Brigade Electronics Group plc, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001) to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.
- 6 The opposition was based on, inter alia, the EU word mark BACKEYE, which was filed on 23 June 1997 and registered on 20 August 1999 under the number 570838 and covers goods in Class 9 corresponding to the following description: ‘Closed circuit television apparatus comprising television cameras and television monitors, all for mounting on vehicles or mobile apparatus, and for use in assisting drivers in manoeuvring, parts and fittings for the aforementioned goods; all goods in Class 9’.
- 7 The grounds relied on in support of the opposition were those set out in Article 8(1)(b) of Regulation No 207/2009 (now Article 8(1)(b) of Regulation 2017/1001).
- 8 By decision of 11 August 2017, the Opposition Division upheld the opposition and refused registration of the mark applied for in respect of all of the goods referred to in paragraph 3 above on the ground that there was a likelihood of confusion on the part of the relevant public.
- 9 On 11 September 2017, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the decision of the Opposition Division.
- 10 By decision of 24 July 2018 (‘the contested decision’), the First Board of Appeal of EUIPO dismissed the appeal.
- 11 In the first place, the Board of Appeal found, in paragraph 21 of the contested decision, that the relevant public consisted of the general public in the European Union and of professionals with specific knowledge or expertise in the field of motor vehicles and, in particular, of trucks. It categorised that public’s level of attention as average to high.
- 12 In the second place, after finding that the parties had not disputed that the goods at issue were identical, the Board of Appeal analysed whether the signs at issue were similar. It pointed out, in paragraphs 35 and 36 of the contested decision, that the element ‘eye’, which was common to the signs at issue, clearly alluded to the goods at issue, since it referred to the organ of sight, to sight or to vision, or to an object suggesting or resembling an eye in appearance or shape. Furthermore, the Board of Appeal took the view that the element ‘corner’ in the mark applied for would be understood by the relevant public as indicating that the goods at issue, such as cameras, monitors or data processing apparatus, were positioned on the side of vehicles in order to visualise blind spots. Likewise, it found that the element ‘back’ in the earlier mark alluded, as regard the goods, to the position of the cameras or monitors mounted on the rear of a vehicle, also in order to visualise blind spots.

- 13 From a visual and phonetic standpoint, the Board of Appeal found, in paragraph 43 of the contested decision, that the signs at issue coincided in their final element ‘eye’ and that they differed in the elements situated at the beginning of those signs, namely ‘back’ and ‘corner’, with the result that the degree of similarity between them had to be considered to be low to average. From a conceptual standpoint, the Board of Appeal found, in paragraph 45 of the contested decision, that the signs at issue were similar to an average degree. Furthermore, the Board of Appeal found that the earlier mark had an enhanced degree of distinctiveness in the light of the extensive use of that mark and its reputation, in particular in the United Kingdom, and that the degree of distinctiveness of that mark therefore had to be categorised as high.
- 14 In the light of all of the foregoing considerations and in view, in particular, of the presence of the element in common ‘eye’, the similar or close meanings of the elements ‘back’ and ‘corner’ and the overall identical structures of the signs at issue, the Board of Appeal found, in paragraph 53 of the contested decision, that there was a likelihood of confusion on the part of the relevant public.

Procedure and forms of order sought

- 15 The applicant claims that the Court should:
- annul the contested decision;
 - in the alternative, stay the proceedings, in accordance with Articles 69 to 71 of the Rules of Procedure of the General Court and, in particular Article 69(d) of those Rules of Procedure, until the EU Treaty and the FEU Treaty cease to apply to the United Kingdom, in accordance with Article 50(3) TEU, or until the United Kingdom effectively revokes its notification of withdrawal from the European Union, in accordance with Article 50(2) TEU, and stays in the European Union;
 - order EUIPO to pay the costs.
- 16 EUIPO and the intervener contend that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.

Law

- 17 It must be pointed out at the outset that, by decision of 21 January 2019, the President of the First Chamber of the General Court decided not to grant the request for a stay of proceedings to which the applicant’s second head of claim relates.
- 18 In support of the first head of claim, seeking the annulment of the contested decision, the applicant relies on two pleas in law, alleging: (i) infringement of Article 95(1) of Regulation 2017/1001 and (ii) infringement of Article 8(1)(b) of that regulation. It submits, in essence, that the Board of Appeal did not, in the contested decision, carry out a diligent examination of the relevant facts and that it erred in finding that there was a likelihood of confusion on the part of the relevant public.

Infringement of Article 95(1) of Regulation 2017/1001

- 19 By its first plea, the applicant submits, in essence, that, in the contested decision, the Board of Appeal did not take account of the fact that the evidence submitted by the intervener did not in any way establish that there had been ‘extensive use’ of the earlier mark and that it had acquired enhanced distinctiveness in the United Kingdom. The applicant maintains that, if the Board of Appeal had duly examined the evidence that had been submitted to it, it would not have found that there had been such use of that mark in that territory or that it had a reputation in that territory.

- 20 It must be pointed out that, in paragraph 47 of the contested decision, the Board of Appeal found, in the light of the evidence submitted by the intervener, that the earlier mark had acquired an enhanced degree of distinctiveness through use, at least in the United Kingdom.
- 21 The applicant submits that the documents which the intervener submitted for the purposes of establishing the enhanced distinctiveness of the earlier mark proved, in actual fact, only that there had been very limited use of that mark or of variants thereof in the course of the years that preceded the adoption of the contested decision. It maintains that, thus, only a limited number of invoices, which mention the earlier mark in the form of abbreviations, were submitted by the intervener in respect of the period from 2008 to 2017. Furthermore, it argues that, on account of the differences between the earlier mark as registered and the variants of that mark used by the intervener, the relevant public will tend to perceive the combination of the words ‘back’ and ‘eye’ as a generic term and not as a trade mark.
- 22 According to the applicant, the Board of Appeal also did not take account of the fact that only a small number of the items of evidence of use of the earlier mark concerned the period from 1988 to 2014. It maintains that the majority of the documents submitted by the intervener only concerned the period 1986-1988.
- 23 Lastly, the applicant submits that the Board of Appeal assessed whether other marks belonging to the intervener, such as the marks BACKSCAN, SIDESCAN, FRONTSCAN and SMARTEYE, had a reputation, even though the intervener had never claimed that they had a reputation.
- 24 EUIPO and the intervener dispute the applicant’s arguments.
- 25 It must be borne in mind that Article 95(1) of Regulation 2017/1001 provides that EUIPO is to examine the facts of its own motion. However, in proceedings relating to relative grounds for refusal of registration, EUIPO is to be restricted in that examination to the facts, evidence and arguments provided by the parties and the relief sought.
- 26 In the present case, it must be stated that the applicant’s arguments, which have been referred to in paragraphs 21 to 23 above, seek solely to establish that the Board of Appeal did not correctly assess the evidence of use of the earlier mark. However, since the question as to whether or not the Board of Appeal correctly assessed certain facts, arguments or evidence falls under the examination of the substantive legality of the contested decision and not the proper conduct of the procedure which led to its adoption, it must be held that those arguments on the part of the applicant are ineffective in the context of the first plea, the purpose of which is to establish infringement of the principle, laid down in Article 95(1) of Regulation 2017/1001, that EUIPO is to examine the facts of its own motion (see, to that effect, judgment of 18 May 2017, *Reisswolf v EUIPO (secret.service.)*, T-163/16, not published, EU:T:2017:350, paragraph 21).
- 27 As regards the question of whether the Board of Appeal erred in taking into account the reputation of other marks belonging to the intervener which are different from the earlier mark, it must be stated that the taking into account of the reputation of those marks was not, in any event, capable of having an effect on the Board of Appeal’s findings relating to the high degree of distinctiveness of the earlier mark and the existence of a likelihood of confusion on the part of the relevant public.
- 28 The Board of Appeal referred to the intervener’s marks BACKSCAN, SIDESCAN, FRONTSCAN and SMARTEYE only for the sake of completeness, in paragraph 55 of the contested decision, for the purpose of reinforcing the finding regarding the existence of a likelihood of confusion which it had already made in paragraph 53 of that decision.
- 29 Consequently, the applicant’s arguments do not make it possible to conclude that there has been infringement of Article 95(1) of Regulation 2017/1001.
- 30 The first plea must therefore be rejected.

Infringement of Article 8(1)(b) of Regulation 2017/1001, regarding the existence of a likelihood of confusion

31 By its second plea, the applicant submits, in essence, that the Board of Appeal erred in finding, in the contested decision, that there was a likelihood of confusion.

Preliminary considerations

32 Article 8(1)(b) of Regulation 2017/1001 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must 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. Furthermore, under Article 8(2)(a)(i) of Regulation 2017/1001, ‘earlier trade marks’ means EU trade marks with a date of application for registration which is earlier than the date of application for registration of the EU trade mark in question.

33 According to settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically linked undertakings constitutes a likelihood of confusion. The likelihood of confusion must be assessed globally, taking into account all factors relevant to the circumstances of the case, in particular the recognition of the trade mark on the market, the association which can be made with the used or registered sign and the degree of similarity between the trade mark and the sign and between the goods or services identified (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 22; see, also, judgments of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 32 and the case-law cited, and of 12 June 2019, *Hansson*, C-705/17, EU:C:2019:481, paragraph 41 and the case-law cited).

34 For the purposes of applying Article 8(1)(b) of Regulation 2017/1001, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009, *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraph 42 and the case-law cited; judgment of 22 September 2016, *Sun Cali v EUIPO — Abercrombie & Fitch Europe (SUN CALI)*, T-512/15, EU:T:2016:527, paragraph 45).

35 For the purposes of the comparison of the signs, it is necessary, in each individual case, to analyse the components of a sign and their relative weight in the perception of the public in order to determine, in the light of the particular circumstances of the case, the overall impression made on that public by the signs at issue (see, to that effect, judgment of 8 May 2014, *Bimbo v OHIM*, C-591/12 P, EU:C:2014:305, paragraph 34).

36 Since the similarity between signs at issue, on which the existence of a likelihood of confusion depends, must be assessed on the basis of the overall impression which those signs make on the public which is relevant with regard to the goods or services in question, the proprietor of a word mark or a composite mark cannot claim an exclusive right over only one part of the mark.

37 In that regard, according to the case-law of the Court, 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 (judgments of 23 October 2002, *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)*, T-6/01, EU:T:2002:261, paragraph 30, and of 10 December 2008, *MIP Metro v OHIM — Metronia (METRONIA)*, T-290/07, not published, EU:T:2008:562, paragraph 41).

38 Furthermore, according to settled case-law, the more distinctive the earlier trade mark, the greater will be the likelihood of confusion (judgments of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24, and of 7 July 2017, *Axel Springer v EUIPO — Stiftung Warentest (TestBild)*, T-359/16, not published, EU:T:2017:477, paragraph 76). Conversely, where the elements of similarity between two signs are the result of the fact that they have a weakly distinctive component or a component which has no distinctive character in common, the impact of those elements of similarity on the global assessment of the likelihood of confusion is itself low (see, to that effect, judgments of 30 May 2018, *L’Oréal v EUIPO*, C-519/17 P and C-522/17 P to C-525/17 P, not published, EU:C:2018:348, paragraph 73; of 22 February 2018, *International Gaming Projects v EUIPO — Zitro IP (TRIPLE TURBO)*, T-210/17, not published, EU:T:2018:91, paragraph 73 and the case-law cited; and of

20 September 2018, *Kwizda Holding v EUIPO — Dermapharm (UROAKUT)*, T-266/17, EU:T:2018:569, paragraph 79 and the case-law cited).

- 39 In order to assess whether or not a mark has any distinctive character, the overall impression created by that mark must be taken into consideration. That does not, however, mean that an examination may not first be made of each of the various components of that mark in turn. It may be useful, in the course of the overall assessment, to examine each of the components of the mark concerned (see, to that effect, judgment of 25 October 2007, *Develey v OHIM*, C-238/06 P, EU:C:2007:635, paragraph 82 and the case-law cited).
- 40 Consequently, if the signs coincide only in a non-dominant, descriptive and non-distinctive element and are dissimilar with regard to all the other aspects, even though the goods are similar or in part identical, other factors, such as the weakly distinctive character of the earlier trade mark, the low degree of visual or phonetic similarity and the conceptual dissimilarities between the marks, may be sufficient to exclude any likelihood of confusion, including a likelihood of association, which cannot be based on a non-distinctive element.
- 41 Furthermore, the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, 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 (see judgment of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 35 and the case-law cited).
- 42 It is in the light of those preliminary considerations that it must be examined whether the Board of Appeal was right in finding, in the contested decision, that the signs at issue were similar and, if so, that there was, for the purposes of Article 8(1)(b) of Regulation 2017/1001, a likelihood of confusion on the part of the relevant public.
- 43 Before that examination is carried out, it must be reiterated that, in paragraph 21 of the contested decision, the Board of Appeal found, in essence, that the relevant public consisted of the general public in the European Union and of professionals with specific knowledge or expertise in the field of motor vehicles and, in particular, of trucks. It categorised that public's level of attention as average to high. Since that analysis, which has not, moreover, been disputed by the applicant, appears to be free from any error of assessment, it must be confirmed.
- 44 Furthermore, the Board of Appeal pointed out, in paragraph 24 of the contested decision, that the Opposition Division had correctly compared the goods at issue and that the parties had not disputed that comparison. It carried out that comparison itself in paragraphs 25 and 26 of the contested decision and came to the same conclusion as the Opposition Division, namely that the goods at issue were identical. Since that finding, which has not, moreover, been disputed by the parties, appears to be free from any error of assessment, it must be confirmed.

The comparison of the signs

- 45 In paragraph 42 of the contested decision, the Board of Appeal found that the signs at issue were word marks, which did not have any dominant elements.
- 46 As regards the distinctive character of the elements comprising the signs at issue, the Board of Appeal found, in paragraph 36 of the contested decision, that, in contrast to the Opposition Division's finding that the element 'eye' was not descriptive, that element 'clearly' alluded to the goods at issue since it referred to sight, vision or to an object resembling an eye in appearance or shape.
- 47 Furthermore, the Board of Appeal stated, in paragraphs 39 and 41 of the contested decision, that the elements 'corner' and 'back' in the signs at issue both referred to the position of the goods at issue, namely that they are mounted either on the side or on the rear of vehicles in order to visualise blind spots. It took the view that the distinctive character of the elements 'corner' and 'back' had to be considered to be weak.

- 48 The Board of Appeal found, in paragraph 43 of the contested decision, that the signs at issue coincided in the element ‘eye’, situated at the end of the signs, and differed in the elements ‘back’ and ‘corner’, situated at the beginning of the signs. In paragraph 44 of the contested decision, it took the view that the elements ‘back’ and ‘corner’ were both an indication of position and had ‘some similarity’ with regard to distance. Consequently, it concluded that the degree of visual and phonetic similarity between the signs at issue had to be classified as low to average.
- 49 Furthermore, in paragraph 45 of the contested decision, the Board of Appeal concluded that the signs at issue were conceptually similar to an average degree. In that regard, it found that the meaning of the element ‘eye’ in each of the signs at issue was identical and that the elements ‘back’ and ‘corner’ would have different meanings attributed to them by the relevant public. However, it took the view that those elements would also be perceived by that public as referring to position or as indicating distance and as being semantically connected.
- 50 The applicant criticises the Board of Appeal for not having found that the element ‘eye’, which is common to the signs at issue, was descriptive of the goods in question.
- 51 Furthermore, the applicant submits that the supposed similarity between the elements ‘corner’ and ‘back’ from a semantic point of view, a similarity which derives from the finding that those elements both refer to the position of the goods at issue, cannot be taken into account for the purposes of assessing whether the signs at issue are visually and phonetically similar.
- 52 The applicant adds that the element ‘corner’ in the mark applied for refers to the ‘field of vision’, since it refers to a ‘blind corner’. It maintains that the term ‘back’ has a meaning which is different from that of the term ‘corner’, since it will be understood by the relevant public as meaning ‘situated behind or in the rear’. It submits that, consequently, the Board of Appeal erred in finding that the signs at issue are conceptually similar.
- 53 EUIPO and the intervener dispute the applicant’s arguments.
- 54 In that regard, first, it must be stated that the relevant public will, in the present case, perceive the signs at issue as the juxtaposition in one word of two inherently weak elements, each of which is descriptive, or at least evocative, of the essential characteristics of the goods concerned (see, to that effect, judgment of 15 October 2008, *Air Products and Chemicals v OHIM — Messer Group (Ferromix, Inomix and Alumix)*, T-305/06 to T-307/06, not published, EU:T:2008:444, paragraph 50).
- 55 Secondly, as regards the visual comparison and the phonetic comparison of the signs at issue, it must be pointed out that those signs coincide as regards the final letters ‘e’, ‘y’ and ‘e’, but differ as regards the first part of those signs, namely ‘back’ and ‘corner’ respectively.
- 56 The first part of a trade mark normally has a greater visual impact than its final part, with the result that consumers, in general, pay more attention to the first part of a mark than to the ending, even though such a consideration does not hold true in all cases (see judgment of 20 September 2018, *UROAKUT*, T-266/17, EU:T:2018:569, paragraph 51 and the case-law cited).
- 57 Thirdly, as the applicant rightly states, the terms ‘back’ and ‘corner’ do not convey the same concept, even though those two terms can refer both to the position of a camera on a vehicle or to the concept of field of vision.
- 58 Furthermore, EUIPO acknowledged, at the hearing, that the similarity of the elements ‘corner’ and ‘back’ from a semantic point of view could not be taken into account for the purposes of the visual and phonetic comparisons of the signs at issue.
- 59 Fourthly, it must be stated that the signs at issue differ by one syllable in length. At the hearing, the applicant also stated, without being contradicted in that regard by EUIPO and the intervener, that, in terms of pronunciation, there would be more stress on the beginning of the signs at issue, namely the elements ‘back’ and ‘corner’, than on the element ‘eye’, which constitutes the last syllable in those signs.

- 60 It follows from all of those considerations that the mere presence of the element in common ‘eye’ does not, in itself, make it possible to conclude that there is a similarity between the signs at issue (see judgment of 20 September 2018, *UROAKUT*, T-266/17, EU:T:2018:569, paragraph 52 and the case-law cited; see, also, to that effect, judgment of 10 December 2015, *El Corte Inglés v OHIM*, C-603/14 P, EU:C:2015:807, paragraph 49 and the case-law cited).
- 61 At the hearing, EUIPO, supported by the intervener, stated that, since the element ‘eye’, which is common to the signs at issue, merely alluded to the goods at issue, it could not be considered to be descriptive of those goods.
- 62 The applicant, however, maintained, also at the hearing, and without being contradicted in that regard by EUIPO, that EUIPO had already found, in the context of the procedure relating to the applicant’s application for the EU word mark RADAREYE, which was filed under the number 15240351 in respect of goods in Class 9 that are identical to the goods covered by the mark applied for and in respect of which registration was then refused, that the element ‘eye’ meant ‘something having an appearance suggestive of an eye: as a device (as a photoelectric cell) that functions in a manner analogous to human vision’ or ‘something suggestive of the vertebrate organ or vision, especially the aperture of a camera, a photosensitive device, such as a photoelectric cell’.
- 63 In that regard, it must be pointed out that it is apparent from the case-law that EUIPO is under a duty to exercise its powers in accordance with the general principles of EU law, including the principle of equal treatment and the principle of sound administration. In the light of those principles, EUIPO must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. Those principles must be applied in a way that is consistent with respect for the principle of legality, which means that the examination of any trade mark application must be stringent and full and must be undertaken in each individual case (see judgment of 28 June 2018, *EUIPO v Puma*, C-564/16 P, EU:C:2018:509, paragraph 61 and the case-law cited).
- 64 In the present case, it must be stated that, in view of the goods in question, the element ‘eye’, which is common to the signs at issue, will have the same descriptive meaning for the relevant public as that referred to in paragraph 62 above.
- 65 In that regard, it must be borne in mind that, according to settled case-law, a term with a clear meaning is considered to be descriptive only if there is a sufficiently direct and specific relationship between that term and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgment of 22 June 2005, *Metso Paper Automation v OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraphs 24 and 25 and the case-law cited).
- 66 In the present case, the element ‘eye’ will be perceived by the relevant public as referring directly and specifically to the function of the goods at issue, which is to facilitate or improve vision, while driving, by means of cameras and monitors, and thus as being descriptive of an essential characteristic of those goods.
- 67 Since, as has already been pointed out in paragraph 56 above, the relevant public will tend, in view of the fact that it reads from left to right, to focus on the first element in the signs at issue when it is faced with them (see, to that effect, judgment of 17 March 2004, *El Corte Inglés v OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)*, T-183/02 and T-184/02, EU:T:2004:79, paragraph 81), the mere presence of the descriptive element in common ‘eye’ does not make it possible to conclude that the signs at issue are visually and phonetically or conceptually similar.
- 68 In those circumstances, it must be held that there is no dominant element in the signs at issue and that each of the elements comprising those signs must be held to be descriptive of the goods in question or one of their characteristics, without any of those elements being more distinctive than the other elements.
- 69 In the light of all of those considerations, it must be held that the contested decision is vitiated by an error of assessment, since the Board of Appeal should have found, first, that the signs at issue differed

visually, phonetically and conceptually and, secondly, that each of the elements comprising those signs, considered separately and as a whole, was descriptive of the goods in question or one of their characteristics.

70 If it is established that there is no similarity between the signs at issue, then a likelihood of confusion between those signs can be excluded, without there being any need to carry out a global assessment, taking into account all relevant factors, of the relevant public's perception of the signs and of the goods or services in question (see judgment of 25 November 2015, *Sephora v OHIM — Mayfield Trading (Representation of two undulating vertical lines)*, T-320/14, not published, EU:T:2015:882, paragraph 60 and the case-law cited).

71 However, the intervener submits, in the present case, that, after it was registered, the earlier mark acquired a high degree of distinctiveness through its use in the territory of the United Kingdom.

72 At the hearing the Court asked EUIPO whether the Board of Appeal would have reached the same conclusion regarding the existence of a likelihood of confusion if the earlier mark had not acquired enhanced distinctiveness through use.

73 EUIPO referred, in that regard, to the contested decision, in which the Board of Appeal found that the inherent distinctive character of the earlier mark in relation to the goods at issue was limited, before pointing out, in paragraph 52 of that decision, that, in view of the evidence of use of the earlier mark provided by the intervener, the degree of distinctiveness of that mark had to be considered to be high. Furthermore, in paragraph 46 of the contested decision, the Board of Appeal stated that the degree of distinctiveness of the earlier mark had to be taken into account in the assessment of the likelihood of confusion and that the more distinctive the earlier mark, the greater would be the likelihood of confusion.

74 In that regard, it must be borne in mind that, since the protection of a registered trade mark depends on there being a likelihood of confusion, marks with a highly distinctive character, either per se or because of their recognition on the market, enjoy broader protection than marks with less distinctive character. It follows that registration of a trade mark may have to be refused where the earlier mark is highly distinctive and, in particular, has a strong reputation (see, to that effect, judgment of 29 September 1998, *Canon, C-39/97*, EU:C:1998:442, paragraphs 18 and 19).

75 In order to determine whether a mark has acquired distinctive character through use, the competent authority must carry out an overall assessment of the evidence that may show that the trade mark has become capable of identifying the goods or services concerned as coming from a particular undertaking and therefore to distinguish those goods and services from those of other undertakings (judgment of 15 October 2008, *Powerserv Personalservice v OHIM — Manpower (MANPOWER)*, T-405/05, EU:T:2008:442, paragraph 130).

76 In those circumstances, an overall assessment of the likelihood of confusion must therefore be carried out.

Overall assessment of the likelihood of confusion

77 A global assessment of the likelihood of confusion implies some interdependence between the factors taken into account and, 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 marks, and vice versa. The interdependence of these factors is expressly mentioned in recital 11 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), which states that it is indispensable to give an interpretation of the concept of 'similarity' in relation to the likelihood of confusion (see, to that effect, judgments of 29 September 1998, *Canon, C-39/97*, EU:C:1998:442, paragraph 17, and of 12 June 2019, *Hansson, C-705/17*, EU:C:2019:481, paragraph 43 and the case-law cited).

78 In the present case, after pointing out, inter alia, that the earlier mark had acquired a high degree of distinctiveness through use, at least in the United Kingdom, the Board of Appeal found, in

paragraph 53 of the contested decision, that there was a likelihood of confusion on the part of the relevant public, the level of attention of which had to be considered to be average to high. It based that finding on the identity of the goods at issue and the overall impression of similarity created by the signs at issue, which was connected with the presence of the element in common 'eye', the identical structure of the signs and its view that the elements 'corner' and 'back' were semantically connected.

79 The applicant submits that the Board of Appeal should have concluded that the signs at issue were different overall. According to the applicant, the errors that the Board of Appeal made as regards the degree of similarity between the signs, the supposedly enhanced degree of distinctiveness of the earlier mark and the taking into account of the reputation of marks other than the earlier mark led the Board of Appeal to find, incorrectly, that there was a likelihood of confusion on the part of the relevant public.

80 EUIPO and the intervener dispute the applicant's arguments.

81 As regards the argument relating to the taking into account of the reputation of marks other than the earlier mark, it must be pointed out that that argument must be rejected on the same grounds as those set out in paragraphs 27 and 28 above.

82 In the present case, in view of the descriptiveness of the element in common 'eye', its position at the end of the signs at issue and the resulting lack of visual and phonetic similarity between the signs, it must be held, as the applicant rightly submits, that the visual and phonetic differences that have been found to exist between the signs at issue cannot be offset by any degree of conceptual similarity, the Board of Appeal having itself acknowledged that the elements 'back' and 'corner' had different meanings.

83 Consequently, even if the earlier mark were considered to have enhanced distinctiveness acquired through use, the Board of Appeal should have found that there was no likelihood of confusion on the part of the relevant public.

84 In the light of all of the foregoing, the contested decision must be annulled.

Costs

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

86 Under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal of EUIPO are to be regarded as recoverable costs.

87 Since EUIPO has been unsuccessful, it must be ordered to bear its own costs and to pay those incurred by the applicant, in accordance with the form of order sought by the applicant.

88 Since the intervener has been unsuccessful, it must bear its own costs.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 24 July 2018 (Case R 1966/2017-1);**
- 2. Orders EUIPO to bear its own costs and to pay those incurred by Exploitiemaatschappij De Berghaaf BV, including the costs necessarily incurred by Exploitiemaatschappij De Berghaaf for the purposes of the proceedings before the Board of Appeal of EUIPO;**

3. Orders Brigade Electronics Group plc to bear its own costs.

Valančius

Nihoul

Öberg

Delivered in open court in Luxembourg on 5 March 2020.

E. Coulon

A. M. Collins

Registrar

President

* Language of the case: English.