



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION**  
**of the Grand Board of Appeal**  
**of 18 September 2013**

In Case R 1462/2012-G

**Lifestyle Supplies V.o.F.**

Gildestraat 23

NL-7622 AZ Borne

The Netherlands

Applicant / Appellant

represented by ONEL TRADEMARKS, Leeuwendeldseweg 12, NL-1382 LX Weesp,  
The Netherlands

v

**Ultimate Nutrition, Inc.**

21 Hyde Road

P.O. Box 643

Farmington, Connecticut 06034

United States of America

Opponent / Respondent

represented by BRAND PROTECT LIMITED, Suite B, 2nd Floor, Rowood House,  
Murdock Road, Bicester OX26 4PP, United Kingdom

APPEAL relating to Opposition Proceedings No B 1 745 671 (Community trade mark  
application No 9 209 552)

**THE GRAND BOARD OF APPEAL**

composed of Th. M. Margellos (Chairperson), C. Bartos (Rapporteur), T. de las Heras  
(Member), D. Schennen (Member), C. Rusconi (Member), H. Salmi (Member),  
A. Szanyi Felkl (Member), S. Martin (Member), F. López de Rego (Member)

Registrar: P. López Fernández de Corres

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 29 June 2010, Lifestyle Supplies V.o.F. ('the applicant') sought to register the word mark

### ULTIMATE GREENS

for various goods in Classes 5, 29 and 30. The following goods are relevant for the current appeal proceedings:

Class 5 – Pharmaceutical and veterinary preparations; dietetic substances adapted for medical use, food for babies; food supplements, powders, extracts and ingredients adapted for medical use; nutritional beverages for medical use; vitamins and vitamin preparations; minerals and mineral preparations; homeopathic products and preparations; natural medicines; medicinal herbs and herbal preparations for medical purposes; non-medicated food supplements; dietetic foodstuffs and supplements, not for medical use; food supplements based on herbs, not adapted for medical use; food supplements, not adapted for medical use, including vitamins, minerals and/or herbs;

Class 29 – Food additives, not adapted for medical use, dietetic foodstuffs, not adapted for medical use, not included in other Classes; food concentrates made from herbs, not adapted for medical use; food based on infusions;

Class 30 – Food additives, not adapted for medical use, including vitamins, minerals and/or herbs, not included in other classes; dietetic foods, not adapted for medical use, not included in other Classes; food concentrates made from herbs, not adapted for medical use; food based on infusions; bars and energy bars.

- 2 The application was published in the Community Trade Marks Bulletin No 187/2010 of 5 October 2010.
- 3 On 25 October 2010, Ultimate Nutrition, Inc. filed an opposition against the mark applied for pursuant to Article 8(1)(b) CTMR. The opposition was based on:
  - a) Community trade mark No 6 024 152



filed on 21 June 2007 and registered on 22 May 2008 for 'vitamins and nutritional food supplements' in Class 5.

b) Community trade mark No 8 863 888



filed on 5 February 2010 and registered on 27 July 2010 for ‘vitamins; nutritional supplements; dietary supplements; food for sports and performance enhancement; dietary foods; powdered nutritional supplement drink mixes and meal replacement bars’ in Class 5.

4 After the exchange of observations, by decision of 4 June 2012, the Opposition Division upheld the opposition in part and rejected the application for the goods mentioned at paragraph 1. The parties were ordered to bear their own costs. The contested decision rejecting part of the application is summarized as follows:

- The goods for which the CTM applied for seeks protection are either similar or identical to the goods for which earlier CTM 6 024 152 is protected.
- The signs are similar to the extent that they coincide in the word element ‘ultimate’. On the other hand, they differ in the word element ‘greens’ in the contested sign, and the word element ‘nutrition’ as well as the figurative elements of the earlier marks.
- Aurally, the pronunciation of the marks coincides in the sound of the letters ‘ultimate’, and to that extent the marks are aurally similar. It differs in the sound of the letters ‘nutrition’ of the earlier marks and the sound of the letters ‘greens’.
- Conceptually, the signs as a whole do not have any meaning from the perspective of the Spanish public. However, a part of the Spanish public will associate the English word ‘ultimate’ (the highest or most significant; elemental; final or total) with the Spanish word ‘*última*’ (last, latest). To that extent, the signs are, at least for a part of the public, conceptually similar, since they all allude to the concept of ‘last’ or ‘latest’. The word ‘nutrition’ is almost identical to the Spanish word ‘*nutrición*’ and its concept will therefore be understood by Spanish speakers. The word element ‘greens’ in the contested sign on the other hand has no meaning for the relevant part of the public. Finally, regarding the figurative elements in earlier mark CTM No 8 863 888, it is likely that at least a part of the public will associate the laurel wreath with excellence and the depiction of the world as geographical. None of these concepts are present in the contested sign.
- Taking into account the above-mentioned visual, aural and, at least for a part of the relevant public, conceptual coincidences, it is considered that the signs are similar.
- The word ‘ultimate’ is the most distinctive in the earlier marks since the word ‘nutrition’, which is highly similar to the Spanish word ‘*NUTRICIÓN*’, is

weak in relation to the goods. The contested sign has no meaning in relation to the goods.

- The earlier trade marks as a whole have no meaning in relation to any of the goods at hand from the perspective of the Spanish public. Therefore, the distinctiveness of the earlier marks must be seen as normal, despite the presence of the weak element ‘NUTRITION’.
  - The earlier marks will primarily be referred to as ‘ULTIMATE NUTRITION’, since the figurative element in one is a particular typeface on a black background, and the laurel wreath and the depiction of the world in the other are laudatory or allusive elements. The word ‘NUTRITION’ is a weak element, and consequently, the word ‘ULTIMATE’ is the most distinctive of the word elements in the earlier marks.
  - The first parts of the word elements in the conflicting signs are identical. Consumers generally tend to focus on the first element of a sign. Consequently, the identical first elements must be taken into account when assessing the likelihood of confusion between the trade marks.
  - It is likely that the Spanish consumer will consider that trade marks with the distinctive word element ‘ULTIMATE’ in common originate from the same undertaking or economically-linked undertakings.
  - The figurative elements and the word ‘nutrition’ in the earlier sign and the word element ‘greens’ in the contested sign do not counteract the significance of the coinciding distinctive and first word element ‘ULTIMATE’ in all marks.
- 5 The applicant filed an appeal against the contested decision, followed by a statement of grounds. It requests to annul the contested decision and to reject the opposition in its entirety.
- 6 No revision was granted pursuant to Article 62 CTMR and the appeal was remitted to the Boards of Appeal.
- 7 The opponent replied and requested to confirm the contested decision.

### **Submissions and arguments of the parties**

- 8 The applicant argues as follows:
- The focus should have been on the public that understands English as that is the most widely understood language in the European Union.
  - The meaning of the word ‘ULTIMATE’ will be understood. A search of this word in Google reveals 283 million hits. Even in Spain the word ‘ULTIMATE’ has a weak distinctive character.
  - Since the focus is on the English-speaking public, the weak element in the conflicting signs is the word ‘ultimate’. The dominant elements are the words ‘nutrition’ and ‘greens’.

- The overall impression given by the signs is important. The conflicting signs are dissimilar in their overall impression.
  - The overall impression of the conflicting marks is that they are not visually similar.
  - The conflicting marks differ in the sound of the words ‘nutrition’ and ‘greens’. Therefore, they are not phonetically identical.
  - The words ‘ultimate nutrition’ lack distinctive character for goods in Class 5. This is illustrated by the Office’s refusal of the application for the word mark ‘ULTIMATE NUTRITION’.
  - The word ‘ultimate’ has a clear and descriptive meaning and, therefore, the focus should be on the words ‘nutrition’ and ‘greens’. There are numerous trade marks in the European Union that begin with the word ‘ultimate’. The concepts conveyed by the laurel leaves around the globe are not present in the mark applied for.
  - The relevant public is likely to take great care in the selection of the goods in question.
- 9 The opponent contends as follows:
- Conceptual similarities are even greater for consumers with an understanding of English. Given that ‘greens’ can mean ‘leaf vegetables’, which are a form of nutrition, there is a strong conceptual similarity between the conflicting marks.
  - From the point of view of English consumers, the conflicting marks remain visually, phonetically and conceptually similar.
  - The similarity of the marks is compounded by the fact that it is the first part of a mark that catches the consumer’s attention and has a significant influence in the general impression made by a mark.
  - The word ‘ULTIMATE’ is not descriptive of any food, unlike the words ‘NUTRITION’ and ‘GREENS’. Therefore, the Opposition Division correctly found the word ‘ULTIMATE’ to be the dominant element.
  - The reasons for the rejection of CTM application No 972 364 for the word mark ‘ULTIMATE NUTRITION’ are unknown.
  - There is a likelihood of confusion irrespective of the level of attention of the relevant public.

### **Reasons**

- 10 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible.
- 11 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, constitutes a likelihood of confusion within the meaning of that

article (see, to that effect, judgment of 11 November 1997, C-251/95, ‘Sabèl’, paras 16 *et seq.*; judgment of 29 September 1998, C-39/97, ‘Canon’, para. 30).

- 12 The specification covered by the application does not preclude the purchase by the general public without the intervention of specialists and professionals. Nonetheless, it can be assumed that consumers of the relevant goods, especially in Class 5, are reasonably well informed, observant and circumspect, since such products affect the state of human health, and consumers are less likely to confuse different versions of such products (see judgment of 5 April 2006, T-202/04, ‘Echinaid’, para. 33). The same applies with respect to food additives and dietetic foodstuffs in Classes 29 and 30, which may also affect the state of health of a person. The goods covered by the earlier marks, and in particular the specification as it is stated in earlier CTM No 8 863 888, includes nutritional products and supplements for sports and performance enhancement. The relevant public of such goods, who are physical fitness and sports enthusiasts as well as trainers and fitness professionals, is well informed, observant and circumspect about the properties and the implications of consuming such goods and supplements. Such a public will closely examine the goods in question and actively seek information on, for example their amino acid, protein or carbohydrate content.
- 13 There are no specific health issues attached to the consumption of food concentrates made from herbs, food based on infusions, bars and energy bars. The average consumer of those goods is deemed to be reasonably well informed and reasonably observant and circumspect (see judgment of 22 June 1999, C-342/97, ‘Lloyd Schuhfabrik’, para. 26).
- 14 Furthermore, since the earlier trade mark is protected in the European Union, the relevant territories for the purpose of analysing the likelihood of confusion are the Member States.

#### *Comparison of the goods*

- 15 It is common ground that the goods are in part, identical, and in part similar. The parties do not put forward any arguments to counter the findings in the contested decision.

#### *I. The opposition based on Community trade mark No 6 024 152*

##### *1. Comparison of the signs*

##### *a) General Considerations*

- 16 The assessment of the similarity between two signs means more than taking just one component of a composite sign and comparing it with another sign. On the contrary, the comparison must be made by examining each of the signs in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite sign may not, in certain circumstances, be dominated by one or more of its components (see judgment of 20 September 2007, C-193/06 P, ‘Quicky’, para. 42). It is only if all the other components of the sign are negligible that the assessment of the similarity can be

carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable on its own of dominating the image of that sign which members of the relevant public keep in their minds, so that all the other components are negligible in the overall impression created by that sign.

- 17 With regard to the assessment of the dominant character of one or more given components of a composite sign, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite sign (see judgment of 12 September 2012, T-295/11, ‘duschy’, para. 57; judgment of 23 October 2002, Case T-6/01, ‘Matratzen’, para. 35)

*b) Inherent distinctive character and the dominant elements of the earlier trade mark*

- 18 The level of protection which is conferred on the proprietor of an earlier trade mark goes hand in hand with the distinctive character. It is therefore necessary to analyse the inherent distinctive character and the dominant elements of the earlier trade mark and assess its distinctive character *per se* in accordance with the facts of the case.
- 19 Earlier CTM No 6 024 152 is a figurative trade mark which is made up of the combination of the adjective ‘ULTIMATE’ with the noun ‘NUTRITION’, that make the wording ‘ULTIMATE NUTRITION’, in a black rectangular background.
- 20 In January 2000, the Office rejected CTM application 972 634. This CTM applied for, filed by the opponent, sought protection for the term ‘ULTIMATE NUTRITION’ for ‘nutritional products, namely dietary supplements’ in Class 5 as a word mark. The opponent did not file any appeal against this rejection. The decision of the examiner became final.
- 21 The Grand Board takes note of that decision and is of the opinion that the term ‘ULTIMATE NUTRITION’ is descriptive and lacks any distinctive character for ‘nutritional products, namely dietary supplements’ or ‘vitamins and nutritional food supplements’, the goods for which CTM No 6 024 152 is registered.
- 22 The *Oxford English Dictionary* (<http://www.oed.com>, 30 July 2013) defines the English adjective ‘ultimate’ as ‘forming a final stage, point, or limit; beyond which there is no advance or progress’, ‘the best that can be achieved or imagined’. It is a synonym of ‘supreme’ or ‘best’ (<http://www.collinsdictionary.com>, 30 July 2013). As such, the word ‘ultimate’ is a promotional word used to indicate the superior quality of the latest goods available on the market and, has no distinctive character at all.
- 23 The term ‘ultimate’ is clearly a word that lends itself to use in commerce to describe products that are the latest, the best; it is as a promotional word designating the superior quality of goods.

- 24 Moreover, the Grand Board observes that the assumption in the contested decision that the non-English-speaking public in Spain will have no notion of the word ‘ultimate’ is unfounded. The English adjective ‘ultimate’ is very close to the Spanish equivalent ‘*última*’, commonly used to designate something that is the latest or the best, as in the expression ‘*la última tecnología*’, in the language of the proceedings ‘state of the art technology’.
- 25 This also holds true with respect to any other Member State. The term ‘ultimate’, of Latin origin, is a very basic word in the English language and equivalents resembling that word exist in other languages in the European Union (e.g. ‘*última*’ in Spanish; ‘*ultimativ*’ in Danish; ‘*ultimativ*’ in German, ‘*ultime*’ in French; ‘*ultimo*’ in Italian; ‘*ultiem*’ in Dutch; ‘*ultimul*’ in Romanian; ‘*ultimativen*’ in Slovenian; etc.). As a word which is apt for use to promote the quality of goods that are the latest and the most advanced, the average consumer in the entire European Union, who is reasonably well informed and reasonably observant and circumspect, will be aware of that meaning.
- 26 This is also confirmed by decision of 25 April 2006, R 76/2006-2 – ‘ULTIMATE’, and decision of 15 April 2013, R 2049/2012-4 – ‘FLASH POWER THE ULTIMATE ENERGY BOOST’.
- 27 In relation to the goods protected by the earlier trade mark which are nutritional supplements or are goods which nourish, the word element ‘nutrition’ also lacks any distinctive character. The word nutrition, a synonym for ‘food’ (<http://www.oed.com>, 30 July 2013), too, is a very basic word in English and French and equivalents resembling that word exist in other languages in the European Union (e.g. ‘*nutrición*’ in Spanish, ‘*Nutrition*’ in German, ‘*nutrizione*’ in Italian and ‘*nutrição*’ in Portuguese). In relation to the goods protected by the earlier trade mark which are nutritional supplements or goods which nourish, the word ‘nutrition’ is descriptive and non-distinctive. The contested decision rightly noted that the Spanish public would perceive that word in such a way. This also holds true with respect to any other Member States.
- 28 The sign consists of an adjective (‘ultimate’) followed by a noun (‘nutrition’). In grammar, an adjective is a ‘describing’ word; the main syntactic role of which is to qualify a noun or noun phrase, giving more information about the object signified. In the case at stake, ‘ultimate’ qualifies ‘nutrition’ and describes in further detail the type of ‘nutrition’, namely that it is the best available nutrition on the market.
- 29 The relevant public in all Member States will immediately and without further analytical effort understand the expression ‘ULTIMATE NUTRITION’, about which there is nothing unusual grammatically in English, as a clear and unambiguous indication of the latest or the best nutrition achievable or imaginable.
- 30 The only difference between CTM 972 634, which was rejected by the Office, and the earlier trade mark subject to the present proceedings is the black rectangle. There is nothing unusual about the plain rectangular background. Indeed a contrasting rectangular background is commonplace and merely gives



the impression of a product label. Indeed tags are used in trade for all kinds of goods (see judgments of 3 July 2003, Case T-122/01 ‘Best Buy’, para. 33; of 15 December 2009, T-476/08, ‘Best Buy’ para. 27; confirmed by judgment of 13 January 2011, C-92/10 P, ‘Best Buy’). Consequently, it lacks any distinctive character.

- 31 The presence of a word sequence against such a background will not leave an impression on the memory of the targeted public as an indication of commercial origin. The black rectangle does not add any distinctive character to the whole sign. There is also nothing unusual about the script in upper case of the wording ‘ULTIMATE NUTRITION’. There is also nothing striking about the typeface of the wording ‘ULTIMATE NUTRITION’ or placing one word on top of the other.
- 32 The fact that the word elements are descriptive has an effect on the relevant public’s perception of these elements, because they cannot constitute the dominant elements of the sign at issue (see judgment of 31 January 2013, T-54/12, ‘Sport’, para. 31). The target public will not generally consider a descriptive element forming part of a complex sign as the distinctive and dominant element of the overall impression conveyed by that sign (see, to that effect, judgments of 3 July 2003, T-129/01, ‘Budmen ’, para. 53; and also, of 18 February 2004, T-10/03, ‘Conforflex’, para. 60).
- 33 Taking into consideration that all word elements are descriptive and non-distinctive, they cannot be the dominant elements of the sign. The rectangle, is, as explained above, neither catchy nor fanciful and has consequently no distinctive character. Overall, all elements have the same value and, consequently, the sign for which the earlier trade mark enjoys protection is not dominated by any specific element.
- 34 This is also confirmed by case-law, since where a sign consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant (see judgment of 12 September 2012, T-295/11, ‘duschy’, para. 61).
- 35 It follows from an overall assessment that the earlier trade mark lacks inherent distinctive character and these findings will be taken into consideration in the comparison of the signs and the global assessment of likelihood of confusion.
- 36 In addition, it must be recalled that a trade mark may be the subject of a request for its cancellation on absolute grounds for invalidity in accordance with Article 52(1)(a) CTMR at any time. Indeed, the purpose of the cancellation procedure based on Article 52(1)(a) CTMR is, *inter alia*, to enable the Office to review the validity of the registration of a trade mark and to adopt, where necessary, a position it should have adopted of its own motion in the registration process (see judgment of 30 May 2013, T-396/11, ‘ultrafilter’, para. 20).
- 37 Even though opposition proceedings are not aimed to examine absolute grounds for refusal, and in particular not with respect to the earlier trade mark which is registered, the Office, and therefore the Opposition Division and the Boards of Appeal, is bound to examine the scope of protection of the opposing trade mark.

The fact that a trade mark that has been registered in breach of Article 7 CTMR, and especially of Article 7(1)(b), (c) or (d) CTMR, and that it might be attacked at any time with a request for cancellation is a factor to be taken into consideration within the framework of the assessment of likelihood of confusion.

- 38 The mere fact that a trade mark is registered does not endow it with distinctive character. It must be noted that the assessment of the distinctive character of the earlier trade mark does not put into question its validity, but is only necessary to take into consideration all relevant factors for the global assessment of likelihood of confusion.

*c) The dominant elements of the CTM applied for*

- 39 The CTM applied for seeks protection for the words ‘ULTIMATE GREENS’.
- 40 With respect to the meaning of the adjective ‘ultimate’, reference is made to findings set out above in paras 22 to 26.
- 41 The term ‘greens’ is a noun in English which means ‘the edible leaves and stems of certain plants, eaten as a vegetable’ (<http://www.collinsdictionary.com>, 30 July 2013). In relation to the goods for which the CTM applied for seeks protection in Classes 5, 29 and 30, which are not vegetables, the term ‘greens’ is at most allusive, since said specification does not include green leafy vegetables and is therefore not directly descriptive of the qualities of the goods at stake.
- 42 Even if the adjective ‘ultimate’ is at the beginning, it will not be perceived as the dominant element of the sign applied for. The adjective ‘ultimate’ qualifies ‘greens’ and describes in further detail the type of goods, namely that they are the best available product line of goods marketed under the trade mark ‘greens’.
- 43 Since, the word ‘ultimate’ is a promotional word used to indicate the superior quality of the goods, it will not be perceived as the dominant element of the sign applied for, even if it is placed at the beginning of the sign.
- 44 Therefore, the term ‘greens’ is the dominant element of the sign for which the CTM applied for seeks protection.

*d) Comparison*

- 45 It must be recalled that even if the beginning of a sign has generally more importance than the ending in the overall impression produced by a sign, this consideration cannot prevail in all cases and cannot, in any event, undermine the principle that an examination of the similarity of the signs must take account of the overall impression produced by those signs, since the average consumer normally perceives a sign as a whole and does not examine its individual details (see judgment of 27 June 2012, T-344/09, ‘Cosmobelleza’, para. 52). This holds especially true in the present case, in which an adjective is put before a noun to qualify and describe it.
- 46 The comparison of the signs must be based on the signs as a whole. The Grand Board recalls that in accordance with the above findings, the sign for which the

earlier CTM enjoys protection does not consist of any dominant element. In the sign for which the CTM applied for seeks protection, the element 'GREENS' is only allusive and therefore dominates the other element, even if that element is to be taken into consideration in the comparison of the signs.

- 47 With respect to the visual comparison, there is some low similarity, since both signs contain a common element. However, this element is not the dominant element in either of the signs.
- 48 The same reasoning applies to the phonetic comparison. The pronunciation of the signs at issue will differ on account of the second word element in those signs, the exact pronunciation of which will vary in accordance with the language of reference irrespective of whether the consumer understands the meaning of the word elements making up the signs at issue. In many languages, if not all, 'NUTRITION' will be pronounced in three syllables, whereas the word 'GREENS' is a one syllable word.
- 49 With respect to the conceptual comparison, reference is made to the above findings with respect to the understanding of the signs by the relevant public. The sign for which the earlier trade mark enjoys protection is understood as referring to the best nutrition on the market. Consumers having sufficient knowledge of English understand the sign applied for as referring to the best vegetable on the market. Even if vegetables are nutrition, they convey a different concept. Very many different types of goods have nutritional properties. The nutritional content is also very different between products. Thus the nutritional properties of a product that is used in sport or enhances performance by including specific amino acids such as glutamine, lysine or taurine, a specific percentage of protein, a specific form of carbohydrate or performance enhancing minerals, will differ from the nutritional content of 'leafy vegetables', which are not commonly consumed *per se* by sports enthusiasts. The simple fact that both signs refer to a specific type of food and 'leafy vegetables' that may have a nutritional value is not sufficient to render the signs similar conceptually. Neither does the reference to the best product on the market help the opponent's case since such slogans are commonly used and consumers will not take them into consideration.
- 50 If the relevant consumer associates the term 'greens' with the colour green, the signs are conceptually different. The fact that the opponent might use its trade mark together with the word 'green' or the colour 'green' is also irrelevant, since the sign protected by the earlier trade mark must be taken into consideration and not any sign possibly used by the opponent.
- 51 Overall, in accordance with the recent case-law of the General Court (see judgment of 14 July 2011, T-160/09 'Ofal Cusi', para. 89; judgment of 21 March 2012, T-63/09 'Swift GTi', para. 103), the Grand Board finds that the conflicting signs are similar to a low degree, and that their similarity is limited to the common descriptive and non-distinctive element 'ULTIMATE'.

## 2. *Global assessment*

- 52 The appreciation of a likelihood of confusion on the part of the public 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 signs and between the goods or services identified (eighth recital of the CTMR). It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see judgment of 22 June 1999, C-342/97, ‘Lloyd Schuhfabrik’, para. 18; judgment of 11 November 1997, C-251/95, ‘Sabèl’, para. 22).
- 53 Likelihood of confusion can only arise if the registration of the younger trade mark would affect or be liable to affect one of the functions of the earlier trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods (see judgment of 12 November 2002, C-206/01, ‘Arsenal’, para. 51; judgment of 16 November 2004, Case C-245/02, ‘Budweiser’, para. 59; judgment of 25 January 2007, C-48/05, ‘Opel’, para. 21).
- 54 The global assessment of likelihood of confusion implies some interdependence between the relevant factors, and in particular the degree of similarity between the trade marks and between the goods and services. Accordingly, a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks and vice versa (see judgment of 22 June 1999, C-342/97, ‘Lloyd Schuhfabrik’, para. 19). The likelihood of confusion is greater the more distinctive the earlier mark is, and an earlier mark with a distinctive character increased by its high recognition on the market will enjoy broader protection than a mark with a less distinctive character (see judgment of 22 June 1999, C-342/97, ‘Lloyd Schuhfabrik’, para. 20).
- 55 The distinctive character of the earlier trade mark is one of the factors to be taken into consideration for the purposes of assessing the likelihood of confusion. The distinctive character can vest in the trade mark’s inherent characteristics or in its use and recognition on the market. The other factors are the degree of similarity of the signs and the degree of similarity of the goods and services. Furthermore, the level of attention of the relevant consumers as well as the typical market conditions must be taken into consideration.
- 56 It is settled case-law of the Court of Justice that global assessment of likelihood of confusion cannot take into consideration only one component of a composite sign and compare it with another sign. The comparison must be made by examining each of the signs in question as a whole (order of 15 January 2010, C-579/08P, ‘FERROMIX’, para. 71).
- 57 The signs coincide only in a non-dominant, descriptive and non-distinctive element and are dissimilar with respect to all the other aspects. Even though the goods are partly identical, the other factors, such as the non-distinctive character of the earlier trade mark and the low visual similarities, are sufficient to exclude any likelihood of confusion, including the risk of association; a risk of association cannot be based on a non-distinctive element.

- 58 In application of the interdependence principle as set out by the Court (see paragraph 53), it must be found in the present case that the identity of the goods is counteracted by the low degree of similarity of the signs and in particular the differences arising from the distinctive element 'GREENS' in the sign for which the CTM applied for seeks protection, which has no counterpart in the sign for which the earlier trade mark is protected.
- 59 Whereas, a company is certainly free to choose a trade mark with a low or even non-distinctive character, including trade marks with descriptive and non-distinctive words, and use it on the market, it must accept, however, in so doing, that competitors are equally entitled to use trade marks with similar or identical descriptive components (decision of 23 May 2012, R 1790/2011-5 – '4REFUEL/REFUEL', para. 15).
- 60 The 'interdependence principle', as set out above in paragraph 53, cannot only be applied in one direction. It must be applied both ways. This implies that the scope of protection of trade marks with a weak distinctive character is weaker, correspondingly. In the application of this principle, any trade mark proprietor may then seek to compensate the intrinsically weak (or even missing, see Article 7(3) CTMR) distinctive character of its sign through use as a trade mark on the market. In such a situation the trade mark would have, at least, a normal distinctive character. However, it is common ground that the opponent cannot rely on this factor in the present case since it did not claim any enhanced distinctive character through use of its earlier trade mark.
- 61 The Court of Justice has repeatedly stressed that granting protection for trade marks is justified only to the extent that the trade mark is capable of fulfilling its essential functions, and when a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods and services (see judgment of 29 September 1998, C-39/97, 'Canon', paras 27 *et seq.* – as regards the notion of a likelihood of confusion; judgment of 25 January 2007, C-48/05, 'Opel', para. 21 – as regards the exception from the rights under a trade mark; judgment of 12 November 2012 C-206/01, 'Arsenal', paras 46 *et seq.* – as regards the need to avoid distortions of trade; judgment of 11 March 2003, C-40/01, 'Minimax', para. 36 – as regards the use requirement; judgment of 16 September 2004, C-329/02 P, 'SAT.2', para. 27 – as regards the notion of distinctiveness). The threshold is the perception of the relevant public. A sign or an element of it which is not distinctive cannot give rise to a perception of a particular trade origin, and a sign or an element of it which gives the public no references to a trade origin cannot suddenly do so simply because it also appears as an element in another mark. While it is true that in the framework of Article 8 CTMR there is no room for an 'availability requirement' (judgment of 10 April 2008, C-102/07, 'Marca Mode' – concerning a mark with a reputation), account should be taken that Article 9 CTMR grants a right to prohibit use of a sign under the same conditions as Article 8, and that Article 12 CTMR (corresponding to Article 6 TMD) contains a limitation of the exclusive rights under a mark vis-à-vis a use made to describe characteristics of goods. While each of these provisions has its own field

of application, all of them echo the same underlying basic principles. The distinctive character of a trade mark is at the heart of trade mark law.

- 62 It would be against the rationale of the CTMR to give too much importance in the assessment of likelihood of confusion to non-distinctive elements. It cannot be that a proprietor of a trade mark composed of figurative and/or word elements, where each of them taken alone or in combination are non-distinctive, were in the position to successfully claim likelihood of confusion based on the presence of one of these elements in the other sign. This would result in an unduly broad protection of descriptive and non-distinctive elements, which would prohibit other competitors from using the same descriptive and non-distinctive elements as components of their trade marks, especially if the use of such a term is in accordance with honest practice in commercial matters.

## *II. The opposition based on of Community trade mark No 8 863 888*

### *1. Comparison of the signs*

#### *a) Inherent distinctive character and the dominant elements of the earlier trade mark*

- 63 This earlier trade mark consists of the English term ‘ULTIMATE NUTRITION’ and a device. This device has the form of a medal. In its centre, the world map can be seen; it is surrounded by a laurel wreath.
- 64 With respect to the word elements, the same findings as above hold true. The device alludes to victory and might suggest to the relevant public that the goods marketed under the sign have won some prizes or are of a specific high quality. It dominates the sign.

#### *b) Comparison*

- 65 The visual distance between the earlier sign protected by Community trade mark No 8 863 888 and the sign for which the CTM applied for seeks protection is even wider than when the latter is compared with Community trade mark No 6 024 152.
- 66 Consequently, the signs are visually dissimilar.
- 67 The pronunciation of the signs at issue will differ on account of the second word element in those signs, the exact pronunciation of which will vary in accordance with the language of reference irrespective of whether the consumer understands the meaning of the word elements making up the marks at issue. In many languages ‘NUTRITION’ will be pronounced in three syllables, whereas the word ‘GREENS’ is a one syllable word.
- 68 As already stated above, the signs are not found to be conceptually similar.

## *2. Global assessment*

- 69 The signs are visually dissimilar and phonetically similar to a low degree.
- 70 The Grand Board already held that no likelihood of confusion can arise between earlier CTM No 6 024 152 and the CTM applied for despite the fact that there were some visual similarities. Consequently, since the sign for which the earlier CTM No 8 863 888 seeks protection is visually dissimilar to the sign for which the CTM applied for seeks protection, no likelihood of confusion can arise, either.

## *III. Result*

- 71 Since there is no likelihood of confusion between the CTM applied for and the earlier trade marks, the appeal must be allowed and the opposition must be rejected.

## **Costs**

- 72 Since the opponent is the losing party, it must bear the fees and representation costs pursuant to Articles 85(1) and (6) CTMR. It follows that it must bear the appeal fee incurred by the applicant of EUR 800 in accordance with Rule 94(6) CTMIR, and the applicant's representation costs in the appeal proceedings of the amount of EUR 550 and in the opposition proceedings of the amount of EUR 300 in accordance with Rule 94(7)(d) CTMIR.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the opposition;**
- 3. Orders the opponent to bear the total amount of EUR 1 650 in respect of the applicant's fees and costs in the appeal and opposition proceedings.**

Th. M. Margellos

C. Bartos

T. de las Heras

D. Schennen

C. Rusconi

H. Salmi

A. Szanyi Felkl

S. Martin

F. López de Rego

Registrar:

P. López Fernández de Corres