

JUDGMENT OF THE GENERAL COURT (Second Chamber)

16 March 2016 (*)

(Community trade mark — Opposition proceedings — Application for the Community word mark SPA WISDOM — Earlier Benelux word mark SPA — Relative grounds for refusal — Unfair advantage taken of the distinctive character or the repute of the earlier trade mark — Article 8(5) of Regulation (EC) No 207/2009)

In Case T-201/14,

The Body Shop International plc, established in Littlehampton (United Kingdom), represented by I. Vernimme, H. Viaene, S. Vandewynckel and D. Gillet, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by J. Crespo Carrillo, acting as Agent,

defendant,

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

Spa Monopole, compagnie fermière de Spa SA/NV, established in Spa (Belgium), represented by E. Cornu and E. De Gryse, lawyers,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 16 January 2014 (Case R 1516/2012-4), relating to opposition proceedings between The Body Shop International plc and Spa Monopole, compagnie fermière de Spa SA/NV,

THE GENERAL COURT (Second Chamber),

composed of M.E. Martins Ribeiro, President, S. Gervasoni and L. Madise (Rapporteur), Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 26 March 2014,

having regard to the response of OHIM lodged at the Court Registry on 21 July 2014,

having regard to the response of the intervener lodged at the Court Registry on 18 July 2014,

further to the hearing on 8 December 2015,

gives the following

Judgment

Background to the dispute

1 On 22 February 2010, the applicant, The Body Shop International plc, filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

2 Registration as a mark was sought for the word sign SPA WISDOM.

3 The goods in respect of which registration was sought are in Class 3 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: ‘Perfumes; soaps; shampoos; cosmetics; hair colourants; hair conditioners; hair dyes; hair lotions; hair styling preparations; non-medicated talcum powder for toilet purposes; sun-tanning preparations; cosmetics; non-medicated massage preparations; shaving preparations; nail care preparations; bath oils; bath salts; essential oils; beauty masks; nail varnish; cotton wool for non-medical purposes; pot-pourri’.

4 The Community trade mark application was published in *Community Trade Marks Bulletin* No 2010/061 of 6 April 2010.

5 On 3 June 2010, the intervener, Spa Monopole, compagnie fermière de Spa SA/NV, filed a notice of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the mark applied for in respect of all the goods referred to in paragraph 3 above.

6 The opposition was based on a number of earlier marks registered in Benelux which use the term ‘spa’, including, in particular, the word mark SPA, which is registered under the number 389 230 and covers goods in Class 32 corresponding to the following description: ‘Mineral water and aerated waters and other non-alcoholic beverages, syrups and other preparations to make beverages’.

7 As regards the earlier mark, the grounds relied on in support of the opposition were based on Article 8(5) of Regulation No 207/2009.

8 By decision of 18 June 2012, the Opposition Division of OHIM upheld the opposition and rejected the application for registration of the mark applied for in its entirety, taking the view that there was a risk that the use of that mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark.

9 On 14 August 2012, the applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Opposition Division.

10 By decision of 16 January 2014 (‘the contested decision’), the Fourth Board of Appeal of OHIM dismissed the appeal. It confirmed the decision of the Opposition Division, which had upheld the opposition on the basis of Article 8(5) of Regulation No 207/2009, on the ground that there was a risk of harm to the earlier mark referred to in paragraph 6 above. First, it stated that the relevant territory was that of the Benelux countries since the earlier mark is registered in those countries and that, taking into account the goods concerned, the relevant public was the general public in those countries. Secondly, in the first place, it found that the opponent had proved genuine

use of the earlier mark and the high reputation of that mark in the Benelux countries. In the second place, it observed that the opponent had proved that the earlier mark, which covers mineral water, relates to an image of exceptional quality, purity and health in respect of those goods. Thirdly, as regards the comparison of the signs, the Board of Appeal found, first, that the evidence provided by the applicant did not prove that the word element 'spa' in the mark applied for was descriptive or weakly distinctive with regard to cosmetic products. Next, it found that the word element 'wisdom' in the mark applied for was distinctive in respect of the goods covered by that mark and would be perceived, by the relevant public, which has a command of English, as a reference to wisdom or to something in which wisdom is exhibited. The Board of Appeal deduced from this that the mark applied for consisted of two distinctive and 'co-dominant' word elements, with the word element 'spa' being the initial element on which the attention of the consumer is usually focused. Lastly, it found that there was an average degree of visual and phonetic similarity between the signs at issue and that they were conceptually similar to that same degree as the consumer might assign the same meaning to the element 'spa', which is common to both of the signs at issue. Fourthly, as regards the risk that the use of the mark applied for would take unfair advantage of the distinctive character or the repute of the earlier mark, the Board of Appeal, first of all, observed that, having regard to the nature and the closeness of the goods covered by the signs at issue, the average degree of similarity between those signs and the high reputation of the earlier mark, the relevant public, which was the same with regard to both of the signs at issue, would be likely to establish a link between those signs. Next, it found that, because of that link and because the message conveyed by the signs at issue was identical, the risk that the use of the mark applied for would take unfair advantage of the advertising effort made by the proprietor of the earlier mark was established in this instance. For the sake of completeness, it found that the use of the mark applied for could be detrimental to the distinctive character of the earlier mark by making it ordinary and by depriving it of its power of attraction, on the ground that it would give rise to dispersion of the earlier mark's identity and hold upon the public mind. It took the view that such a situation would be likely to result in a reduction in the economic value of the earlier mark in the medium or long term. Lastly, as regards the cause which the applicant put forward for the purpose of justifying the use of the mark applied for, the Board of Appeal found that the use of the word element 'spa' within the mark applied for was not necessary for the marketing of the cosmetic products covered by that mark.

Forms of order sought

11 The applicant claims that the Court should:

- declare the action admissible;
- annul the contested decision;
- order OHIM and, if necessary, the intervener to pay the costs.

12 OHIM and the intervener contend that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

Law

13 In support of its action, the applicant puts forward a single plea in law alleging infringement of Article 8(5) of Regulation No 207/2009. That plea consists of two claims. By the first claim, the

applicant maintains, in essence, that the condition relating to the similarity between the signs at issue is not satisfied in the present case, on account of the descriptiveness and generic nature of the term ‘spa’ in the mark applied for and the absence of any likelihood of association, on the part of the relevant public, between the signs at issue. By the second claim, the applicant maintains that the condition relating to the existence of one of the injuries to the earlier mark which are referred to in Article 8(5) of Regulation No 207/2009 is not satisfied in the present case and, in addition, that there is a due cause which makes it possible to use the term ‘spa’ within the mark applied for.

14 Article 8(5) of Regulation No 207/2009 provides that upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for must not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

15 As far as trade marks registered with the Benelux Trade Mark Office are concerned, the Benelux territory must be treated like the territory of a Member State (see, by analogy, judgment of 14 September 1999 in *General Motors*, C-375/97, ECR, EU:C:1999:408, paragraph 29).

16 Furthermore, for the same reasons as those relating to the condition as to the existence of a reputation in a Member State, a Benelux trade mark cannot therefore be required to have a reputation throughout the Benelux territory. It is sufficient for a Benelux trade mark to have a reputation in a substantial part of the Benelux territory, which may consist of a part of one of the Benelux countries (see, by analogy, judgment in *General Motors*, cited in paragraph 15 above, EU:C:1999:408, paragraph 29).

17 For an earlier trade mark to be afforded the broader protection under Article 8(5) of Regulation No 207/2009, the following conditions must be satisfied: first, the marks at issue must be identical or similar; secondly, the earlier mark cited in opposition must have a reputation; and, thirdly, there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. Those three conditions are cumulative and failure to satisfy one of them is sufficient to render that provision inapplicable (see judgment of 9 March 2012 in *Ella Valley Vineyards v OHIM — HFP (ELLA VALLEY VINEYARDS)*, T-32/10, ECR, EU:T:2012:118, paragraph 18 and the case-law cited).

18 More specifically, the third of the conditions for the application of Article 8(5) of Regulation No 207/2009 mentioned in the preceding paragraph refers to three distinct and alternative types of risk, namely that use of the trade mark applied for without due cause would (i) be detrimental to the distinctive character of the earlier mark or (ii) be detrimental to the repute of the earlier mark or (iii) take unfair advantage of the distinctive character or repute of the earlier mark. The first type of risk referred to in that provision arises where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. That risk thus refers to the dilution of the earlier mark through the dispersion of its identity and its hold upon the public mind. The second type of risk occurs where the goods or services covered by the mark applied for may be perceived by the public in such a way that the earlier mark’s power of attraction is diminished. The third type of risk concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that

the marketing of those goods is made easier by that association with the earlier mark with a reputation. It should, however, be emphasised that in none of those cases is it necessary that there be a likelihood of confusion between the marks at issue; the relevant public only has to be able to establish a link between them and does not necessarily have to confuse them. Lastly, having regard to the wording of Article 8(5) of Regulation No 207/2009, the existence of one of the abovementioned types of risk is sufficient for that provision to apply (see judgment of 22 March 2007 in *Sigla v OHIM — Elleni Holding (VIPS)*, T-215/03, ECR, EU:T:2007:93, paragraphs 36 to 42 and the case-law cited).

19 In order to better define the risk referred to by Article 8(5) of Regulation No 207/2009, it must be pointed out that the primary function of a mark is unquestionably that of an ‘indication of origin’. The fact remains that a mark also acts as a means of conveying other messages concerning, inter alia, the qualities or particular characteristics of the goods or services which it covers or the images and feelings which it conveys, such as, for example, luxury, lifestyle, exclusivity, adventure, youth. To that effect the mark has an inherent economic value which is independent of and separate from that of the goods and services for which it is registered. The messages in question which are conveyed inter alia by a mark with a reputation or which are associated with it confer on that mark a significant value which deserves protection, particularly because, in most cases, the reputation of a mark is the result of considerable effort and investment on the part of its proprietor. Consequently, Article 8(5) of Regulation No 207/2009 ensures that a mark with a reputation is protected with regard to any application for an identical or similar mark which might adversely affect its image, even if the goods or services covered by the mark applied for are not similar to those for which the earlier mark with a reputation has been registered (judgment in *VIPS*, cited in paragraph 18 above, EU:T:2007:93, paragraph 35).

20 It is in the light of the principles established by the case-law cited above that it must be examined whether the Board of Appeal was right to find that the conditions for the application of Article 8(5) of Regulation No 207/2009, referred to in paragraph 17 above, were satisfied in the present case.

21 In the first place, it must be stated that the earlier mark, with regard to which the examination of the risk of the injuries referred to in Article 8(5) of Regulation No 207/2009 was carried out, is a trade mark which is registered in the Benelux countries. Consequently, as the Board of Appeal correctly found in paragraph 24 of the contested decision, a finding which the applicant does not dispute, the relevant territory is that of those countries.

22 In the second place, as regards the relevant public, it is important to point out that the Board of Appeal also correctly found, in paragraph 25 of the contested decision, a finding which the applicant does not dispute, that the goods at issue were intended for the general public which thus constitutes the relevant public.

The reputation of the earlier mark

23 According to the case-law, in order to satisfy the requirement of reputation, the earlier national mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark (see, by analogy, judgment in *General Motors*, cited in paragraph 15 above, EU:C:1999:408, paragraph 31, and judgment of 13 December 2004 in *El Corte Inglés v OHIM — Pucci (EMILIO PUCCI)*, T-8/03, ECR, EU:T:2004:358, paragraph 67).

24 In the present case, it is not disputed that the earlier mark, which is registered in Benelux under the number 389 230 in respect of goods in Class 32, has, as is apparent from paragraph 28 of

the contested decision, on account of its genuine and very extensive use in that territory, acquired a high reputation in respect of the goods covered by that mark.

The similarity of the signs at issue

25 As far as the condition that the signs at issue must be identical or similar is concerned, the signs which have to be compared are, on the one hand, the earlier mark SPA, which covers mineral water, and, on the other hand, the mark applied for SPA WISDOM, which covers cosmetic products. The first of those marks consists solely of the word element ‘spa’, which is not stylised, and the second of those marks consists of two word elements, ‘spa’ and ‘wisdom’, which are not stylised and are separated by a space.

26 In that regard, first of all, it must be borne in mind that, in order to satisfy the condition set out in Article 8(5) of Regulation No 207/2009 that the signs at issue must be identical or similar, it is not necessary to prove that there exists, on the part of the relevant public, a likelihood of confusion between the earlier mark with a reputation and the mark applied for. It is sufficient for the degree of similarity between those two marks to have the effect that the relevant public establishes a link between them. In that regard, the greater the similarity between the marks at issue, the more likely it is that the mark applied for will bring the earlier mark with a reputation to the mind of the relevant public (see judgment in *ELLA VALLEY VINEYARDS*, cited in paragraph 17 above, EU:T:2012:118, paragraph 37 and the case-law cited).

27 The assessment of the visual, phonetic or conceptual similarity of the signs at issue must be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements (see, to that effect, judgment in *ELLA VALLEY VINEYARDS*, cited in paragraph 17 above, EU:T:2012:118, paragraph 38 and the case-law cited).

28 It is in the light of those principles that it must be determined whether the Board of Appeal was right in finding that there was an average degree of similarity between the signs at issue.

29 The applicant submits, in essence, that the Board of Appeal erred in finding that the signs at issue were similar. It maintains that the Board of Appeal did not notice that the term ‘spa’ has become generic and descriptive in respect of cosmetic products and that, although the General Court has rejected such an argument in certain cases, that stems from the fact that the perception of the relevant public was different at the time of those cases and that, in contrast to the present case, evidence of the generic nature and descriptiveness of the term ‘spa’ was not provided by the parties in question.

30 OHIM, supported by the intervener, contends that, in accordance with the findings in paragraphs 40 and 41 of the contested decision, most of the evidence which the applicant provided to establish the generic nature and descriptiveness of the term ‘spa’ shows that that term is used in respect of goods and services which are not cosmetic products and that the few examples of use of the term ‘spa’ in respect of cosmetic products do not make it possible to ascertain where and to what extent that use took place and, in any event, do not show that the term ‘spa’ is used to describe cosmetic products, but merely that it serves as a play on words to evoke the idea of a ‘home spa’.

31 In the present case, it is necessary to make the following observations as regards the evidence which the applicant provided to establish that the term ‘spa’ is generic and descriptive with regard to cosmetic products.

32 First, as the Board of Appeal correctly states in paragraph 40 of the contested decision, the main part of the evidence concerns the use of the term ‘spa’ to refer to commercial establishments offering health and wellness services based on hydrotherapy or relates to products which are not cosmetics, such as jacuzzis, baths, bathroom accessories or candles (Annexes A-14 to A-17, pp. 451 to 624). There are some examples which show that the term ‘spa’ in relation to cosmetic products explains, in a descriptive way, that those products can help the consumer to create his own spa-experience of health, wellness and relaxation ‘at home’. Those examples show that the term ‘spa’ is used as a play on words alluding to the common use of that term for wellness centres and do not concern the use of the word ‘spa’ as a reference to characteristics of cosmetic products.

33 Secondly, as OHIM and the intervener point out, the use of the term ‘spa’ in relation to cosmetic products was not allowed in Benelux with regard to certain trade marks which the applicant has stated are marks in which the term ‘spa’ is used in respect of cosmetic products. That is, in particular, the case as regards the trade marks LIV Spa (Annex A-5, p. 240), NUXE (Annex A-5, pp. 258 to 264), BIGUINE (Annex A-5, pp. 136 to 144) and Palmolive (Annex A-7, p. 342), in respect of which the intervener has stated, without being contradicted by the applicant, that it successfully objected to the use in those marks of the term ‘spa’ in relation to cosmetic products.

34 Thirdly, it must be borne in mind that it is apparent from the Court’s case-law that evidence which comes from websites and does not contain any reference to the dates and places where the goods were marketed and used does not serve to show the way in which the relevant public perceives the mark affixed to those goods (see, to that effect, judgment of 12 September 2007 in *ColArt/Americas v OHIM (BASICS)*, T-164/06, EU:T:2007:274, paragraph 50).

35 In that regard, it must be pointed out that the items of evidence provided by the applicant are extracts from websites or from pages of magazines which do not prove, as is correctly stated in paragraph 41 of the contested decision, whether the cosmetic products on which the term ‘spa’ appears were actually sold, to what extent they were sold and whether they were sold in the Benelux countries. That is the case, inter alia, to mention only a few of them, of the goods marketed under the trade mark T’e’N (TECHNOLOGIA e NATURA) (Annex A-5, pp. 158 to 163), the African Spa goods covered by the mark THERME (Annex A-5, p. 164), the goods covered by the Italian mark FM Federico Mahora (Annex A-5, pp. 223 to 237), the goods covered by the mark GINCKEL’S (Annex A-5, pp. 241 to 243), the ‘spa in a bag’ goods covered by the mark Caudalie (Annex A-5, pp. 265 to 276), the goods covered by the mark Cien (Annex A-5, pp. 245 to 250), the goods covered by the mark Decléor an advertisement for which appears in the magazine *Elle* (Annex A-6, p. 283) and the goods covered by the mark Waterl’eau (Annex A-6, pp. 289 to 294). Those items of evidence also do not prove that the term ‘spa’ has the function of describing the goods concerned. They may show, as the Board of Appeal stated in paragraph 40 of the contested decision, that that word is affixed to certain goods to create a play on words which evokes the idea of health and wellness centres and, in particular, of a ‘home spa’.

36 In the light of the foregoing, it must be held that the evidence provided by the applicant, as is correctly stated in paragraph 39 of the contested decision, does not make it possible to invalidate the finding that the term ‘spa’ is not descriptive or weakly distinctive with regard to cosmetic products. The Court has, moreover, come to the same conclusion on several occasions, by pointing out, inter alia, that the term ‘spa’ may possibly be a generic and descriptive term for places for hydrotherapy such as hammams or saunas, but not for cosmetic products, on the ground that the links between cosmetic products and hydrotherapy centres are not such that the generic nature or descriptiveness of that word can be extended to them (judgments of 25 March 2009 in *L’Oréal v OHIM — Spa Monopole (SPALINE)*, T-21/07, EU:T:2009:80, paragraph 31, and *L’Oréal v OHIM — Spa Monopole (SPA THERAPY)*, T-109/07, ECR, EU:T:2009:81, paragraph 28).

37 Accordingly, first, the Board of Appeal was right to find, in paragraphs 39 to 42 of the contested decision, that the evidence provided by the applicant did not prove that the word ‘spa’ in the mark applied for was descriptive or weakly distinctive with regard to cosmetic products. Secondly, it was right in stating, in paragraph 43 of the contested decision, that the word ‘wisdom’ in the mark applied for would be perceived by the relevant public, which has a good command of English, as a reference to wisdom or to something in which wisdom is exhibited and that that element was distinctive with regard to the goods covered by the mark applied for.

38 It follows that the Board of Appeal did not err when it found, in paragraph 44 of the contested decision, that the mark applied for consisted of two terms which were distinctive with regard to cosmetic products and that the term ‘spa’ in the mark applied for, which is separated by a space from the term ‘wisdom’, was a ‘co-dominant’ element in the light of its position at the beginning of that mark, which, according to the case-law, is more likely to attract the relevant public’s attention (see, to that effect, judgment of 17 March 2004 in *El Corte Inglés v OHIM — González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)*, T-183/02 and T-184/02, ECR, EU:T:2004:79, paragraph 83). Furthermore, since the mark applied for reproduces the earlier mark in its entirety, the Board of Appeal also did not err in concluding, in paragraphs 45 and 46 of the contested decision, that there was an average degree of visual and phonetic similarity between the signs at issue and that they were conceptually similar to that same degree on the ground that the term ‘spa’, which they have in common, was capable of evoking the same idea with regard to both of the signs.

The unfair advantage taken of, and detriment to, the distinctive character or the repute of the earlier mark

39 It is apparent from the case-law that the purpose of Article 8(5) of Regulation No 207/2009 is not to prevent registration of any mark which is identical with a mark with a reputation or similar to it. The objective of that provision is, notably, to enable the proprietor of an earlier national mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark, or to take unfair advantage of that repute or distinctive character (judgment of 25 May 2005 in *Spa Monopole v OHIM — Spa-Finders Travel Arrangements (SPA-FINDERS)*, T-67/04, ECR, EU:T:2005:179, paragraph 40).

40 The existence of a link between the mark applied for and the earlier mark is an essential condition for the application of Article 8(5) of Regulation No 207/2009. The infringements referred to in that provision, where they occur, are the consequence of a certain degree of similarity between the mark applied for and the earlier mark, by virtue of which the public concerned makes a connection between them, that is to say, establishes a link between them, even though it does not confuse them (see judgment in *SPA-FINDERS*, cited in paragraph 39 above, EU:T:2005:179, paragraph 41 and the case-law cited; judgment of 12 November 2009 in *Spa Monopole v OHIM — De Francesco Import (SpagO)*, T-438/07, ECR, EU:T:2009:434, paragraph 15; see also, by analogy, judgment of 27 November 2008 in *Intel Corporation*, C-252/07, ECR, EU:C:2008:655, paragraph 30 and the case-law cited).

41 Whether the relevant public makes a link between the marks at issue must be assessed globally, taking into account all factors relevant to the circumstances of the case (judgment in *ELLA VALLEY VINEYARDS*, cited in paragraph 17 above, EU:T:2012:118, paragraph 20).

42 The Court has specified the factors which may be relevant in the global assessment aimed at determining whether that link between the signs at issue exists. Among those factors the Court has thus mentioned, first, the degree of similarity between the marks at issue; secondly, the nature of the goods or services for which the marks at issue are registered, including the degree of closeness or

dissimilarity between those goods or services, and the relevant section of the public; thirdly, the strength of the earlier mark's reputation; fourthly, the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and, fifthly, the existence of a likelihood of confusion on the part of the public (see judgment in *ELLA VALLEY VINEYARDS*, cited in paragraph 17 above, EU:T:2012:118, paragraph 21 and the case-law cited).

43 In the present case, as regards the factors to be taken into account in the global assessment aimed at determining whether there is a link between the signs at issue, first, it must be pointed out that, as is apparent from paragraphs 21 and 22 above, the relevant public consists of the general public in the Benelux countries. Secondly, it is important to bear in mind that, as has been stated in paragraph 38 above, there is an average degree of similarity between the signs at issue. Thirdly, it must be pointed out that, as has been stated in paragraph 24 above, the earlier mark has a high reputation for mineral water.

44 It is therefore necessary to assess the nature and the degree of closeness between the goods covered by the signs at issue in order to determine whether the relevant public makes a link between those signs.

45 In that regard, in the first place, it is important to point out that the degree of closeness between the goods covered by the signs at issue which is required by Article 8(5) of Regulation No 207/2009 does not imply that the goods in question must be identical or similar. Consequently, the applicant's argument that the goods covered by the signs at issue do not belong to the same category and are not sold in the same shops or sections of those shops does not preclude there being a certain closeness between those goods.

46 In the second place, it must be borne in mind that the mark applied for covers cosmetic products and that one of their main characteristics is that they consist in part of water. Furthermore, as the Board of Appeal correctly stated in paragraph 53 of the contested decision, there is a particular and natural connection between the activity of producing mineral water and the marketing of cosmetic products. Consequently, a number of proprietors of famous water brands have also developed, either by themselves or by means of licensees, their own line of cosmetic products which include the reputed waters or their minerals as an ingredient. That is true, for example, of the brands Vittel, Evian, Icelandic Glacial or Vichy or of the intervener itself, which, at least for a certain period, marketed a SPA vaporiser containing natural mineral water, which was offered for sale on the same shelves as cosmetic products, as is apparent from paragraph 54 of the contested decision and is, moreover, not disputed by the applicant. Furthermore, it is apparent from the documents in the case-file that the intervener also concluded licence agreements with cosmetics companies, such as Yves Rocher, Sothys and Elisabeth Arden, in order to allow them to market cosmetic products containing the mineral water covered by the earlier mark.

47 In the same vein, the Court has already had occasion to hold in its case-law that, since the goods covered by the earlier word mark, namely mineral water, may be used as ingredients in cosmetic products, there is a certain closeness between those two types of goods, which is reinforced by the fact that mineral water operators sometimes sell cosmetic products which comprise mineral water (judgment in *SPALINE*, cited in paragraph 36 above, EU:T:2009:80, paragraph 35).

48 Accordingly, it must be held that the Board of Appeal did not err in finding, in paragraphs 52 and 53 of the contested decision, that there is a certain link between the goods covered by the signs at issue.

49 Consequently, in the light of the target public with respect to the signs at issue, namely the general public in the Benelux countries, as has been found in paragraph 43 above; the average degree of similarity between those signs, pointed out in paragraph 38 above; the closeness between the goods covered by the signs at issue, established in paragraph 46 above; and the high reputation of the earlier mark, referred to in paragraph 24 above, the Board of Appeal did not err in finding, in paragraph 51 of the contested decision, that the relevant public was likely to establish a link between the signs at issue.

50 That finding is not affected by the applicant's argument that, on account of the much stronger links between beauty centres and cosmetic products, the consumer will not make a link between the cosmetic products covered by the mark applied for and the mineral water covered by the earlier mark. The applicant bases its claim, first, on the conviction that the term 'spa' has become generic and descriptive with regard to cosmetic products and, secondly, on OHIM's findings in some of its decisions. They are, inter alia, the decision of the Fourth Board of Appeal of OHIM of 22 June 2012 in Case R 135/2011-4, relating to the opposition by the proprietor of the earlier mark to the registration of the trade mark OLEOSPA (Annex A-11 to the application), the decision of the Opposition Division of 6 September 2012 B1871071, relating to the opposition by the proprietor of the earlier mark to the registration of the trade mark MARY KAY LASH SPA (Annex A-12 to the application), and extracts from other decisions of the Opposition Divisions of OHIM in which it was found, in essence, that cosmetic products and wellness and hydrotherapy centres are complementary and that there is thus a certain similarity between them (Annex A-13 to the application).

51 In that regard, first, it must be pointed out that it is apparent from settled case-law that the legality of the decisions of Boards of Appeal must be assessed solely on the basis of Regulation No 207/2009, as interpreted by the European Union Courts, and not on the basis of a previous decision-making practice of those Boards of Appeal (see judgment of 16 March 2005 in *L'Oréal v OHIM — Revlon (FLEXI AIR)*, T-112/03, ECR, EU:T:2005:102, paragraph 68 and the case-law cited; see also, to that effect, judgment of 13 June 2014 in *Grupo Flexi de León v OHIM (FLEXI)*, T-352/12, EU:T:2014:519, paragraph 32 and the case-law cited). Furthermore, it must be stated that the Court annulled the decision of the Fourth Board of Appeal of OHIM of 22 June 2012 referred to by the applicant (judgment of 27 February 2015 in *Spa Monopole v OHIM — Olivar Del Desierto (OLEOSPA)*, T-377/12, EU:T:2015:121).

52 Secondly, it must be borne in mind that, as has been stated in paragraphs 36 and 37 above, the applicant has not provided evidence capable of rebutting the finding that the term 'spa' is not, for the relevant public, descriptive and generic in respect of cosmetic products. Furthermore, the Court has already held that that term has, for that public, acquired a secondary meaning, namely that of the earlier mark covering mineral waters (judgment of 19 June 2008 in *Mülhens v OHIM — Spa Monopole (MINERAL SPA)*, T-93/06, EU:T:2008:215, paragraphs 29 and 30). Consequently, it is not inconceivable that the public will associate the term 'spa' with the earlier mark covering mineral water.

53 Thirdly, as has been stated in paragraphs 47 and 48 above, there is a certain link between cosmetic products and mineral water on the ground that mineral water constitutes one of the ingredients in cosmetic products. That link is, in addition, reinforced by the fact that certain mineral water operators put their own line of cosmetic products on the market (see to that effect, judgment in *SPALINE*, cited in paragraph 36 above, EU:T:2009:80, paragraph 35).

54 It follows that, contrary to what the applicant claims and as OHIM correctly points out, the link between cosmetic products and hydrotherapy centres will not, for the relevant public, eclipse the link between those products and the mineral water covered by the earlier mark.

55 It must therefore be determined whether, in the light of that link, there is a risk that the use of the mark applied for would take unfair advantage of the repute of the earlier mark.

56 In that regard, in accordance with the case-law referred to in paragraphs 18 and 19 above, it is important to state that the concept of taking unfair advantage of the repute of the earlier mark, referred to as ‘parasitism’, does not relate to the detriment caused to that earlier mark but to the advantage taken by the third party as a result of the use without due cause of the sign which is similar or identical to that mark. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (see, to that effect, judgment in *MINERAL SPA*, cited in paragraph 52 above, EU:T:2008:215, paragraph 40 and the case-law cited; see also, by analogy, judgment of 22 September 2011 in *Interflora and Interflora British Unit*, C-323/09, ECR, EU:C:2011:604, paragraph 74).

57 The risk of unfair advantage being taken of the distinctive character or the repute of the earlier trade mark occurs where the relevant public, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears that mark, which is similar to an earlier mark with a reputation (judgment in *VIPS*, cited in paragraph 18 above, EU:T:2007:93, paragraph 42).

58 Furthermore, it has been pointed out in the case-law of the Court of Justice that, the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking, or will take, unfair advantage of the distinctive character or the repute of the earlier mark or is, or will be, detrimental to them (see, by analogy, judgment in *Intel Corporation*, cited in paragraph 40 above, EU:C:2008:655, paragraph 67). In addition, the stronger the earlier mark’s distinctive character and reputation, the easier it will be to accept that harm has been caused to it (see, by analogy, judgment in *General Motors*, cited in paragraph 15 above, EU:C:1999:408, paragraph 30). The General Court has stated that it is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment or of unfair advantage being taken by the mark applied for is so obvious that the opposing party does not need to put forward or prove any other fact to that end (see, to that effect, judgment in *VIPS*, cited in paragraph 18 above, EU:T:2007:93, paragraph 48). It has also stated that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He just has to adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or of detriment (see, to that effect, judgment in *SPA-FINDERS*, cited in paragraph 39 above, EU:T:2005:179, paragraphs 40 and 41).

59 In that regard, first, it is important to point out that, as is apparent from paragraphs 32, 33 and 57 of the contested decision, the image of the earlier word mark and the message it conveys relate to health, beauty, purity and richness in minerals, a finding that is not disputed by the applicant, which confines itself to stating that the intervenor cannot have a monopoly on that image or that message.

60 Next, it must be stated, first, that it is common ground that the image and the message conveyed by the earlier mark may also apply to the cosmetic products in respect of which

registration has been sought, inasmuch as those products are intended to protect, take care of and cleanse the skin and their purpose is that of beauty. Secondly, even if it were accepted, as the applicant submits, that the message conveyed by the mark applied for is to invite ‘the consumer to enjoy the benefits of traditional spa baths at home ... , taking care of his/her body while helping underdeveloped countries since some of the ... ingredients [of the products covered by the mark applied for] originate from fair trade producers’, that would not preclude the abovementioned image and message conveyed by the earlier mark from applying to the mark applied for.

61 Lastly, it is important to bear in mind that it is common ground, as has been stated in paragraph 24 and reiterated in paragraph 43 above, that the earlier mark enjoys a high reputation with the relevant public.

62 In the light of all of those factors, it must be held that the Board of Appeal did not err in finding, in paragraph 57 of the contested decision, that there was a risk of a free-riding transfer of the advertising effort made by the proprietor of the earlier mark in favour of the applicant.

63 Consequently, the Board of Appeal was right to find, in paragraphs 55 to 57 of the contested decision, that there was a risk that the use of the mark applied for would take unfair advantage of the repute of the earlier mark and of the image conveyed by that mark, with the result that the marketing of the goods covered by the mark applied for would be made easier by their association with the earlier mark.

Whether there is a due cause which makes it possible to allow the term ‘spa’ to be used in the mark applied for

64 In order to justify the use and registration of the mark applied for, the applicant submits that the term ‘spa’ in that mark serves to show that the goods covered by that mark are destined to be used for the bath and, in particular, to re-create a ‘home spa’ experience.

65 In that regard, it must be pointed out that whether there is a due cause which makes it possible to use a mark which adversely affects a mark with a reputation is a matter which must be interpreted restrictively.

66 In the present case, since the generic nature and descriptiveness of the word ‘spa’ does not extend to cosmetic products, as has been stated in paragraphs 36 and 37 above, the word ‘spa’ has not become so necessary for the marketing of those products that the applicant could not reasonably be required to refrain from the use of it in the mark applied for, at least, as OHIM correctly states, in such a prominent position as that of the beginning of the mark applied for. The applicant may therefore reasonably be required to refrain from the use of that term in the mark applied for.

67 In view of the foregoing considerations, the Board of Appeal was right to find, in paragraph 62 of the contested decision, that there was no due cause for the use of the term ‘spa’ in the mark applied for.

68 The action must therefore be dismissed in its entirety, without it being necessary to determine whether there is a risk that the use of the mark applied for would be detrimental to the distinctive character or the repute of the earlier trade mark. As is apparent from the case-law referred to in paragraph 18 above, the existence of one of the injuries referred to in Article 8(5) of Regulation No 207/2009 is sufficient for that provision to apply.

Costs

69 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it is ordered to bear its own costs and to pay those incurred by OHIM and the intervener, in accordance with the forms of order sought by those parties.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders The Body Shop International plc to pay the costs.**

Martins Ribeiro

Gervasoni

Madise

Delivered in open court in Luxembourg on 16 March 2016.

[Signatures]

[*](#) Language of the case: English.