



Press and Information

General Court of the European Union  
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Judgment in Case T-332/10  
Viaguara S.A. v OHIM

## **The sign "VIAGUARA" cannot be registered as a Community trade mark for drinks**

*Use of that sign is likely to take unfair advantage of the distinctive character or repute of the trade mark VIAGRA*

The Community Trade Mark Regulation<sup>1</sup> provides that registration of a trade mark may be refused for certain expressly prescribed grounds. In particular, marks which are identical or similar to an earlier mark are refused registration, and, in the case of an earlier reputed Community trade mark, marks are refused registration 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.

In October 2005 the Polish company Viaguara S.A applied to the Office for Harmonisation in the Internal Market (OHIM) for registration of the word sign VIAGUARA as a Community trade mark, in particular for energy drinks and alcoholic drinks.

However, the American company Pfizer Inc., proprietor of the earlier Community trade mark VIAGRA (registered in particular for a drug to treat erectile dysfunction), opposed that application. On the basis on that opposition, OHIM refused to register VIAGUARA as a Community trade mark.

Viaguara S.A. applied to the General Court to have that decision annulled.

In its judgment today, **the General Court dismisses the action and confirms the decision of OHIM.**

As regards the condition relating to **the repute of the earlier mark**, the General Court holds that OHIM was correct to find that the reputation of the mark VIAGRA extends not only to consumers of the drugs concerned, but also to the general population.

The General Court then examines **the similarity of the signs at issue**. In that regard, it notes that when it comes to word marks, the consumer generally pays more attention to the initial part of the word. Therefore, the presence of the same stem "viag" in the signs at issue gives rise to a strong visual similarity which is, moreover, reinforced by the final part "ra" which is common to the two signs. Likewise, it finds that the signs are phonetically very similar and that there is nothing to distinguish the signs conceptually. The General Court therefore holds that the marks at issue are very similar.

The General Court observes that, even though a direct link cannot be established **between the goods covered by the marks at issue**, which are dissimilar, an association with the earlier mark is still possible, having regard to the high degree of similarity between the signs and to the huge reputation acquired by the earlier mark which extends beyond the public concerned by the goods for which it has been registered. Therefore, even if the respective publics targeted by the marks at issue do not completely overlap, as the goods concerned are different, a connection between the marks is likely to be made.

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<sup>1</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)

Lastly, the General Court rules on the condition relating to **the risk of an unfair advantage being taken of the distinctive character or the repute of the mark Viagra**. It 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. The Court finds in that regard that even if the non-alcoholic drinks concerned do not actually have the same benefits as a drug to treat erectile dysfunction, the consumer will be inclined to buy them thinking that he will find similar qualities, such as an increase in libido, owing to the transfer of positive associations projected by the image of the earlier mark. Moreover, as regards the alcoholic drinks produced by Viaguara S.A. containing guarana, it should be noted that the applicant has itself claimed that they have other fortifying and stimulating effects on the mind and the body, as well as properties which are beneficial for health, similar to a drug.

The General Court observes in that context that, although the product covered by the mark Viagra is a drug used to treat erectile dysfunction and is sold only on prescription, the fact remains that it does not necessarily refer to the treatment of a serious illness, but to an image of vitality and power, since it enables persons affected by erectile dysfunction to improve their sex life and quality of life and that the association with such an image is not incompatible with the "seriousness" which is intrinsic to medicinal products. Since the drug concerned is also used "recreationally" by young persons, the General Court states that such an image could be transferred to non-medicinal products, and in particular, the alcoholic drinks of the mark applied for, of a different nature, but consumed when going out or at parties.

The General Court concludes that Viaguara S.A, by using a mark similar to the earlier mark, is attempting to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of that mark in order to create and maintain its image, to promote its own products. Therefore, **the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of the mark Viagra**.

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**NOTE:** An appeal, limited to points of law only, may be brought before the Court of Justice against the decision of the General Court within two months of notification of the decision.

**NOTE:** An action for annulment seeks the annulment of acts of the institutions of the European Union that are contrary to European Union law. The Member States, the European institutions and individuals may, under certain conditions, bring an action for annulment before the Court of Justice or the General Court. If the action is well founded, the act is annulled. The institution concerned must fill any legal vacuum created by the annulment of the act.

**NOTE:** Community trade marks are valid throughout the European Union and co-exist with national trade marks. Applications for registration of a Community trade mark are sent to OHIM. Actions against its decisions may be brought before the General Court.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery

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