

Case T-67/04

Spa Monopole, compagnie fermière de Spa SA/NV

v

**Office for Harmonisation in the Internal market
(Trade marks and Designs) (OHIM)**

(Community trade mark — Opposition proceedings — Application for Community word mark SPA-FINDERS — Earlier national word marks SPA and LES THERMES DE SPA — Article 8(5) of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Second Chamber), 25 May 2005 . . II - 1829

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion*

*with the earlier mark — Protection of well-known earlier mark extended to dissimilar goods or services — Objective — Proof to be adduced by proprietor
(Council Regulation No 40/94, Art. 8(5))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Protection of well-known earlier mark extended to dissimilar goods or services — Condition — Link between the marks — Criteria for assessment
(Council Regulation No 40/94, Art. 8(5))*
3. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Protection of well-known earlier mark extended to dissimilar goods or services — Conditions — Repute of the earlier mark — Detriment to the distinctive character or repute of the earlier mark — Taking unfair advantage of the distinctive character or repute of the earlier mark — Criteria for assessment
(Council Regulation No 40/94, Art. 8(5))*
4. *Community trade mark — Definition and acquisition of the Community trade mark — Relative grounds for refusal — Opposition by the proprietor of an earlier identical or similar mark registered for identical or similar goods or services — Likelihood of confusion with the earlier mark — Protection of well-known earlier mark extended to dissimilar goods or services — Word marks SPA-FINDERS and SPA
(Council Regulation No 40/94, Art. 8(5))*

1. The purpose of Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides protection for the trade mark which is registered earlier and enjoys a repute which extends to goods or services which are not similar, is not to prevent registration of any mark which is identical with a mark of repute 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. In that connection, the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must

however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment.

(see para. 40)

2. 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 40/94 on the Community trade mark which provides protection for the trade mark which is registered earlier and enjoys a repute which extends to goods or services which are not similar. Indeed, 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, establishes a link between them. The existence of such a link must be appreciated globally, taking into account all factors relevant to the circumstances of the case. In that regard, the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it.

(see para. 41)

3. In order to satisfy the condition of repute raised by Article 8(5) of Regulation No 40/94 on the Community trade mark, which provides protection for the trade mark which is registered earlier and enjoys a repute which extends to goods or services which are not similar, the earlier mark must be known by a significant part of the public concerned by the goods or services covered by it.

As regards the condition of detriment to the distinctive character of the mark, this is made out where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used.

As regards the condition of detriment to the repute of the mark this is made out where the goods for which the mark applied for is used appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished.

As regards the condition of taking unfair advantage of the distinctive character or

the repute of the earlier mark this must be intended to encompass instances where there is clear exploitation of and free-riding on a famous mark or an attempt to trade upon its reputation.

(see paras 34, 43, 46, 51)

4. In relation to the mark SPA, which is registered in Benelux for 'mineral and aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages', falling within Class 32 of the Nice Agreement, the use of the word sign SPA-FINDERS whose registration as a Community trade mark is the subject of an application for 'printed publications including catalogues, magazines newsletters' falling within Class 16 and for 'travel agency services' falling within Class 39 of the Nice Agreement, is not likely to take unfair advantage of the distinctive character or repute of the earlier mark or be detrimental to them.

In that connection, even if the public were to make an immediate link between the marks at issue, the existence of such a link is not sufficient to demonstrate the risk of detriment to the distinctive character of the earlier mark. Moreover, since the term 'spa' is frequently used to designate, for example, the Belgian town of Spa and the Belgian racing circuit of Spa-Francorchamps or, in general, places for hydrotherapy such as hammams or saunas, the risk of detriment to the distinctive character of the mark SPA seems to be limited. In addition, there is no 'antagonism' between the goods and services covered by the marks SPA and SPA-FINDERS which might be detrimental to the repute of SPA mineral waters, and it is unlikely that the mark SPA-FINDERS will tarnish the image of the SPA mark. Finally since the two marks designate very different goods it is unlikely that the goods and services covered by the mark SPA-FINDERS, even if they turn out to be of lower quality, would diminish the attractiveness of the mark SPA.

(see paras 44, 48-49, 53)