

**Notification to the applicant/holder of a decision**

Alicante, 23/03/2016

HOFHUIS ALKEMA GROEN ADVOCATEN  
Keizersgracht 212  
NL-1016 DX Amsterdam  
PAÍSES BAJOS

*Your reference:* **TM5057EU00/VB/sp**

*Opposition number:* **B 002404344**

*Contested trade mark number:* **012715298**

*Name of the applicant/holder:* **YouMedical Brands B.V.**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **23/03/2016**.

**Benoit VLEMINCQ**

Enclosures (excluding the cover letter): 15 pages.

**Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) EUTMIR.**

**OPPOSITION No B 2 404 344**

**Wartner Europe B.V.**, Keileweg 8, 3029 BS Rotterdam, Netherlands (opponent), represented by **Altius**, Avenue du Port 86 C B414, 1000 Brussels, Belgium (professional representative)

a g a i n s t

**YouMedical Brands B.V.**, Rijnsburgstraat 9-11 8th floor, 1059 AT Amsterdam, Netherlands (applicant), represented by **Hofhuis Alkema Groen Advocaten**, Keizersgracht 212, 1016 DX Amsterdam, Netherlands (professional representative).

On 23/03/2016, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 2 404 344 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

**REASONS:**

The opponent filed an opposition against all the goods of European Union trade mark application No 12 715 298. The opposition is based on European Union trade mark registration No 6 380 661. The opponent invoked Article 8(1)(b) and 8(5) EUTMR.

**LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR**

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

**a) The goods**

The goods on which the opposition is based are the following:

Class 3: *Soaps; cosmetics.*

Class 5: *Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; disinfectants.*

The contested goods are the following:

Class 3: *Cosmetics; disinfectant soap.*

Class 5: *Pharmaceutical preparations for cosmetic purposes, including pharmaceutical preparations for dermatological use, also intended for treating external skin swellings, including warts; disinfectants for hygiene purposes.*

An interpretation of the wording of the list of goods is required to determine the scope of protection of these goods. The term 'including', used in the applicant list of goods, indicates that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (see the judgment of 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

### **Contested goods in Class 3**

The contested *cosmetics* are identically contained in both lists of goods.

The contested *disinfectant soap* is included in the broad category of the opponent's *soaps*. Hence they are considered identical.

### **Contested goods in Class 5**

The contested *pharmaceutical preparations for cosmetic purposes, including pharmaceutical preparations for dermatological use, also intended for treating external skin swellings, including warts* are included in the broad category of the opponent's *pharmaceutical preparations*. Therefore they are deemed identical.

The contested *disinfectants for hygiene purposes* are identically included in both lists of goods.

### **b) Relevant public – degree of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods found to be identical are directed at the public at large as well as business customers with specific professional knowledge or expertise, namely health professionals.

It is likely that the public will display a relatively high degree of attention when purchasing some of the aforementioned goods, given that they may, to a lesser or greater extent, affect their state of health. In particular, it is apparent from the case-law that, so far as pharmaceutical preparations and medicines are concerned, the relevant public's degree of attention is considered high, whether or not issued on

prescription (15/12/2010, T 331/09, Tolposan, EU:T:2010:520, § 26 and 15/03/2012, T 288/08, Zydus, EU:T:2012:124, § 36). In particular, medical professionals have a high degree of attentiveness when prescribing medicines. With regard to non-professionals, they also show a higher degree of attention, regardless whether the pharmaceuticals are sold without prescription. Therefore, the public's degree of attention is considered to be high.

### c) The signs

WARTNER	WORTIE
Earlier trade mark	Contested sign

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The earlier sign is the seven-lettered word mark 'WARTNER'.

The contested sign is the six-lettered word mark 'WORTIE'.

The element 'WART' of the earlier sign refers to 'a small, hard, benign growth on the skin, caused by a virus' (information extracted from the online Oxford English dictionary) for the English-speaking part of the public. Moreover, it is not excluded that this verbal component will also be understood by the Dutch-speaking part of the public as its Dutch equivalent 'WRAT' is very similar. Bearing in mind that some of the relevant goods are pharmaceuticals and sanitary preparations that could be used to treat such a disease, this element may appear weak for part of the relevant goods for the aforementioned part of the public. Hence for this part of the public, this element will be of a lesser importance in the present comparison.

That being said, the earlier sign will only appear as a fanciful or foreign word for a part of the relevant public, with no element that could be considered clearly more distinctive than others.

As for the contested mark, it has no elements that could be considered clearly more distinctive than other elements.

Moreover, neither the earlier mark nor the contested sign has any element that could be considered more dominant (visually eye-catching) than other elements.

**Visually**, the signs have four letters in common placed in the same order out of six/seven letters: 'W-RT-E'. That being said, although both signs begin with the letter 'W', it is associated with distinct vowels, namely 'A' in the earlier mark and 'O' in the contested mark. As regards the common letters 'RT', they are situated in the middle of the signs, an area where consumers generally tend to focus less when being confronted with a trade mark. As for the common vowel 'E', it has a very little impact on the visual comparison as it is surrounded by differing letters: 'NER' in the earlier sign and 'IE' in the contested sign. As a result, the similarities arising from these

common letters are largely counterbalanced by the differing letters. Moreover, the vowel structure of each sign is significantly divergent, that is ‘\*A\*\*E\*’ in the earlier mark (two vowels) versus ‘\*O\*\*IE’ in the contested sign (three vowels), noting also that the only vowel ‘E’ shared by both signs occupies a different place in each sign, namely the penultimate position in the earlier mark and the last one in the contested sign.

Therefore, the signs are visually similar to a low degree.

**Aurally** and irrespective of the different pronunciation rules in different parts of the relevant territory, although the pronunciation of the signs coincides in the sound of the common consonants ‘W-RT( )’, the beginnings of the marks are still differentiated due to the juxtaposed vowels to these consonants, namely ‘A’ in the earlier sign and ‘O’ in the contested sign: ‘WAR’ versus ‘WOR’. Moreover, as seen above, the common consonants ‘RT’, although pronounced in the same manner, are situated in the middle of the signs, an area where consumers generally tend to focus less when being confronted with a trade mark. Furthermore, the endings of the signs differ quite considerably ‘TIE’/‘TNER’, notably because the earlier mark finishes on the consonant ‘R’ whereas the contested mark on the vowel ‘E’. Although the latter is identically contained in both signs, its impact on the aural comparison is limited as it is surrounded by differing letters. Finally, the previous assessment about the vowel structure of each sign also applies for the aural comparison.

Therefore, the signs are aurally similar to a low degree.

**Conceptually**, neither of the signs has any meaning as a whole for the public in the relevant territory and they may appear as fanciful or foreign words.

Reference is made to the previous assertions regarding the meaning of WART for the English and Dutch speakers. Hence, since only one sign has a meaning for this part of the public, the sign are not conceptually similar.

As for the part of the public who will not perceive any meaning in the signs, since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

#### **d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in ‘Global assessment’). The examination will proceed on the assumption that the earlier mark has enhanced distinctiveness.

**e) Global assessment, other arguments and conclusion**

According to the case-law of the Court of Justice, in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, aural and conceptual similarities between the marks. The comparison 'must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components' (11/11/1997, C 251/95, Sabèl, EU:C:1997:528, § 22.). Likelihood of confusion must be assessed globally, taking into account all the circumstances of the case.

Likelihood of confusion implies some interdependence between the relevant factors, and, in particular, similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa (29/09/1998, C 39/97, Canon, EU:C:1998:442, § 17).

Moreover, it must be borne in mind that although the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect, account is taken of the fact that consumers only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that they have kept in their minds. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (22/06/1999, C 342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

The Opposition Division has assumed in part d) of this decision that the earlier mark has been extensively used and enjoys an enhanced scope of protection. The examination of likelihood of confusion will, therefore, proceed on the premise that the earlier mark has an enhanced degree of distinctiveness. The more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore, marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

As a preliminary remark, it must be reminded that the relevant public is the general public, as well as professionals in the health sector of the European Union, with a high degree of attention.

In the present case, the contested goods have been found identical.

As for the signs, although they show some visual and aural similarities due to their four common letters 'W-RT-E', the impact of the similarities arising from the latter is limited, in particular given their central position for some of them, their different endings and their divergent vowel structure. As a result, the differences between the signs are more decisive for the outcome than the similarities, also the high attentiveness of the relevant public also leans in favour of the absence of a risk of confusion to the extent that the relevant public will be more aware of the differences between the signs.

It must also be noted that the conceptual level is irrelevant for a part of the public, while for the part of the public that will understand the meaning of the element 'WART', the signs are even more further apart since only the earlier mark may convey a concept. Moreover, for this part of the relevant public, the impact of this component is lesser and, consequently, also its coinciding letters 'W\*RT'.


Hence, the visual and aural coincidences between the signs are outweighed by their differences and will not give rise to a likelihood of confusion, even in relation to identical goods. Therefore, the opposition must be rejected insofar as it was based on Article 8(1)(b) EUTMR.

The opponent refers to previous decisions of the Office to support its arguments. However, the Office is not bound by its previous decisions as each case has to be dealt with separately and with regard to its particularities.

This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198).

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.

In the present case, the opponent referred to the opposition decision No 2 130 725 of

24/04/2014, relating to the trade marks WAHACA and . However this decision appears irrelevant to the present proceedings as the trade marks in that case only had one differing letter in penultimate position and the signs presented much more similarities in their verbal elements than in the present case.

Given that the opposition is not well founded under Article 8(1) EUTMR it is unnecessary to examine the evidence of use filed by the opponent.

Likewise, even on the assumption that the earlier mark enjoys an enhanced distinctiveness due to its extensive use, the outcome of no likelihood of confusion remains the same. Therefore, it is not necessary to examine the evidence of enhanced distinctiveness.

#### **REPUTATION – ARTICLE 8(5) EUTMR**

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, 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.

Therefore, the grounds of refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08, & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41). However, the fulfilment of all the above mentioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

#### **a) Reputation of the earlier trade mark**

According to the opponent, the earlier trade mark has a reputation in the United Kingdom, Germany, Netherlands, Belgium and Luxembourg.

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case the contested trade mark was filed on 21/03/2014. However, the contested trade mark has a priority date of 26/09/2013. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the United Kingdom, Germany, Netherlands, Belgium and Luxembourg prior to that date. The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation, namely:

Class 5: *Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; disinfectants.*

Moreover, the relevant public is the general public as well as professionals of the health sector in the relevant territory.

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

The opponent submitted evidence to support this claim. As the opponent requested to keep certain commercial data contained in the evidence confidential vis-à-vis third



parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data.

As a preliminary remark, it must be noted that some of the evidence did not relate to the trade mark 'WARTNER' but to the applicant's trade mark applications or websites. Therefore these pieces of evidence are irrelevant to the present assessment of the reputation of the mark 'WARTNER' and have to be put aside and are not included in the following list of evidence. Likewise, the annexes II.C.8, II.C.10 and II.C.15 on CD have been submitted by the opponent after the time limit and will not be taken into account in the present assessment.

The evidence consists, in particular, of the following documents:

- Annex I.1: various undated screenshots in English and other languages from the website [www.wartner.com](http://www.wartner.com), on which the trade mark 'WARTNER' appears in relation with products for removal of warts and verrucas, nail fungus as well as corns and persistent callus.
- Annex II.A.1: documents from IMS (*'IMS Health is a leading global information and technology services company providing clients in the healthcare industry with end-to-end solutions to measure and improve their performance'* information extracted from the website [www.imshealth.com](http://www.imshealth.com) on 11/03/2016) in English and dated 08/2005, presenting a chart showing the number of sales and the market share of wart removal products sold under the trade marks 'WARTNER' and 'CRYOPHARMA' for August 2003, 2004 and 2005, for a certain territory (United Kingdom, Germany, Netherlands, Belgium, France, Spain, Portugal, Italy, Switzerland).
- Annex II.A.2: undated document from IMS in English showing the market shares for the 'WARTNER' products for the removal of warts and corns on 09/2013 and for Europe.
- Annex II.A.3: letter in English dated 23/02/2011 from Paul Jenner, director of marketing communications at IMS Health granting permission to the company Omega Pharma to use the claim 'No1 anti-wart brand in the world' on all packs of 'WARTNER' and 'CRYOPHARMA' products.
- Annex II.A.4: letter in English dated 14/02/2014 from Tor Constantino, Director of Global Public Relations and External Affairs at IMS Health granting permission to the company Omega Pharma to use the claim 'No1 anti-wart brand in the world' in all communications.
- Annex II.B.1: eight invoices in Dutch dated 2011, 2012, 2013 and 2014, addressed to various towns in the Netherlands and on which can be seen 'WARTNER' products.
- Annex II.B.2: CE certificate for medical device issued on 14/05/1998 to Wartner B.V. for a wart treatment product.
- Annex II.B.3: undated document of an unknown provenance showing the number and the amounts of sales of 'WARTNER' products from 2010 to 2014 for the territory of Germany.

- Annex II.B.4: three invoices in German and dated 2001 for marketing expenditures on which the trade mark 'WARTNER' appears.
- Annex II.B.5: twelve invoices in English dated 2012, 2013 and 2014, addressed in particular to the United Kingdom and on which the trade mark 'WARTNER' appears.
- Annex II.C.1: various press articles on which the trade mark 'WARTNER' appears:
  - undated article in Dutch from an unknown source;
  - article in Dutch from Het Volk dated 27/05/2000;
  - article in Dutch from Het Nieuwsblad dated 25/05/2000;
  - article in French from Le Soir dated 06/06/2000;
  - article in French from DH dated 17/05/2000;
  - article in French from Vers L'Avenir dated 27/05/2000;
  - article in Dutch from Het Laatste Nieuws dated 27/05/2000;
  - article in Dutch from Laatste Nieuws dated 18/05/2000;
  - article in French from D-santé dated 06/2000;
  - article in French from Flair dated 15/06/2000;
  - article in French from Notre Temps dated 07/2000;
  - article in Dutch from Onze Tijd dated 07/2000;
  - article in French from Gaël dated 01/08/2000;
  - article in Dutch from De Weekkrant ed.Tienen dated 03/07/2000;
  - article in Dutch from Knack Weekend dated 27/07/2000;
  - article in French from Tageblatt dated 01/08/2000;
  - article in French from Le Soir Illustré dated 26/07/2000;
  - article in French from Santé dated 07/2000;
  - article in Dutch from Goed Gevoel dated 08/2000;
  - article in Dutch from Teve Blad dated 15/07/2000;
  - article in French from Notre Temps dated 01/07/2000;
  - article in Dutch from Onze Tijd dated 19/06/2000;
  - article in Dutch from D-Gezondheid dated 20/06/2000;
  - article in Dutch from Flash magazine dated 26/06/2000;
  - article in Dutch from Boeket Magazine dated 06/2000.
- Annex II.C.2: two undated leaflets in Dutch and in French on which the trade mark 'WARTNER' appears in relation with products for the removal of verrucas.
- Annex II.C.3: undated leaflets in Dutch and in French on which the trade mark 'WARTNER' appears in relation with products for the removal of verrucas and nail fungus
- Annex II.C.4: various invoices relating to the marketing and advertising of 'WARTNER' products in Belgium, namely:
  - 3 invoices in Dutch dated 2001 for marketing and advertising (TV campaign, radio) on which the trade mark 'WARTNER' appears.
  - document in Dutch presenting the times of airing of a radio spot on Fréquence Wallonie between 24/09/2001 and 29/09/2001 (12 airings). There is no mention of the trade mark 'WARTNER'.

- two invoices in French without a clear source dated in 2002 for advertisements in the newspapers 'Le Soir' and 'De Standaard' for 'WARTNER' products, on 11/05/2002, 25/05/2005, 08/06/2002 and 22/06/2002;
  - six invoices in Dutch dated 2011 and 2012 for 'WARTNER' campaigns for verruca removal products on various channels (101 airings on seven channels between 01/08/2010 and 26/08/2010; 170 airings on four channels between 04/07/2011 and 31/07/2011; 96 airings on three channels between 01/09/2011 and 30/09/2011; 101 airings on four channels between 01/08/2011 and 31/08/2011; 138 airings on five channels between 09/07/2012 and 29/07/2012; 133 airings on five channels between 06/08/2012 and 31/08/2012)
  - invoice in French dated of 25/06/2013 for the adaptation of a 'WARTNER' spot in French;
  - seven invoices in Dutch for 'WARTNER' campaigns dated 2013, and 2014;
  - invoice in Dutch dated 2014 for the update of 'WARTNER' Belgium website.
- Annex II.C.5: fourteen invoices in Dutch dated 2013 and 2014 relating to the marketing and advertising of 'WARTNER' products in the Netherlands, including two invoices for a 'WARTNER' campaign (300 airings on five channels between 15/04/2013 and 05/05/2013).
  - Annex II.C.6: four photographs of 'WARTNER' displays or 'WARTNER' products displayed on shelves in various shops.
  - Annex II.C.7:
    - six undated examples of advertisements for 'WARTNER' products in Dutch;
    - advertisement for a 'WARTNER' product in an undated Kruidvat catalogue in Dutch;
    - five advertisements for 'WARTNER' products in Dutch in unknown retail catalogues.
  - Annex II.C.9: undated leaflet in German showing various 'WARTNER' advertisements and packaging from 2004 to 2012.
  - Annex II.C.11: document in German presenting a 2001 campaign for 'WARTNER' products in various printed media.
  - Annex II.C.12:
    - document dated 27/08/2014 from Nielsen showing marketing expenditures for the 'WARTNER' products from 2005 to 2014 in relation with various media supports.
    - six invoices dated 2013 and 2014 for advertisements of 'WARTNER' products in TV.
  - Annex II.C.13: article mentioning the 'WARTNER' products and an advertisement in German in Apotheke Krobe dated 2004.
  - Annex II.C.14: leaflet in English dated 2011 relating to 'WARTNER' products for removal of verrucas, warts, corns and callus'.

It is clear from the evidence that the earlier trade mark 'WARTNER' has been subject to long standing and intensive use in the Netherlands, Belgium and Germany. In particular, the opponent submitted a document attesting its use in the Netherlands back to 1998 (Annex II.B.2). As for the territory of Belgium, various press articles confirm the launching of 'WARTNER' products in 2000 (Annex II.B.4). Concerning the German territory, the opponent supplied invoices dated of 2001 (Annex II.B.4). Moreover, the opponent submitted several documents showing the continuous use of the trade mark 'WARTNER' until 2014, whether it is through invoices (Annex II.B.1), sales or market shares reports (Annexes II.A.1 and II.A.2), marketing expenditures reports or advertisings (Annexes II.C.7, II.C.9, II.C.11, II.C.12).

Furthermore, several pieces of evidence show the large financial investments on marketing, advertising and promotion for the trade mark 'WARTNER', in various media supports, for instance in the press, on television or radio. The substantial amount of advertising increases consumer exposure to the opponent's mark. In particular, the opponent submitted documents attesting that advertising and promotional expenditure in connection with its 'WARTNER' products are substantial in the Belgium territory (Annex II.C.4). For example, between 07/2011 and 09/2011, 367 television advertisements have been aired on various Belgium channels, as well as 271 between 07/2012 and 08/2012. Similarly, between 04/2013 and 05/2013, 300 advertisements have been aired on Dutch television (annex II. C5). As for the German territory, the opponent supplied a document presenting the amount of promoting expenditure for various media supports between 2005 and 2014, here again confirming a considerable investment (Annex II.C.12).

The opponent also submitted documents relating to the sales numbers and market shares of 'WARTNER' products (Annex II.A.1). In particular, it can be observed that the opponent has an overall leading position on the European market for products for warts removal between 2003 and 2005, namely for the territories of the United Kingdom, Germany, Netherlands, Belgium, France, Spain, Portugal, Italy and Switzerland. It must be noted that the latter is not part of the European Union and that some of the other countries, namely France, Italy, Portugal and Spain, are not concerned by the claim of reputation. Although the numbers also concern the products sold under the trade mark 'CRYOPHARMA', the opponent indicated in its observations that the latter was marketed under the mark 'WARTNER'. Moreover, the attached diagram showing the market shares in the aforementioned territories for warts removal products indicates that for 2004 and 2005, the opponent had a leading position with the sole 'WARTNER' trade mark. Moreover, several diagrams confirm the dominance of the opponent with the 'WARTNER' mark on this particular market for the territories of Belgium (around 40 % in 2004, around 50% in 2005), Germany (around 40% in 2005) and the Netherlands (around 30% in 2004, around 40% in 2005). Furthermore, this dominant position is confirmed by the document submitted in Annex II.A.2 showing the market shares for Europe on 09/2013 for 'WARTNER' products for the removal of warts and corns. Moreover, this leading situation is also attested on a more general level due to the opponent's right, given by the company IMS Health, to use the claim 'No1 anti-wart brand in the world' on all packs of 'WARTNER' and 'CRYOPHARMA' products and displays for the years 2011 and 2014 (Annexes II.A.3 and II.A.4).

As regards the products concerned by the submitted evidence, numerous documents directly concern products for the removal of verrucas, warts, calluses and corns (Annexes I.1, II.A.1, II.A.2, II.B.2, II.C.1, II.C.2, II.C.3, II.C.6, II.C.7, II.C.9 and II.C.14).

That being said, it must be noted that the opponent claimed reputation of the earlier trade mark for *sanitary preparations for medical purposes; disinfectants; veterinary*

*preparations* in Class 5, for which no evidence have been filed, as well as *pharmaceutical preparations* in Class 5 which is a broader category of products than the products shown in the evidence.

Therefore, the evidence filed by the opponent does not show reputation of the trade mark for the entire category of goods of the earlier mark for which it was claimed, but demonstrates use for only some of the goods included in the category for which the mark is registered. Accordingly, in the present case, the evidence shows reputation of the trade mark for *pharmaceutical preparations for dermatological use* in Class 5.

In the light of the above, and although the actual numbers of sales and marketing expenses cannot be disclosed due to confidentiality, the Opposition Division is of the opinion that the earlier trade mark has been subject to a long-standing and intensive use and that it was generally well-known by the consumers of Germany, Belgium and Netherlands before the contested mark's priority date, 26/09/2013, at least in relation to the following goods in Class 5: *pharmaceutical preparations for dermatological use*.

#### **b) The 'link' between the signs**

As seen above, the earlier mark is reputed. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed in the judgments of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66. It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

In the present case, as seen above the goods for which reputation has been proved, namely *pharmaceutical preparations for dermatological use*, are identical and highly similar to the contested *Pharmaceutical preparations for cosmetic purposes*,

*including pharmaceutical preparations for dermatological use, also intended for treating external skin swellings, including warts in Class 5.*

As for the contested *disinfectants for hygiene purposes* in Class 5, they are substances that destroy germs causing diseases. As such, they have the same medical general purpose as the opponent's *pharmaceutical preparations for dermatological use*. They can originate from the same undertakings and share distribution channels as well as end users. Therefore they must be considered similar.

As regards the contested *cosmetics and disinfectant soap* in Class 3, they are used to enhance or protect the appearance or odour of the human body. The opponent's *pharmaceutical preparations for dermatological use* on the other hand, comprise products, such as skin or hair care preparations with medical properties. They may have the same purpose as cosmetics. Moreover, they have the same distribution channels since they can be found in pharmacies or other specialised shops. They are directed at the same public and are often manufactured by the same companies. Therefore they must be considered similar.

Moreover, it must be borne in mind that the relevant public is the general public as well as professionals of the health with a high degree of attention.

Furthermore, it must be noted that, although the earlier trade mark possesses a weakly distinctive element in relation with the relevant goods for the English or Dutch-speaking parts of the public, namely 'WART', it has an inherent distinctive character, enhanced by the long-standing use and intensive use in Germany, Belgium and Netherlands.

As for the degree of similarity between the signs 'WARTNER' and 'WORTIE', they have only very low visual and aural similarities. Although they share letters in common, the latter only results in limited similarities between the trade marks as they are counterbalanced by their differences. Hence, although both signs begin with the letter 'W', it is associated with distinct vowels, namely 'A' in the earlier mark and 'O' in the contested mark. As for the common consonants 'RT', although pronounced in the same manner, they are situated in the middle of the signs, an area where consumers generally tend to focus less when being confronted with a trade mark. Moreover, the endings of the signs differ quite considerably 'TIE'/'TNER', notably because the earlier mark finishes on the consonant 'R' whereas the contested mark finishes on the vowel 'E'. Furthermore, the vowel structure of each sign is significantly divergent, that is '\*A\*\*E\*' in the earlier mark (two vowels) versus '\*O\*\*IE\*' in the contested sign (three vowels). Moreover, though sharing the only vowel ('E') this is in a different place in each sign, namely the penultimate position in the earlier mark and the last position in the contested sign. As a result and as seen before, there is no likelihood of confusion between the signs.

On this point it is relevant to clarify that the question of whether or not a link would be made is not solely dependent on the question of likelihood of confusion, as remarked from the outset. Indeed, protection under Article 8(1)(b) EUTMR is dependent on likelihood of confusion, but under Article 8(5) EUTMR there may be a lesser degree of similarity between the marks in question but still a risk of injury in the sense of the relevant provision. It is sufficient that the relevant public merely make a connection between the marks, that is to say, establish a link between them (judgment of 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53). Nevertheless the signs must display a sufficient degree of similarity in order for the later mark to bring

to mind the earlier mark. If the signs are not sufficiently similar, the possibility of the consumer forming a link will not exist.

Although the public might be able to perceive some coincidences between the signs at hand, they will only appear fortuitous and will not give rise to a déjà-vu feeling as the opponent indicates in its observations. The Opposition Division is of the opinion that the contested sign is too distant from the earlier sign to invoke the earlier mark in the mind of the relevant consumers, all the more so as the latter show a higher degree of attention given the nature of the relevant goods.

Furthermore, the opponent indicated in its observations that the applicant had filed a Benelux trade mark application 'WARTIE' on 21/05/2013 for similar goods, which was later withdrawn following an opposition from the opponent. The opponent also stated that the applicant uses the trade mark 'WARTIE' as well as 'WORTIE' in some of the countries in which its warts removal products are commercialised. In particular, the opponent is of the opinion that as this mark 'WARTIE' is closer to its own registered trade mark 'WARTNER', it will lead the public to confusion, thus reinforcing the link between the marks 'WARTNER' and 'WORTIE'. Nevertheless, such consideration cannot be taken into account in the present assessment as it does not concern the relevant trade marks.

In the light of the above, and in spite of the identity or similarity of the relevant goods and the reputation of the earlier mark, the differences between the signs and their different overall impression are significant enough for the public not to make any connection between them. Therefore, one of the conditions for applying Article 8(5) EUTMR, namely that the signs be sufficiently similar to lead the relevant public to make a connection between them, has not been met.

Therefore, the opposition fails also as far as it is based on the ground of Article 8(5) EUTMR.

## **COSTS**

According to Article 85(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and Rule 94(7)(d)(ii) EUTMIR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



### **The Opposition Division**

Vanessa PAGE

Benoit VLEMINCQ

Michaela SIMANDLOVA

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 EUTMR, notice of appeal shall be filed in writing at the Office within two months of the date of notification of this decision. It shall be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal shall be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) EUTMR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.