

OPPOSITION No B 2 883 117

S.A. Spa Monopole, Compagnie fermière de Spa, en abrégé S.A. Spa Monopole N.V., Rue Laporte, 34, 4900 Spa, Belgium (opponent), represented by **Gevers**, Brussels Airport Business Park, Holidaystraat, 5, 1831 Diegem, Belgium (professional representative)

a g a i n s t

Panturex Danismanlik Sanayi İç Ve Dis Ticaret Limited Sirketi, Uskumru Köy Mahallesi, Feslegen Sokak No: 7, Sariyer – Istanbul, Turkey (applicant), represented by **Silex IP**, Poeta Joan Maragall 9, Esc. Izq., 3º Izq., 28020 Madrid, Spain (professional representative).

On 31/01/2019, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 883 117 is upheld for all the contested goods, namely

Class 16: *Paper towels; toilet paper; paper napkins.*

Class 32: *Beers; preparations for making beer; mineral water, spring water, table water, soda water; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, non-alcoholic soft drinks; energy drinks.*

2. European Union trade mark application No 16 200 883 is rejected for all the contested goods. It may proceed for the remaining goods.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

The opponent filed an opposition against some of the goods of European Union trade mark application No 16 200 883 for the figurative mark , namely against some of the goods in Class 16 and all of the goods in Class 32. The opposition is based on, inter alia, Benelux trade mark registration No 389 230 for the word mark 'SPA'. The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of the trade marks on which the opposition is, inter alia, based, namely Benelux trade mark registration No 389 230 for the word mark 'SPA'.

The date of filing of the contested application is 23/12/2016. The opponent was, therefore, required to prove that the trade mark on which the opposition is based was put to genuine use in the Benelux countries from 23/12/2011 to 22/12/2016 inclusive.

The request was submitted in due time and is admissible given that the earlier trade mark was registered more than five years prior to the relevant date mentioned above.

Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 32: *Mineral water and aerated waters and other non-alcoholic beverages; syrups and other preparations to make beverages.*

According to Article 10(3) EUTMDR (former Rule 22(3) EUTMIR, in force before 01/10/2017), the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 19/03/2018, in accordance with Article 10(2) EUTMDR (former Rule 22(2) EUTMIR, in force before 01/10/2017), the Office gave the opponent until 24/05/2018 to submit evidence of use of the earlier trade mark. The deadline for filing proof of use was extended until 24/07/2018. On 25/10/2017 and 07/11/2017, together with the documents for filing further facts, evidence and arguments, the opponent submitted in particular the evidence below mentioned, which will also be taken into account for proving use, as it was submitted before the deadline mentioned above.

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.

The evidence to be taken into account is, inter alia, the following:

Evidence of 25/10/2017 and 07/11/2017:

[?] Extracts of the publication 'LE GUIDE DU BUVEUR D'EAU' by Emmanuelle Evina, Reviewed Edition 1997, referring to more than 90 mineral and spring waters and citing on page 241 till 245 the trade mark SPA, mentioning the international reputation of the trade mark on page 241 as well as the high purity of the mineral water SPA REINE.

[?] Extracts from the Belgian weekly magazine 'Echos de SPA THEUX' – edition 26 August 1998 entitled: 'Bons Baisers de Spa: Spa Monopole en cartes postales' and referring to the fact that the company Spa Monopole is not only a company known all over the world but has also become an inevitable magnet for tourists in the region with approximately 40.000 visitors on an annual basis, citing the word mark 'SPA' in the last paragraph.

[?] Copy of an extract from the Belgian daily magazine 'La Meuse Verviers' – edition 7 December 1999 entitled: 'LES ARTISTES en bouteille' relating to the opening of the 35th harnessing for Spa Monopole, mentioning that the company produces 500.000.000 litres per year.

- [?] Copies of an extract of the book entitled: 'THE ORIGINAL SPA WATERS OF BELGIUM' by L.M. Crismer, 1989, pages 9, 10, 11, 65, 66, 67, 72, 75, 88, 96, 99, 103. On pages 66 and 67, the extract shows a range of labels of the word mark 'SPA' since 1921.
- [?] An extract of a publication entitled: 'THE GOOD WATER GUIDE' by Maureen & Timothy Green – THE WORLD'S BEST BOTTLED WATERS Revised edition 1994, page 88, showing a label bearing the word mark 'SPA'.
- [?] Copy of an extract from the publication 'THE FAMOUS BRANDS' by Theo Visser & Robert-Jan Heijning, Editions Markgraaf 1985, page 122 which refers to mineral water 'SPA'.
- [?] Copy of an extract from a supplement to the newspaper 'La Dernière Heure' dated 10 June 1994, 'SPECIAL NATURE L'EAU', pages 4 and 8.
- [?] Copy of an extract from the 'Eco Soir' - 'Le Soir' September 1, 2000'.
- [?] Information regarding the events sponsored by the opponent, extract of the Internet sites including a leaflet regarding the sponsoring of '20 KM de Bruxelles – Edition 2000', where the participants wear a number showing the word mark 'SPA'.
- [?] Copy of a Declaration from Mr. Marc du Bois, Managing Director of S.A. Spa Monopole N.V., regarding the sales figures and the global advertising budget in respect of products sold by S.A. Spa Monopole N.V. under the trade mark 'SPA' in the Benelux countries (natural mineral waters, carbonated mineral waters, soft drinks and other non-alcoholic drinks) for the period 1990 to 2014.
- [?] 1 CD relating to Annual Reports for the period 1989 to 1999 with an English summary and showing the structure of the group SPADEL and the relationship between SPADEL S.A. and the opponent. The reports also show various advertisements of the trade mark 'SPA' and the extent of use.
- [?] 1 CD concerning the opponent which contains an old short film entitled: 'SPA RICHESSE NATIONALE' (Spa national resource) which shows the extent of the activity of the company Spa Monopole in the early years and which also includes a compilation of advertisements and commercials of the trade mark 'SPA' in the years 1923, 1960, 1975, 1987, 1989, 1990, 1992, 1993, 1994, 1996, 1998 and 2000.
- [?] 1 CD relating to various advertisements of the trade mark 'SPA'.
- [?] Copies of extracts of 'Trends Magazine Top 5000' No 51-52 of 23 December 1999, No 51 of 21 December 2000, No 50 of 11 December 2003 citing the 'TOP 5000 biggest enterprises in Belgium' showing the turnover of Spa Monopole for the years 1997-1998, 1998-1999, 2001 and 2002. The extracts show that the opponent ranks third in the first two lists and the third as regards the breweries and soft drinks sector.
- [?] Extracts from the magazine entitled: 'bottledwaterworld' May-June 2001.
- [?] Extracts from the publication entitled: 'Le grand livre de l'eau, Histoire, Traditions, Environment, Art de Vivre' de Jacques Mercier, La Renaissance du Livre, 2000, citing the opponent on page 112 and listing various trade marks

of the Belgian market regarding mineral waters in Belgium, mentioning that 'SPA is the leader with 23,6% of the market' on page 117.

[?] Extract of 'La libre Entreprise' of 22 July 2000, entitled: 'Que d'eaux, que d'eaux'.

[?] Copy of 3 labels affixed to the goods of the opponent showing that the mineral water 'SPA' is recognised by the Royal Academy of Medicine in Belgium as being highly beneficial for the health and showing also the use on the labels of the word mark 'SPA'.

[?] Extracts of the Decision *Estee Lauder Cosmetics* (Appeal Court Brussels 31/03/1983).

[?] Copy of extracts from the publication 'Trends Tendances' No 30-31 of 25 July 2002 entitled: 'Nestle Waters/Spadel – Des Eaux fortes'.

[?] Extract of 'London Baby Book 2002/03' by Kate Calvert.

[?] Extracts of annual reports relating to advertisements made by the opponent showing the image of purity of the mineral water 'SPA' during the years 1991, 1993-1997.

[?] Copy of a leaflet regarding the Biennial Spa Foundation Prize 'The Original Spa Water' created in 2003.

[?] Copy of a press article from 'La Libre Belgique' dated 20 December 2005, citing the trade mark 'SPA' as the 7th most valuable Belgian trade mark.

[?] Copy of an independent survey, namely the 'Reader's Digest survey European most trusted brands' citing 'SPA' as the 7th most trusted brand for soft drinks in Belgium and the Netherlands for the years 2003, 2004 and 2005.

[?] Copy of a press article from 'L'Echo', dated 17 January 2003 citing Spadel as the leader on the market of waters.

[?] Copy of extracts from press articles regarding the reputation of the trade mark 'SPA' for mineral waters: articles from 'Het laatste Nieuws' (13/03/2003), 'La Dernière Heure' (13/03/2003), 'De Financieel-Economische Tijd' (17/03/2003).

[?] Copy of a press article 'SPA couronnée meilleure eau d'Europe' (Belgian newspaper 'La Dernière Heure – Les Sports' – 30 January 2009) and English translation. This prize is awarded by CERAM (Centre Européen de Recherche en Eaux Minérales), 'the European Center for research in mineral waters'. This prize is based on a scientific study based on four criteria: the intrinsic characteristics of the goods, the company's policy in the field of protection of natural resources, the research and development and the marketing of the goods. This prize was awarded for the first time to 'SPA', 'a Belgian water that has reached a milestone in the history of natural mineral waters and that is today still recognised for its original purity and its constant quality'. A copy is enclosed of the press report from CERAM ('Centre Européen de Recherche en Eaux Minérales'), dated 29 January 2009 and an extract from the Belgian press article 'Le Soir', dated 30 January 2009.

[?] Extracts from the website 'www.wherebrandsbecomestars.com/The-Brand-Rankings.aspx', printed on 29 April 2010, showing the trade mark 'SPA' in 22nd position amongst the 100 most performing brands in the Dutch supermarkets for the years 2008 and 2009, in the industry of 'food and beverage'.

[?] Extract from a catalogue from the supermarket 'Colruyt', dated 19 May 2010 till 1 June 2010 showing a campaign for 30 years of red prices and in particular the mineral water 'SPA' which was already commercialised in 1980 and the label used in 1980 compared to the label used in 2010.

[?] Copy of extracts from Belgian publication 'Bizz' – June 2010 'La cure de jeunesse d'une eau multiséculaire'.

[?] Extracts of Annual Reports for the years 2005, 2006, 2007, 2009, 2010, 2011, 2012 and 2013 and an English translation showing the activity of the opponent relating to the mineral waters and soft drinks commercialised under the trade mark 'SPA' and some sales figures relating to the trade mark 'SPA'.

[?] Copy of an article from 'Entreprendre Today' concerning an opinion poll conducted by the independent company 'akkanto' which shows that SPADEL (trade marks 'SPA' and 'BRU') is the Belgian company which has the second best reputation among the top ten Belgian enterprises. The poll was conducted among 14.000 Belgian persons during January-February 2012 (copy of press article dated 25 April 2012).

[?] Copies of extracts of the magazine 'Trendstop' 2012 (supplement to 'Trends Tendances' No 49 of 8 December 2011) and 'Trendstop' 2013 (supplement to 'Trends Tendances' No 49 of 6 December 2012). These extracts relate to the ranking of the TOP 5000 biggest enterprises in Belgium according to financial results in 2009, 2010 and 2011 and show Spa Monopole at the 3rd position in its sector (drinks, with or without alcohol).

[?] Copies of press release extracts for 2008, 2009, 2010 and 2011.

[?] Copies of extracts of the magazine 'Trendstop' 2014 (supplement to 'Trends-Tendances' No 49 of 5 December 2013). These extracts relate to the ranking of the TOP 5000 biggest enterprises in Belgium according to financial results in 2011 and 2012 and show Spa Monopole in 3rd position in its sector (drinks, with or without alcohol). The turnover figures of 'Spa Monopole' for the year 2011 were EUR 121.776.000 and for 2012 EUR 122.280.000.

[?] Copies of extracts of the magazine 'Trendstop' 2015 (supplement to 'Trends-Tendances' No 50 of 11 December 2014). These extracts relate to the ranking of the TOP 5000 biggest enterprises in Belgium according to financial results in 2012 and 2013 and show Spa Monopole in 3rd position in its sector (drinks, with or without alcohol). The turnover figures of 'Spa Monopole' for the year 2013 were EUR 123.004.000 and for 2014 EUR 133.959.000.

[?] Copies of extracts of the magazine 'Trendstop' 2016 (supplement to 'Trends-Tendances' No 50 of 10 December 2015). These extracts relate to the ranking of the TOP 5000 biggest enterprises in Belgium according to financial results in 2013 and 2014 and show Spa Monopole in 3rd position in its sector (drinks, with or without alcohol).

[?] Copy of an article dated 30 November 2016 of the Belgian newspaper 'La Libre Belgique', titled: 'Les eaux SPA visent l'Horeca néerlandais' (The SPA waters target the Dutch horeca) mentioning the market share of Spadel in the Netherlands and in Belgium. The article mentions that 'SPA' owns approximately 30% in the sector of the large retailers in the Netherlands of the bottled water product. In Belgium, the group owns approximately 20% of the market shares in all the sectors.

[?] A copy of the decision rendered by the Court of Commerce of Brussels on 19 December 2003, in case 'SPA' versus 'ART OF SPA' with an English summary (Ingénieur Conseil No 4, 2003, pg 359 till 378), ordering the nullity of the Benelux trade mark 'ART OF SPA' in Class 3.

[?] Judgment of the Court of Appeal of Brussels of 4 September 2007 ruling on Cases R.G.: 2004/AR/1447 and 2007/AR/105 and a translation thereof, confirming the judgment of the Court of Commerce of Brussels of 19 December 2003 in the case of 'ART OF SPA'.

[?] Copy of the decision rendered by the Court of Appeal of Liege (Belgium) on 8 March 2010 confirming the reputation of, inter alia, trade mark 'SPA' in Class 32 in the Benelux and an English translation of some extracts (21 pages). A copy of the publication of this decision, together with a summary in English (ICIP – Ingénieur Conseil No 1/2010, pages 59, 60, 61 and 62) (3 pages). Therefore, a full translation into English of the decision rendered in French by the Court of Appeal of Liege.

[?] Copy of the decision rendered by the Court of Commerce of Brussels on 3 February 2011 and an English translation of some extracts, of 'SPA MONOPOLE' versus 'The Body Shop International' ('SPA WISDOM').

[?] Copy of the decision rendered by the Court of Appeal of Brussels on 16 September 2016 confirming the judgment of the Court of Commerce of Brussels of 3 February 2011 in the case Spa Monopole/The Body Shop International ('SPA WISDOM').

The Court of Justice has held that there is 'genuine use' of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (11/03/2003, C40/01, Minimax, EU:C:2003:145 and 12/03/2003, T174/01, Silk Cocoon, EU:T:2003:68).

Taking into account the evidence in its entirety, it is sufficient to prove genuine use of the earlier trade mark during the relevant period in the relevant territory, which will, hereunder, be described in more detail.

The article in 'Entreprendre Today' concerning an opinion poll conducted among 14.000 Belgian persons, a survey conducted by 'Ipsos' in Belgium amongst 2.500 persons and published in 'Le Soir', the extracts of the magazine 'Trendstop' from several dates (2012, 2013, 2014, 2015 and 2016), the advertisement with reduction vouchers valid until 30/04/015 in Belgium and Luxembourg (published in the Belgian newspaper 'La Libre Belgique'), a copy of a promotional action 'WAKE UP WITH SPA' in the Netherlands and Belgium with reduction vouchers valid in Belgium until 31/07/2015, the article in the Belgian newspaper 'La Libre Belgique' mentioning, inter

alia, the market share of Spadel in Belgium and the Netherlands, the various articles in newspapers, such as 'La Libre Belgique', 'Le Soir', 'Knack' and 'L'Echo' and the annual reports, show that the place of use is mainly Belgium, but also, even to a lesser extent, the Netherlands. This all can be inferred from the language of the documents (French and Dutch), the opinion poll and the survey, but also the article from 'Entreprendre Today' showing that the company 'SPA' has the second best reputation among the top ten Belgian enterprises, as well as that, according to the survey, 'SPA' is ranked in 16th position. Furthermore, in the three articles from the magazine 'Trendstop', these mention that 'Spa Monopole' is at the 3rd position in its sector and the article of 'La Libre Belgique', titled: 'Les eaux SPA visent l'Horeca néerlandais' mentions the market share of 30% in the sector of large retailers in the Netherlands and of 20% in all the sectors in Belgium. In this sense, according to Article 15(1) and Article 42(2) EUTMR, if the earlier mark is a European trade mark, it must be used in the European Union. However, genuine use with the meaning of Article 15 EUTMR may also be found when the criteria of that article have been complied with in only one part of the European Union, such as in a single Member State or in a part thereof. The same principle is applicable with respect to an earlier Benelux trade mark, which is used only in one part of the Benelux countries (Belgium and the Netherlands), which is mainly the case here. Therefore, it is considered that the evidence proves that the mark has been used in the relevant territory, namely the Benelux.

As previously mentioned, the opponent was required to prove that the trade mark on which the opposition is based was put to genuine use during the period from 23/12/2011 to 22/12/2016. Even though the evidence shows a lot of use of the trade mark before the relevant dates, there is also sufficient evidence falling inside of the relevant period, such as the extracts of the annual reports from 2011, 2012, 2013, 2014, 2015 and 2016, a press article in 'Entreprendre Today', dated 25/04/2012, several extracts from the magazine 'Trendstop', dated in 2012, 2013, 2014, 2015 and 2016, an article of 30/11/2016 in 'La Libre Belgique', an article of 09/10/2014 in 'La Libre Belgique-Brabant Wallon', an article of 27/03/2015 in 'Le Soir', an article of 07/04/2015 in 'Knack' and an article of 31/03/2015 in 'L'Echo'. Therefore, in the view of the Opposition Division, the evidence of use filed by the opponent contains sufficient indications concerning the time of use, also because the opponent has submitted material covering the whole period of five years, it is equally distributed over these years, and it is dated even before and after the relevant date.

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

In particular the number of sales mentioned in the annual reports show that the total number of goods sold amounts to an extraordinarily number of sales, (see for the exact numbers above and also hereunder), and provides the Opposition Division with sufficient information concerning the commercial volume, territorial scope, duration, and frequency of use and give sufficient indications concerning the extent of the use of the earlier mark. Furthermore, it is also important to mention that according to, for example, the opinion poll conducted by the independent company 'akkanto', the opponent has the second best reputation among the top ten enterprises in Belgium, as well, according to the extracts of the magazine 'Trendstop', all these show 'Spa' in 3rd position and in 2015-2016 in 5th position and, from the article in 'La Libre Belgique', the market share in the Netherlands can be deduced, namely 30% in the sector of large retailers and 20% market share in Belgium in all the sectors. Furthermore, the turnover figures amount to a very high number of sales, as well as the investment expenditures in 2014 do (the number of which for reasons of confidentiality cannot be revealed).

Moreover, the evidence shows that the mark has been used in accordance with its function and as registered for at least some of the goods on which the opposition is based, namely *mineral water and aerated waters* in Class 32, as the proof concerns essentially these products, which clearly emerges, for instance, from the annual reports, the different press articles and advertisements. Even though some of the evidence shows the mark 'SPA' in a figurative way, this does not affect the distinctive character of the word mark, because the figurative elements are merely secondary.

The Opposition Division will now examine the opposition on the ground of Article 8(5) EUTMR.

REPUTATION — ARTICLE 8(5) EUTMR

The Opposition Division claims reputation in relation to earlier Benelux trade mark registration No 389 230 in the Benelux countries for *mineral water and aerated waters* in Class 32.

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will 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 European Union 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 contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for 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: 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, T345/08 & T357/08, 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

The evidence submitted by the opponent to prove the reputation of the earlier trade mark has already been listed above under the section of 'PROOF OF USE'; the opponent submitted evidence to prove reputation on 25/10/2017 and 07/11/2017.

Reputation implies a knowledge threshold that 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 23/12/2016. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the Benelux countries prior to that date. The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation.

The evidence mentioned before relates to the relevant period and shows that on account of the intensity and duration of use and the value associated with the mark a significant part of the relevant public recognises the trade mark 'SPA' and knows the goods (at least part of them) marketed under this sign. The earlier trade mark has been subject to long-standing and intensive use and is generally known in the sector of mineral waters, for which it enjoys a leading position in the Benelux market, and represents the biggest part of the Belgian market in the field of bottled mineral waters (see, inter alia, 'Le Grand Livre de l'Eau, Histoire, Traditions, Environnement, Art de Vivre'). This is also attested by a variety of independent sources, impressive figures, such as 'SPA' being the leader with 23,6% of the market and the production of 500.000.000 litres per year, publications in books and magazines, press releases, decisions of the national Courts. Furthermore, the continuous advertising and promotional campaigns since 1923 are particularly significant. There is also an extract showing that the trade mark 'SPA' is rated as the 7th most valuable Belgian trade mark and some extracts from 'Trends Magazine Top 5000' showing that the opponent ranks third as regards the breweries and soft drinks sector.

In particular, the sales figures and the global advertising budget featuring the earlier trade mark during the period from 1990 to 2014 (some of which for reasons of confidentiality and as requested by the opponent cannot be revealed in this decision) are very impressive. Even though the figures appear in the Declaration signed by Mr Marc du Bois, Managing Director of S.A. Spa Monopole N.V., these figures are corroborated by the following evidence: extract from the website www.wherebrandsbecomestars.com, dated 29/10/2010, showing the trade mark 'SPA' in 22nd position amongst the 100 most performing brands in the Dutch supermarkets in 2008, 2009; an article from 'Entreprendre Today' concerning an opinion poll showing that the Belgian company has the second best reputation among the top ten Belgian enterprises during 2012; extracts from the magazine 'Trendstop' from several years (2011-2016) according to which the opponent is ranked at the 3rd position in the beverage sector. All this evidence together allows the Opposition Division to conclude that the mark 'SPA' is widely recognised by the Benelux consumers as a very well-known mark in relation to *mineral water and aerated waters* in Class 32.

From all the above mentioned it can be concluded that the 'SPA' reputation is beyond serious dispute. The opponent has provided cogent and incontrovertible evidence that the trade mark in question has been put to intensive use. The evidence demonstrates that it has sold substantial amounts of bottles of water. It is, therefore, reasonable that the trade mark in question must have come to the attention of a large number of consumers in the Benelux, especially as the opponent has also supplied so much evidence regarding the 'SPA' brand. It shows unequivocally that the mark

shows a high degree of recognition among the relevant public.

The Opposition Division, and also the opponent in its observations, refers to judgments of the General Court which acknowledge a high reputation of the mark 'SPA' for *mineral waters* (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179; 12/11/2009, T-438/07, SpagO, EU:T:2009:434; Mineral Spa). In the 'Mineral Spa' case the General Court stated that '[...] the reputation of the earlier mark [SPA] in the Benelux for mineral water is, at the very least, very significant' and it refers to several other decisions of the Boards of Appeal (decision of 02/03/1999, R 1231/2005-4 and R 1250/2005-4, 'WINE SPA', § 34; 26/04/2012, R 264/2011-4, 'SPA SERENITY', § 51; 26/10/2012, R 2157/2011-4, 'VICHY SPA', § 36).

Furthermore, the reputation of the earlier mark 'SPA' for goods in Class 32 has also more recently been confirmed by the General Court in its judgment of 05/05/2015, T131/12, SPARITUAL, EU:T:2015:257, § 44 and by the Boards of Appeal in the decisions of 29/04/2013, R 1594/2012-4, 'ARETE SPA', § 36; 14/02/2013, R 2186/2010-2, 'SENSORI SPA', § 38; 06/07/2015, R 2334/2013-4, 'OLIOSPA', § 37; 16/01/2014, R 1516/2012-4, 'SPA WISDOM', §). In the 'OLIOSPA' case the Board of Appeal stated: 'In the light of the documents submitted by the opponent, the earlier trade mark has a reputation in the Benelux countries in respect of 'mineral and aerated waters'. ...The sales figures, marketing expenditure and market share as well as the various references in the press to the success of the trade mark, are all circumstances that establish unequivocally that the trade mark enjoys a high degree of recognition among the general public in the Benelux countries in respect of mineral water and aerated waters.'

From the above cited evidence, as well as from the mentioned national court decisions, the General Court and the Boards of Appeal, the Opposition Division concludes that the earlier trade mark has acquired a high degree of distinctiveness through its use on the market.

Therefore, taking into account the above and the evidence as a whole, it is concluded that the earlier mark 'SPA' obtained a strong reputation in the Benelux countries for *mineral water and aerated waters* in Class 32.

The contested goods are the following:

Class 16: *Paper towels; toilet paper; paper napkins.*

Class 32: *Beers; preparations for making beer; mineral water, spring water, table water, soda water; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, non-alcoholic soft drinks; energy drinks.*

b) The signs

SPA	
Earlier trade mark	Contested sign

The relevant territories consist of the Benelux countries.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in

mind, in particular, their distinctive and dominant components (11/11/1997, C251/95, Sabèl, EU:C:1997:528, § 23).

The earlier mark is a word mark composed of the word 'SPA'. This means not only that it does not claim any particular figurative element or appearance, but also that differences in the use of lower or upper case letters are immaterial, even if lower case and upper case letters alternate (31/01/2013, T-66/11, 'Babilu', EU:T:2013:48, § 57). The contested sign is a figurative mark consisting of the word 'Spaaq', written in a slightly fancy dark blue and bold typeface outlined in white and light blue and written in title case letters. The word is written in a more diagonal manner.

The earlier mark 'SPA' refers to the name of a Belgian town famous for its mineral and thermal sources, the Belgian racing circuit of Spa-Francorchamps and may also denote a reference to hydrotherapy such as hammams or saunas and is a generic term for health and wellness centres providing treatment services for the body based on hydrotherapy (12/11/2009, T-438/07, SpagO, EU:T:2009:434, § 28; 19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215, § 31; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 44; 25/03/2009, T-109/07, Spa Therapy, EU:T:2009:81; 25/03/2009, T-21/07, Spaline, EU:T:2009:80; 02/03/2009, R 1231/2005-4 and R 1250/2005-4, WINE SPA, § 36; 03/11/2008, R 219/2005-4, BUBBLE SPA, § 24). The use of the word 'SPA' has spread extensively throughout the world during recent decades, due to the development of tourism and the interest in wellness, including in the Benelux countries. The word 'SPA' has an inherently normal distinctiveness for the goods in Class 32, but, as explained above, it has become reputed for *mineral water and aerated waters*.

With respect to the contested sign, the element 'Spaaq' is meaningless for the consumers in the Benelux countries and it is normally distinctive for the goods at stake.

Visually, the signs are similar to the extent that they coincide in the letters 'S-P-A-', meaning that the whole earlier mark is entirely included in the contested sign at the beginning, with the only difference the slightly fancy typeface in which this word is written. The marks differ in the final letters '-a-q' of the contested sign, which have no counterparts in the earlier mark. However, the letter 'a' is a repetition of the previous letter and the letter 'q' is written in such a way that it is also quite similar to the letter 'a'.

Regarding the only slightly fancy typeface in which the verbal element of the contested sign is written, this stylisation will not lead the consumer's attention away from the element it embellishes.

Furthermore, consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right or from top to bottom, which makes the part placed at the left or on top of the sign (the initial part) the one that first catches the attention of the reader. In the present case, the fact that the first three letters of the signs coincide is relevant for the comparison.

Therefore, taking all the aforementioned into account, the signs are visually similar to a low degree.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides in the sound of the letters /SPA/ (earlier mark) and /Spaa/ of the contested sign, present identically in the signs under comparison, since, in particular in the Dutch language, the one letter 'A' at the end of the earlier mark, since it is a vowel at the end, is pronounced the same way as the two letters 'aa' in the contested sign. The pronunciation differs in the sound of the last letter /q/ of the contested sign, pronounced as being the letter /k/. As it falls at the

end, it is the place where the consumer focuses less its attention.

Therefore, taking all the aforementioned into account, the marks are aurally similar to a high degree.

Conceptually, although the public in the relevant territory will perceive the meanings of the earlier mark as explained above, the other sign has no meaning in that territory. Since one of the signs will not be associated with any meaning, the signs are not conceptually similar.

Taking into account that the signs have been found similar in at least one aspect of the comparison, the examination of the existence of a risk of injury will proceed.

c) The 'link' between the signs

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, C408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 27/11/2008, C252/07, 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, C252/07, 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.

As seen above, the signs are visually similar to a low degree, aurally to a high degree and conceptually the marks are not similar and the earlier mark 'SPA' has, moreover, obtained a high distinctive character due to its strong reputation in relation to *mineral water and aerated waters* in Class 32.

The contested goods are the following:

Class 16: *Paper towels; toilet paper; paper napkins.*

Class 32: *Beers; preparations for making beer; mineral water, spring water, table water, soda water; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, non-*

alcoholic soft drinks; energy drinks.

The goods in relation to which the earlier mark has been found to be reputed are the following:

Class 32: *Mineral water and aerated waters.*

Class 16:

The relevant goods for which the earlier mark enjoys a high degree of reputation in the Benelux countries and the contested goods of *paper towels; toilet paper; paper napkins* are obviously not similar; rather, they are quite dissimilar from each other, given that they differ in nature and purpose as well as in their usual distribution channels and producers; they are not complementary neither are they in competition. In this regard the Opposition Division concurs with the applicant that the goods in question are well removed from each other and that there is no natural extension of the business of water to, for example, the paper industry. However, they have the same public in common, namely the general public, which is one of the factors for a link to be established. The fact that the goods are not similar does not mean that, therefore, the provisions of Article 8(5) EUTMR cannot apply. If the relevant public would be likely to make an association between the two marks, and if, because of that association, the image of the goods would be affected positively, or the image of the goods would be affected negatively, the provisions of Article 8(5) EUTMR would apply.

The reputation of the earlier mark is extremely strong and nothing impairs its inherent distinctive character. Furthermore, the similarities between the signs are obvious and immediately perceptible. As set out above, the signs in question are similar to the extent that they share the letters 'S-P-A' which forms the entirety of the earlier reputed mark and the beginning of the contested sign, in which it is also only written in a slightly fancy typeface. It is important that the marks coincide in the first three letters, because it is this part which, as a general principle, catches the attention of the consumer first.

The Opposition Division also points out that the contested sign is in particular written in a dark blue and light blue colour, which actually reinforces a certain link to water, as for water these colours are often used. Furthermore, the blue colour is often used in this branch as giving the image of a certain purity, exactly the image that the opponent intends to give to its goods.

Class 32:

There exists a clear link between all the contested goods in Class 32, since all these goods, broadly speaking, belong to the beverage sector. Therefore, some goods, such as the contested *mineral water, spring water, table water, soda water* are even identical to the opponent's reputed *mineral water and aerated waters* and the remaining goods are, at least, similar, since they all belong to the beverage sector, can coincide in provider, distribution channels and have the same purpose; all these goods are closely related to the sector of the opponent's activities.

Furthermore, it should be borne in mind that the relevant goods are beverages and, since these are frequently ordered in noisy establishments (bars, nightclubs), the phonetic similarity between the signs is particularly relevant (15/01/2003, T99/01, Mystery, EU:T:2003:7, § 48). Accordingly, in such cases, it may be appropriate to attach particular importance to the phonetic similarity between the signs at issue. In the case at hand, it has been pointed out above that the marks are phonetically

highly similar, which is an important factor to be taken into account.

For all the above mentioned goods, at least an association with the earlier mark remains, therefore, possible, taking into account the similarities between the marks, the identity and similarity between the goods and, in particular, the strong reputation acquired by the earlier mark.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that, when encountering the contested mark, the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T301/09, Citigate, EU:T:2012:473, § 96).

d) Risk of injury

Use of the contested mark will fall under Article 8(5) EUTMR when any of the following situations arise:

it takes unfair advantage of the distinctive character or the repute of the earlier mark;

it is detrimental to the repute of the earlier mark;

it is detrimental to the distinctive character of the earlier mark.

Although detriment or unfair advantage may be only potential in opposition proceedings, a mere possibility is not sufficient for Article 8(5) EUTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (06/06/2012, T60/10, Royal Shakespeare, EU:T:2012:348, § 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

The opponent claims that use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the distinctive character of the earlier trade mark.

The opponent bases its claim, inter alia, on the following:

The 'SPA' trade mark by Spa Monopole has been intensively and exclusively used for mineral waters and non-alcoholic beverages since early 1921. The public in the Benelux territory is so familiar with the trade mark 'SPA' for mineral and aerated waters and other non-alcoholic beverages that it is highly probable that a similar trade mark will be associated with the earlier trade mark 'SPA' of the opponent and will, therefore, be a potential detriment to the distinctive character and high reputation of the earlier trade mark 'SPA'. The use of the figurative trade mark 'Spaaq' will be detrimental to the reputation and distinctiveness of the earlier mark in the Benelux territory in Class 32. The opponent has developed through numerous

years a constant image of 'purity' and other beneficial qualities, exceptional quality, health, beauty, richness in minerals and curative characteristics. The natural mineral water is uniquely suited to both pregnant and feeding mothers, babies and young children, because of its very low mineral and salt content. Drinking mineral water is essential to a healthy diet and has many medical implications. It is also approved by the Ministry of Health as such and recommended by the Royal Academy of Medicine. The creation of this image has been an ongoing process that has continued for many years. Therefore, and as demonstrated above, it is clear that an image of purity is attached to the earlier mark 'SPA' of the opponent. In addition, the mineral waters 'SPA' have been awarded the first prize for the quality of the mineral waters. This prize is attributed by CERAM, 'the European Centre for research in mineral waters' and quotes: 'A Belgian water that has reached a milestone in the history of natural mineral waters and that is today still recognised for its original purity and its constant quality'. According to the opponent, this image of health, beauty, purity and richness in minerals has been confirmed by the General Court in judgments of Mineral Spa, § 43 and of 16/03/2016, T-201/14, SPA WISDOM, EU:T:2016:148, § 60, and also in several decisions of the Boards of Appeal (for example, decision of 16/01/2014, R 1516/2012-4, SPA/SPA WISDOM, § 32; 11/09/2014, R 258/2014-1, SPA/PALAI SPA, § 57, 59-60; 06/07/2015, R 2334/2013, SPA/OLIOSPA, § 42; 06/07/2015, R 814/2014-4, SPA/Dr. Spafish (figurative), § 36; 30/11/2016, R 2477/2015-2, SPA/DOT SPA COSMETICS). The use of the contested sign 'Spaaq' (FIGURATIVE) for goods that are not under the control of the opponent may have a negative impact on the reputation acquired. It will affect the image of purity and the highly beneficial qualities associated with the mineral waters 'SPA', because the consumers will be misled as to the nature of the goods. The applicant would take unfair advantage of the image and goodwill built up by the opponent over the years and in which he invested huge amounts of money in order to obtain and maintain such image. Therefore, it would be quite unfair to allow the applicant with its later mark 'Spaaq' (FIGURATIVE) to ride along on the reputation and goodwill of the 'SPA' trade mark, without it having to undertake any investments to achieve a similar reputation. The benefits enjoyed by the applicant would thus not be based on its own merits, but on the high reputation of the earlier mark in the Benelux territory. The latter would positively influence the perception of the relevant public towards the goods marketed under the applicant's mark. Furthermore, it follows from the above that the use and registration of the contested sign would tarnish the reputed trade mark 'SPA', as it is likely to have a negative influence on such image of purity. Therefore, the applicant's mark would potentially take unfair advantage of, or would be detrimental to, the distinctive character and reputation of the earlier mark 'SPA' given the proximity, and even identity, between (some of) the goods.

Unfair advantage (free-riding) – goods in Class 32

Unfair advantage in the context of Article 8(5) EUTMR covers cases where there is clear exploitation and 'freeriding on the coattails' of a famous mark or an attempt to trade upon its reputation. In other words, there is a risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (Royal Shakespeare, § 48, and 22/03/2007, T215/03, Vips, EU:T:2007:93, § 40).

According to the Court of Justice of the European Union

... as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to

average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.

(Intel, § 36.)

To determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake an overall assessment, which takes into account all the factors relevant to the circumstances of the case (10/05/2007, T47/06, Nasdaq, EU:T:2007:131, § 53, confirmed, on appeal, by 12/03/2009, C320/07 P, Nasdaq, EU:C:2009:146; see also Adidas, § 29, 30, 38; Intel, § 57, 58, 66; 24/03/2011, C552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53).

The applicant's intention is not a material factor. Taking unfair advantage of the distinctiveness or the repute of a trade mark may be a deliberate decision, for example, where there is clear exploitation and free-riding on the coat-tails of a famous mark, or an attempt to trade upon the reputation of a famous mark. However, taking unfair advantage does not necessarily require a deliberate intention to exploit the goodwill attached to someone else's trade mark. The concept of taking unfair advantage 'concerns the risk that the image of the mark with a reputation or the characteristics that it projects are transferred to the goods and services covered by the mark applied for, with the result that the marketing of those goods and services is made easier by that association with the earlier mark with a reputation' (Mineral Spa, § 40; 22/03/2007, T215/03, Vips, EU:T:2007:93, § 40; 30/01/2008, T128/06, Camelo, EU:T:2008:22, § 46).

In the present case, the earlier mark has obtained a strong reputation among the relevant public in relation to *mineral water and aerated waters* in Class 32. It has become an attractive and powerful brand in the Benelux market. As can be seen in the evidence provided by the opponent, the mark 'SPA' is associated with an image of health, beauty, purity, richness in minerals and curative characteristics. The image reflects the prestige acquired by the 'SPA' trade mark and fulfils one of the functions of the trade mark, the advertising function, which consists of associating certain qualities with a mark.

Taking into account the strong reputation of the earlier mark, the similarities between the marks and the fact that the conflicting goods belong to the same connected markets, it is concluded that the relevant public will make a connection between the marks, an association that will produce a commercial benefit for the applicant. There is a high probability that the use of the mark applied for may lead to free-riding, that is to say, it would take unfair advantage of the well-established reputation of the earlier mark and the considerable investments undertaken by the opponent to achieve that reputation. The contested sign could take unfair advantage of the image of the earlier trade mark and the message conveyed by it, that is, that its goods have identical characteristics to those of the opponent, namely that they are 'healthy, beautiful, pure, rich in minerals and with curative characteristics'. The use of the trade mark applied for could also lead to the perception that the applicant is associated with or belongs to the opponent and, therefore, could facilitate the marketing of the goods for which registration is sought.

Detriment to the repute (tarnishing) – Class 16

Detriment to repute occurs where the goods or services covered by the contested trade mark appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished. There is a risk of such detriment occurring, inter alia, where the contested goods or services have a characteristic or a quality which may have a negative influence on the image of an earlier mark with a reputation on

account of it being identical or similar to the contested trade mark (18/06/2009, C487/07, L'Oréal, EU:C:2009:378, § 40, and 22/03/2007, T215/03, Vips, EU:T:2007:93, § 39).

The Opposition Division notes that the use of the contested sign which could be linked to the opponent's mark, reputed for mineral and aerated waters in the mind of the average consumer in the Benelux, is likely to negatively affect the above mentioned image of purity and other beneficial qualities, exceptional quality, health, beauty, richness in minerals and curative characteristics, in which the opponent has invested large amounts of money over several decades. The use of the contested mark is likely to evoke a negative or at least an unpleasant mental association which would be in total conflict with the recognised prestige and reputation of the earlier mark 'SPA'. This feeling could be felt by the consumer in such a way that the attractive force of the earlier mark would be diminished. This association will cast a shadow over the opponent's trade mark, leading to conflicting or even incompatible messages that will clash with the idea of purity inherent to the image of the opponent's trade mark. It is highly probable that the association of the mark, which has acquired a strong reputation for drinking waters, with paper towels and paper napkins (products that are mainly used to clean dirt and after that are thrown away), and even more with toilet paper, will have a negative influence on the perception of the mark. The use of the contested sign is incompatible with the special image that the earlier mark has acquired. In short, it is easy to see how a consumer buying mineral waters may be dissuaded from doing so or be reluctant to do so if they perceive an association with, for example, a brand of toilet paper and the like, they buy or are aware of. In this way the earlier mark may be tarnished by use of the contested sign for the contested goods in Class 16.

In consequence, the Opposition Division is of the view that the negative connotations conveyed by the contested goods in Class 16 contrast sharply with the specific image of the earlier mark and are likely to tarnish its image and cause detriment to its reputation.

Other types of injury

As seen above, the existence of a risk of injury is an essential condition for Article 8(5) EUTMR to apply. The risk of injury may be of three different types. For an opposition to be well founded in this respect it is sufficient if only one of these types is found to exist. In the present case, the Opposition Division has already established that the contested trade mark would take unfair advantage of the distinctive character or repute of the earlier trade mark for the goods in Class 32 and that it would be detrimental to its repute for the goods in Class 16. It follows that there is no need to examine whether the other form of injury also applies.

e) Conclusion

Considering all the above, the opposition is well founded under Article 8(5) EUTMR. Therefore, the contested trade mark must be rejected for all the contested goods.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the

costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR (former Rule 94(3) and (6) and Rule 94(7)(d)(i) EUTMIR, in force before 01/10/2017), the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.

The Opposition Division

Saida CRABBE	Chantal VAN RIEL	Richard BIANCHI
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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.