

## OPPOSITION No B 3 172 073

**Aesthetic Technology Limited**, Park View House, Worrall Street, Congleton CW12 1DT, United Kingdom (opponent), represented by **Murgitroyd & Company**, 2nd Floor 57 Adelaide Road, Dublin DO2 Y3C6, Ireland (professional representative)

a g a i n s t

**Medspa Laboratoires**, 68 rue du Faubourg Saint-Honoré, 75008 Paris, France (applicant).

On 22/06/2023, the Opposition Division takes the following

### DECISION:

1. Opposition No B 3 172 073 is partially upheld, namely for the following contested goods and services:

Class 3: *Ethereal oils; essential oils; essential oils for aromatherapy use; emulsified essential oils; aromatic essential oils; blended essential oils; helichrysum [essential oils]; bergamot oil; natural essential oils; aromatherapy oil; tissues impregnated with cosmetic lotions; cosmetics; cosmetics and cosmetic preparations; cosmetic kits; organic cosmetics; emollient preparations [cosmetics]; non-medicated cosmetics; cosmetics for use on the skin; cosmetic creams and lotions; functional cosmetics; softening cleanser [cosmetic]; skin care preparations; bath preparations, not for medical purposes; bath concentrates (Non-medicated -); bath powders (Non-medicated -); bubble bath; bath creams (Non-medicated -); bath pearls (Non-medicated -); non-medicated bath salts; antiperspirants [toiletries]; skin cleansing cream [non-medicated]; skin conditioning creams for cosmetic purposes; skin cream; skin lightening creams; perfumed oils for skin care; skin care oils [cosmetic]; cosmetic products in the form of aerosols for skincare; skin care creams [cosmetic]; refill packs for skin care cream dispensers; skin whitening preparations [cosmetic]; skin cleansers [cosmetic]; moist paper hand towels impregnated with a cosmetic lotion; cosmetic paste for application to the face to counteract glare; moisturising skin creams [cosmetic]; skin care lotions [cosmetic]; skin whitening preparations; skin lighteners; skin whitening creams; skin softening preparations; cosmetic preparations for skin renewal; cosmetic preparations for skin firming; skin lightening compositions [cosmetic]; cosmetic facial lotions; facial toners [cosmetic]; moisturising skin lotions [cosmetic]; lip protectors [cosmetic]; lotions for cosmetic purposes; lip cream; lip conditioners; skin lotion; lip balms [non-medicated]; lip cosmetics; cosmetic moisturisers; facial moisturisers [cosmetic]; cosmetic preparations for skin care; essences for skin care; anti-aging skincare preparations; wrinkle removing skin care preparations; aloe soap; soap; antiperspirant soap; cosmetic soaps; carbollic soaps; deodorant soap; soaps in liquid form; toilet soap; perfumed soaps; facial soaps.*

Class 5: All goods in this class, **except for** *panty liners [sanitary]; heating patches for medical purposes; mouthwashes for medical purposes; mouthwashes [gargles] for medical purposes; pharmaceutical preparations for ocular or intraocular surgery; radiopharmaceutical products; cardiovascular agents for medical purposes; contrast media for use with X-ray equipment; diagnostic preparations for medical purposes; diagnostic substances for medical use; lactagogues; analeptics; cardiovascular pharmaceuticals; anti-epileptic pharmaceutical preparations; anti-diabetic pharmaceuticals; electrolyte replacement beverages for medical purposes; dietary supplements for controlling cholesterol; dietary supplements for animals; dietetic substances adapted for veterinary use; dietetic food adapted for veterinary use; chemical*

*preparations for veterinary purposes; medical foodstuff additives for veterinary use; food supplements for veterinary use; preparations of microorganisms for veterinary use; bacteriological preparations for veterinary use; disinfectants for swimming pools; disinfectants for veterinary use; medicated hair lotions; ootherapy preparations; dietetic beverages for babies adapted for medical purposes; food for babies; food preparations for babies and infants; beverages for infants; babies' diaper-pants*

Class 44: All services in this class, **except for garden design services; pet beauty salon services; information services relating to veterinary pharmaceuticals; veterinary surgical services; respite care services in the nature of nursing aid services; convalescent home services; rest home services; nursing home services; hospital nursing home services; arranging of accommodation in convalescent homes; cosmetic dentistry; psychiatric services.**

2. European Union trade mark application No 18 662 699 is rejected for the goods and services as reflected under 1. of this dictum. It may proceed for the remaining goods and services.
3. Each party bears its own costs.

## **REASONS**

On 31/05/2022, the opponent filed an opposition against all the goods and services (Classes 3, 5 and 44) of European Union trade mark application No 18 662 699 'DERMALUX' (word mark). The opposition is based on European Union trade registration No 14 333 116 'DERMALUX' (word mark). The opponent invoked Article 8(1)(a) and 8(1)(b) EUTMR. However, there is no obligation to examine all legal grounds invoked against the same application (16/09/2004, T-342/02, Moser Grupo Media, S.L., 11/05/2006, T-194/05, Teletech International). The Office is rather free to choose the legal ground to examine first in light of the principle of procedural economy. In the present case, the Office finds it appropriate to first examine the opposition in relation to Article 8(1)(b) 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 relevant goods or services, under the assumption that they bear the marks in question, come from the same or economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several interdependent factors, which include the similarity of the goods and services and the signs, the distinctiveness of the earlier mark and the relevant public.

#### **a) The goods and services**

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

Class 10: *Skin treatment apparatus and instruments; light treatment apparatus, devices and instruments for use in photo dynamic therapy, skin rejuvenation and the treatment of acne, dermatitis, eczema, pigmentation, psoriasis and rosacea; parts and fittings for the aforesaid goods.*

Class 44: *Medical services, namely, skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea; medical clinics providing skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation*

*treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea; beauty services, namely, skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea; information, advice and consultancy services relating the aforesaid.*

The contested goods and services are the following:

Class 3: *Skin cleansing cream [non-medicated]; Tissues impregnated with leather gloss agents; Skin conditioning creams for cosmetic purposes; Skin cream; Skin lightening creams; Perfumed oils for skin care; Skin care oils [cosmetic]; Cosmetic products in the form of aerosols for skincare; Preservative creams for leather; Skin care creams [cosmetic]; Refill packs for skin care cream dispensers; Skin whitening preparations [cosmetic]; Leather and shoe cleaning and polishing preparations; Skin cleansers [cosmetic]; Moisturising skin creams [cosmetic]; Skin care lotions [cosmetic]; Skin whitening preparations; Skin lighteners; Skin whitening creams; Skin softening preparations; Cosmetic preparations for skin renewal; Cosmetic preparations for skin firming; Sun-tanning preparations [cosmetics]; Cosmetics for use on the skin; Skin lightening compositions [cosmetic]; Sun blocking preparations [cosmetics]; Moist paper hand towels impregnated with a cosmetic lotion; Hair strengthening treatment lotions; Cosmetic creams and lotions; Laundry preparations; Biological laundry detergents; Commercial laundry detergents; Colour run prevention laundry sheets; Laundry liquids; Chemical laundry preparations; Laundry bleach; Laundry soap; Laundry additives; Soda lye; Liquid soap for laundry; Sugar soap; Laundry sizing; Rinsing agents for laundry; Essential oils as perfume for laundry purposes; Laundry detergents for household cleaning use; Polishing preparations; Abrasives; Grease-removing preparations; Polishing powders; Automobile polishes; Impregnated cloths for polishing; Denture polishes; Polishing paper; Polishing creams; Abrasive preparations for polishing; Polishing stones; Metal polishes; Chrome polish; Sandcloth; Wood treatment preparations for polishing; Creams for leather; Cosmetic paste for application to the face to counteract glare; Leather dressings; Conditioners in the form of sprays for the scalp; Leather preservatives [polishes]; Aloe soap; Soap; Carboic soaps; Antiperspirant soap; Cosmetic soaps; Deodorant soap; Detergent soap; Soaps in liquid form; Toilet soap; Soap for brightening textile; Perfumed soaps; Facial soaps; Colouring lotions for the hair; Cosmetic facial lotions; Facial toners [cosmetic]; Moisturising skin lotions [cosmetic]; Hair protection lotions; Lip stains [cosmetics]; Hair lotions; Natural oils for perfumes; Tissues impregnated with cosmetic lotions; Lip protectors [cosmetic]; Lotions for cosmetic purposes; After-sun oils [cosmetics]; Perfumes; Eau de parfum; Scented water; Fragrance preparations; Household fragrances; Perfumery and fragrances; Liquid perfumes; Air fragrancng preparations; Aromatics for perfumes; Extracts of perfumes; Perfumes for ceramics; Room fragrancng preparations; Air fragrance reed diffusers; Solid perfumes; Lotions for strengthening the nails; Suntanning oil [cosmetics]; Ethereal oils; Food flavourings [essential oils]; Essential oils for aromatherapy use; Emulsified essential oils; Essential oils for use in air fresheners; Aromatic essential oils; Perfumery, essential oils; Blended essential oils; Helichrysum [essential oils]; Bergamot oil; Natural essential oils; Aromatherapy oil; Lip coatings [cosmetic]; Lip cosmetics; Lip cream; Lip conditioners; Sun blocking lipsticks [cosmetics]; Skin lotion; Suntan lotion [cosmetics]; Cosmetic suntan lotions; Cosmetics; Cosmetics and cosmetic preparations; Cosmetic kits; Functional cosmetics; Organic cosmetics; Cosmetic preparations for slimming purposes; Decorative cosmetics; Emollient preparations [cosmetics]; Self-tanning preparations [cosmetics]; Styling lotions; Hair care lotions; Shampoos; Hair creams; Hair protection creams; Cosmetics for the use on the hair; Hair glaze; Hair conditioners; Hair spray; Hair moisturisers;*

*Hairstyling serums; Hair colour removers; Lipsticks; Lip glosses; Lip liners; Lip gloss palettes; Lipstick cases; Sun protectors for lips; Lip balms [non-medicated]; Depilatory preparations; Depilatory lotions; Depilatory creams; Hair removal and shaving preparations; Depilatory wax; Shaving lotion; Wax strips for removing body hair; Shaving sets, comprised of shaving cream and aftershave; Shaving cream; Shaving sprays; Make-up removing preparations; Make-up preparations; Cosmetic moisturisers; Antiperspirants [toiletries]; Cleaning preparations; Softening cleanser [cosmetic]; Facial moisturisers [cosmetic]; Toilet cleaners; After sun moisturisers; Non-medicated cosmetics; Baby hair conditioner; Baby shampoo; Bath preparations, not for medical purposes; Mouthwashes, not for medical purposes; Bath concentrates (Non-medicated -); Bath powders (Non-medicated -); Bubble bath; Bath creams (Non-medicated -); Bath pearls (Non-medicated -); Non-medicated bath salts; Skin care preparations; Cosmetic preparations for skin care; Essences for skin care; Anti-aging skincare preparations; Wrinkle removing skin care preparations.*

Class 5: *Contrast media for use with X-ray equipment; Skin care creams for medical use; Pharmaceutical preparations for hydrating the skin during pregnancy; Disinfectant soap; Antibacterial soap; Medicated soap; Germicidal preparations [other than soap]; Creams (Medicated -) for the lips; Medicated hair lotions; Antiseptic washing preparations; Opothrapy preparations; Radiopharmaceutical products; Anti-inflammatory preparations; Chemico-pharmaceutical preparations; Chemical preparations for sanitary purposes; Dietetic substances adapted for medical use; Chemical preparations for medical purposes; Dietetic substances adapted for veterinary use; Chemical preparations for veterinary purposes; Dietetic foods adapted for medical purposes; Freeze-dried food adapted for medical purposes; Pharmaceuticals; Cardiovascular pharmaceuticals; Anti-epileptic pharmaceutical preparations; Anti-diabetic pharmaceuticals; Homeopathic pharmaceuticals; Diaphoretics; Antibacterial pharmaceuticals; Analeptics; Dermatological pharmaceutical products; Lactagogues; Dietetic food preparations adapted for medical use; Preparations of microorganisms for medical or veterinary use; Dietetic preparations adapted for medical use; Nutraceutical preparations for therapeutic or medical purposes; Bacteriological preparations for medical and veterinary use; Biological preparations for medical purposes; Dietetic beverages adapted for medical purposes; Dietetic infusions for medical use; Sanitary preparations for medical purposes; Sanitary sterilising preparations; Panty liners [sanitary]; Biochemical preparations for medical use; Phytotherapy preparations for medical purposes; Biotechnological preparations for medical use; Dietetic food adapted for veterinary use; Dietetic sweeteners for medical purposes; Dietetic confectionery adapted for medical purposes; Medical foodstuff additives for veterinary use; Cardiovascular agents for medical purposes; Homogenized food adapted for medical purposes; Antibacterial substances for medical purposes; Mixed biological preparations for medical purposes; Mineral preparations and substances for medical use; Electrolyte replacement beverages for medical purposes; Diagnostic substances for medical use; Therapeutic medicated bath preparations; Dietetic beverages for babies adapted for medical purposes; Medicated baby powders; Herbal preparations for medical use; Food for babies; Food preparations for babies and infants; Babies' diaper-pants; Dietetic substances for babies; Beverages for infants; Chemical preparations for pharmaceutical purposes; Bacteriological preparations for medical purposes; Food supplements; Dietary and nutritional supplements; Dietary supplements for infants; Anti-oxidant food supplements; Dietary supplements and dietetic preparations; Dietary supplements with a cosmetic effect; Dietary supplements for controlling cholesterol; Protein dietary supplements; Food supplements consisting of trace elements; Mineral dietary supplements; Medicated food supplements; Nutritional supplements; Dietary supplements consisting primarily*

*of magnesium; Dietary supplements for animals; Food supplements for veterinary use; Bath preparations for medical purposes; Heating patches for medical purposes; Dressings, medical; Wipes for medical use; Disinfectants for medical use; Cleansing solutions for medical use; Plasters, materials for dressings; Disinfectant dressings; Medical dressings, coverings and applicators; Surgical plasters; Bandages for dressings; Medical and surgical dressings; Elastic bandages [dressings]; Cleaning solvents for removing adhesive plasters; Materials for dressings; Adhesive dressings; Enzyme preparations for medical purposes; Disinfectants; Disinfectants and antiseptics; Disinfectant swabs; Sanitizing wipes; Cleaning cloths impregnated with disinfectant for hygiene purposes; Medicated and sanitising soaps and detergents; Antiseptic cleansers; Washes (disinfectant -) [other than soap]; Disinfectants for hygiene purposes; Disinfectants for medical instruments; Antiseptics; Bacteria fighting cleanser; Disinfectants for swimming pools; Disinfectants for veterinary use; Disinfectants for medical apparatus and instruments; Caffeine preparations for medical use; Albuminous preparations for medical purposes; Diagnostic preparations for medical purposes; Mouthwashes for medical purposes; Mouthwashes [gargles] for medical purposes; Vaginal washes for medical purposes; Chemical adjuvants for medical purposes; Pharmaceutical preparations for skin care; Pharmacological preparations for skin care; Anesthetics for surgical use; Anesthetics for non-surgical use; Pharmaceutical preparations for ocular or intraocular surgery.*

**Class 44:** *X-ray services; Cosmetic electrolysis; Cosmetic make-up services; Body waxing services for the human body; Depilatory waxing; Cosmetic laser treatment of unwanted hair; Information services relating to veterinary pharmaceuticals; Providing information about dietary supplements and nutrition; Health care consultancy services [medical]; Medical and healthcare clinics; Managed health care services; Professional consultancy relating to health care; Medical and healthcare services; Home health care services; Consultancy in the field of body and beauty care; Consulting services relating to health care; Advisory services relating to beauty treatment; Ambulant medical care; Health care in the nature of health maintenance organizations; Medical treatment services; Respite care services in the nature of nursing aid services; Provision of medical services; Medical tele-reporting [medical services]; Medical consultations; Medical information; Medical assistance; Medical diagnostic services; Heat therapy [medical]; Medical counseling; Medical clinic services; Medical evaluation services; Advisory services relating to medical services; Beauty care for human beings; Application of cosmetic products to the body; Beauty salon services; Application of cosmetic products to the face; Beauty care; Services for the care of the skin; Consultation services relating to skin care; Facial beauty treatment services; Leasing skin care equipment; Skin care salons; Hygienic and beauty care; Plastic surgery; Cosmetic and plastic surgery; Surgery; Surgery (Cosmetic -); Cosmetic and plastic surgery clinic services; Cosmetic dentistry; Veterinary surgical services; Convalescent home services; Services of a hair and beauty salon; Hair salon services; Hair salon services for children; Rest home services; Providing information relating to beauty salon services; Nursing home services; Barber shop services; Pet beauty salon services; Hairdressing; Garden design services; Hospital services; Hospital nursing home services; Psychiatric services; Pharmaceutical services; Paramedical services; Therapy services; Arranging of accommodation in convalescent homes; Hair salon services for men; Airbrush tanning salon services; Tanning salon and solarium services; Hair salon services for women; Rental of machines and apparatus for use in beauty salons or barbers' shops.*

An interpretation of the wording of the list of goods and services is required to determine the scope of protection of these goods and services. The term 'namely', used in the opponent's list

of goods and services to show the relationship of individual goods and services to a broader category, is exclusive and restricts the scope of protection only to the goods and services specifically listed.

According to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification. 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 or complementary.

### Contested goods in Class 3

The contested *ethereal oils; essential oils; essential oils for aromatherapy use; emulsified essential oils; aromatic essential oils; blended essential oils; helichrysum [essential oils]; bergamot oil; natural essential oils; aromatherapy oil; tissues impregnated with cosmetic lotions; cosmetics; cosmetics and cosmetic preparations; cosmetic kits; organic cosmetics; emollient preparations [cosmetics]; non-medicated cosmetics; cosmetics for use on the skin; cosmetic creams and lotions; functional cosmetics; softening cleanser [cosmetic]; skin care preparations; bath preparations, not for medical purposes; bath concentrates (Non-medicated -); bath powders (Non-medicated -); bubble bath; bath creams (Non-medicated -); bath pearls (Non-medicated -); non-medicated bath salts; antiperspirants [toiletries]; moist paper hand towels impregnated with a cosmetic lotion; cosmetic paste for application to the face to counteract glare; skin cleansing cream [non-medicated]; skin conditioning creams for cosmetic purposes; skin cream; skin lightening creams; perfumed oils for skin care; skin care oils [cosmetic]; cosmetic products in the form of aerosols for skincare; skin care creams [cosmetic]; refill packs for skin care cream dispensers; skin whitening preparations [cosmetic]; skin cleansers [cosmetic]; moisturising skin creams [cosmetic]; skin care lotions [cosmetic]; skin whitening preparations; skin lighteners; skin whitening creams; skin softening preparations; cosmetic preparations for skin renewal; cosmetic preparations for skin firming; skin lightening compositions [cosmetic]; cosmetic facial lotions; facial toners [cosmetic]; moisturising skin lotions [cosmetic]; lotions for cosmetic purposes; lip protectors [cosmetic]; lip cream; lip conditioners; lip balms [non-medicated]; lip cosmetics; skin lotion; cosmetic moisturisers; facial moisturisers [cosmetic]; cosmetic preparations for skin care; essences for skin care; anti-aging skincare preparations; wrinkle removing skin care preparations; aloe soap; soap; antiperspirant soap; cosmetic soaps; carbolic soaps; deodorant soap; soaps in liquid form; toilet soap; perfumed soaps; facial soaps are similar to the opponent's beauty services, namely, skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea in Class 44.*

Despite their differences in nature and method of use, both the opponent's services and the aforementioned contested goods are intended to improve or maintain one's wellness and beauty so they serve the same purpose. Providers of *beauty services in the nature of skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea* may particularly also offer the corresponding beauty care products to their clients for consumption at home. Therefore, they may coincide in their relevant public and distribution channels. Furthermore, they can be complementary as the opponent's services usually require prior or posterior treatment with the aforementioned contested goods leading to some complementarity between them. In fact, consumers even expect treatment with these types of beauty care products when being provided with the opponent's services.

The remaining contested goods are *cosmetic preparations for slimming purposes; food flavourings [essential oils]; hair removal and shaving preparations; make-up preparations; hair strengthening treatment lotions; conditioners in the form of sprays for the scalp; colouring lotions for the hair; hair protection lotions; hair lotions; styling lotions; hair care lotions; shampoos; hair creams; hair protection creams; cosmetics for the use on the hair; hair glaze; hair conditioners;*

*hair spray; hair moisturisers; hairstyling serums; hair colour removers; baby hair conditioner; baby shampoo; depilatory preparations; depilatory lotions; depilatory creams; depilatory wax; shaving lotion; wax strips for removing body hair; shaving sets, comprised of shaving cream and aftershave; shaving cream; shaving sprays; lotions for strengthening the nails; lip stains [cosmetics]; lip coatings [cosmetic]; lipsticks; lip glosses; lip liners; lip gloss palettes; lipstick cases; decorative cosmetics; self-tanning preparations [cosmetics]; make-up removing preparations; sun-tanning preparations [cosmetics]; sun blocking preparations [cosmetics]; after-sun oils [cosmetics]; suntanning oil [cosmetics]; sun blocking lipsticks [cosmetics]; suntan lotion [cosmetics]; cosmetic suntan lotions; sun protectors for lips; after sun moisturisers; denture polishes; mouthwashes, not for medical purposes; perfumery and fragrances; natural oils for perfumes; perfumes; eau de parfum; scented water; fragrance preparations; liquid perfumes; aromatics for perfumes; extracts of perfumes; solid perfumes perfumery as well as different types of cleaning preparations for use in the home and other environments, namely essential oils for use in air fresheners; automobile polishes; abrasives; leather preservatives [polishes]; leather dressings; creams for leather; preservative creams for leather; tissues impregnated with leather gloss agents; soap for brightening textile; detergent soap; laundry detergents for household cleaning use; essential oils as perfume for laundry purposes; rinsing agents for laundry; laundry sizing; liquid soap for laundry; laundry additives; laundry soap; laundry bleach; chemical laundry preparations; laundry liquids; colour run prevention laundry sheets; commercial laundry detergents; biological laundry detergents; room fragrancing preparations; air fragrancing preparations; toilet cleaners; cleaning preparations; air fragrance reed diffusers; perfumes for ceramics; household fragrances; wood treatment preparations for polishing; chrome polish; metal polishes; polishing creams; impregnated cloths for polishing; polishing powders; grease-removing preparations; polishing preparations; sugar soap; soda lye; laundry preparations; leather and shoe cleaning and polishing preparations; sandcloth; polishing stones; abrasive preparations for polishing; polishing paper. All these remaining contested goods in Class 3 are dissimilar to all goods and services covered by the opponent's earlier mark in Classes 10 and 44. Their natures, purposes and methods of use are different. They do not coincide in their producer/provider and do not share the same distribution channels. Furthermore, these goods and services are neither complementary nor in competition.*

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

*The contested medicated and sanitising soaps and detergents; disinfectants and antiseptics; cleaning solvents for removing adhesive plasters; cleansing solutions for medical use; sanitary sterilising preparations; sanitary preparations for medical purposes; chemical preparations for sanitary purposes; bacteria fighting cleanser; medicated baby powders; disinfectant swabs; medical dressings, coverings and applicators; adhesive dressings; materials for dressings; medical and surgical dressings; bandages for dressings; surgical plasters; disinfectant dressings; plasters, materials for dressings; dressings, medical; elastic bandages [dressings]; antibacterial soap; germicidal preparations [other than soap]; antiseptic washing preparations; wipes for medical use; disinfectants for medical use; disinfectants; sanitizing wipes; cleaning cloths impregnated with disinfectant for hygiene purposes; antiseptic cleansers; washes (disinfectant -) [other than soap]; disinfectants for hygiene purposes; disinfectants for medical instruments; antiseptics; disinfectants for medical apparatus and instruments; disinfectant soap; medicated soap; vaginal washes for medical purposes; antibacterial substances for medical purposes are at least similar to a low degree to the opponent's skin treatment apparatus and instruments in Class 10 as they coincide at least in relevant public and distribution channels. Furthermore, they are complementary.*

*The contested dietetic substances adapted for medical use; dietetic foods adapted for medical purposes; freeze-dried food adapted for medical purposes; dietetic food preparations adapted for medical use; dietetic preparations adapted for medical use; nutraceutical preparations for therapeutic or medical purposes; mineral preparations and substances for medical use; dietetic beverages adapted for medical purposes; dietetic infusions for medical use; dietetic sweeteners for medical purposes; dietetic confectionery adapted for medical purposes; homogenized food adapted for medical purposes; food supplements; dietary and nutritional supplements; dietary*

*supplements for infants; dietetic substances for babies; anti-oxidant food supplements; dietary supplements with a cosmetic effect; protein dietary supplements; food supplements consisting of trace elements; mineral dietary supplements; nutritional supplements; dietary supplements consisting primarily of magnesium; albuminous preparations for medical purposes; skin care creams for medical use; pharmaceutical preparations for hydrating the skin during pregnancy; creams (Medicated -) for the lips; herbal preparations for medical use; chemical preparations for pharmaceutical purposes; caffeine preparations for medical use; chemical adjuvants for medical purposes; pharmaceutical preparations for skin care; pharmacological preparations for skin care; anesthetics for surgical use; anesthetics for non-surgical use; dietary supplements and dietetic preparations; medicated food supplements; chemical preparations for medical purposes; anti-inflammatory preparations; chemico-pharmaceutical preparations; pharmaceuticals; biological preparations for medical purposes; biochemical preparations for medical use; mixed biological preparations for medical purposes; bacteriological preparations for medical purposes; therapeutic medicated bath preparations; bath preparations for medical purposes; enzyme preparations for medical purposes; preparations of microorganisms for medical use; bacteriological preparations for medical use; homeopathic pharmaceuticals; diaphoretics; antibacterial pharmaceuticals; dermatological pharmaceutical products; phytotherapy preparations for medical purposes; biotechnological preparations for medical use are at least similar to a low degree to the opponent's medical services, namely, skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea in Class 44 as they have the same purpose. They usually coincide at least in relevant public and distribution channels. Furthermore, some of these goods and services are complementary.*

The remaining contested goods in Class 5 are *panty liners [sanitary]; heating patches for medical purposes; mouthwashes for medical purposes; mouthwashes [gargles] for medical purposes; pharmaceutical preparations for ocular or intraocular surgery; radiopharmaceutical products; cardiovascular agents for medical purposes; contrast media for use with X-ray equipment; diagnostic preparations for medical purposes; diagnostic substances for medical use; lactagogues; analeptics; cardiovascular pharmaceuticals; anti-epileptic pharmaceutical preparations; anti-diabetic pharmaceuticals; electrolyte replacement beverages for medical purposes; dietary supplements for controlling cholesterol; dietary supplements for animals; dietetic substances adapted for veterinary use; dietetic food adapted for veterinary use; chemical preparations for veterinary purposes; medical foodstuff additives for veterinary use; food supplements for veterinary use; preparations of microorganisms for veterinary use; bacteriological preparations for veterinary use; disinfectants for swimming pools; disinfectants for veterinary use; medicated hair lotions; ootherapy preparations; dietetic beverages for babies adapted for medical purposes; food for babies; food preparations for babies and infants; beverages for infants; babies' diaper-pants. They are dissimilar to all goods and services covered by the opponent's earlier mark in Classes 10 and 44. Their natures, purposes and methods of use are different. They do not coincide in their producer/provider and do not share the same distribution channels. Furthermore, they are neither complementary nor in competition.*

#### **Contested services in Class 44**

The contested *providing information about dietary supplements and nutrition; health care consultancy services [medical]; medical and healthcare clinics; managed health care services; professional consultancy relating to health care; medical and healthcare services; home health care services; consulting services relating to health care; health care in the nature of health maintenance organizations; pharmaceutical services; therapy services; x-ray services; ambulant medical care; medical treatment services; provision of medical services; medical tele-reporting [medical services]; medical consultations; medical information; medical assistance; medical diagnostic services; heat therapy [medical]; medical counseling; medical clinic services; medical evaluation services; advisory services relating to medical services; plastic surgery; cosmetic and plastic surgery; surgery; surgery (Cosmetic -); cosmetic and plastic surgery clinic services; hospital services; paramedical services are at least similar to a low degree to the opponent's medical services, namely, skin rejuvenation treatments, photo dynamic therapy, scar*

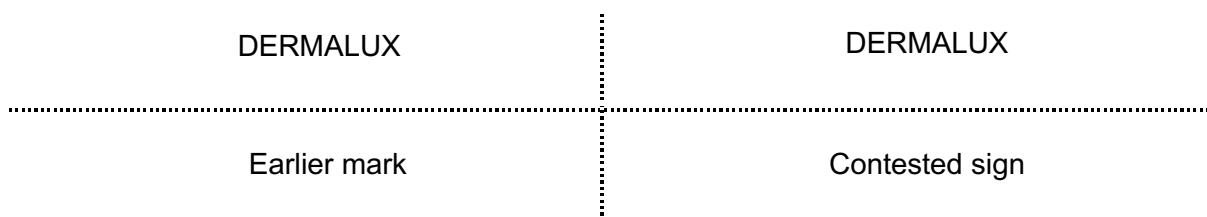


*repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea* as they usually also coincide at least in provider, distribution channels and public. Although some of these services could also coincide in further relevant criteria such as complementarity, or could even be identical, it follows from the above considerations that all the aforementioned contested services are at least similar to a low degree to the opponent's services.

The contested *cosmetic electrolysis; cosmetic make-up services; body waxing services for the human body; depilatory waxing; cosmetic laser treatment of unwanted hair; consultancy in the field of body and beauty care; advisory services relating to beauty treatment; beauty care for human beings; application of cosmetic products to the body; beauty salon services; application of cosmetic products to the face; beauty care; services for the care of the skin; consultation services relating to skin care; facial beauty treatment services; leasing skin care equipment; skin care salons; hygienic and beauty care; services of a hair and beauty salon; hair salon services; hair salon services for children; providing information relating to beauty salon services; barber shop services; hairdressing; hair salon services for men; airbrush tanning salon services; tanning salon and solarium services; hair salon services for women; rental of machines and apparatus for use in beauty salons or barbers' shops* are at least similar to a low degree to the opponent's beauty services, namely, *skin rejuvenation treatments, photo dynamic therapy, scar repair, mesorejuvenation treatment and treatments for acne, dermatitis, eczema, pigmentation, psoriasis and rosacea*, as they usually coincide at least in provider, distribution channels and public. Although some of these services could also coincide in further relevant criteria such as complementarity, or could even be identical, it follows from the above that all the aforementioned services are at least similar to a low degree.

The remaining contested services in Class 44 are *garden design services; pet beauty salon services; information services relating to veterinary pharmaceuticals; veterinary surgical services; respite care services in the nature of nursing aid services; convalescent home services; rest home services; nursing home services; hospital nursing home services; arranging of accommodation in convalescent homes; cosmetic dentistry; psychiatric services* and dissimilar to all goods and services covered by the opponent's earlier mark in Classes 10 and 44. Their natures, purposes and methods of use are different. They do not coincide in producer and/or provider and do not share the same distribution channels. Furthermore, they are neither complementary nor in competition.

#### b) The signs



The signs are identical.

#### c) Global assessment

The signs were found to be identical and some of the contested goods and services are at least similar to a low degree or dissimilar. The likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those 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).

In the present case, the identity of the signs is sufficient to offset the only low degree of similarity established in respect of some of the goods and services. Consequently, there is a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR and the contested trade mark must be refused in respect of all the goods and services in respect of which similarity, even if to a low degree, to those of the earlier trade mark has been established.

The remaining contested goods and services are dissimilar. As the identity or similarity of the goods and services is a necessary condition for the application of Article 8(1) EUTMR, the opposition based on this article, which is directed against those goods and services, cannot be successful. For the sake of completeness, it must be mentioned that the opposition must also fail insofar as based on grounds under Article 8(1)(a) EUTMR and directed against the remaining goods and services because the goods and services are obviously not identical.

## **COSTS**

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 109(3) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division will decide a different apportionment of costs.

Since the opposition is successful for only some of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



## **The Opposition Division**

Valeria ANCHINI

Philipp HOMANN

Marta GARCÍA COLLADO

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.