

OPPOSITION No B 3 220 731

Parfums Christian Dior, 33, Avenue Hoche, 75008 Paris, France (opponent), represented by **Bomhard IP, S.L.**, C/Bilbao, 1, 5º, 03001 Alicante, Spain (professional representative)

a g a i n s t

Dmytro Volodymyrovych Savenko, Zarichna Street, building 3-a, Flat 135, 02137 Kyiv, Ukraine (applicant), represented by **Juozas Lapienis**, 21-92, Seimyniskiu Str., 09236 Vilnius, Lithuania (professional representative).

On 13/01/2026, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 220 731 is upheld for all the contested goods and services.
2. European Union trade mark application No 19 015 845 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 23/07/2024, the opponent filed an opposition against all the goods and services of

ADORE
European Union trade mark application No 19 015 845 professional (figurative mark). The opposition is based on international trade mark registration designating the European Union No 687 422 'J'ADORE' (word mark). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

REPUTATION — ARTICLE 8(5) EUTMR

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of 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, T-357/08, BOTOCYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTOLIST / BOTOX, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned 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

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 18/04/2024. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation prior to that date. In principle, it is sufficient that the opponent show that its mark already had a reputation on that date. While it follows from the wording of Article 8(5) EUTMR that the conditions for its application also need to be present at the time of taking the decision, and therefore the reputation of the earlier mark must subsist until the decision on the opposition is taken, any subsequent loss of reputation is for the applicant to claim and prove.

The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation, namely

Class 3: Perfumery; cosmetics.

The opposition is directed against all the goods and services which, after two limitations, are the following:

Class 3: Nail glitter; adhesives for cosmetic purposes, namely for manicure and pedicure purposes; nail cream; nail polish; dressings for nail reconstruction; nail art stickers; oils for cosmetic purposes, namely for manicure and pedicure purposes; nail care preparations; shining preparations [polish] (for manicure and pedicure purposes); degreasing preparations, other than for use in manufacturing processes (for manicure and pedicure purposes); nail polish removers; nail paint (cosmetics); cosmetic stamps, filled (for manicure and pedicure purposes); false nails; nail enamel; nail hardeners (cosmetics); nail tips; nail gel; cotton wool for cosmetic purposes, namely for manicure and pedicure purposes.

Class 35: Arranging and conducting of commercial events related to manicure and pedicure services and goods for the care of nail, hand and foot; demonstration of goods, namely the goods for manicure and pedicure; dissemination of advertising matter related to manicure and pedicure goods and services; distribution of samples, namely the samples of manicure and pedicure goods; influencer marketing in the field of manicure and pedicure goods and services; presentation of goods on communication media, for retail purposes, namely the goods for manicure and pedicure; procurement services for others [purchasing goods and services for other businesses] in the field of manicure and pedicure goods and services; promotion of manicure and pedicure goods through influencers; provision of an online marketplace for buyers and sellers of manicure and pedicure goods and services.

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

On 07/05/2025 the opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept 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 consists, in particular, of the following documents:

Enclosure OP-1: excerpt of earlier mark J'ADORE.

Enclosure OP-2: reputation memorandum.

- Annex 1: Excerpts from several articles setting out details of the long history of J'ADORE (a perfume reformulated by Dior as from 1999) and a timeline outlining its evolution into one of the leading brands in the perfumery field.
- Annex 2: Printouts of NPD Group Inc. ranking reports regarding 'J'ADORE' brand in the category women fragrances in France, Italy and Spain for the years 2016-2019.
- Annex 3: Excerpt from Euromonitor International titled 'The Battle of the Fragrance Titans' dated 08/03/2014. It states that 'J'ADORE' fragrance had overtaken its main rival in many markets around the world and retained its leading position in France; printouts of a survey carried out by the independent provider of strategic market research Moodie David Report (an established provider of real-time business intelligence on the global travel retail sector), dated 15/10/2013 titled 'Dior tops inflight beauty distribution rankings, DRP reports' showing the 'J'ADORE' brand for perfumery goods in the ranking of summer & Fall 2013.
- Annex 4: Press articles and excerpts from, inter alia, mainstream fashion magazines referring to perfume and scents rankings such as *Fragrantica* in 2023, *Elle* (Spain) in 2023, *El Mundo* (Spain) in 2022, *Challenges* (France) 2013, 2014, *Le Huffington Post* in 2012, *ABC Luxe* in France in 2014, *L'Express* (France) in 2012, 2013, 2014, *Cosmopolitan* (France) in 2011, *Strategies Magazine* (France) in 2005, *Cosmétique Magazine* (France) 2004. The articles named the earlier mark 'J'ADORE' as one of the best-selling brands for women's fragrance between 2004 and 2023, in particular in France.

- Annex 5: Excerpts and a summary of awards received by the 'J'ADORE' perfume between 2001 and 2019 such as The Fragrance Foundation (US winners), Eurobest 2011, Cosmopolitan Fragrance Awards 'J'ADORE Best women's fragrance advert' (Spain); Vogue Beauty Awards 'J'ADORE Best women's fragrance campaign' (Spain); Academia del Perfume - Best classic fragrance (Spain 2013); Les Nouvelles Esthétiques – Fifi Awards (France 2014); La Academia del Perfume – Best classic fragrance (Spain 2017).
- Annex 6: Excerpts of the Annual Reports for Dior's Perfumes and Cosmetics between 2017 and 2022, including, inter alia, revenue by geographic region of delivery including for France and Europe (excl. France) and by business group (Perfumes & Cosmetics). Although there is not figure directly linked to the mark 'J'ADORE', it contains remarks throughout as to the performance thereof.
- Annexes 7-10: Affidavits containing relevant information as to the performance of the earlier mark in the relevant territory for a number of years between 1999 and 2022:
 - 1) signed by the Chief Financial Officer of Parfums Christian Dior dated 17/11/2023 (annex 7).
 - 2) signed by the Chief Financial Officer of Parfums Christian Dior dated 28/06/2019 (annex 8).
 - 3) signed by the General Counsel- Intellectual Property of Parfums Christian Dior dated 16/03/2015 (annex 9).
 - 4) signed by the Parfums Christian Dior's CEO dated 20/06/2006 (annex 10).

These documents show, inter alia, the turnover and sales volumes of goods (perfumes) under the earlier mark 'J'ADORE', including market shares of the brand in France, figures of expenditure in advertising and promoting the brand in several EU countries and, sales numbers of 'J'ADORE' goods by way of a representative sample in France, Germany and Spain and the EU (excl. UK) between 2016 and 2022.

- Annex 11: Excerpts from Dior's official social media pages such as Facebook, Twitter, Instagram, YouTube, Pinterest or LinkedIn, including some references to goods and ads on the 'J'ADORE' fragrance and its muse, Charlize Teron. The documents include extracts of similarweb, a web analytics provider that ranks the dior.com website in no. 347 with 3.20 million visits in a period of six months between 11/2018 and 04/2019.
- Annex 12: Extensive selection of printouts of 'J'ADORE' trade mark advertisements published in some mainstream magazines in, inter alia, France (most of them), Belgium, Italy, Spain between 2008 and 2019, such as Vogue, Elle, Cosmopolitan, Glamour, Vanity Fair, Marie Claire, Cosmétiquemag, Styles, Madame Figaro, Biba, Stylist, Grazia, Gala. Some of the documents include reference to their circulation figures. A compilation of print- and digital- advertising campaigns of 'J'ADORE' perfumes in, inter alia, mainstream magazines and newspapers from 2016 and 2022 covering e.g. France, Spain, Italy, Germany, Greece, Netherlands, Poland as well as from some countries outside of the relevant territory (e.g. China, Japan, United States, South Korea, UAE, Australia, Brazil, Mexico) and a timeline of 'J'ADORE' perfume advertisement campaigns from 1999 to 2018 is also included.

- Annex 13: Excerpts from the official Dior's online store displaying images of the range of 'J'ADORE' perfumes including some cosmetics goods.
- Annexes 14-15: Excerpts from press media referring to the opponent's sponsorships activities: 1) Coverage of a Christmas dinner hosted by 'J'ADORE' in 2018 in Spain – 'Una cena de Navidad de Dior con J'ADORE', for their new campaign of 'J'ADORE'; 2) A document from Commb (2011) where it is stated that the objective of the campaign was to increase purchase intention reinforcing the luxury image of the brand and differentiate 'J'ADORE' from other perfumes during the very competitive Christmas period; 3) Parfums Christian Dior helped to showcase the 'Or' Exhibition from 2018, which took place in Marseille, France. The exhibition included 'J'ADORE' Dior flacons handcrafted with gold and diamonds by artisans in Dior's fine jewellery ateliers and the gold-coloured sequined couture dress Charlize Theron wore in the 'J'ADORE' Dior advertising campaign; 4) "Dior J'adore!" Exhibition - September 2023, at the Beaux-arts de Paris, France. The exhibition tells the story of the iconic fragrance, J'Adore, and how it has evolved, from its conception and original inspiration in 1999 to its latest iteration, L'or de J'Adore, composed by the world-famous perfumer Francis Kurkdjian.
- Annex 16: Excerpts of publications and books referring to 'J'ADORE' perfume or to its advertising campaign featuring the actress Charlize Theron. They show that the advertising campaign has been widely broadcast in the relevant territory. For example, in Styles (France) in 2012, Journal du Luxe in 2015 (France), Vogue (Italy) in 2011, El Pais (Spain) in 2010, 2011, 2018, Vogue (Spain) in 2014, El Mundo in 2018 (Spain), Zeleb 2018 (Spain), Glamour in 2019 (Spain).
- Annex 17: Several decisions issued by the EUIPO dated and a decision issued by INPI (the French trade mark Office) dated 2013 which confirm the reputation of the earlier trade mark in relation to perfumery between 2007 and 2023.

The opponent provided a thorough report, memorandum of the history of the mark 'J'ADORE' in the European Union (Enclosure OP-2), its use and recognition, with a particular focus on France. Its arguments have been supported by voluminous probative material from independent sources.

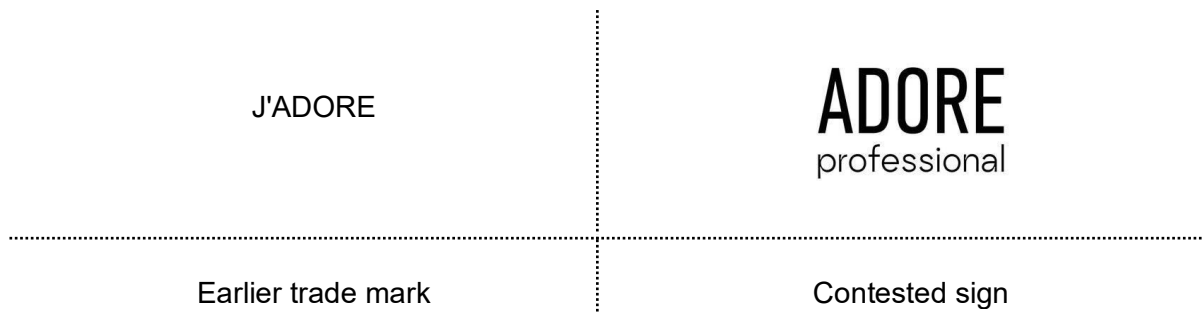
The evidence relates mostly to the relevant period, namely before 18/04/2024, (contested sign's filing date), and shows that the earlier trade mark has been subject to a long-standing and intensive use and is generally known in the sector of perfumes, for which it enjoys a consolidated position among the leading brands as attested by diverse independent sources. The turnover figures, market shares and rankings, marketing expenditure, press clips referring to 'J'ADORE' perfumes as one of the top perfumes for several years not only in the EU but also in other non-EU countries (information confirmed by numerous sources) clearly show that the mark enjoys a high degree of recognition among the relevant public.

The opponent has requested that the expenditure made in advertising and the figures concerning turnover be kept confidential vis-à-vis third parties, and, therefore, specific figures cannot be made public; however, it can be stated that both sets of figures are over several million euros and contribute to the appreciation that the threshold of knowledge of the mark is high among the relevant public. Furthermore, the mark has been advertised extensively not only in mainstream magazines and newspapers. For example, the evidence demonstrates a significant mediatic impact of actress Charlize Theron's worldwide 'J'ADORE' advertising campaign. Moreover, the Intellectual Property Authorities of INPI and the EUIPO, have deemed its reputation proved. It is therefore reasonable to conclude that the earlier mark must have come to the attention of a large number of consumers in France,

and even in the whole European Union as demonstrated by the high evidential value of the material submitted as to the rankings the mark occupies in several EU countries, the vast selection of marketing and promotional evidence submitted and the impressive revenue attained by the goods bearing the mark 'J'ADORE'.

On the basis of the above the Opposition Division concludes that the earlier trade mark has a significant reputation in the European Union for some of the goods for which the opponent has claimed reputation, namely, *perfumery* in Class 3.

b) The signs



The relevant territory is the European Union.

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

The earlier mark 'J'ADORE' will be understood by the French-speaking public as *I adore*, *I love* referring to one's strong feeling of affection; a great interest and pleasure in something. In English, 'ADORE' means *to love intensively or deeply*. Furthermore, since the equivalent term in some other official languages is very similar, such as in Spanish 'adorar' or in Italian 'adorare', it can be considered that the relevant public speaking these languages will also understand this term with the above meaning. Albeit the words 'adore, love' are commonly used in order to create a positive connotation to customers, the expression '*I adore or I love*' have no direct meaning for the goods at issue and are normally distinctive. Moreover, for the other part of the public, these words have no meaning and, as such, are distinctive to a normal degree.

The contested sign is composed of the verbal elements 'ADORE' written in standard upper-case letters placed above the verbal element 'professional', written in standard lower-case letters of smaller size than the element above. The element 'ADORE' as explained is understood as *love* by at least a substantial part of the public, for this part of the public, the term has a below average degree of distinctive character, in contrast it has normal distinctive character for the remaining part of the public. The second element 'professional' is a non-distinctive word for the goods in question, as it is a basic English term broadly used in the marketplace that will be understood by the relevant consumers (general and professional) as alluding to the fact that the relevant goods are aimed to professionals or perform as if they were done by a professional. 'ADORE' is the dominant element as it is the most eye-catching.

Visually, the signs coincide in the term 'ADORE', this is, the dominant and distinctive element of the contested sign and the longest of the earlier mark. The signs differ in the letter 'J' of the earlier mark and the non-distinctive element 'professional' of the contested sign, of a subsidiary nature also due to its small size. The signs also differ in the apostrophe (') between the letters 'J' and 'A' in the earlier mark, having a reduced impact from a visual perspective due to its small size, as well as in the typeface of the contested sign, which will be perceived as a graphical means of bringing the verbal elements to the attention of the public and therefore has a limited impact in the perception of the signs.

The consideration that the consumer normally attaches more importance to the initial part of a trade mark cannot apply in all cases and call into question the principle that the examination of the similarity of trade marks must be based on the overall impression produced by them. There is no reason to believe that average consumers, who are reasonably well informed, observant and circumspect, will systematically disregard the subsequent part of the verbal element of a trade mark to the extent that they only remember the first part (07/06/2023, T-33/22, Porto insígnia / Insignia et al., EU:T:2023:316, § 56-57).

In the present case, the coincidence in the element of mayor trade mark significance in both signs is rather relevant as far as the comparison of the signs is concerned.

Therefore, the signs are visually similar to an above average 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 'ADORE', present identically in both signs. The pronunciation differs in the sound of the letter 'J' of the earlier mark, which has no counterpart in the contested sign.

As regards the element 'professional', given its non-distinctive character and secondary position within the sign, it is unlikely to be pronounced. Case-law confirms that consumers generally refer to the dominant elements while less prominent elements are not pronounced, nor tend to pronounce non-distinctive verbal elements (03/07/2013, T-206/12, LIBERTE american blend (fig.) / La LIBERTAD et al., EU:T:2013:342, § 43-44) and (30/11/2011, T-477/10, SE© Sports Equipment, EU:T:2011:707, § 55; 04/02/2013, T-159/11, WALICHNOWY MARKO (fig.) / MAR-KO, EU:T:2013:56, § 44) in any case, consumers tend to shorten marks containing several words.

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

Conceptually, as for at least a part of the public both signs will be associated with the term 'ADORE' meaning *love* and differ in the personal pronoun 'I' ('Je'/'J' in French) and in the non-distinctive term 'professional', the signs are conceptually similar to an above average degree. However, for a part of the public only the element 'professional' will be understood and the signs are consequently conceptually dissimilar. However, this conceptual difference has little impact on the comparison of the signs as originates from a non-distinctive concept.

As the signs have been found similar in every aspect of the comparison, the examination of the existence of a risk of injury will proceed.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are rather similar. 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 by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

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

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

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

In the present case, the contested *nail glitter; adhesives for cosmetic purposes, namely for manicure and pedicure purposes; nail cream; nail polish; dressings for nail reconstruction; nail art stickers; oils for cosmetic purposes, namely for manicure and pedicure purposes; nail care preparations; shining preparations [polish] (for manicure and pedicure purposes); degreasing preparations, other than for use in manufacturing processes (for manicure and pedicure purposes); nail polish removers; nail paint (cosmetics); cosmetic stamps, filled (for manicure and pedicure purposes); false nails; nail enamel; nail hardeners (cosmetics); nail tips; nail gel; cotton wool for cosmetic purposes, namely for manicure and pedicure purposes* in Class 3 are closely related to the opponent's *perfumery*. These contested goods are all toiletries and beauty, and nail care preparations and products used normally in combination with, or at least in the same location and with the same aim as, preparations for beautification and personal hygiene as the opponent's *perfumery*.

Moreover, as outlined previously the signs are visually similar to an above average degree, aurally highly similar and conceptually (at least for a substantial part of the public) similar to an above average degree. As set out above the inherent distinctive character of the earlier mark, as a whole, is normal and due to the intensive and longstanding use of the mark in question it has been demonstrated that the sign has attained a consolidated position in the perfumery sector within the European Union and thus enjoys a significant reputation. Therefore, a global appreciation of all these relevant factors allows to draw the conclusion that consumers that know the earlier mark 'J'ADORE', when confronted with the contested

sign 'ADORE professional', in the context of the above mentioned contested goods, will, almost certainly, establish a link (or association) between the signs.

While the relevant section of the public for the services covered by the conflicting mark only overlaps to some extent, in respect of *arranging and conducting of commercial events related to manicure and pedicure services and goods for the care of nail, hand and foot; demonstration of goods, namely the goods for manicure and pedicure; dissemination of advertising matter related to manicure and pedicure goods and services; distribution of samples, namely the samples of manicure and pedicure goods; influencer marketing in the field of manicure and pedicure goods and services; presentation of goods on communication media, for retail purposes, namely the goods for manicure and pedicure; procurement services for others [purchasing goods and services for other businesses] in the field of manicure and pedicure goods and services; promotion of manicure and pedicure goods through influencers; provision of an online marketplace for buyers and sellers of manicure and pedicure goods and services* in Class 35, account must be taken that these services and the opponent's goods concern the same sector (i.e. beauty and hygiene). Consequently, and despite that there is some distance between the goods and services referred, it cannot be excluded that given the reputation of the earlier mark that the contested mark would remind the relevant consumer of the earlier mark.

Therefore, taking into account and weighing up all the relevant factors of the present case, it must be concluded 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, T-301/09, CITIGATE / CITICORP et al., 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' (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., 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.

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) EUTMR covers cases where there is clear exploitation and 'free-riding on the coat-tails' 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 (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 48; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40).

The proprietor of the earlier mark bases its claim on the following:

- The evidence submitted with this brief shows that, the J'ADORE Mark is widely known in the territory of the European Union in connection with perfumery. In particular, the opponent's products are widely known and enjoy an outstanding reputation for high quality, exclusivity, consistency, and reliability. the consistent high market position of the products sold under the earlier J'ADORE mark reflects the fact that consumers cherish the earlier 'J'ADORE' mark and the quality of the products branded under the 'J'ADORE' mark. These properties could easily be transferred to the contested mark.
- The ensuing image transfer would facilitate the sale or enhance the appeal of cosmetic products, or the provision of business, marketing, and promotional services specifically tailored for manicure and pedicure goods designated by the contested mark. this would take unfair advantage of the longstanding efforts of the opponent regarding the marketing and quality control of its goods and related services.
- Accordingly, the use of the contested mark would take unfair advantage of the repute and distinctiveness of the earlier 'J'ADORE' mark.

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.

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36.)

The more immediately and strongly the earlier mark is brought to mind by the later sign, the greater the likelihood that current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental thereto (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 67-69; 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 41, 43).

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 that takes into account all the factors relevant to the circumstances of the case (10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 53; 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 30, 38; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66; 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53).

The applicant argues that its mark has been registered and in continuous use in Ukraine since 2015 for professional nail care products and that the brand was subsequently extended to the European Union market in 2020, where it has continued to develop in good faith, without reference to or intention to imitate the opponent's reputed trade mark. In this regard it must be clarified that 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 which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation' (19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215, § 40; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40; 30/01/2008, T-128/06, Camelo, EU:T:2008:22, § 46). Consequently, the applicant's argument over the lack of intention to imitate the opponent's reputed trade mark must be set aside as unfounded.

The opponent has demonstrated that it uses the earlier mark as from 1999 and that 'J'ADORE' has been for long now recognised as one of the top and leading brands within the perfumery sector. Moreover, the evidence submitted by the opponent shows that the earlier mark has a positive image associated with quality, luxury, reliability, and good value.

As explained in section c) of this decision, considering the reputation of the earlier mark, the high and/or above average degree of similarity between the signs and the fact that part of the conflicting goods and services are somehow connected, the relevant public will establish a link between the marks in respect of those goods and services. This link will create an association that will produce a commercial benefit for the applicant by misappropriating the power of attraction and image of quality, luxury, reliability and good value of the earlier mark. By using the trade mark applied for, the applicant, will take a 'free ride' on the investment of the opponent which will likely stimulate the sales of the applicant's goods and services to an extent that is disproportionately high in comparison with the size of its promotional investment. Therefore, in the circumstances of this case, there is a likelihood that the contested sign will ride on the coat-tails of the earlier reputed mark.

On the basis of the above, it is concluded that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

Other types of injury

The opponent also argues that use of the contested trade mark would be detrimental to the distinctive character of the earlier trade mark.

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, as seen above, the Opposition Division has already concluded that the contested trade mark would take unfair advantage of the distinctive character or repute of the earlier trade mark. It follows that there is no need to examine whether other types also apply.

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 and services.

Given that the opposition is entirely successful under Article 8(5) EUTMR, it is not necessary to examine the remaining grounds.

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) EUTMR, 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**

Helena
GRANADO CARPENTER

María del Carmen
COBOS PALOMO

Marzena
MACIAK

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.