

JUDGMENT OF THE GENERAL COURT (First Chamber)

17 April 2024 (*)

(EU trade mark – Opposition proceedings – Application for the EU figurative mark Healthily – Earlier EU figurative mark Healthies – Relative ground for refusal – Likelihood of confusion – Article 8(1)(b) of Regulation (EU) 2017/1001 – Obligation to state reasons – Article 94(1) of Regulation 2017/1001 – Legitimate expectations)

In Case T-288/23,

Unilab LP, established in Rockville, Maryland (United States), represented by M. Kondrat, lawyer,
applicant,

v

European Union Intellectual Property Office (EUIPO), represented by K. Misztal and
J. Ivanauskas, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

Cofares, Sociedad Cooperativa Farmaceutica Española, established in Madrid (Spain),

THE GENERAL COURT (First Chamber),

composed of D. Spielmann, President, R. Mastroianni (Rapporteur) and S. L. Kalèda, Judges,

Registrar: V. Di Bucci,

having regard to the written part of the procedure,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

1 By its action under Article 263 TFEU, the applicant, Unilab LP, seeks the annulment and the alteration of the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 1 March 2023 (Case R 1959/2022-2) ('the contested decision').

Background to the dispute

2 On 22 October 2022, the applicant filed an application for registration of an EU trade mark with EUIPO in respect of the following figurative sign:

Healthily

3 Following the restriction made in the course of the proceedings before EUIPO, the mark applied for covered goods in Classes 3, 5 and 10 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, corresponding, for each of those classes, to the following description:

- Class 3: ‘Cosmetics; cosmetic preparations for slimming purposes, shaving preparations, breath fresheners, oral and dental preparations, hair grooming preparations, sun-tanning preparations (cosmetics), perfumes, perfumes, tissues impregnated with cosmetic lotions, depilatory preparations, cosmetic utensils, namely antiperspirants, roll-on deodorants, mousses being hair styling aids, douching preparations for personal hygiene or deodorant purposes; sanitary preparations included in this class; ethereal oils’;
- Class 5: ‘Pharmaceutical products; medical preparations; vitamins and minerals included in this class; mineral food supplements; mineral waters for medical purposes; parapharmaceuticals; food supplements; dietetic foods; dietary substances; herbal preparations; medicinal herbs; tea for medical purposes; biocides, biological preparations, germicides; vaccines, serums, blood-derived preparations, biotechnological preparations; pharmaceutical preparations for skin care, anti-acne products, dental preparations and materials; pharmaceutical lotions, infant formula, dressings (medical); sanitary preparations for medical purposes; disinfectants; veterinary preparations included in this class; chemical preparations for medical purposes, diagnostic preparations for medical purposes, suppositories for medical purposes, enzyme preparations for medical purposes; chewing gum for therapeutic use; medicinal drinks, medicinal herbs; medicinal infusions; tonics (medicines); poultices; medicated cosmetics’;
- Class 10: ‘Physical therapy equipment; medical and veterinary apparatus and instruments; furniture and bedding for medical purposes; medical clothing; prosthetics and artificial implants; orthopedic and mobility aids; therapeutic patches; compresses for supporting the body; ice packs for the treatment of injuries’.

4 On 11 May 2021, Cofares, Sociedad Cooperativa Farmaceutica Española filed a notice of opposition to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

5 The opposition was based on the following EU figurative mark, which is registered under the number 18272799:



6 That mark covers goods and services in, inter alia, Classes 5 and 44, corresponding, for each of those classes, to the following description:

- Class 5: ‘Pharmaceuticals’;
- Class 44: ‘Medical services; hygienic and beauty care’.

7 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

8 On 9 August 2022, the Opposition Division upheld the opposition on the basis of Article 8(1)(b) of Regulation 2017/1001 in respect of all the goods referred to in paragraph 3 above, with the exception of ‘furniture and bedding for medical purposes; medical clothing’, in Class 10.

9 On 6 October 2022, the applicant filed a notice of appeal with EUIPO against the decision of the Opposition Division.

10 By the contested decision, the Board of Appeal dismissed the appeal on the ground that there was a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation 2017/1001. In particular, it found, first of all, that the relevant public consisted of the general public and professionals displaying a level of attention which could vary from average to high. Next, it found, like the Opposition Division, that the goods and services at issue had to be considered to be, at least, similar to a low degree. Lastly, as regards the comparison between the signs at issue, the Board of Appeal found that the word ‘health’ did not have any clear and direct meaning for the relevant public and did not correspond to any basic English word and that the applicant had not shown that that public had sufficient knowledge of English to understand that term. The Board of Appeal found that the signs at issue were visually and phonetically similar to a high degree, that a conceptual comparison of those signs could not be carried out and that the inherent distinctiveness of the earlier mark was average in degree. It concluded that those similarities were of sufficient relevance for there to be a likelihood of confusion on the part of the relevant public, even despite that public’s level of attention, which varied from average to high.

Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision;

- alter the contested decision by stating that there are no relative grounds for refusal of registration of the mark applied for and that that mark is to be registered in respect of all the goods and services;
- order EUIPO to pay the costs.

12 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs in the event that a hearing is convened.

Law

The issue of whether the Court has the jurisdiction to examine the second head of claim

13 As regards the second head of claim, it must be pointed out that that head of claim requests that the Court alter the contested decision so that the mark is to be registered and may be understood as requesting that the Court alter the contested decision within the meaning of Article 72(3) of Regulation 2017/1001 by adopting the decision that the Board of Appeal should have taken, in accordance with the provisions of that regulation. The competent bodies of EUIPO do not, however, adopt formal decisions recording the registration of an EU trade mark which could be the subject of an appeal. Consequently, the Board of Appeal does not have power to take cognisance of a claim that it should register an EU trade mark. Nor, in those circumstances, is it for the Court to take cognisance of a claim for alteration requesting that it amend the decision of a Board of Appeal in that sense (see, to that effect, judgment of 12 April 2011, *Euro-Information v OHIM (EURO AUTOMATIC PAYMENT)*, T-28/10, EU:T:2011:158, paragraph 13 and the case-law cited). It follows that the second head of claim must be rejected on the grounds of lack of jurisdiction.

Substance

14 The applicant relies on three pleas in law, alleging, first, infringement of Article 8(1)(b) of Regulation 2017/1001, secondly, infringement of the principles of the protection of legitimate expectations and legal certainty and, thirdly, infringement of Article 94(1) and Article 95(1) of Regulation 2017/1001.

15 The Court considers it appropriate to examine the third plea first.

The third plea in law, alleging that the statement of reasons for the contested decision is inadequate

16 In the context of that plea, the applicant submits, in essence, that the contested decision is vitiated by an inadequate statement of reasons, in the light of the fact that the Board of Appeal did not diligently examine the facts, evidence and arguments as regards the comparison of the signs at issue, and in particular the assessment of the distinctive character of the word element in common placed at the beginning of the signs at issue, namely ‘health’, and as regards the comparison of the goods and services at issue.

17 EUIPO disputes the applicant’s arguments.

18 The obligation to state reasons, an obligation which is incumbent on the Board of Appeal and which stems from, inter alia, Article 94(1) of Regulation 2017/1001, has two purposes: (i) to allow interested parties to know the justification for the measure taken so as to enable them to protect their rights and (ii) to enable the Courts of the European Union to exercise their power to review the legality of the decision (see judgment of 19 December 2019, *Currency One v EUIPO – Cinkciarz.pl (CINKCIARZ)*, T-501/18, EU:T:2019:879, paragraph 67 and the case-law cited).

19 In that regard, it must be borne in mind that the obligation to state reasons does not require the Boards of Appeal to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. It is sufficient if they set out the facts and the legal considerations having decisive importance in the context of the decision (judgment of 15 January 2015, *MEM v OHIM (MONACO)*, T-197/13, EU:T:2015:16, paragraph 19).

20 In the present case, it is apparent from paragraphs 21 and 43 to 48 of the contested decision that the reasoning followed by the Board of Appeal regarding, respectively, the comparison of the goods and services at issue and the assessment of the distinctive character of the word element ‘health’, which is common to the signs at issue, set out, contrary to what the applicant claims, in a clear and unequivocal manner, the fundamental considerations on the basis of which it had found that the provisions of Article 8(1)(b) of Regulation 2017/1001 precluded, in the present case, the registration of the mark applied for in respect of those goods.

21 In the first place, it is apparent from paragraph 21 of the contested decision that the Board of Appeal, first of all, assessed the comparison between the goods in Classes 3 and 5 covered by the mark applied for and the ‘pharmaceuticals’ in Class 5 and services in the field of hygiene and beauty care in Class 44 covered by the earlier mark and found that they were at least similar to a low degree. Next, it also compared the goods in Class 10 covered by the mark applied for and the goods and services covered by the earlier mark and found that some were dissimilar whereas others were similar to the ‘pharmaceuticals’ in Class 5 and the ‘medical services’ in Class 44 covered by the earlier mark.

22 In the second place, it is apparent from paragraphs 43 to 48 of the contested decision that the Board of Appeal took into account the evidence which the applicant had submitted in order to prove the relevant public’s knowledge of English and found that that evidence could not, on its own, be considered to be sufficient to conclude that the relevant Hungarian, Italian and Spanish public was able to grasp the meaning of the English word ‘health’, which the applicant had not proved to be a basic English word. That statement of reasons thus enabled the applicant to understand the contested decision and to dispute its lawfulness, as is shown by the arguments which the applicant has submitted in the context of the present action.

23 In those circumstances, the applicant cannot maintain that the contested decision is vitiated by a failure to state reasons, with the result that the third plea must be rejected.

The first plea, alleging infringement of Article 8(1)(b) of Regulation 2017/1001

24 By its first plea, the applicant submits, to begin with, that, as regards the comparison of the goods and services at issue, most of those goods and services are dissimilar. Next, the applicant claims that, as regards the comparison of the signs at issue, first, the Board of Appeal made an error of assessment in finding that at least a non-negligible part of the relevant Hungarian, Italian and

Spanish public would not attribute any clear meaning to the element ‘health’, which is common to both of the signs. Secondly, it argues that the signs at issue are visually, phonetically and conceptually dissimilar overall in that the only point of similarity between them lies in the descriptive element which they have in common, namely ‘health’. Consequently, the applicant claims that there is no likelihood of confusion.

25 EUIPO disputes the applicant’s arguments.

26 Article 8(1)(b) of Regulation 2017/1001 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark.

27 According to settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically linked undertakings constitutes a likelihood of confusion. According to the same case-law, the likelihood of confusion must be assessed globally, according to the relevant public’s perception of the signs and goods or services in question and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services covered (see judgment of 9 July 2003, *Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, EU:T:2003:199, paragraphs 30 to 33 and the case-law cited).

28 For the purposes of applying Article 8(1)(b) of Regulation 2017/1001, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009, *Commercy v OHIM – easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraph 42 and the case-law cited).

29 Where the protection of the earlier trade mark extends to the entirety of the European Union, it is necessary to take into account the perception of the marks at issue by the consumer of the goods or services in question in that territory. However, it must be borne in mind that, for an EU trade mark to be refused registration, it is sufficient that a relative ground for refusal for the purposes of Article 8(1)(b) of Regulation 2017/1001 exists in part of the European Union (see, to that effect, judgment of 14 December 2006, *Mast-Jägermeister v OHIM – Licorera Zacapaneca (VENADO with frame and others)*, T-81/03, T-82/03 and T-103/03, EU:T:2006:397, paragraph 76 and the case-law cited).

30 It is in the light of the abovementioned principles that the present plea must be examined.

The relevant public

31 In the present case, the Board of Appeal found that the relevant territory was that of the European Union. Furthermore, it found that, with regard to the goods in Class 3, the relevant public consisted of the general public and that its level of attention was at least average. As regards, on the one hand, the goods at issue in Class 5, the Board of Appeal found that they were aimed both at a public of professionals and at the general public and as regards, on the other hand, the goods in Class

10, it found that they were aimed only at a professional public in the medical and pharmaceutical field. It concluded that the part of the relevant public consisting of professionals had a high level of attention and that that consisting of the general public displayed a higher than average level of attention on the ground that the goods in Class 5 had a medical purpose or could have an impact on health and the human body. The parties do not dispute that assessment.

The comparison of the goods and services

32 In assessing the similarity of the goods or services at issue, all the relevant factors relating to those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see judgment of 14 May 2013, *Sanco v OHIM – Marsalman (Representation of a chicken)*, T-249/11, EU:T:2013:238, paragraph 21 and the case-law cited).

33 In that regard, it must be stated that complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods and services intended for different publics cannot be complementary (see judgment of 22 January 2009, *easyHotel*, T-316/07, EU:T:2009:14, paragraphs 57 and 58 and the case-law cited).

34 Furthermore, it must be pointed out that goods and services may be regarded as identical where the goods and services covered by the earlier mark are included in a more general category covered by the later mark (see judgments of 7 September 2006, *Meric v OHIM – Arbora & Ausonia (PAM-PIM'S BABY-PROP)*, T-133/05, EU:T:2006:247, paragraph 29 and the case-law cited, and of 21 July 2016, *Ogrodnik v EUIPO – Aviário Tropical (Tropical)*, T-804/14, not published, EU:T:2016:431, paragraph 34 and the case-law cited). Likewise, where the goods and services covered by the earlier mark include the goods and services covered by the mark applied for, those goods and services are considered to be identical (judgment of 24 November 2005, *Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE)*, T-346/04, EU:T:2005:420, paragraph 34).

35 It must also be pointed out that the classification of goods and services under the Nice Agreement is to serve exclusively administrative purposes. Consequently, goods and services may not be regarded as being dissimilar on the ground that they appear in different classes of that classification (judgment of 6 June 2018, *Uponor Innovation v EUIPO – Swep International (SMATRIX)*, T-264/17, not published, EU:T:2018:329, paragraph 26).

36 In the present case, the Board of Appeal found, first, that the goods in Classes 3 and 5 covered by the mark applied for were at least similar to a low degree to the category of 'pharmaceuticals' in Class 5 or to the services in the field of hygiene and beauty care in Class 44 covered by the earlier mark. It found, secondly, that some of the goods in Class 10 covered by the mark applied for, namely 'furniture and bedding for medical purposes' and 'medical clothing', were dissimilar to all the goods and services covered by the earlier mark and that the remaining goods in Class 10 covered by the mark applied for were similar to 'pharmaceuticals' in Class 5 or to 'medical services' in Class 44, all of which were covered by the earlier mark.

37 First of all, the applicant submits, in essence, that most of the goods and services at issue are dissimilar. In particular, it contends that the Board of Appeal erred in finding that there was a similarity, on account of their complementarity, between some of the goods in Class 5 covered by the mark applied for, namely ‘food supplements’, ‘sanitary preparations for medical use’, ‘disinfectants’ and ‘chemical preparations for medical purposes’, and the goods and services covered by the earlier mark. Next, the applicant claims that the Board of Appeal erred in finding that the medical devices in Class 10 covered by the earlier mark could be considered to be similar, even to a low degree, to the goods and services covered by the earlier mark. The applicant adds that the goods in Class 3 covered by the mark applied for are not similar to the goods in Class 5 and the services in Class 44 covered by the earlier mark, since they are neither complementary nor in competition with each other and also do not have the same distribution channels, since the goods covered by the mark applied for are intended to maintain a person’s hygiene whereas the goods and services covered by the earlier mark are intended to treat or prevent diseases affecting a person’s organism or to improve his or her appearance.

38 EUIPO disputes the applicant’s arguments.

39 It must be borne in mind at the outset that a Board of Appeal may lawfully adopt the grounds of a decision taken by the Opposition Division, which thus form an integral part of the statement of reasons for the Board of Appeal’s decision. Thus, when the Board of Appeal confirms a lower-level decision of EUIPO, that decision, together with its statement of reasons, forms part of the context in which the Board of Appeal’s decision was adopted, a context which is known to the parties and enables the Court to carry out fully its judicial review as to whether the Board of Appeal’s assessment was well founded (see judgment of 13 September 2010, *Inditex v OHIM – Marín Díaz de Cerio (OFTEN)*, T-292/08, EU:T:2010:399, paragraphs 48 and 49 and the case-law cited). Consequently, in the present case, it cannot be claimed that the Board of Appeal did not examine the issue of the similarity of the goods and services at issue or state reasons for its decision regarding that issue.

40 As regards the similarity between some of the goods in Class 5 covered by the mark applied for, namely ‘food supplements’, ‘sanitary preparations for medical purposes’, ‘disinfectants’ and ‘chemical preparations for medical purposes’, and the pharmaceuticals in Class 5 covered by the earlier mark, it must be pointed out that all those goods are, as the Board of Appeal rightly found, at least similar to a low degree. It must be stated that those goods are intended for the same public and have the same intended purpose, as they are intended for use in treatment. They also have the same nature, since they are perceived by consumers as goods belonging to the same general category of healthcare products. Furthermore, they are closely complementary in so far as preparations for medical purposes may prove to be indispensable when pharmaceutical preparations are administered (see, by analogy, judgment of 28 October 2010, *Farmeco v OHIM – Allergan (BOTUMAX)*, T-131/09, not published, EU:T:2010:458, paragraph 30).

41 It follows from the foregoing that those goods in Class 5 covered by the mark applied for must be held to be at least similar to a low degree to the ‘pharmaceuticals’ in the same class covered by the earlier mark.

42 As regards the similarity between the other goods in Class 5 and those in Class 3 covered by the mark applied for and the goods and services covered by the earlier mark, it must be held, as the Opposition Division and the Board of Appeal found, that some of those goods in Classes 3 and 5

covered by the mark applied for are at least similar to a low degree to the ‘pharmaceuticals’ in Class 5 covered by the earlier mark. The other goods in Classes 3 and 5 covered by the mark applied for are at least similar to a low degree to the services in the field of hygiene and beauty care in Class 44 covered by the earlier mark, in so far as they have the same general purpose, namely the beautifying, perfuming and care of the human body. Furthermore, there is also a complementary connection between those goods and services, since the former may be used to provide the latter and they are aimed at the same customers and have the same distribution channels. As regards the similarity between the goods in Class 10 covered by the mark applied for and the goods and services covered by the earlier mark, it must be pointed out that the ‘physical therapy equipment’, ‘medical and veterinary apparatus and instruments’, ‘prosthetics and artificial implants’ and ‘orthopedic and mobility aids’ in Class 10 covered by the mark applied for are similar to the ‘medical services’ in Class 44 covered by the earlier mark because they are complementary, since they are likely to be used during or after medical treatment, are aimed at the same public and have the same purpose. The ‘therapeutic patches’, ‘compresses for supporting the body’ and ‘ice packs for the treatment of injuries’ in Class 10 are, as the Opposition Division rightly found, similar to the ‘pharmaceuticals’ in Class 5 covered by the earlier mark because they have the same end user, share the same distribution channels and have the same purpose. Lastly, it must be stated that the other goods in Class 10 covered by the mark applied for, namely the ‘furniture and bedding for medical purposes’ and the ‘medical clothing’, are, as the Opposition Division and the Board of Appeal rightly found, dissimilar to all the goods and services covered by the earlier mark.

43 Consequently, in the light of the foregoing considerations, it must be held that the Board of Appeal was right in finding, in paragraph 21 of the contested decision, that, first, the goods in Classes 3 and 5 covered by the mark applied for were at least similar to a low degree to the ‘pharmaceuticals’ in Class 5 or to the ‘hygienic and beauty care’ in Class 44 covered by the earlier mark. The Board of Appeal was right in finding that, secondly, the goods in Class 10 covered by the mark applied for were similar to the ‘pharmaceuticals’ in Class 5 or to the ‘medical services’ in Class 44 covered by the earlier mark.

The comparison of the signs

44 The global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (see, to that effect, judgment of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 35 and the case-law cited).

45 Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see judgment of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (judgments of 12 June 2007, *OHIM v Shaker*,

C-334/05 P, EU:C:2007:333, paragraph 42, and of 20 September 2007, *Nestlé v OHIM*, C-193/06 P, not published, EU:C:2007:539, paragraph 43). That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (judgment of 20 September 2007, *Nestlé v OHIM*, C-193/06 P, not published, EU:C:2007:539, paragraph 43).

46 It must be pointed out at the outset, as observed by the Board of Appeal, that the earlier mark is a figurative mark and consists of the word element ‘healthies’ written in a standard blue font, followed by a figurative element which may be perceived as two overlapping letters ‘v’ (represented in blue and purple and different in height and size). The mark applied for is also a figurative mark and consists of the word element ‘healthily’ represented in a standard black font.

– *The distinctive character of ‘health’*

47 The Board of Appeal found, first of all, that the comparison of the signs had to be carried out from the point of view of the Hungarian-, Italian- and Spanish-speaking public. Next, it pointed out that, according to settled case-law, knowledge of a foreign language could not generally be assumed and that the Spanish public’s degree of knowledge of English was generally considered to be low.

48 Furthermore, according to the Board of Appeal, the evidence which the applicant had submitted in order to prove the relevant public’s knowledge of English could not, on its own, be considered to be sufficient to conclude that the relevant Hungarian, Italian and Spanish public was able to grasp the meaning of the English word ‘health’, which the applicant had not proved to be a word which was part of basic English vocabulary. That was all the more true, according to the Board of Appeal, since the equivalents of that word in Hungarian, Italian and Spanish, namely ‘egészség’, ‘salute’ and ‘salud’ respectively, do not resemble the word ‘health’. It found that the same applied to the English word ‘healthy’, which is translated as ‘salutare’ in Italian, ‘egészséges’ in Hungarian and ‘saludable/sano’ in Spanish. In the light of the foregoing, the Board of Appeal found that neither of the signs at issue as a whole had a meaning for a significant proportion of the relevant public and that therefore, at least for a non-negligible part of that public, the signs would not have any meaning.

49 Furthermore, as regards the earlier mark, it found that both the word element ‘healthies’ and the figurative element resembling two stylised letters ‘v’ were distinctive, in so far as neither of those elements conveyed a clear and direct message related to the goods and services at issue. As regards the mark applied for, the word element ‘healthily’ was, according to the Board of Appeal also distinctive, in so far as the relevant public would not perceive in that mark a direct and clear meaning related to the goods and services at issue.

50 The applicant submits that at least a non-negligible part of the relevant public will immediately attribute a clear meaning to the element ‘health’, which is common to the signs at issue. According to the applicant, that element is a simple English word which is generally known throughout the European Union. It argues that, consequently, since that element is weak and purely descriptive of the goods and services at issue, it has less weight in the comparison of the signs, which differ in their other elements.

51 EUIPO disputes the applicant’s arguments.

52 As regards the allegedly descriptive character of the word element ‘health’, it must be borne in mind that, first, according to settled case-law, knowledge of a foreign language cannot, in general, be assumed (see judgment of 14 July 2021, *Cole Haan v EUIPO – Samsøe & Samsøe Holding (Ø)*, T-399/20, EU:T:2021:442, paragraph 39 and the case-law cited).

53 Secondly, although it is true that many consumers in the European Union know basic English vocabulary (see judgment of 22 June 2022, *Kubara v EUIPO (good calories)*, T-602/21, not published, EU:T:2022:382, paragraph 33 and the case-law cited), it has, by contrast, been held that other English terms or one of their meanings could not be considered to form part of such basic vocabulary (see, to that effect, judgments of 16 October 2014, *Junited Autoglas Deutschland v OHIM – Belron Hungary (United Autoglas)*, T-297/13, not published, EU:T:2014:893, paragraphs 32 and 42, and of 16 February 2017, *Jaguar Land Rover v EUIPO – Nissan Jidosha (Land Glider)*, T-71/15, not published, EU:T:2017:82, paragraph 45).

54 Consequently, with the exception of certain terms forming part of basic English vocabulary, it cannot be assumed that English terms are widely known in the European Union. However, if the English terms have an equivalent in the language of the non-English-speaking public and a link may be established by that public between those terms and their translation into the language concerned, then that public must be held to understand their meaning (see judgment of 15 September 2021, *Celler Lagravera v EUIPO – Cyclic Beer Farm (Cíclic)*, T-673/20, not published, EU:T:2021:591, paragraph 46 and the case-law cited). In the present case, first, the English term ‘health’ cannot be considered to form part of that language’s basic vocabulary which may be assumed to be widely known to consumers throughout the European Union. Secondly, as the Board of Appeal rightly found, part of the relevant public is not able to establish a link between that term and its equivalents in Hungarian, Italian and Spanish, namely ‘egészség’, ‘salute’ and ‘salud’ respectively. The same is true of the English word ‘healthy’, which is translated as ‘salutare’ in Italian, ‘egészséges’ in Hungarian and ‘saludable/sano’ in Spanish.

55 Furthermore, it must be pointed out that the Board of Appeal did not make any error of assessment in finding that, as regards the proficiency in English of the Hungarian, Italian and Spanish public, the ‘English Proficiency Index’, relied on by the applicant, had no objective statistical merit, since it was based on very limited data from a survey of persons who were willing to take a free English test online and of their own accord.

56 It follows that the Board of Appeal was right in finding that the English word ‘health’ had no meaning for the Hungarian, Italian, and Spanish public and that it was therefore not descriptive of the goods and services at issue.

– *The visual similarity*

57 The Board of Appeal found that the signs at issue were visually similar to a high degree on account of the coincidence, in the initial parts of those signs, of seven out of their nine letters, namely ‘healthi’, and that that coincidence concerned the only word element in the mark applied for and the most distinctive element of the earlier mark.

58 The applicant submits that the visual similarities are outweighed by the differences between the signs at issue, namely the suffix ‘ily’ in the mark applied for and the suffix ‘ies’ in the earlier mark and the figurative element of the earlier mark.

59 EUIPO disputes the applicant's arguments.

60 It must be stated at the outset that the signs at issue have the sequence of seven letters at the beginning of the word elements of those signs, namely 'h', 'e', 'a', 'l', 't', 'h', 'i', in common and that they differ in their respective endings, namely 'es' with regard to the earlier mark and 'ly' with regard to the mark applied for, in the presence of the figurative element in the earlier sign and in the stylisation of their fonts.

61 In the present case, must be pointed out, as observed by the Board of Appeal, that, where a trade mark consists of word and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more readily refer to the goods in question by citing the name of the mark than by describing the figurative element of that mark (judgment of 14 July 2005, *Wassen International v OHIM – Stroschein Gesundheitskost (SELENIUM-ACE)*, T-312/03, EU:T:2005:289, paragraph 37).

62 Accordingly, first, the Board of Appeal was right in finding that there was no element in the earlier mark which could be considered to be visually more striking, since both the element 'healthies' and the figurative element consisting of two stylised letters 'v' were distinctive. Secondly, the Board of Appeal was also right in finding that the element 'healthily' in the mark applied for was distinctive, in so far as the relevant public would not see in it a clear and direct meaning related to the goods and services at issue.

63 Consequently, in the present case, the Board of Appeal did not make any error of assessment in finding that there was a high degree of visual similarity between the signs at issue.

– *The phonetic similarity*

64 From a phonetic standpoint, the Board of Appeal found that, since consumers normally pay more attention to the initial part of marks, the coincidence in the sequence of the first seven letters of the word elements in the signs at issue was sufficient to establish a high degree of phonetic similarity between those signs.

65 The applicant submits that the signs at issue are short and have the descriptive and non-distinctive word element 'health' in common, which takes up most of the length of those signs. Consequently, according to the applicant, the use of different suffixes, namely 'ily' with regard to the mark applied for and 'ies' with regard to the earlier mark, creates a different phonetic perception of the signs at issue.

66 EUIPO disputes the applicant's arguments.

67 In the present case, it must first of all be stated, as has been held in paragraph 56 above, that the word element 'health', which is common to the signs at issue, is not descriptive of the goods and services at issue. Furthermore, as the Board of Appeal rightly found, the signs at issue coincide in the pronunciation of the first parts of those signs, namely 'healthi', and differ in the pronunciation of their endings, namely 'ly' with regard to the mark applied for and 'es' with regard to the earlier mark. Since those differences are minimal, it must be held, as the Board of Appeal found, that the signs at issue are phonetically similar to a high degree.

– *The conceptual similarity*

68 The Board of Appeal found that, from a conceptual standpoint, for at least a non-negligible part of the relevant public, the signs at issue did not convey any particular meaning and that a conceptual comparison between those signs could not therefore be carried out.

69 The applicant submits that the element ‘health’ is descriptive and that the relevant public will understand the meaning of that word in conjunction with the suffixes ‘ily’ and ‘ies’ intuitively rather than from a linguistic or scientific point of view. According to the applicant, the combination of those terms simply refers to goods or services that are related to health.

70 EUIPO disputes the applicant’s arguments.

71 It must be borne in mind that, according to the case-law, where neither of the signs at issue taken as a whole has any meaning, it must be held that a conceptual comparison is not possible (see, to that effect, judgments of 21 September 2017, *Novartis v EUIPO – MEDA (Zymara)*, T-214/15, not published, EU:T:2017:637, paragraph 149, and of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 96).

72 In the present case, it has been held in paragraphs 54 to 56 above that the word ‘health’ is not descriptive of the goods and services at issue. Consequently, as the Board of Appeal correctly found, it must be held that, for a non-negligible part of the relevant public, the signs at issue do not convey any particular meaning and that it is not possible to carry out a conceptual comparison of those signs.

The global assessment of the likelihood of confusion

73 The Board of Appeal found that there was a likelihood of confusion. First of all, it found that the relevant public consisted of the general public and of the specialist public in the medical sector and that the level of attention varied from average to high. Next, it found that the goods in Classes 3, 5 and 10 covered by the mark applied for were either at least similar to a low degree or similar to the goods and services covered by the earlier mark. Lastly, it found that the signs at issue were visually and phonetically similar to a high degree, that it was not possible to carry out a conceptual comparison between those signs and that the inherent distinctiveness of the earlier mark was average in degree.

74 The applicant submits that the level of attention of the relevant public in the present case is high. It argues that, thus, for a likelihood of confusion to be found to exist, it is not sufficient for just any degree of similarity between the signs at issue to be demonstrated but that, on the contrary, the degree of similarity has to be such that the relevant public might consider that the goods and services at issue come from the same undertaking or from economically linked undertakings.

75 It therefore submits that the mere fact that the marks at issue coincide in the part which their word elements have in common, namely ‘health’, is insufficient to constitute an indication of the existence of a likelihood of confusion. It adds that that similarity is outweighed by the different suffixes in the signs at issue, which are clearly perceptible on account of the limited length of those signs and the high level of attention of the relevant public.

76 EUIPO disputes the applicant's arguments.

77 A global assessment of the likelihood of confusion implies some interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and that of the goods or services covered. Accordingly, a low degree of similarity between those goods or services may be offset by a high degree of similarity between the marks, and vice versa (judgments of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442, paragraph 17, and of 14 December 2006, *VENADO with frame and others*, T-81/03, T-82/03 and T-103/03, EU:T:2006:397, paragraph 74).

78 It follows from the considerations which have already been set out in paragraphs 31 to 57 above that, first of all, as regards the goods in Class 3, the general public displays at least an average level of attention. Furthermore, as regards the goods in Class 5, the level of attention of the relevant public, which consists of professionals and of the general public, is high with regard to the former and higher than average with regard to the latter. Lastly, as regards the goods in Class 10, those goods are aimed only at a public of professionals, who display a high level of attention. It has also been held, as regards the similarity of the goods and services at issue, that the goods in Classes 3 and 5 covered by the mark applied for must be held to be at least similar to a low degree to the 'pharmaceuticals' in Class 5 or to the 'hygienic and beauty care' in Class 44 covered by the earlier mark and that the goods in Class 10 covered by the mark applied for are similar to the 'pharmaceuticals' or to the 'medical services' covered by the earlier mark. It has also been held that, contrary to what the applicant claims, the element 'health', which constitutes the beginning of the word elements of the signs at issue, has no meaning for the relevant public and is therefore not descriptive of the goods and services at issue and that, on the contrary, it has a normal degree of distinctiveness with regard to that public. Furthermore, there is a high degree of visual and phonetic similarity between the signs at issue and it is not possible to carry out a conceptual comparison between those signs. Lastly, the Board of Appeal did not make any error of assessment in finding that the reduced distinctive character of an element must be demonstrated by the actual use and peaceful coexistence of marks which have an element in common. Consequently, since the applicant has not proved the use of marks containing the element 'health', but merely their presence in the Register of EU trade marks, it has not shown that the element 'health' is weakly distinctive. Accordingly, and in the light of the case-law which has been referred to in paragraph 77 above, the Board of Appeal was fully entitled to find that there was a likelihood of confusion between the signs at issue with regard to the goods and services at issue.

79 It follows from all of the foregoing considerations that the Board of Appeal was right in dismissing the appeal brought by the applicant against the Opposition Division's decision on the basis of Article 8(1)(b) of Regulation 2017/1001, with the result that the first plea must be rejected.

The second plea, alleging infringement of the principles of the protection of legitimate expectations and legal certainty

80 In support of its second plea, the applicant submits that the Board of Appeal infringed the principles of the protection of legitimate expectations and legal certainty by departing from EUIPO's previous practice.

81 EUIPO disputes the applicant's arguments.

82 It must be borne in mind that the decisions concerning the registration of a sign as an EU trade mark which the Boards of Appeal of EUIPO take under Regulation 2017/1001 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of those decisions must be assessed solely on the basis of that regulation, as interpreted by the Courts of the European Union, and not on the basis of a previous decision-making practice (see, to that effect, judgment of 26 April 2007, *Alcon v OHIM*, C-412/05 P, EU:C:2007:252, paragraph 65).

83 According to settled case-law, in the light of the principles of equal treatment and of sound administration, although EUIPO must, when examining an application for registration of an EU trade mark, take into account the decisions already taken in respect of similar applications, the way in which those principles are applied must, however, be consistent with respect for legality. Consequently, in particular, for reasons of legal certainty and, more specifically, of sound administration, the examination of any trade mark application must be stringent and full and must be undertaken in each individual case, in order to prevent trade marks from being improperly registered (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraphs 74 to 77, and order of 11 September 2014, *Think Schuhwerk v OHIM*, C-521/13 P, EU:C:2014:2222, paragraph 57).

84 In the present case, as is apparent from the analysis set out in paragraphs 24 to 79 above, the Board of Appeal carried out a full and specific examination of the mark applied for and was fully entitled to find that that mark was caught by the ground for refusal laid down in Article 8(1)(b) of Regulation 2017/1001, with the result that the applicant cannot usefully rely, for the purposes of casting doubt on that conclusion, on previous decisions of EUIPO.

85 Furthermore, it must be pointed out that the right to rely on the principle of the protection of legitimate expectations extends to any person in a situation where it is apparent that the EU administration, inter alia, by giving him or her precise assurances, has caused him or her to entertain expectations which are justified (judgments of 22 June 2006, *Belgium and Forum 187 v Commission*, C-182/03 and C-217/03, EU:C:2006:416, paragraph 147, and of 25 October 2007, *Kominou and Others v Commission*, C-167/06 P, not published, EU:C:2007:633, paragraph 63).

86 Three conditions must be satisfied in order to claim entitlement to the protection of legitimate expectations. First, precise, unconditional and consistent assurances originating from authorised and reliable sources must have been given to the person concerned by the EU administration. Secondly, those assurances must be such as to give rise to a legitimate expectation on the part of the person to whom they are addressed. Thirdly, the assurances given must comply with the applicable rules (see judgment of 30 June 2005, *Branco v Commission*, T-347/03, EU:T:2005:265, paragraph 102 and the case-law cited).

87 In the present case, it must be stated that the applicant has not established that EUIPO had given it precise assurances as to how it would act in respect of the application for registration of the mark applied for.

88 In the light of all of the foregoing, the second plea must be rejected and, consequently, the action must be dismissed in its entirety.

Costs

89 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

90 Although the applicant has been unsuccessful, EUIPO has applied for the applicant to be ordered to pay the costs only in the event that a hearing is convened. Since no hearing has been arranged, it is appropriate to order each party to bear its own costs.

On those grounds,

THE GENERAL COURT (First Chamber)

hereby:

1. **Dismisses the action;**
2. **Orders Unilab LP and the European Union Intellectual Property Office (EUIPO) to bear their own respective costs.**

Spielmann

Mastroianni

Kalèda

Delivered in open court in Luxembourg on 17 April 2024.

V. Di Bucci

S. Papasavvas

Registrar

President

* Language of the case: English.