

***GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)***

***Part C***

***Opposition***

***Section 5***

***Trade marks with reputation (Article 8(5)  
EUTMR)***

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## 1 Introduction

### 1.1 Purpose of Article 8(5) EUTMR

Whereas, under Article 8(1)(a) EUTMR, double identity of signs and goods/services and, under Article 8(1)(b) EUTMR, a likelihood of confusion are the necessary preconditions for the protection of a registered trade mark, Article 8(5) EUTMR requires neither identity/similarity of goods/services nor a likelihood of confusion. Article 8(5) EUTMR grants protection for registered trade marks not only as regards identical/similar goods/services but also in relation to dissimilar goods/services without requiring any likelihood of confusion, provided the signs are identical or similar, the earlier mark enjoys a reputation, and the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

The rationale behind the extended protection under Article 8(5) EUTMR is the consideration that the function and value of a trade mark are not confined to its being an indicator of origin. A trade mark can also convey messages other than an indication of the origin of the goods and services, such as a promise or reassurance of quality or a certain image of, for example, luxury, lifestyle, exclusivity, etc. ('advertising function') (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378). Trade mark owners frequently invest large sums of money and effort in creating a certain brand image associated with their trade mark. This image associated with a trade mark confers on it an — often significant — economic value, which is independent of that of the goods and services for which it is registered.

Article 8(5) EUTMR aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided it can be demonstrated that use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. Consequently, the main focus of Article 8(5) EUTMR is not the protection of the general public against confusion as to origin, but rather the protection of the trade mark proprietor against use that takes unfair advantage of, or is detrimental to, the distinctive character or repute of a mark for which it has made significant investments.

### 1.2 Legal framework

According to **Article 8(5) EUTMR**, upon opposition by the proprietor of a registered earlier trade mark, within the meaning of paragraph 2, the trade mark applied for 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 EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The same wording is used in the parallel provision of **Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks ('TMD')**, namely **Article 5(3)(a) TMD**.

The wording of Article 8(5) EUTMR is also very similar to that used in **Article 9(2)(c) EUTMR** and **Article 10(2)(c) TMD**, that is, the provisions determining the exclusive rights of a trade mark proprietor, with only a slight difference in the way these refer to the condition of detriment. Unlike the conditional form in Article 8(5) EUTMR, which applies where use of the trade mark applied for 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark', Article 9(2)(c) EUTMR and Article 10(2)(c) TMD read 'takes unfair advantage of, or is detrimental to'. The reason for this difference is that in the first case — Article 8(5) EUTMR — registrability is at stake, which may have to be decided upon without any use of the later mark having been made, while in the second case the prohibition of use is at issue. The impact of this difference on the kind of evidence required for proving detriment in either case is discussed in paragraph 3.4 below.

## 2 Scope of Applicability

The previous wording of Article 8(5) EUTMR, which was applicable until 23/03/2016, gave rise to some controversy as regards its applicability exclusively to (a) earlier registered marks and (b) dissimilar goods and services. As these issues directly affected the scope of its application, it was necessary to clarify whether it was possible to also apply Article 8(5) EUTMR to (a) unregistered/well-known marks and (b) similar or identical goods and services.

### 2.1 Applicability to registered marks

#### 2.1.1 The requirement of registration

According to the clear wording of the current version of Article 8(5) EUTMR, as introduced by Amending Regulation (EU) 2015/2424, this norm protects a 'registered earlier trade mark'. Even if the requirement of registration was not expressly mentioned in the previous version of this provision, the Office interpreted it in this way, since according to its wording the applicability of the provision was restricted, indirectly but clearly, to **earlier registered trade marks** by prohibiting registration where [the

application] was identical or similar to the earlier trade mark and was to be registered for goods and services that were not similar to those for which the **earlier trade mark was registered**. It follows that the existence of an **earlier registration** has always been a **necessary condition** for the application of Article 8(5) EUTMR and that, as a consequence, the reference to Article 8(2) EUTMR should be limited to earlier registrations and earlier applications subject to their registration (11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 55).

#### 2.1.2 Relationship between marks with reputation (Article 8(5) EUTMR) and well-known marks (Article 8(2)(c) EUTMR)

The requirement of **registration** serves to mark the border between Article 8(5) EUTMR and Article 8(2)(c) EUTMR. However, neither Article 8(2)(c) EUTMR nor Article 6*bis* of the Paris Convention stipulate expressly that the well-known mark has to be a non-registered mark. The reason for the principle that only non-registered marks are covered by these latter provisions results indirectly both from the spirit and the *ratio legis* of these provisions.

As regards the Paris Convention, the purpose of the provision of Article 6*bis*, introduced for the first time in the Convention in 1925, was to prevent the registration and use of a trade mark liable to create confusion with another mark already well known in the country of such registration, even where the latter well-known mark was not, or not yet, protected in that country by registration.

As regards the EUTMR, the purpose was to close a legal gap as Article 8(5) EUTMR protects only registered EUTMs. Without Article 8(2)(c) EUTMR, reputed non-registered trade marks would have remained without protection (apart from that of Article 8(4) EUTMR). In order to close this legal gap, the EUTMR provided for the protection of well-known marks within the sense of Article 6*bis* of the Paris Convention, as this Article had been drawn up mainly to afford protection to non-registered trade marks with a well-known character.

Consequently, on the one hand, **well-known marks** that are **not registered** in the relevant territory cannot be protected under Article 8(5) EUTMR against dissimilar goods. They can only be protected against **identical or similar goods** if there is a likelihood of confusion pursuant to Article 8(1)(b) EUTMR, to which Article 8(2)(c) EUTMR refers for determining the scope of protection. However, this is without prejudice to the fact that well-known marks, to the extent that they are not registered, may also be protected under Article 8(4) EUTMR. Therefore, if the relevant national law affords them protection against dissimilar goods and services, such enhanced protection may also be invoked under Article 8(4) EUTMR.

On the other hand, where well-known marks have been **registered**, either as EUTMs, or as national marks in one of the Member States, they **can be invoked under Article 8(5) EUTMR**, but only if they also **fulfil the requirements of reputation**.

Even though the terms 'well known' (a traditional term used in Article 6*bis* of the Paris Convention) and 'reputation' denote distinct legal concepts, there is a **substantial overlap** between them, as shown by a comparison of how well-known marks are

defined in the WIPO Joint Recommendation Concerning Provision on the Protection of Well-Known Marks with how reputation was described by the Court of Justice in its judgment of 14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 22 (concluding that the different terminology is merely a ‘... nuance, which does not entail any real contradiction ...’).

In practical terms, the threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same. Therefore, it will not be unusual for a mark that has acquired well-known character to have also reached the threshold laid down by the Court in *Chevy* (*General Motors*) for marks with reputation, given that in both cases the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public, and that the thresholds required for each case are expressed in quite similar terms (‘known ...’ or ‘well known in at least one relevant sector of the public’<sup>64</sup>) for well-known marks, and ‘known by a significant part of the public concerned’ for marks with reputation).

This has also been confirmed by case-law. In its judgment of 22/11/2007, C-328/06, *Fincas Tarragona*, EU:C:2007:704, the Court qualified the notions of ‘reputation’ and ‘well known’ as kindred concepts, underlining in this way the substantial overlap and relationship between them (para. 17). See also the judgment of 11/07/2007, T-150/04, *Tosca Blu*, EU:T:2007:214, § 56-57.

The overlap between marks with reputation and registered well-known marks has repercussions when grounds of opposition are raised, in the sense that it should not matter for the applicability of Article 8(5) EUTMR if the opponent calls its earlier registration a well-known mark instead of a mark with reputation. For this reason, the terminology used must be carefully scrutinised, especially where the grounds of the opposition are not clearly explained, and a flexible approach should be taken where appropriate.

In the context of Article 8(2)(c) EUTMR, the requirements for applying Article 6*bis* of the Paris Convention and Article 8(1)(a) or (b) EUTMR are the same, although the terminology used is different. Both provisions require similarity or identity between the goods or services, and similar or identical signs (Article 6*bis* uses the terms ‘reproduction’, which is equivalent to identity, and ‘imitation’, which refers to similarity). Both Articles also require a likelihood of confusion (‘liable to create confusion’ is the phrase used in Article 6*bis*). However, while, according to Article 8(2)(c) EUTMR, a well-known mark can serve as an earlier right and, thus, as the **basis** of an opposition, the **grounds** for an opposition under Article 8(2)(c) EUTMR are (solely) Article 8(1)(a) or (b) EUTMR.

For example, if the opponent bases the opposition on (i) an earlier registration invoking Article 8(1)(b) EUTMR and Article 8(5) EUTMR and (ii) an identical earlier well-known mark in the same territory under Article 8(2)(c) EUTMR, the earlier right must be examined:

<sup>64</sup> () Article 2(2)(b) and 2(2)(c) of the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

1. under Article 8(1)(b) EUTMR as an earlier **registration** with enhanced distinctiveness (in view of its well-known character);
2. under Article 8(5) EUTMR, as an earlier **registration** with reputation;
3. under Article 8(2)(c) EUTMR in conjunction with Article 8(1)(b) EUTMR as an earlier **non-registered well-known mark** (which will only be useful if registration is not proven, as otherwise the outcome is the same as in bullet point 1. above).

Even if the opponent has not expressly based its opposition on Article 8(5) EUTMR, the contents of the notice and the wording of the explanation of grounds must be carefully analysed with a view to objectively establishing whether the opponent also wants to rely on Article 8(5) EUTMR.

## 2.2 Applicability to similar and identical goods and services

According to the clear wording of the current version of Article 8(5) EUTMR, the protection provided by this provision is ‘irrespective of whether the goods or services for which [the later mark] is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered’. This is a codification of the case-law<sup>(65)</sup> of the Court of Justice, interpreting the previous version of the provision.

## 3 Conditions of Application

The following conditions need be met for Article 8(5) EUTMR to apply (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, confirmed 10/05/2012, C-100/11 P, Botolist / Botocyl, EU:C:2012:285):

1. earlier **registered mark with reputation** in the relevant territory;
2. **identity or similarity** between the contested EUTM application and the earlier mark;
3. use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark;
4. such use must be **without due cause**.

These conditions are **cumulative** and failure to satisfy any one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 30; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 34; 16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41).

The order in which these requirements are examined may vary depending on the circumstances of each case. For instance, the examination may start by assessing the similarities between the signs, especially where there is little or nothing to say on the subject, either because the marks are identical or because they are patently similar or dissimilar.

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<sup>65</sup> () Judgment of 09/01/2003, C-292/00, Davidoff, EU:C:2003:9.



### 3.1 Earlier mark with reputation

#### 3.1.1 Nature of reputation

The nature and scope of reputation are not defined by either the EUTMR or the TMD. Furthermore, the terms used in the different language versions of these texts are not fully equivalent, which has led to considerable confusion as to the true meaning of the term 'reputation', as admitted by Advocate General Jacobs in his opinion of 26/11/1998, C-375/97, *Chevy*, EU:C:1998:575, § 34-36.

Given the lack of statutory definition, the Court defined the nature of reputation by reference to the purpose of the relevant provisions. In interpreting Article 5(2) TMD, the Court held that the text of the TMD 'implies a **certain degree of knowledge of the earlier trade mark** among the public' and explained that it 'is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks ... and that the earlier mark may consequently be damaged' (14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 23).

In view of these considerations, the Court concluded that reputation is a **knowledge threshold requirement**, implying that it must be principally assessed on the basis of **quantitative** criteria. In order to satisfy the requirement of reputation, the earlier mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark (14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 22-23; 25/05/2005, T-67/04, *Spa-Finders*, EU:T:2005:179, § 34).

Moreover, if reputation is to be assessed on the basis of quantitative criteria, arguments or evidence relating to the esteem in which the public might hold the mark, rather than to its recognition, are not directly relevant for establishing that the earlier mark has acquired sufficient reputation for the purposes of Article 8(5) EUTMR. However, as the economic value of reputation is also the protected subject-matter of this provision, any **qualitative aspects** thereof are relevant when assessing the possibility of detriment or unfair advantage (see also paragraph 3.4 below). Article 8(5) EUTMR protects 'famous' marks not as such, but rather for the success and renown ('goodwill') they have acquired in the market. A sign does not enjoy any reputation inherently, for example, simply because it refers to a renowned person or event, but only for the goods and services it designates and the use that has been made of it.

Case No	Comment
22/07/2010, R 11/2008-4, CASAS DE FERNANDO ALONSO (fig.) / FERNANDO ALONSO	All the evidence submitted by the opponent related to the fame of Fernando Alonso as a champion racing driver and to the use of his image by different undertakings to promote their goods and services. There was no proof of reputation for use of the earlier mark as registered for the relevant goods and services (paras 44 and 48).
03/03/2011, R 201/2010-2, BALMAIN ASSET MANAGEMENT / BALMAIN (fig.)	The only items of evidence regarding reputation of the earlier mark submitted within the time limit, namely a page showing websites containing the word 'BALMAIN', a Wikipedia extract about the French designer Pierre Balmain, and five extracts from the website www.style.com referring to the 'BALMAIN' wear collection, were clearly not sufficient to establish the reputation of the earlier mark in the EU. Therefore, the opposition was rejected as unsubstantiated (paras 36 and 37).

### 3.1.2 Scope of reputation

#### 3.1.2.1 Degree of recognition

Having defined reputation as a knowledge threshold requirement, the question that necessarily follows is **how much awareness** the earlier mark must attain among the public in order to pass this threshold. The Court held in this respect that the 'degree of knowledge required must be considered to be reached when the earlier trade mark is **known by a significant part** of the public' and added that it 'cannot be inferred from either the letter or the spirit of Article 5(2) [TMD] that the trade mark must be known by a given percentage of the public' (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 25-26; 16/11/2011, T-500/10, Doorsa, EU:T:2011:679, § 45).

By refraining from defining in more detail the meaning of the term 'significant' and by stating that the trade mark does not have to be known by a given percentage of the public, the Court in substance advised **against the use of fixed criteria** of general applicability, since a predetermined degree of recognition may not be appropriate for a realistic assessment of reputation if taken alone.

Hence, in determining whether the earlier mark is known by a significant part of the public, account must be taken not only of the degree of awareness of the mark, but also of **any other factor** relevant to the specific case. For more about the relevant factors and their interplay, see paragraph 3.1.3 below.

However, where goods or services concern quite **small groups of consumers**, the limited overall size of the market means that a significant part thereof is also restricted in absolute numbers. Hence, the limited size of the relevant market should not be regarded in itself as a factor capable of preventing a mark from acquiring a reputation within the meaning of Article 8(5) EUTMR, as reputation is more a question of proportions and less of absolute numbers.

The need for the earlier mark to be known by a significant part of the public also serves to mark the difference between the notions of **reputation** as a necessary condition for the application of Article 8(5) EUTMR and **enhanced distinctiveness through use** as a factor for evaluating likelihood of confusion for the purposes of Article 8(1)(b) EUTMR.

Even though both terms are concerned with the recognition of the mark among the relevant public, in the case of **reputation** a **threshold** exists below which extended protection cannot be granted, whereas in the case of **enhanced distinctiveness** there is **no threshold**. It follows that in the latter case any indication of enhanced recognition of the mark should be taken into account and evaluated according to its significance, regardless of whether it reaches the limit required by Article 8(5) EUTMR. Therefore, a finding of 'enhanced distinctiveness' under Article 8(1)(b) EUTMR will not necessarily be conclusive for the purposes of Article 8(5) EUTMR.

Case No	Comment
21/04/2010, R 1054/2007-4, MANDARINO (fig.) / MANDARINA DUCK (fig.)	The documents submitted by the opponent showed promotional efforts in such a way that the distinctiveness was increased through use. However, the use was not enough to reach the threshold of reputation. None of the documents referred to the recognition of the earlier trade mark by the relevant end consumers; nor was any evidence submitted about the market share of the opponent's goods (para. 61).

### 3.1.2.2 Relevant public

In defining the kind of public that should be taken into account for assessing reputation, the Court held that the 'public amongst which the earlier trade mark must have acquired a reputation is **that [public] concerned by that trade mark**, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector' (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 24; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 34, 41).

Hence, if the goods and services covered by the mark are **mass consumption** products, the relevant public will be the **public at large**, whereas if the designated

goods have a very **specific application** or exclusively target **professional or industrial users**, the relevant public will be limited to the **specific purchasers** of the products in question.

Case No	Comment
04/08/2011, R 1265/2010-2, MATTONI (fig.) / MATTONI	Taking into account the nature of the goods for which the opponent claims reputation, namely <i>mineral water</i> , the relevant public is the public at large (para. 44).
15/09/2011, R 2100/2010-1, SEXIALIS / CIALIS et al.	The goods for which the sign enjoys reputation are <i>medicinal preparations for the treatment of sexual dysfunction</i> . The relevant public is the general public and professionals with a high level of attention (para. 64).
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl; confirmed 10/05/2012, C-100/11 P, Botolist / Botocyl	The goods for which the earlier mark enjoys reputation are <i>pharmaceutical preparations for the treatment of wrinkles</i> . The evidence of the promotion of the earlier mark 'BOTOX' in English in the scientific and general-interest press was sufficient to establish the mark's reputation amongst both the general public and health-care professionals (C-100/11 P, paras 65 to 67). Therefore, both these categories of consumers have to be taken into account.

In addition to the actual buyers of the relevant goods, the notion of the relevant public extends to the **potential purchasers** thereof, as well as to those members of the public that only come **indirectly into contact** with the mark, to the extent that such consumer groups are also targeted by the goods in question, for instance, sports fans in relation to athletic gear, or frequent air-travellers as regards air carriers, etc.

Case No	Comment
10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	The relevant services are stock exchange price quotation services in Classes 35 and 36, which normally target professionals. The opponent submitted evidence showing that the mark 'NASDAQ' appears almost daily in many <b>newspapers</b> and on many <b>television channels</b> that can be read/viewed throughout Europe. Therefore, the Board was right to hold that the reputation of the trade mark 'NASDAQ' had to be determined for European consumers not only among the professional public, but also in an important subsection of the general public (paras 47 and 51).
06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348	The evidence submitted in respect of reputation supports and reinforces the fact that the relevant public for <i>theatre productions</i> is the public at large and not a limited and exclusive circle. The intervener's activities were advertised, presented and commented on in numerous newspapers targeting the public at large. The intervener toured different regions throughout the United Kingdom and performed before a wide public in the United Kingdom. An activity on a large scale and, hence, a service offered to the public at large, is reflected both in the high turnover and the high box-office sales. Furthermore, it is clear from the documents submitted by the intervener that the intervener received substantial annual sponsorship income from undertakings in diverse sectors that also reach the public at large, such as banks, undertakings in the alcoholic drinks sector and car manufacturers (paras 35 and 36).

Quite often, a given product will concern **various purchaser groups** with different profiles, as in the case of multipurpose goods or goods that are handled by several intermediaries before they reach their final destination (distributors, retailers, end-users). In such cases the question arises whether reputation has to be assessed within each separate group or if it should cover all the different types of purchaser. The example given by the Court in its judgment of 14/09/1999, C-375/97, Chevy, EU:C:1999:408 (traders in a specific sector) implies that reputation within one single group may suffice.

Likewise, if the earlier trade mark is registered for quite **heterogeneous goods/** services, different segments of the public may be concerned by each type of good/ service, and, therefore, the overall reputation of the mark will have to be assessed separately for each category of goods involved.

The foregoing only deals with the kind of public to be taken into account when assessing whether the earlier mark has reached the threshold of reputation laid down by the Court in *Chevy (General Motors)*. However, a relevant question arises when assessing detriment or unfair advantage, namely whether the earlier mark must also be known to the public concerned by the goods and services of the later mark, since otherwise it is difficult to see how the public will be in a position to associate the two. This issue is discussed in paragraph 3.4 below.

### 3.1.2.3 Goods and services covered

The goods and services must first of all be those for which the earlier trade mark is registered and for which reputation is claimed.

Case No	Comment
28/04/2011, R 1473/2010-1, SÜEDTIROL / SÜDTIROL (fig.) et al.	The opposition was dismissed since the earlier marks were not registered for the services that, according to the opponent, enjoy a reputation. Article 8(5) EUTMR can only be invoked if the trade mark affirmed to be well known/renowned is a registered trade mark and if the goods/services for which this reputation/renown is claimed appear on the certificate (para. 49).

The goods and services to which the evidence refers have to be identical (not only similar) to the goods and services for which the earlier trade mark is registered.

Case No	Comment
09/11/2010, R 1033/2009-4, PEPE / bebe	The goods that were assessed to be reputed in Germany by the decision and order referred to only concern articles of skin and body care and children's cream. These articles are not identical to the earlier mark's goods in Class 3, <i>make-up products; nail treating products; namely nail lacquer and remover</i> . Therefore, the opponent did not prove reputation for the earlier German mark in the relevant territories (para. 31).

Where the earlier mark is registered for a wide range of goods and services targeting different kinds of public, it will be necessary to assess reputation separately for each category of goods. In such cases the earlier mark may not have a reputation for all of them, as it may not have been used at all for some of the goods, whereas for others it may not have reached the degree of knowledge necessary for the application of Article 8(5) EUTMR.

Hence, if the evidence shows that the earlier mark enjoys a **partial reputation**, that is, the reputation only covers some of the goods or services for which it is registered, it is only to that extent that this mark may be protected under Article 8(5) EUTMR. Consequently, it is **only these goods** that may be taken into account for the purposes of the examination.

Case No	Comment
14/06/2011, R 1588/2009-4, PINEAPPLE / APPLE	The Board concluded that the enhanced distinctiveness and reputation of the earlier marks did not concern the opponent's G&S, which were considered to be identical or similar to the contested G&S. For these G&S no enhanced distinctiveness or reputation was proven, with the exception of <i>computer software</i> in Class 9 (para. 43).
10/12/2009, R 1466/2008-2 & R 1565/2008-2, COMMERZBANK ARENA / ARENA et al.	The evidence submitted sufficiently demonstrated that the 'ARENA' brand was known by a significant part of the relevant public. However, the evidence did not include any relevant information that could allow the level of brand awareness of the 'ARENA' brand in sectors other than <i>swimwear and swimming articles</i> to be determined (paras 58 and 60).

#### 3.1.2.4 Relevant territory

According to Article 8(5) EUTMR, the **relevant territory** for establishing the reputation of the earlier mark is the territory of protection: the earlier mark must **have a reputation in the territory where it is registered**. Therefore, for national marks the relevant territory is the Member State concerned, whereas for EUTMs the relevant territory is the European Union.

In *Chevy (General Motors)*, the Court stated that a national trade mark cannot be required to have a reputation throughout the entire territory of the Member State concerned. It is sufficient if reputation exists in a substantial part of that territory. For the Benelux territory in particular, the Court held that a substantial part thereof may consist

of part of one of the Benelux countries (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 28-29).

The Court has clarified that, for an earlier European Union trade mark, reputation throughout the territory of a single Member State may suffice.

Case No	Comment
06/10/2009, C-301/07, Pago, EU:C:2009:611	The case concerned a European Union trade mark with a reputation throughout Austria. The Court indicated that a European Union trade mark must be known in a substantial part of the EU by a significant part of the public concerned by the goods or services covered by that trade mark. In view of the facts of the particular case, the territory of the Member State in question (Austria) was considered to constitute a substantial part of the territory of the EU (paras 29 and 30).

In general, however, when evaluating whether the part of the territory in question is a substantial one, account must be taken both of the size of the geographical area concerned and of the proportion of the overall population living there, since both these criteria may affect the overall significance of the specific territory.

Case No	Comment
21/08/2009, R 1283/2006-4, RANCHO PANCHO (fig.) / EL RANCHO	Although the evidence submitted showed use of the mark in 17 restaurants in France in 2002, this figure was considered rather low for a country of 65 million inhabitants. Therefore, the reputation was not proven (para. 22).

Opponents often indicate in the notice of opposition that the earlier mark has a reputation in an area that extends beyond the territory of protection (e.g. a pan-European reputation is alleged for a national mark). In such a case the opponent's claim must be examined for the territory of protection only.

Similarly, the **evidence submitted must specifically concern the relevant territory**. For example, if the evidence relates to Japan, or to undefined regions, it will not be able to prove reputation in the EU or in a Member State. Therefore, figures concerning sales in the EU as a whole, or worldwide sales, are not appropriate for showing reputation in a specific Member State, if the relevant data are not broken down by territory. In other words, a 'wider' reputation must also be specifically proven for the relevant territory if it is to be taken into account.



Case No	Comment
22/03/2011, R 1718/2008-1, LINGLONG / LL (fig.) et al.	Most of the documents submitted related to countries outside the European Union, mainly China, the opponent's home country, and other Asian countries. Consequently, the opponent cannot successfully claim to hold a well-known mark in the EU (para. 53).
14/06/2010, R 1795/2008-4, ZAPPER-CLICK, (appeal dismissed in 03/10/2012, T-360/10, ZAPPER-CLICK, EU:T:2012:517)	The respondent maintained in the notice of cancellation that reputation was claimed for the territory of the UK. However, the international registration only designated Spain, France and Portugal and, therefore, did not extend to the territory of the UK. In addition, the respondent did not file any evidence of a reputation in the Member States designated by the international registration (para. 45).

However, where reputation is claimed as extending beyond the territory of protection and there is evidence to this effect, this must be taken into account because it may reinforce the finding of reputation in the territory of protection.

#### 3.1.2.5 Relevant point in time

The opponent must show that the earlier mark had acquired a reputation by the **filing date** of the contested EUTM application, taking account, where appropriate, of any **priority** claimed, on condition of course that the priority claim has been accepted by the Office.

In addition, the reputation of the earlier mark must subsist until the decision on the opposition is taken. However, in principle it will be sufficient for the opponent to show that its mark already had a reputation on the filing/priority date of the EUTM application, while any subsequent **loss of reputation** is for the applicant to claim and prove. In practice, such an occurrence will be rather exceptional, since it presupposes a dramatic change of market conditions over a relatively short period of time.

Where the opposition is based on an **earlier application**, there is no formal obstacle for the application of Article 8(5) EUTMR, which encompasses earlier applications by reference to Article 8(2) EUTMR. Although, in most cases, the earlier application will not have acquired sufficient reputation in so short a time, it cannot be *a priori* excluded that a sufficient degree of reputation may be achieved in an exceptionally short period. In addition, the application may be for a mark that was already in use long before the application was filed and has therefore had sufficient time to acquire a reputation. In any event, as the effects of registration are retroactive, the applicability of Article 8(5) EUTMR to earlier applications cannot be regarded as a deviation from the rule that

Article 8(5) EUTMR only applies to earlier registrations, as concluded in paragraph 2.1 above.

In general, the **closer to the relevant date** the evidence is, the **easier** it will be to assume that the earlier mark had **acquired reputation** at that time. The evidential value of a particular document is likely to vary depending on how close the period covered is to the filing date. Evidence of reputation with regard to a later point in time than the relevant date might nevertheless allow conclusions to be drawn as to the earlier mark's reputation at the relevant date (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 31; 17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 53; 15/12/2005, T-262/04, Briquet à Pierre, EU:T:2005:463, § 82).

For this reason, the materials submitted with a view to proving reputation must be dated, or at least **clearly indicate when** the facts attested therein took place. Consequently, undated documents, or documents bearing a date added afterwards (e.g. hand-written dates on printed documents), are not appropriate for giving reliable information about the material time.

Case No	Comment
15/03/2010, R 55/2009-2, BRAVIA / BRAVIA	The evidence showed that the mark 'BRAVIA/ BRAVIA' was used for LCD televisions in Austria, the Czech Republic, France, Germany, Hungary, Italy, the Netherlands, Poland, Portugal, Slovakia and Turkey. However, none of the documents were dated. The opponent failed to submit any information regarding duration. Therefore, the evidence, taken as whole, was insufficient to prove reputation in the European Union (paras 27 and 28).
09/11/2010, R 1033/2009-4, PEPE / bebe	In the Board's view, a judgment from 1972 was not able to prove enhanced distinctiveness at the time of filing the mark, that is, 20/10/2006. Furthermore, 'it follows from the decision of the [Court] [21/04/2005, T-164/03, monBeBé, EU:T:2005:140] that the reputation of the earlier mark has been assessed as from 13 June 1996, i.e. more than ten years before the reputation date to be taken into consideration' (para. 31).

If the **period** between the latest evidence of use and the filing of the EUTM application is quite **significant**, the relevance of the evidence should be carefully assessed by reference to the kind of goods and services concerned. This is because changes in consumer habits and perceptions may take some time to happen, usually depending on the particular market involved.

For instance, the clothing market is strongly tied to yearly seasons and to the different collections presented every quarter. This will have to be taken into account in assessing a possible loss of reputation in this particular field. Likewise, the market for internet providers and e-commerce companies is very competitive and undergoes rapid growth, as well as rapid demise, which means that reputation in this area may be diluted faster than in other market sectors.

Case No	Comment
17/12/2010, R 883/2009-4, MUSTANG / MUSTANG CALZADOS (fig.)	The appellant failed to prove that its earlier mark was already well known on the application date of the contested mark. The certificates regarding the reputation of the 'Mustang designation' refer neither to the 'Calzados Mustang' figurative mark asserted by the applicant nor to the time when reputation must be determined (para. 28).

A similar question arises in the case of **evidence that post-dates the filing date** of the EUTM application. Even though such evidence will not usually be sufficient on its own to prove that the mark had acquired a reputation when the EUTM was filed, it is not appropriate to reject it as irrelevant either. Given that reputation is usually built up over a period of years and cannot simply be switched on and off, and that certain kinds of evidence (e.g. opinion polls, affidavits) are not necessarily available before the relevant date, as they are usually prepared only after the dispute arises, such evidence must be evaluated on the basis of its contents **and in conjunction with the rest of the evidence**. For example, an opinion poll conducted after the material time but showing a sufficiently high degree of recognition might be sufficient to prove that the mark had acquired a reputation on the relevant date if it is also shown that the market conditions have not changed (e.g. the same levels of sales and advertising expenditure were maintained before the opinion poll was carried out).

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P, EU:C:2012:285	Although the reputation of an earlier mark must be established at the filing date of the contested mark, documents bearing a later date cannot be denied evidential value if they enable conclusions to be drawn with regard to the situation as it was on that date (para. 52).

The possibility cannot automatically be ruled out that a document drawn up some time before or after that date may contain useful information in view of the fact that the reputation of a trade mark is, in general, acquired progressively. The evidential value of such a document is likely to vary depending on how close the period covered is to the


filing date (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 31; 17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 53; 15/12/2005, T-262/04, Briquet à Pierre, EU:T:2005:463, § 82).

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed by 10/05/2012, C-100/11 P	The press articles submitted proved that there was significant media coverage of the products marketed under the trade mark BOTOX on the filing date of the disputed marks (para. 53).


### 3.1.2.6 Reputation acquired as part of another mark


Reputation proven for a complex sign refers to that sign as such and not a particular element alone. As an example, the reputation acquired by a figurative mark may, but will not automatically, benefit a word mark with which it is subsequently used.

To establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play therein 'a predominant or even significant role' (21/05/2005, T-55/13, F1H20 / F1 et al., EU:T:2015:309 § 47). When the earlier mark has been used as part of another mark, it is incumbent on the opponent to prove that the earlier mark has independently acquired a reputation (12/02/2015, T-505/12, B, EU:T:2015:95, § 121). The examples below give guidance.

Case No	Comment
17/03/2015, T-611/11, Manea Spa, EU:T:2015:152 (Relevant Classes 3, 24, 25, 43 and 44)	<p>The word mark 'Spa' was used as part of another registration combining the word element with the logo of a pantomime character, as reproduced here</p>  <p>. The word element occupies a central position in the complex sign, and therefore plays a 'distinct and predominant' role.</p>

Case No	Comment
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<p>17/02/2011, T-10/09, F1-Live, EU:T:2011:45; 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314 (Relevant Classes 16, 38 and 41) and 21/05/2005, T-55/13, F1H20 / F1 et al., EU:T:2015:309 (Relevant Classes 9, 25, 38 and 41)</p>	<p>On the other hand, in case T-10/09 it was held that the evidence of reputation referred to the earlier figurative mark 'F1 Formula 1'</p>  <p>and not to the earlier word marks, 'F1'. Without its particular logotype the text 'Formula 1' and its abbreviation 'F1' are perceived as descriptive elements for a category of racing cars or races involving those cars. The reputation was not proven for the word marks (see paras 53, 54 and 67).</p> <p>In case T-55/13, the Court held that the reputation with which the complex sign 'F1' is associated did not benefit the word element alone, which does not play a 'predominant or even significant' role in the earlier figurative mark (see para. 47).</p>
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Case No	Comment
<p>12/02/2015, T-76/13, QUARTODIMIGLIO QM, EU:T:2015:94</p>	<p>The same conclusion applies to a 'winged hourglass' figurative element used in a complex mark in association with the word 'Longines'</p>  <p>. The figurative element remains clearly ancillary and in the background in the overall impression conveyed by the complex mark (paras 104 to 106). The Court found that the opponent had failed to submit opinion polls showing the recognition of the 'winged hourglass' logo independently of the word element, and the use of this figurative element alone in a limited number of documents was found insufficient from both a quantitative and qualitative point of view (paras 91 to 93 and para. 112).</p>

### 3.1.3 Assessment of reputation — relevant factors

Apart from indicating that '[i]t cannot be inferred from either the letter or the spirit of Article 5(2) of the [TMD] that the trade mark must be known by a **given percentage** of the public', the Court also held that **all the relevant facts** must be considered when

assessing the reputation of the earlier mark, ‘**in particular the market share** held by the trade mark, the **intensity, geographical extent** and **duration** of its use, and the **size of investment** made by the undertaking in promoting it’ (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 25, 27).

If these two statements are taken together, it follows that the level of knowledge required for the purposes of Article 8(5) EUTMR cannot be defined in the abstract, but should be evaluated on a **case-by-case** basis, taking into account **not only the degree of awareness of the mark, but also any other fact relevant to the specific case**, that is, any factor capable of giving information about the performance of the mark in the market.

The list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark (such as the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the amount spent by the undertaking in promoting it) only serve as examples. The conclusion that the mark enjoys reputation does not necessarily have to be reached on the basis of indications regarding all those factors.

Case No	Comment
10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	<p>The opponent provided detailed evidence relating to the intensity, geographical extent and duration of use of its trade mark, Nasdaq, as well as to the amount spent in promoting it, demonstrating that it was known by a significant part of the relevant public. The Court considered that the fact that it did not produce figures regarding market share did not call this finding into question (para. 51).</p> <p>The Court concluded that, first, the factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the intervener is already sufficient in itself to conclusively prove the reputation of its mark, Nasdaq (para. 52).</p>

Moreover, the relevant factors should be assessed with a view not only to establishing the degree of recognition of the mark amongst the relevant public, but also to ascertaining whether the **other requirements** related to reputation are fulfilled, for example, whether the alleged reputation covers a significant part of the territory concerned or whether the reputation had indeed been acquired by the filing/priority date of the contested EUTM application.

The same kind of test is applied to ascertain whether the trade mark has acquired **enhanced distinctiveness** through use for the purposes of Article 8(1)(b) EUTMR, or whether the mark is **well known** within the meaning of Article 6*bis* of the Paris Convention, since what has to be proven in all these cases is in substance the same, namely the degree to which the mark is known by the relevant public, without prejudice to the threshold required in each case.

### 3.1.3.1 Trade mark awareness

The statement of the Court that it is not necessary for the mark to be 'known by a given percentage of the public', cannot be taken in itself as meaning that figures of trade mark awareness are irrelevant, or should be given a lower probative value, when assessing reputation. It only implies that percentages of awareness defined in the abstract may not be appropriate for all cases and that, consequently, it is **not possible to fix a priori a generally applicable threshold of recognition** beyond which it should be assumed that the mark is reputed (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 24; 16/11/2011, T-500/10, Doorsa, EU:T:2011:679, § 52).

Therefore, even though not expressly listed by the Court among the factors to be taken into account for assessing reputation, the **degree of recognition** of the mark amongst the relevant public is **directly relevant** and can be particularly helpful in evaluating whether the mark is sufficiently known for the purposes of Article 8(5) EUTMR, provided of course that the method of its calculation is reliable.

As a rule, the **higher the percentage** of trade mark awareness, the **easier** it will be to accept that the **mark has a reputation**. However, in the absence of a clear threshold, only if the evidence shows a **high degree** of trade mark awareness, will percentages of recognition be **persuasive**. Percentages alone are not conclusive. Rather, as explained before, reputation has to be evaluated by making an overall assessment of all the factors relevant to the case. The higher the degree of awareness, the less additional evidence may be required to prove reputation and vice versa.

Case No	Comment
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<p>24/02/2010, R 765/2009-1, Bob the Builder (fig.) / BOB et al.</p>	<p>The evidence submitted proved that the earlier mark enjoyed a very significant reputation in Sweden for <i>jellies, jams, fruit stews, fruit drinks, concentrates for production of drinks and juice</i>. According to the survey conducted by TNS Gallup, spontaneous awareness (answers by telephone to the question 'What brands for — 'the relevant group of products is mentioned' — have you heard about or do you know about?') of the trade mark 'BOB' varied between 25 % and 71 %, depending on the goods: <i>apple sauces, jams, marmalades, soft drinks, fruit drinks and fruit juices</i>. Supported awareness (answers to a questionnaire showing the products bearing the mark) varied between 49 % and 90 %, depending on the goods. Furthermore, the market share for 2001 to 2006 averaged 30-35 % in the above product groups (para. 34).</p>
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Where the evidence shows that the mark only enjoys a **lesser degree of recognition**, it should not automatically be assumed that the mark is reputed; this means that, most of the time, **mere percentages will not be conclusive** in themselves. In such cases, only if evidence of awareness is coupled with sufficient indications of the overall performance of the mark in the market will it be possible to evaluate with a reasonable degree of certainty whether the mark is known by a significant part of the relevant public.

### 3.1.3.2 Market share

The **market share** enjoyed by the goods offered or sold under the mark and the **position** it occupies in the market are valuable indications for assessing reputation, as they both serve to indicate the **percentage of the relevant public that actually buys** the goods and to measure the success of the mark against competing goods.

Market share is defined as the **percentage of total sales** obtained by a brand in a particular sector of the market. When defining the relevant market sector, the goods and services for which the **mark has been used** must be taken into account. If the scope of such goods and services is narrower than those for which the mark is registered, a situation of partial reputation arises, similar to the one where the mark is registered for a variety of goods, but has acquired a reputation only for part of them. This means that, in such a case, only **the goods and services for which the mark has actually been used and acquired a reputation will** be taken into account for the purposes of the examination.



Therefore, a very **substantial market share**, or a **leader position** in the market, will usually be a **strong indication of reputation**, especially if combined with a reasonably high degree of trade mark awareness. Conversely, a **small market share** will in most cases be an **indication against reputation**, unless there are other factors that suffice on their own to support such a claim.

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P, EU:C:2012:285	'... the size of the <b>market share of BOTOX in the United Kingdom, 74.3 % in 2003</b> , like the degree of awareness of the trade mark of 75 % among the specialised public accustomed to pharmaceutical treatments against wrinkles, is sufficient to substantiate the existence of a considerable degree of recognition on the market' (para. 76).
13/12/2004, T-08/03, Emilio Pucci, EU:T:2004:358	The Court considered that the opponent failed to prove the enhanced distinctiveness or reputation of its earlier trade marks, since the evidence submitted (advertisements, seven letters from a number of advertising directors and a video cassette) did not include adequately substantiated or verifiable objective evidence to make it possible <b>to assess the market share</b> held by the marks Emilio Pucci in Spain, how intensive, geographically widespread and long-standing use of the marks had been, or the amount invested by the undertaking in promoting them (para. 73).

Another reason why a **moderate market share will not always be conclusive against reputation** is that the percentage of the public that in reality knows the mark may be much higher than the number of actual buyers of the relevant goods. This would be the case, for example, for goods that are normally used by more than one user (e.g. family magazines or newspapers) (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 35-36; 10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 47, 51) or for luxury goods, which many may know, but few can buy (e.g. a high percentage of European consumers know the trade mark 'Ferrari' for cars, but only few own one). For this reason, the market share proved by the evidence should be assessed taking into account the particularities of the specific market.

Case No	Comment
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29/05/2012, R 1659/2011-2, KENZO / KENZO	KENZO identifies, in the eyes of the European public, a pre-eminent provider of recognised fashion and luxury items in the form of perfumes, cosmetics and clothing. The relevant public however was considered to be the general public (para. 29).
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In certain cases it will **not be easy to define the market share** of the earlier mark, for example when the exact size of the relevant market cannot be measured accurately, owing to peculiarities of the goods or services concerned.

Case No	Comment
12/01/2011, R 446/2010-1, TURBOMANIA / TURBOMANIA	The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public. The evidence clearly showed that the trade mark appeared continuously in specialist magazines for the market from December 2003 to March 2007 (the date of the EUTM application). That meant that the public targeted by the magazines had constant, ongoing exposure to the opponent's trade mark over a long period covering more than 3 years prior to the relevant date. Such a huge presence in the press specifically targeting the relevant public was more than sufficient evidence that the relevant public was aware of the trade mark (para. 31).

In such cases, **other similar indications** may be relevant, such as TV audience ratings, as in the case of motor racing and other sporting or cultural events.

Case No	Comment
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10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	The opponent submitted evidence showing that the mark Nasdaq appeared almost daily, particularly with reference to the Nasdaq indices, in many <b>newspapers</b> and on many <b>television channels</b> that can be read/viewed throughout Europe. The opponent also submitted evidence of <b>substantial investments in advertising</b> . The Court found reputation proven, even though the opponent did not submit any market share figures (paras 47 to 52).
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### 3.1.3.3 Intensity of use

The intensity of use of a mark may be demonstrated by **sales volumes** (i.e. the number of units sold) and **turnover** (i.e. the total value of those sales) attained by the opponent for goods bearing the mark. Usually, the relevant figures correspond to sales in 1 year, but there may be cases where the time unit used is different.

Case No	Comment
15/09/2011, R 2100/2010-1, SEXIALIS / CIALIS et al.	The documents submitted (press articles, sales figures, surveys) showed that the earlier sign, CIALIS, was intensively used before the filing date of the EUTM application, that the products under the mark CIALIS were marketed in several Member States where they enjoyed a consolidated position among the leading brands, and that there was a high degree of recognition when compared with the market leader Viagra. Large and constantly growing market share and sales numbers also showed 'the vast expansion of CIALIS' (para. 55).

In evaluating the importance of a given turnover or sales volume, account should be taken of **how large the relevant market is in terms of population**, as this has a bearing on the number of potential purchasers of the products in question. For example, the relative value of the same number of sales will be much bigger, for example, in Luxembourg than in Germany.

Moreover, whether or not a given sales volume or turnover is substantial will depend on the **kind of product** concerned. For example, it is much easier to achieve a high sales volume for everyday mass consumption goods than for luxury or durable products that are bought rarely, without this meaning that in the former case more consumers have come into contact with the mark, as it is likely that the same person has bought the

same product more than once. It follows that the **kind, value and durability** of the goods and services in question should be taken into consideration in determining the significance of a given sales volume or turnover.

Turnover and sales figures will be more useful as **indirect indications**, to be assessed in conjunction with the rest of the evidence, than as direct proof of reputation. In particular, such indications can be especially helpful for **completing the information given by percentages** as regards market share and awareness, by giving a more **realistic impression** of the market. For example, they may reveal a very large amount of sales behind a not-so-impressive market share, which may be useful in assessing reputation in the case of competitive markets, where it is in general more difficult for a single brand to account for a substantial portion of the overall sales.

By contrast, where the market share of the products for which the mark is used is not given separately, it will not be possible to determine whether a given turnover corresponds to a substantial presence in the market or not, unless the opponent also submits evidence showing the **overall size of the relevant market in monetary terms**, so that the opponent's percentage of the market can be inferred.

Case No	Comment
21/04/2010, R 1054/2007-4, MANDARINO (fig.) / MANDARINA DUCK (fig.)	Reputation was not sufficiently proven, in particular because none of the documents referred to recognition of the earlier trade mark by the relevant end consumers. Nor was any evidence about the market share of the opponent's goods submitted. Information about market share is particularly important in the sector in which the opponent had its core business ( <i>handbags, transport items, accessories and clothing</i> ), as it is 'a quite atomized and competitive sector' and 'there are many different competitors and designers in that product range' (paras 59 to 61).

This does not mean that the importance of turnover figures or volume of sales should be underestimated, as both are significant indications of **the number of consumers** that are expected to have encountered the mark. Therefore, it **cannot be excluded** that a **substantial** amount of turnover or sales volume may, in certain cases, be **decisive** for a finding of reputation, either alone, or in conjunction with very little other evidence.

Case No	Comment
12/01/2011, R 445/2010-1, FLATZ / FLATZ	Although, for reasons of <i>force majeure</i> , it was not possible for the earlier trade mark to become well known by traditional methods, that is, through sales of the product, it did become extremely well known as a result of promotional activities, through the trade mark being extensively, continually and constantly publicised in the specialist press and at sector fairs, thereby reaching virtually the whole of the three relevant sectors of the public. The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public that, on the relevant date, FLATZ was the trade mark with which the opponent identified its <i>electronic bingo machines</i> (paras 41, 42, 50 and 51).
10/12/2009, R 1466/2008-2 & R 1565/2008-2, COMMERZBANK ARENA / ARENA ET AL.	The lack of figures regarding market share held by the trade mark ARENA in the relevant countries was not in itself capable of calling the finding of reputation into question. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serves to illustrate examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence submitted by the opponent is already sufficient in itself to prove conclusively the substantial degree of recognition of the ARENA mark amongst the relevant public (para. 59).

However, as this would deviate from the rule that reputation has to be evaluated by making an overall assessment of all factors relevant to the case, findings of reputation based almost exclusively on such figures should be generally avoided, or at least confined to exceptional cases in which such a finding would really be justified.

#### 3.1.3.4 Geographical extent of use

Indications of the territorial extent of use are mainly useful for determining whether the alleged reputation is **widespread enough to cover a substantial part** of the relevant territory, within the sense given in paragraph 3.1 above. In this assessment, account should be taken of the population density in the areas concerned, as the critical criterion is the proportion of consumers knowing the mark, rather than the size of the geographical area as such. Similarly, what is important is public awareness of the mark

rather than availability of the goods or services. A mark may, therefore, have a territorially widespread reputation on the basis of advertising, promotion, media reports, etc.

In general, the more widespread the use, the easier it will be to conclude that the mark has passed the required threshold, whereas any indication showing use beyond a substantial part of the relevant territory will be a positive indicator of reputation. Conversely, a very limited amount of use in the relevant territory will be a strong indication against reputation, as for example where the vast majority of the goods are exported to a third jurisdiction in sealed containers directly from their place of production.

Case No	Comment
26/05/2011, R 966/2010-1, ERT (fig.) / ERT (fig.)	If the earlier mark were so well known in the 27 Member States of the EU for TV broadcasting and magazines, it should have been easy for the opponent to provide information about 'the reach of the mark' just before 2008, when the EUTM application was filed. The magazine sales figures did not cover the right period. Nor did the documents submitted give any indication of the extent to which the public was aware of the mark (paras 16 and 18).

However, evidence of actual use in the relevant territory should not be regarded as a necessary condition for the acquisition of reputation, as what matters most is knowledge of the mark and not how it was acquired.

Such knowledge may be generated by, for example, intensive advertising prior to the launching of a new product or, in the case of high levels of cross-border shopping, it may be fuelled by a significant price difference in the respective markets, a phenomenon often referred to as '**territorial spill-over**' of reputation from one territory to another. However, when it is claimed that such circumstances have occurred, the corresponding evidence must demonstrate this. For example, it cannot be assumed, merely because of the principle of free trade in the European Union, that goods put on the market in Member State X have also penetrated the market of Member State Y in significant quantities.

#### 3.1.3.5 Duration of use

Indications of the duration of use are particularly useful for determining the **longevity** of the mark. The longer the mark has been used in the market, the larger will be the number of consumers that are likely to have encountered it, and the more likely it is that such consumers will have encountered the mark more than once. For example, a

market presence of 45, 50 or 100-plus years is considered a strong indication of reputation.

Case No	Comment
10/12/2009, R 1466/2008-2 & R 1565/2008-2, COMMERZBANK ARENA / ARENA ET AL.	The evidence submitted showed a particularly impressive duration of use (over 30 years) and geographical extent of use (over seventy-five countries worldwide, including the Member States concerned) for the ARENA brand (para. 55).
29/03/2012, T-369/10, Beatle, EU:T:2012:177 (appeal dismissed in 14/05/2013, C-294/12 P, EU:C:2013:300)	The Beatles group was considered to be a group with an exceptional reputation, lasting for more than 40 years (para. 36).

The duration of use of the mark should not be inferred by mere reference to the term of its registration. Registration and use do not necessarily coincide, as the mark may have been put to actual use either before or after it was filed. Therefore, where the opponent invokes actual use preceding the term of registration, it must prove that such use actually began before it applied for its mark.

Nevertheless, a long registration period may sometimes serve as an indirect indication of a long presence on the market, as it would be unusual for a proprietor to maintain a registered mark for many decades without any economic interest behind it.

In the end, the decisive element is whether the earlier mark had a reputation at the time of filing of the contested application. Whether that reputation also existed at some earlier point in time is legally irrelevant. Therefore, evidence of **continuous use up to the filing date** of the application will be a positive indicator of reputation.

By contrast, if **use of the mark was suspended** over a significant period, or if the period between the latest evidence of use and the filing of the EUTM application is quite long, it will be more difficult to conclude that the mark's reputation survived the interruption of use, or that it subsisted until the filing date of the application (see paragraph 3.1.2.5 above).

### 3.1.3.6 Promotional activities

The **nature** and **scale of the promotional activities** undertaken by the opponent are useful indications when assessing the reputation of the mark, to the extent that these activities were undertaken to build up a brand image and enhance trade mark awareness among the public. Therefore, **a long, intensive and widespread** promotional campaign may be a **strong indication** that the mark has acquired a reputation among the potential or actual purchasers of the goods in question, and that it may actually have become known beyond the circle of the actual purchasers of those goods.

Case No	Comment
10/05/2012, C-100/11 P, Botolist / Botocyl	Evidence of the promotion of BOTOX in English in the scientific and general-interest press was sufficient to establish the mark's reputation amongst both the general public and health-care professionals (paras 65 and 66).
12/01/2011, R 445/2010-1, FLATZ / FLATZ	Although, for reasons of <i>force majeure</i> , it was not possible for the earlier trade mark to become well known by traditional methods, that is, through sales of the product, it did become extremely well known as a result of promotional activities, through the trade mark being extensively, continually and constantly publicised in the specialist press and at sector fairs, thereby reaching virtually the whole of the three relevant sectors of the public. The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public that, on the relevant date, FLATZ was the trade mark with which the opponent identified its <i>electronic bingo machines</i> (paras 41, 42, 50 and 51).
29/05/2012, R 1659/2011-2, KENZO / KENZO (confirmed, 22/01/2015, T-393/12, EU:T:2015:45, § 57)	The opponent's goods, <i>cosmetics, perfumes and clothing</i> , have been advertised and articles have been written about them in many of the world's leading fashion-related lifestyle magazines, and in some of Europe's leading mainstream periodicals. In line with the case-law, the reputation of KENZO for the said goods is confirmed (para. 29).

Even though it cannot be ruled out that a mark acquires a reputation before any actual use, promotional activities will usually not be sufficient on their own for establishing that the earlier mark has indeed acquired a reputation (see paragraph 3.1.3.4 above). For example, it will be difficult to prove knowledge amongst a significant part of the public exclusively by reference to promotion or advertising, carried out as preparatory acts for the launching of a new product, as the actual impact of publicity on the perception of the public will be difficult to measure without reference to sales. In such situations, the only means of evidence available to the opponent are opinion polls and similar instruments, the probative value of which may vary depending on the reliability of the method used, the size of the statistical sample, etc. (for the probative value of opinion polls, see paragraph 3.1.4 below).

The impact of the opponent's promotional activities may be shown either **directly**, by reference to the **amount of promotional expenditure**, or **indirectly**, by way of



inference from the **nature of the promotional strategy** adopted by the opponent and **the kind of medium used** for advertising the mark.

For example, advertising on a nationwide TV channel or in a prestigious periodical should be given more weight than campaigns of a regional or local scope, especially if coupled with high audience or circulation figures. Likewise, the sponsoring of prestigious athletic or cultural events may be a further indication of intensive promotion, as such schemes often involve a considerable investment.

Case No	Comment
22/01/2010, R 1673/2008-2, FIESTA / FIESTA (fig.) ET AL.	It is apparent from Ferrero's various advertising campaigns on Italian television (including Rai) that the earlier mark was widely exposed to viewers in 2005 and 2006. Many of these spots appear to have been broadcast at peak viewing times (e.g. during Formula 1 Grand Prix coverage) (para. 41).

Furthermore, the **contents of the advertising strategy** chosen by the opponent can be useful for revealing the **kind of image** the opponent is trying to create for its brand. This may be of particular importance when assessing the possibility of detriment to, or unfair advantage being taken of, a particular image allegedly conveyed by the mark, since the existence and contents of such an image must be abundantly clear from the evidence submitted by the opponent (see paragraph 3.4 below).

Case No	Comment
11/01/2011, R 306/2010-4, CARRERA / CARRERA, (under appeal, 27/11/2014, T-173/11, Carrera / CARRERA, EU:T:2014:1001)	The opponent's trade mark is not only known per se but, due to the high price of sports cars and the opponent's intensive expenditure on advertising, and against the background of its successes in racing, the public associates it with an image of luxury, high technology and high performance (para. 31).

### 3.1.3.7 Other factors

The Court has made clear that the above list of factors is only indicative and has underlined that all the facts relevant to the particular case must be taken into consideration when assessing the reputation of the earlier mark (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 27). Other factors may be found in Court case-law dealing with enhanced distinctiveness through use, or in WIPO's Joint Recommendation. Therefore, depending on their relevance in each case, the following factors may be

added: record of successful enforcement; number of registrations; certification and awards; and the value associated with the mark.

#### Record of successful enforcement

Records of successful enforcement of a mark against dissimilar goods or services are important because they may demonstrate that, at least in relation to other traders, there is acceptance of protection against dissimilar goods or services.

Such records may consist of the successful prosecution of complaints outside the courts, such as the acceptance of cease and desist requests, delimitation agreements in trade mark cases, etc.

Furthermore, evidence showing that the reputation of the opponent's mark has been repeatedly recognised and protected against infringing acts by **decisions of judicial or administrative authorities** will be an important indication that the mark enjoys a reputation in the relevant territory, especially where such decisions are recent. That effect may be reinforced when there is a substantial number of decisions of this kind (on the probative value of decisions, see paragraph 3.1.4.4 below). This factor is mentioned in Article 2(1)(b)(5) of WIPO's Joint Recommendation.

#### Number of registrations

The **number** and **duration of registrations** and applications for the mark around Europe or the world is also relevant, but is in itself a weak indication of the degree of recognition of the sign by the relevant public. The fact that the opponent has many trade mark registrations and in many classes may indirectly attest to the international circulation of the brand, but cannot decisively prove a reputation in itself. This factor is mentioned in Article 2(1)(b)(4) of the WIPO Joint Recommendation, where the need for actual use is made clear: the duration and geographical area of any registrations, and/or any applications for registration, of the mark are relevant 'to the extent that they reflect use or recognition of the mark'.

#### Certification and awards

Certification, awards, and similar public recognition instruments usually provide information about the history of the mark, or reveal certain quality aspects of the opponent's products, but as a rule they will not be sufficient in themselves to establish reputation and will be more useful as indirect indications. For example, the fact that the opponent has been a holder of a royal warrant for many years may perhaps show that the mark invoked is a traditional brand, but cannot give first-hand information about trade mark awareness. However, if the certification concerns facts that are related to the performance of the mark, its relevance will be much higher. This factor is mentioned by the Court in *Lloyd Schuhfabrik (Lloyd Schufabrik Meyer)* and *Chiemsee (Windsurfing Chiemsee)* in relation to the assessment of enhanced distinctiveness through use.

Case No	Comment
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14/06/2012, R 1637/2011-5, made by APART since 1975 / Apart et al.	The new evidence submitted by the appellant and accepted by BoA shows that the earlier mark had consistently been granted a high brand rating as well as prizes in surveys carried out by specialised companies in Poland between 2005 and 2009 (para. 30). It was therefore considered that the appellant successfully proved reputation in Poland for jewellery, but did not prove reputation for the other goods and services covered by its earlier signs.
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### The value associated with the mark

The fact that a mark is solicited by third companies for reproduction on their products, either as a trade mark, or as mere decoration, is a strong indication that the mark possesses a high degree of attractiveness and an important economic value. Therefore, the extent to which the mark is exploited through **licensing, merchandising and sponsoring**, as well as the scale of the respective schemes, are useful indications in assessing reputation. This factor is mentioned in Article 2(1)(b)(6) of the WIPO Joint Recommendation.

#### 3.1.4 Proof of reputation

##### 3.1.4.1 Standard of proof

The opponent must submit evidence enabling the Office to reach the **positive conclusion** that the earlier mark has acquired a reputation in the relevant territory. The wording used in Article 8(5) EUTMR and Article 7(2)(f) EUTMDR is quite clear in this respect: the earlier mark deserves enlarged protection only if it 'has a reputation'.

It follows that the **evidence must be clear and convincing**, in the sense that the opponent must clearly establish all the facts necessary to safely conclude that the mark is known by a significant part of the public. The reputation of the earlier mark must be established to the satisfaction of the Office and not merely assumed.

##### 3.1.4.2 Burden of proof

According to the second sentence of Article 95(1) EUTMR, in *inter partes* proceedings the Office is restricted in its examination to the facts, evidence and arguments provided by the parties. It follows that, when assessing whether the earlier mark enjoys reputation, the Office may **neither take into account** facts known to it as a result of its own **private knowledge** of the market **nor conduct an ex officio investigation**, but should exclusively base its findings on the information and evidence submitted by the opponent.

Exceptions to this rule apply where particular facts are so well established that they can be considered as universally known and, thus, are also presumed to be known to the Office (e.g. the fact that a particular country has a certain number of consumers, or the fact that food products target the general public). However, whether or not a mark has passed the threshold of reputation established by the Court in *Chevy (General Motors)* is not in itself a pure question of fact, since it requires the legal evaluation of several factual indications, and the reputation of the earlier mark may therefore not be simply assumed to be a universally known fact.

Case No	Comment
22/06/2004, T-185/02, Picaro, EU:T:2004:189  (confirmed 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25)	The Board of Appeal may take into consideration, in addition to the facts expressly put forward by the parties, facts that are well known, that is, which are likely to be known by anyone or that may be learnt from generally accessible sources. 'It must be borne in mind, at the outset, that the legal rule stated in Article 74(1) in fine of Regulation No 40/94 [now Article 95(1) EUTMR] constitutes an exception to the principle of examination of the facts by [the Office] of its own motion, laid down in limine by that provision. That exception must therefore be given a strict interpretation, defining its extent so as not to exceed what is necessary for achieving its object' (paras 29 to 32).
30/03/2009, R 1472/2007-2, El Polo / POLO	It is common knowledge that the earlier mark is indeed a very famous brand, not only in France, but in most European countries, in large part due to the public's exposure to products at airport and duty free boutiques as well as long-standing advertising in widely circulated magazines. The weight of evidence required to support statements that are universally known to be true need not be great (para. 32).

Article 7(2)(f) EUTMDR provides that the burden of putting forward and proving the relevant facts lies with the opponent, by expressly requiring it to provide evidence attesting that the earlier mark **has a reputation** for the goods and services claimed. According to Article 7(1) and Article 7(2)(f) EUTMDR and Office practice, such evidence may be submitted either together with the notice of opposition, or subsequently within 4 months of the date of notification of the opposition to the applicant. The opponent may also refer to facts and evidence submitted in the course of another opposition, provided that the relevant materials are indicated in a clear and unambiguous way and that the language of proceedings is the same in both cases.

If the evidence of reputation is not in the correct **language**, the Office may, of its own motion or upon reasoned request by the other party, require the opponent to submit a translation of the evidence in that language, within a period specified by the Office (Article 7(3) EUTMDR and Article 24 EUTMR).

It is left to the discretion of the Office whether the opponent has to submit a translation of the evidence of reputation into the language of the proceedings. If the applicant explicitly requests a translation of the evidence in the language of the proceedings, the Office, in principle, will require a translation from the opponent. However, a rejection of such a request is feasible where it appears that the applicant's request, in view of the self-explanatory character of the submitted evidence, is exaggerated or even abusive.

Where the Office requires a translation of the evidence, it will give the opponent a period of 2 months to submit it. In view of the volume of documents often needed for proving reputation, it may be sufficient to translate only the material parts of long documents or publications. Similarly, it is not necessary to translate the entirety of documents or parts of documents that contain mainly figures or statistics, the meaning of which is evident, as is often the case with invoices, order forms, diagrams, brochures, catalogues, etc. The means of evidence will only be taken into account insofar as a translation has been produced or insofar as the means of evidence are self-explanatory regardless of their textual components.

As regards the structure and format in which written evidence of reputation must be filed, Article 55 EUTMDR applies, which provides that the documents or other items of evidence must be contained in annexes to a submission, which must be numbered consecutively.

Submissions must include an index indicating, for each document or item annexed thereto the following:

1. the number of the annex;
2. a short description of the document or item, and if applicable, the number of pages;
3. the page number of the submission where the document or item is mentioned.

The opponent may also indicate, in the index of annexes, which specific parts of a document it relies upon in support of its arguments.

Pursuant to Article 55(3) EUTMDR, where the submissions or annexes do not comply with the requirements, the Office may invite the opponent to remedy any deficiency within a set time limit. If the deficiencies are not remedied and if it is still not possible for the Office to clearly establish to which ground or argument a document or item refers, that evidence will not be taken into account (Article 55(4) EUTMDR).

#### 3.1.4.3 Evaluation of the evidence

The basic rules on the evaluation of evidence are also applicable here: the evidence should be assessed **as a whole**, that is, each indication should be weighed up against the others, with information confirmed by more than one source generally being considered more reliable than facts derived from isolated references. Indeed, the more

independent, reliable and well-informed the source of the information is, the higher the probative value of the evidence will be.

Therefore, information **deriving directly from the opponent** is unlikely to be enough on its own, especially if it only consists of **opinions** and **estimates** instead of facts, or if it is of an **unofficial character** and lacks objective confirmation, as for example when the opponent submits internal memoranda or tables with data and figures of unknown origin.

Case No	Comment
29/04/2010, R 295/2009-4, PG PROINGEC CONSULTORIA (fig.) / PROINTEC (fig.) et al.	The content of the documentation submitted does not clearly demonstrate that the earlier marks enjoy a reputation. The documentation emanates, in the main, from the respondent directly and contains information taken from its trade catalogues, its own advertising and documents downloaded from its website. There is insufficient documentation/information from third parties to reflect clearly and objectively what precisely the respondent's position on the market is. Reputation not proved (para. 26).
16/11/2011, T-500/10, Doorsa, EU:T:2011:679	As regards documents in the case file that come from the company itself, the General Court has held that, to assess the evidential value of such a document, account should be taken first and foremost of the credibility of the account it contains. The General Court added that it is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, prima facie, the documents appear sound and reliable (para. 49).

However, if such information is publicly available or has been compiled for official purposes and contains information and data that have been objectively verified, or reproduces statements made in public, its probative value is generally higher.

As regards its contents, the more indications the evidence gives about the various factors from which reputation may be inferred, the more relevant and conclusive it will be. In particular, evidence that, as a whole, gives **little or no quantitative data and information** will not be appropriate for providing indications about **vital factors**, such as trade mark awareness, market share and intensity of use and, consequently, will not be sufficient to support a finding of reputation.

## 3.1.4.4 Means of evidence

There is no direct indication in the Regulations as to which kind of evidence is more appropriate for proving reputation. The opponent may avail itself of **all the means of evidence of Article 97(1) EUTMR**, provided they are capable of showing that the mark does indeed have the required reputation.

The following means of evidence are the most frequently submitted by opponents in opposition proceedings before the Office (this list does not reflect their relative importance or probative value):

1. sworn or affirmed statements
2. decisions of courts or administrative authorities
3. decisions of the Office
4. opinion polls and market surveys
5. audits and inspections
6. certification and awards
7. articles in the press or in specialised publications
8. annual reports on economic results and company profiles
9. invoices and other commercial documents
10. advertising and promotional material.

Evidence of this kind may also be submitted under Article 8(1)(b) EUTMR in order to prove that the earlier mark has obtained a higher degree of distinctiveness, or under Article 8(2)(c) EUTMR in relation to well-known marks.

Sworn or affirmed statements

The weight and probative value of statutory declarations is determined by the general rules applied by the Office to the assessment of such evidence. In particular, both the capacity of the person giving the evidence and the relevance of such evidence to the particular case must be taken into account. For further details on the weight and probative value of affidavits, see the Guidelines, Part C, Opposition, Section 6, Proof of Use.

Case No	Comment
12/05/2011, R 729/2009-1, SKYBLOG / SKY et al.	The statement submitted by an expert consultancy firm in the area of digital media strategy in the UK attests to the fact that the opponent is 'the leading supplier of digital television in the UK' and that 'Sky has an enormous and impressive reputation' (para. 37).

Decisions of courts or administrative authorities

Opponents often invoke decisions of national authorities or courts that have accepted the reputation of the earlier mark. Even though national decisions are admissible

evidence and may have evidentiary value, especially if they originate from a Member State the territory of which is also relevant for the opposition concerned, they are not binding for the Office, in the sense that it is not mandatory for the Office to follow their conclusion.

Case No	Comment
17/12/2010, T-192/09, Seve Trophy, EU:T:2010:553	As far as judgments of Spanish courts are concerned, the European Union trade mark system is an autonomous system, consisting of a set of rules and objectives that are specific and applied independently of any national system (para. 79).

Since such decisions may serve to indicate reputation and to record successful enforcement of the mark, their relevance should be addressed and examined. Consideration should be given to the type of proceedings involved, to whether the issue was in fact reputation within the sense of Article 8(5) EUTMR, to the level of the court, and to the number of such decisions.

Case No	Comment
10/05/2012, C-100/11 P, Botolist / Botocyl, EU:C:2012:285	Decisions of the UK national office relating to the reputation of BOTOX are facts that may, if relevant, be taken into account by the General Court, despite the EUTM owners not being parties in those decisions (para. 78).

There might be differences between the substantive and procedural conditions applicable in national proceedings and those applied in opposition proceedings before the Office. Firstly, there may be differences as to how the requirement of reputation is defined or interpreted. Secondly, the weight the Office gives to the evidence is not necessarily the same as the weight given to it in national proceedings. Furthermore, national instances may be able to take into account *ex officio* facts known to them directly, whereas, under Article 95 EUTMR, the Office may not.

For these reasons, the probative value of national decisions will be considerably enhanced if the conditions of law and facts on the basis of which they were taken are made abundantly clear. This is because, in the absence of these elements, it will be more difficult both for the applicant to exercise its right of defence and for the Office to assess the decision's relevance with a reasonable degree of certainty. Similarly, if the decision is not yet final, or if it is outdated due to the time that has elapsed between the two cases, its probative value will be diminished accordingly.

Consequently, the probative value of national decisions should be assessed on the basis of their contents and may vary depending on the case.



### Office Decisions

The opponent may also refer to earlier Office decisions, on condition that such a reference is clear and unambiguous, and that the language of the proceedings is the same. Otherwise, the opponent must also file a translation of the decision within the 4-month period for filing further facts, evidence and arguments, in order to allow the applicant to exercise its right of defence.

As regards the relevance and probative value of previous Office decisions, the same rules as for national decisions apply. Even where the reference is admissible and the decision is relevant, the Office is not bound to come to the same conclusion and must examine each case on its own merits. Recognition of the reputation of an earlier mark cannot depend on prior recognition in the context of separate proceedings concerning the parties and different legal and factual elements. It is therefore for any party relying on the reputation of its earlier mark to establish, in the circumscribed context of each set of proceedings to which it is a party and on the basis of the facts that it considers most appropriate, that that mark has acquired a reputation; it cannot merely claim to adduce that evidence by virtue of its having been recognised, even for the same mark, in a separate administrative procedure (23/10/2015, T-597/13, *dadida / CALIDA*, EU:T:2015:804, § 43-45).

It follows that previous Office decisions only have a relative probative value and should be evaluated in conjunction with the rest of the evidence, especially where the opponent relies on a previous Office decision without referring to particular materials filed in the corresponding proceedings, that is, where the applicant has not had a chance to comment on such materials, or where the time that has elapsed between the two cases is quite long. The situation may be different if the evidence to which the opponent refers had been submitted in other proceedings between the same parties and the applicant had been aware of the evidence concerning the reputation of an earlier mark (22/01/2015, T-322/13, *KENZO*, EU:T:2015:47, § 18).

### Opinion polls and market surveys

Opinion polls and market surveys are the most suitable means of evidence for providing information about the degree of knowledge of the mark, the market share it has, or the position it occupies in the market in relation to competitors' goods.

The probative value of opinion polls and market surveys is determined by the status and degree of independence of the entity conducting it, by the relevance and accuracy of the information it provides, and by the reliability of the method applied.

More particularly, in evaluating the credibility of an opinion poll or market survey, the Office needs to know the following.

1. Whether or not it has been conducted by an independent and recognised research institute or company, in order to determine the reliability of the source of the evidence (27/03/2014, R 540/2013-2, *Shape of a bottle (3D)*, § 49).
2. The number and profile (sex, age, occupation and background) of the interviewees, in order to evaluate whether the results of the survey are representative of the different kinds of potential consumers of the goods in question.

3. The method and circumstances under which the survey was carried out and the complete list of questions included in the questionnaire. It is also important to know how and in what order the questions were formulated, in order to ascertain whether the respondents were confronted with leading questions.
4. Whether the percentage reflected in the survey corresponds to the total amount of persons questioned or only to those who actually replied.

Unless the above indications are present, the results of a market survey or opinion poll should not be considered of high probative value, and will not in principle be sufficient on their own to support a finding of reputation.

Case No	Comment
08/04/2011, R 925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al.	The cancellation applicant did not submit sufficient proof of the reputation of its trade marks. According to the extracts from the 2001 survey conducted in Italy, although the level of 'prompted recognition' stands at 86 %, the rate of 'spontaneous recognition' is only 56 %. Moreover, no indication is given of the questions put to the people surveyed, making it impossible to determine whether the questions were really open and unassisted. The survey further fails to state for which goods the trade mark is known (para. 27).
27/03/2014, R 540/2013-2, Shape of a bottle (3D)	The surveys do not seem to be carried out by the well-known GfK company, as the applicant argues, but rather by a Mr Philip Malivore who, according to his own declaration, is only 'a former director of GfK'. The Board is thus perplexed as to how a former employee of GfK can be authorised to use that company's logo on each and every page of the surveys when he is now 'an independent market research consultant'. These facts cast considerable doubt on the source, reliability and independent nature of the surveys (para. 49).

Likewise, if the above indications are given, but the reliability of source and method are questionable, the statistical sample is too small, or the questions were leading, the credibility of the evidence will be diminished accordingly.

Case No	Comment
15/03/2011, R 1191/2010-4, MÁS KOLOMBIANA ...Y QUÉ MÁS!! / COLOMBIANA LA NUESTRA	The survey submitted by the opponent does not provide conclusive information to demonstrate that the earlier sign is well known to the Spanish public for <i>aerated waters</i> as the interviewees were carefully selected on the basis of their origin, that is, Colombians resident in Spain. This is only a very small part of the population living in Spain. The figures relating to sales, to investment in publicity and to the mark's presence in publications directed at the immigrant public, contained in the statement made before a notary public, are likewise insufficient for a finding that the earlier sign is well known. Moreover, the statements are not corroborated by conclusive data on the extent or turnover of the goods (para. 23).
01/06/2011, R 1345/2010-1, Fukato Fukato (fig.) / DEVICE OF A SQUARE (fig.) et al.	In support of its claim under Article 8(5) EUTMR, the opponent relies exclusively on an opinion poll that was carried out in 2007. That opinion poll was conducted by an independent company. In principle, samples of 1 000-2 000 interviewees are considered sufficient, provided they are representative of the type of consumer concerned. The opponent's opinion poll was based on a sample of 500 interviewees, which is not sufficient in respect of the services for which reputation is claimed. According to the opinion poll, the logo of the earlier mark has been associated especially with services in the financial and insurance fields. Since the opposition is only based on Class 42 with regard to the earlier European Union trade mark, it does not cover financial and insurance services. Consequently, the opinion poll submitted is not suitable proof of the reputation of the opponent's European Union trade mark (para. 58).

Conversely, opinion polls and market surveys that fulfil the above requirements (independence and trustworthiness of source, reasonably large and widespread sample and reliable method) will be a strong indication of reputation, especially if they show a high degree of trade mark awareness.

#### Audits and inspections

Audits and inspections of the opponent's undertaking may provide useful information about the intensity of use of the mark, as they usually comprise data on financial results, sales volumes, turnover, profits, etc. However, such evidence will be pertinent only if it specifically refers to the goods sold under the mark in question, rather than to the opponent's activities in general.

Audits and inspections may be carried out on the initiative of the opponent itself, or may be required by company law and/or financial regulations. In the former case, the same rules as for opinion polls and market surveys apply, that is, the status of the entity conducting the audit and the reliability of the applied method will be of essence for determining its credibility, with the probative value of official audits and inspections being as a rule much higher, since they are usually conducted by a state authority or by a recognised body of auditors on the basis of generally accepted standards and rules.

#### Certification and awards

This kind of evidence includes certification and awards by public authorities or official institutions, such as chambers of commerce and industry, professional associations and societies, consumer organisations, etc.

The reliability of certification by authorities is generally high, as emanating from independent and specialised sources, which attest facts in the course of their official tasks. For example, the average circulation figures for periodicals issued by the competent press-distribution associations are conclusive evidence about the performance of a mark in the sector.

Case No	Comment
25/01/2011, R 907/2009-2, O2PLS / O2 et al.	The many brand awards won by the mark were, together with the huge investment in advertising and the number of articles published in different publications, considered an important part of the evidence for reputation (para. 9(iii) and para. 27).

The same applies to quality certification and awards granted by such authorities, as the opponent usually has to meet objective standards in order to receive the award. Conversely, prizes and awards offered by unknown entities, or on the basis of unspecified or subjective criteria, should be given very little weight.

The relevance of a certification or award to the specific case largely depends on its contents. For example, the fact that the opponent is a holder of an ISO 9001 quality certificate, or of a royal warrant, does not automatically mean that the sign is known to the public. It only means that the opponent's goods meet certain quality or technical standards or that it is a supplier of a royal house. However, if such evidence is coupled with other indications of quality and market success, it may lead to the conclusion that the earlier mark has a reputation.

#### Articles in the press or in specialised publications

The probative value of press articles and other publications concerning the opponent's mark mainly depends on whether such publications are covert promotional matter, or if, on the contrary, they are the result of independent and objective research.

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P	The very existence of articles in a scientific publication or the general-interest press constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX amongst the general public, irrespective of the positive or negative content of those articles (para. 54).
10/03/2011, R 555/2009-2, BACI MILANO (fig.) / BACI & ABBRACCI	The reputation of the earlier trade mark in Italy was proven by the copious amount of documentation submitted by the opponent, which included, inter alia, an article from <i>Economy</i> revealing that in 2005 the 'BACI & ABBRACCI' trade mark was one of the fifteen most counterfeited fashion brands in the world; an article published in <i>Il Tempo</i> on 05/08/2005, in which the 'BACI & ABBRACCI' trade mark is mentioned alongside others, including Dolce & Gabbana, Armani, Lacoste and Puma, as being targeted by counterfeiters; an article published in <i>Fashion</i> on 15/06/2006, in which the trade mark is defined as 'a true market phenomenon'; publicity campaigns from 2004 to 2007, with testimonials from entertainment and sports celebrities; and a market survey conducted by the renowned independent agency Doxa in September 2007, from which it emerges that the trade mark is 'top of mind' in the fashion sector for 0.6 % of the Italian public (para. 35).

Hence, if such articles appear in publications of a high status or are written by independent professionals, they will have quite a high value, as for example when the success of a specific brand becomes the object of a case study in specialised journals or in scientific publications. The presence of a mark in a dictionary (which is not a press article but is still a publication) is a means of evidence with high value.

Case No	Comment
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16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed by 10/05/2012, C-100/11 P	The inclusion of a word in a dictionary is the expression of a fair amount of recognition on the part of the public. The references in the 2002 and 2003 editions of a number of dictionaries published in the United Kingdom constitute one of the items of evidence that may establish the reputation of the trade mark BOTOX in that country or amongst the English-speaking public of the European Union (paras 55 and 56).
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#### Annual reports on economic results and company profiles

This type of evidence includes all kinds of internal publications giving varied information about the history, activities and perspectives of the opponent's company, or more detailed figures about turnovers, sales, advertising, etc.

To the extent that such evidence derives from the opponent and is mainly intended to promote its image, its probative value will mostly depend on its contents, and the relevant information should be treated with caution, especially if it mainly consists of estimates and subjective evaluations.

However, where such publications are circulated to clients and other interested circles and contain objectively verifiable information and data, which may have been compiled or revised by independent auditors (as is often the case with annual reports), their probative value will be substantially enhanced.

#### Invoices and other commercial documents

All kinds of commercial documents may be grouped under this heading, such as invoices, order forms, distribution and sponsoring contracts, samples of correspondence with clients, suppliers or associates, etc. Documents of this sort may provide a great variety of information on intensity of use, geographical extent and duration of use of the mark.

Even though the relevance and credibility of commercial documents is not disputed, it will generally be difficult to prove reputation on the basis of such materials alone, given the variety of factors involved and the volume of documents required. Furthermore, evidence relating to distribution or sponsoring contracts and commercial correspondence are more appropriate for giving indications about the geographical extent or promotional side of the opponent's activities, than for measuring the success of the mark in the market, and thus may only serve as indirect indications of reputation.

Case No	Comment
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14/04/2011, R 1272/2010-1, GRUPO BIMBO (fig.) / BIMBO et al.  (08/07/2015, T-357/11 INTP, GRUPO BIMBO (fig.) / BIMBO et al., EU:T:2015:534)	<p>The evidence submitted shows a high level of recognition of the mark on the Spanish market. The total invoices on the Spanish tin-loaf market in 2004 amounted to EUR 346.7 million, of which the opponent's invoices amounted to EUR 204.9 million. The invoices submitted cover advertisements on TV, as well as in newspapers and magazines. Therefore, the reputation of 'BIMBO' in Spain for <i>industrially produced bread</i> has been substantiated (para. 64).</p> <p>The Court did not address this point.</p>
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#### Advertising and promotional material

This kind of evidence may take various forms, such as press cuttings, advertising spots, promotional articles, offers, brochures, catalogues, leaflets, etc. In general, such evidence cannot be conclusive of reputation on its own, due to the fact that it cannot give much information about actual trade mark awareness.

However, some conclusions about the degree of exposure of the public to advertising messages concerning the mark may be drawn by reference to the kind of medium used (national, regional, local) and the audience rates or circulation figures attained by the relevant spots or publications — if, of course, this kind of information is available.

Case No	Comment
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<p>10/01/2011, R 43/2010-4, FFR (fig.) / CONSORZIO VINO CHIANTI CLASSICO (fig.), (05/12/2012, T-143/11, F.F.R., EU:T:2012:645)</p>	<p>The documents submitted show that the device of a black rooster has acquired reputation and will be associated with wines from the Chianti Classico region. The opponent provided several copies of <b>advertisements in newspapers and magazines, showing its promotional activity</b>, as well as independent articles displaying a black rooster in connection with the Chianti Classico region.</p> <p>However, given that the reputation only pertains to the device of a black rooster and given that this device is only one part of the earlier marks, serious doubts arise about whether reputation can be attributed to the marks as a whole. Moreover, for the same reason, doubt also arises about which marks the reputation could be attributed to, given that the opponent owns several marks. (paras 26 and 27).</p> <p>The Court did not assess the evidence on reputation.</p>
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In addition, such evidence may give useful indications of the kind of goods covered, the form in which the mark is actually used and the kind of image the opponent is trying to create for its brand. For example, if the evidence shows that the earlier registration for which reputation is claimed covers a device, but in fact this device is used in combination with a verbal element, it would not be correct to accept that the device itself has a reputation. Rather, it should be assessed whether the reputation extends to the device. For that purpose, it is important to assess whether the device plays a predominant or even significant role when used in combination with the verbal element, and has acquired a reputation in itself. This has to be assessed on a case-by-case basis. See example judgments in paragraph 3.1.2.6 above.

### 3.2 The similarity of the signs

A certain degree of similarity between the signs must be found for an opposition under Article 8(5) EUTMR to succeed (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53). If the signs are found **dissimilar** overall, the examination aimed at establishing whether the other requirements under Article 8(5) EUTMR are met **should not be carried out**, as the opposition cannot succeed.

A subject that gives rise to some uncertainty is the relationship between the term 'similar' within the meaning of Article 8(5) EUTMR and the term 'similarity' used in Article 8(1)(b) EUTMR. According to the clear wording of these two provisions, **similarity (or identity) between the signs is a precondition for the application of**



**both Article 8(1)(b) and Article 8(5) EUTMR.** The use of essentially the same term in both provisions is an argument in favour of the need to interpret this term in the same way, and the case-law has confirmed this.

Accordingly, similarity should be assessed according to the **same criteria** that apply in the context of Article 8(1)(b) EUTMR, thus taking into account elements of **visual, aural or conceptual similarity** (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 28, relating to the interpretation of Article 5(2) TMD; 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 52). See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

The general rules for assessing signs established for examining this criterion under Article 8(1)(b) EUTMR apply, such as the rule that consumers perceive the sign as a whole and only rarely have the chance to make a direct comparison between the different marks, and must place their trust in the imperfect image of them that they have kept in mind (25/01/2012, T-332/10, Viaguara, EU:T:2012:26, § 33, 34) (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 3, Imperfect Recollection).

### 3.2.1 Notion of ‘similarity’ pursuant to Article 8(5) EUTMR compared with Article 8(1)(b) EUTMR

Despite application of the same criteria for similarity of the signs in Article 8(1)(b) and Article 8(5) EUTMR, the purposes underlying these Articles are different: in Article 8(1)(b) EUTMR, the aim is to prevent the registration of a later trade mark that, if used, could confuse the relevant public as regards the commercial origin of the goods or services concerned, whereas in Article 8(5) EUTMR, the aim is to prevent the registration of a later trade mark that, if used, could take unfair advantage of, or be detrimental to, the reputation or distinctiveness of the earlier reputed trade mark.

The relationship between the notion of ‘similarity’ under the two provisions was addressed by the Court in *TiMiKinderjoghurt*: ‘It should be noted at the outset that ... the existence of a similarity between the earlier mark and the challenged mark is a precondition for the application both of Article 8(1)(b) [EUTMR] and of Article 8(5) [EUTMR]’ (para. 51). Article 8(5) [EUTMR], like Article 8(1)(b) [EUTMR], is manifestly inapplicable if any similarity between the marks is ruled out (20/11/2014, C-581/13 P & C-582/13 P, Golden balls, EU:C:2014:2387, § 73).

In the context both of Article 8(1)(b) and of Article 8(5) EUTMR, a finding of similarity between the marks in question requires the existence, in particular, of elements of visual, aural or conceptual similarity (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 28).

However, those provisions differ in terms of the degree of similarity required. Whereas the protection provided for under Article 8(1)(b) EUTMR is conditional upon a finding of a degree of similarity between the marks at issue such that there is a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5)

EUTMR. Accordingly, the types of injury referred to in Article 8(5) EUTMR may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 27, 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66).

Nevertheless, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, depending on whether the assessment is carried out under Article 8(1)(b) EUTMR or under Article 8(5) EUTMR.

To sum up, the application of both Article 8(1)(b) and Article 8(5) EUTMR requires a finding of similarity between the signs. Consequently, if, when Article 8(1)(b) EUTMR is examined, the signs are found to be **dissimilar**, the opposition will necessarily fail under Article 8(5) EUTMR too.

However, once the signs have been found to be **similar**, depending on whether Article 8(1)(b) or Article 8(5) EUTMR is involved, the examiner will independently assess whether the degree of similarity is sufficient for the relevant provision to apply (in correlation with the further relevant factors).

Therefore, a degree of similarity between the marks that, after an overall assessment of the factors, leads to a partial finding of likelihood of confusion under Article 8(1)(b) EUTMR does not **necessarily** trigger a link between the signs under Article 8(5) EUTMR, for example because the markets concerned are completely distinct. A full analysis must take place. This is because **the similarity of the signs is only one of the factors to be considered when assessing whether there is such a link** (see the relevant criteria listed under paragraph 3.3 below on the 'link').

Depending on the case, the following scenarios are possible.

- Article 8(1)(b) EUTMR fails because the signs are **dissimilar** — Article 8(5) EUTMR fails too, since the same conclusion applies.
- Likelihood of confusion pursuant to Article 8(1)(b) EUTMR is excluded (e.g. because the goods or services are dissimilar or very remotely similar), but the signs are similar — the examination of Article 8(5) EUTMR must be carried out (05/12/2012, T-143/11, F.F.R., EU:T:2012:645, § 66-71).
- The similarity of the signs together with the other relevant factors justifies the **exclusion** of likelihood of confusion pursuant to Article 8(1)(b) EUTMR, but the similarity between the signs might be sufficient to establish a **link** between them under Article 8(5) EUTMR, in view of the other relevant factors to be taken into account.

### 3.3 The link between the signs

The Court has made it clear that, in order to assess whether use of the contested mark would be likely to cause detriment to, or take unfair advantage of, the distinctive character or repute of the earlier mark, it is **necessary to establish** — once the signs

have been found to be similar — **whether, given all the relevant factors, a link (or association) between the signs will be established in the mind of the relevant public.** The subsequent case-law has made it clear that such an analysis should precede the final assessment of the existence of a risk of injury.

The notion of a link between the signs was addressed by the Court in its judgment of 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 30 (and the case-law cited therein), which, although referring to the interpretation of Article 4(4)(a) of First Council Directive 89/104/EEC, is applicable to Article 8(5) EUTMR, which is the equivalent provision in the EUTMR. In *Intel*, the Court, stated the following (para. 30):

The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

The term ‘**link**’ is often also referred to as ‘**association**’ in other paragraphs of this part of the Guidelines as well as in case-law. These **terms** are, at times, **used interchangeably**.

The Court made it clear that the mere fact that the marks in question are similar **is not sufficient** for it to be concluded that there is a link between them. Rather, **whether or not there is a link between the marks at issue must be appreciated globally**, taking into account all factors relevant to the circumstances of the case.

According to *Intel* (para. 42), the following may be **relevant factors** when assessing whether such a link exists.

- The degree of similarity between the conflicting marks. The more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public (06/07/2012, T-60/10, *Royal Shakespeare*, EU:T:2012:348, § 26 and, by analogy, 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 44).
- The nature of the goods or services for which the earlier mark is reputed and the later mark seeks registration, including the degree of similarity or dissimilarity between those goods or services, and the relevant section of the public. The goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public (*Intel*, paragraph 49).
- The strength of the earlier mark’s reputation.
- The degree of the earlier mark’s distinctive character, whether inherent or acquired through use. The more inherently distinctive the prior mark, the more likely it will be brought to a consumer’s mind when encountering a similar (or identical) later mark.
- The existence of likelihood of confusion on the part of the public.

This list is not exhaustive, and a link between the marks at issue may be established or excluded on the basis of only some of those criteria.

The question of whether the relevant public will establish a link between the marks at issue is a **question of fact**, which must be answered in the light of the facts and circumstances of each individual case.

The assessment of whether a 'link' will be established must take into account all the relevant factors that will then need to be balanced. Therefore, even a faint or remote degree of similarity between the signs (which might not be sufficient for a finding of likelihood of confusion under Article 8(1)(b) EUTMR) still justifies assessing all the relevant factors to determine if it is likely that a link between the signs will be established in the mind of the relevant public. In this respect, in its judgment of 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 65-66, the Court stated the following:

Although that global assessment implies some interdependence between the relevant factors, and a low degree of similarity between the marks may therefore be offset by the strong distinctive character of the earlier mark ... the fact remains that where there is no similarity between the earlier mark and the challenged mark, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that ... the relevant public makes a link between them ...

... It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public.

The fact that the goods and services designated by the marks at issue belong to distant sectors of trade is not, in itself, sufficient to exclude the possibility of the existence of a link. The specific reputation of the earlier mark (including qualitative aspects, such as a particular image, lifestyle, or particular circumstances of marketing that have become associated with the reputation of the mark) and the degree of similarity between the marks could make it possible for the image of the reputed mark to be transferred to the contested mark notwithstanding the distance between the relevant market sectors.

However, where the goods and services designated by the marks address the general public on the one hand, and a specialised public on the other, the mere fact that members of the specialised public are necessarily part of the general public is not conclusive as to the existence of a link. The fact that a specialised public may be familiar with the earlier mark covering goods or services aimed at the general public, that is not sufficient to demonstrate that that specialised public will establish a link between the marks at issue (26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604, § 45-46).

The General Court also found that the existence of a family of marks was a factor to be taken into account in assessing the establishment, on the part of the relevant public, of a link between the marks at issue (05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 73).

Case-law has made it clear that a link is not sufficient, in itself, to establish that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 96, and the case-law cited therein). However, as will be explained in detail under paragraph 3.4, 'The risk of injury', below, the existence of a link (or association) between the signs is necessary before it can be determined whether detriment or unfair advantage is likely.

#### Examples where a link was found between the signs

The following are examples where it was found that the degree of similarity between the signs (together with further factors) was sufficient to conclude that consumers would establish a link between them.

Earlier reputed sign	EUTM application	Case No
BOTOX	BOTOLIST and BOTOCYL	16/12/2010, T-345/08 & T-357/08 confirmed by 10/05/2012, C-100/11 P, EU:C:2012:285
<p><b>The trade mark BOTOX had a reputation for <i>pharmaceutical preparations for the treatment of wrinkles</i> in the United Kingdom on the filing date of the contested marks, which cover a range of goods in Class 3. The General Court confirmed the Board's finding that there is a certain overlap between the goods, namely a low degree of similarity between the opponent's <i>pharmaceutical preparations for the treatment of wrinkles</i> and the contested <i>cosmetics among other creams</i>, whereas the remaining contested goods, namely <i>perfumes, sun-tanning milks, shampoos, bath salts</i>, etc., are dissimilar. Nevertheless, <b>the goods at issue concern related market sectors</b>. The General Court confirmed the Board's finding that the relevant public — practitioners as well as the general public — would not fail to notice that both the trade marks applied for, BOTOLIST and BOTOCYL, begin with 'BOTO-', which comprises almost the whole of the mark BOTOX, which is well known to the public. The General Court pointed out that 'BOTO-' is not a common prefix, either in the pharmaceutical field or in the cosmetic field and that it has no descriptive meaning. Even if the sign BOTOX could be broken down into 'bo' for 'botulinum' and 'tox' for 'toxin', in reference to the active ingredient that it uses, that word would then have to be considered to have acquired a distinctive character, inherent or through use, at least in the United Kingdom. <b>In light of all the relevant factors, the public would naturally be led to establish a link between the marks BOTOLIST and BOTOCYL and the reputed mark BOTOX</b> (paras 65 to 79).</b></p>		

Earlier reputed sign	EUTM application	Case No
RED BULL		11/01/2010, R 70/2009-1

The Board found that a link would be established between RED DOG and RED BULL because (i) the marks have some relevant common features, (ii) the conflicting goods in Classes 32-33 are identical, (3) the RED BULL mark is reputed, (iv) the RED BULL mark has acquired a strong distinctive character through use and (v) there might be a possibility of confusion (para. 19). **It is reasonable to assume that the average consumer of beverages, who knows the reputed RED BULL mark and sees the RED DOG marks on the same kind of beverages would immediately recall the earlier mark.** According to the *Intel* judgment, this is 'tantamount to the existence of a link' between the marks (para. 24).

Earlier reputed sign	EUTM application	Case No
Viagra	Viaguara	25/01/2012, T-332/10, EU:T:2012:26

**The trade marks are highly similar overall** (para. 42). Visually, all the letters of the earlier trade mark are present in the contested one, and the first four and final two are in the same order. There is visual similarity, especially since the public tends to pay more attention to the beginnings of words (paras 35 and 36). The identity of the first and last syllable, together with the fact that the middle syllables have the sound [g] in common, leads to a high degree of phonetic similarity (paras 38 and 39). Neither of the signs has a meaning and, therefore, the public will not differentiate them conceptually (para. 40).

The earlier mark covers *pharmaceuticals for the treatment of erectile dysfunctions* in Class 5, whereas the contested mark covers *non-alcoholic and alcoholic drinks* in Classes 32 and 33. The reputation of the earlier sign for the goods mentioned is not disputed. The General Court found that **although no direct connection can be established between the goods covered by the marks in dispute since they are dissimilar, an association with the earlier mark remains possible, taking into account the high degree of similarity between the signs and the strong reputation acquired by the earlier mark. Therefore, the General Court concludes that a link is likely to be established between the marks** (para. 52).

Earlier reputed sign	EUTM application	Case No
RSC-ROYAL SHAKESPEARE COMPANY	Royal Shakespeare	06/07/2012, T-60/10, EU:T:2012:348



As the contested trade mark is exclusively made up of the central and distinctive element of the earlier trade mark, namely the expression 'royal shakespeare', **the signs at issue are visually, phonetically and conceptually similar**. Therefore, **the average consumer will establish a link between those signs** (para. 29). The earlier mark covers services in Class 41, including *theatre productions*, whereas the contested mark covers *non-alcoholic and alcoholic drinks* in Classes 32 and 33 and *providing of food and drink, restaurants, bars, pubs, hotels; temporary accommodation* in Class 42. **The General Court confirmed the Board's finding of the 'exceptional' reputation of the earlier mark in the United Kingdom for theatre productions**. The relevant public for the contested trade mark is the same as the relevant public for the earlier trade mark, namely the public at large (para. 58). **Although the contested goods in Classes 32-33 do not appear to be directly and immediately linked to the opponent's theatre productions, there is a certain proximity and link between them**. The General Court refers to the judgment of 04/11/2008, T-161/07, Coyote ugly, EU:T:2008:473, § 31-37, where a certain similarity between *entertainment services* and *beer* was found due to their complementarity. The General Court added that it is common practice, in theatres, for bar and catering services to be offered either alongside and during the interval of a performance. Moreover, irrespective of the above, in view of the established reputation of the earlier trade mark, the relevant public, namely the public at large in the United Kingdom, would be able to make a link with the intervener when seeing a beer with the contested trade mark in a supermarket or in a bar (para. 60).

#### Examples where no link was found between the signs


The following are examples where an overall assessment of all of the relevant factors showed that it was unlikely that a link would be established between the signs.


Earlier reputed sign	EUTM application	Case No
		29/04/2010, R 724/2009-4

Earlier reputed sign	EUTM application	Case No
<p>The signs only have a certain degree of visual and aural similarity. The Board confirms that the reputation of the earlier marks has been proven solely for <i>distribution of energy services</i>. These services are completely different from the goods for which protection is requested in Classes 18, 20, 24 and 27. The relevant section of the public is the same, given that the services for which a reputation has been proven, namely <i>distribution of energy services</i>, are aimed at the general public and the goods in dispute are also aimed at the average consumer who is reasonably observant and circumspect. However, even if the relevant section of the public for the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public. The huge differences in usage between the goods in dispute and the services for which reputation has been proven make it very unlikely that the public will make a link between the signs in dispute, which is essential for the application of Article 8(5) EUTMR and for unfair advantage to be taken of the distinctive character or repute of the earlier mark. It is even less likely that, when intending to purchase a bag or item of furniture, the relevant public will link these goods to a trade mark that is very well known, but for services in the energy sector (paras 69 and 79).</p>		

Earlier reputed signs	EUTM application	Case No
<p>G-STAR and</p> 		<p>21/01/2010, T-309/08, EU:T:2010:22</p>
<p><b>Visually the signs give a different overall impression</b>, due to the figurative element of a Chinese dragon's head placed at the beginning of the mark applied for. Aurally, there is a rather <b>close aural similarity</b> between the marks at issue. The signs are conceptually different, since the element 'star' of the earlier marks is a word that is part of basic English vocabulary, the meaning of which is widely understood throughout the EU. Therefore, the earlier marks will be perceived as referring to a star or a famous person. It is possible that a part of the relevant public will attribute to the element 'stor' of the contested mark the sense of the Danish and Swedish word 'stor', meaning 'big, large', or will regard it as a reference to the English word 'store' meaning 'shop, storage'. It is, however, more likely that the majority of the relevant public will not attribute any particular meaning to that element. Therefore, the relevant public will perceive the marks at issue as <b>conceptually different</b> inasmuch as the earlier marks have a clear meaning throughout the EU, while the mark applied for has either a different meaning for part of the relevant public or no meaning. According to settled case-law, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences between those signs may counteract the visual and aural similarities between them. The Board of Appeal was right to find that <b>the visual and conceptual differences between the marks prevented any assumption of a possible link between them</b> (paras 25 to 36).</p>		



Earlier reputed sign	EUTM application	Case No
ONLY		07/10/2010, R 1556/2009-2 (confirmed 08/12/2011, T-586/10, EU:T:2011:722)
<p>The goods in Class 3 are identical and target the same public. There is a slight degree of visual and conceptual similarity between the signs at issue and a moderate degree of aural similarity. Even if the earlier marks had a reputation, the differences between the signs, in particular due to the conceptual unit created by the combination of the element 'only' and the distinctive dominant element 'givenchy', would be significant enough for the public not to make any connection between them. Therefore, the Board of Appeal was correct in finding that one of the conditions for applying Article 8(5) EUTMR, namely that the signs be sufficiently similar to lead the relevant public to make a connection between them, has not been met (paras 65 and 66).</p>		

Earlier reputed signs	EUTM application	Case No
KARUNA		29/06/2010, R 696/2009-4, (confirmed 20/06/2012, T-357/10, EU:T:2012:312)
<p>The goods concerned, <i>chocolate</i> in Class 30, are identical. The signs <b>differ visually</b> not only because of the figurative elements in the sign applied for, but also because of their verbal elements. Even though the verbal elements of the marks at issue have three letters out of six in common, a difference arises because the earlier marks begin with the letters 'ka' while the mark applied for begins with the letters 'co', and because the consumer normally attaches more importance to the first part of words. <b>There is a low degree of phonetic similarity between the signs taken as a whole.</b> Conceptually, the word 'corona', meaning 'crown' in Spanish, does not have any meaning in Estonian, Latvian or Lithuanian. Accordingly, <b>no conceptual comparison is possible between the signs at issue</b> in the three Baltic States. The mere fact that the Lithuanian word 'karūna' means 'crown' is not sufficient to establish that the relevant public associates the terms 'karuna' or 'karūna' with the word 'corona', which remains a foreign word. To conclude, <b>the General Court reiterated that if the condition of similarity of the signs is not met under Article 8(1)(b) EUTMR, it must also be held, on the basis of the same analysis, that that condition is not met under Article 8(5) EUTMR either</b> (paras 30 to 34 and 49).</p>		

### 3.4 The risk of injury <sup>66</sup>

#### 3.4.1 Protected subject matter

Article 8(5) EUTMR does **not protect the reputation** of the earlier mark **as such**, in the sense that it does **not intend to prevent the registration of all marks identical with or similar to a mark with reputation**. In addition, there must be a likelihood that use of the contested application without due cause would take unfair advantage of, or would be detrimental to, the distinctive character or the repute of the earlier mark. The Court confirmed this by stating that once the condition as to the existence of reputation is fulfilled, the examination has to proceed regarding the **condition that the earlier mark must be detrimentally affected** without due cause (14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 30).

The Court did not set out in more detail exactly what would count as detriment or unfair advantage, even though it stated in *Sabèl* that Article 8(5) EUTMR '[does] not require proof of likelihood of confusion', thereby stating the obvious, namely that the enlarged protection granted to reputed marks is not concerned with their function of origin (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 20).

However, in a series of previous decisions, the Court stated that apart from indicating origin, a trade mark may also fulfil other functions worthy of protection. More particularly, it confirmed that a trade mark can offer a guarantee that all the goods coming from a single undertaking have the same quality (**guarantee function**) and that it can serve as an advertising instrument by reflecting back the goodwill and prestige it has acquired in the market (**advertising function**) (17/10/1990, C-10/89, *Hag II*, EU:C:1990:359; 11/07/1996, C-427/93, C-429/93 & C-436/93, *Bristol-Myers Squibb v Paranova A/S*, EU:C:1996:282; 11/11/1997, C-349/95, *Ballantine*, EU:C:1997:530; 04/11/1997, C-337/95, *Dior*, EU:C:1997:517; 23/02/1999, C-63/97, *BMW*, EU:C:1999:82).

It follows that trade marks serve not only to indicate the origin of a product, but also to convey a certain **message or image** to the consumer, which is **incorporated in the sign** mostly through use and, once acquired, forms part of its distinctiveness and repute. In most cases of reputation these features of the trade mark will be particularly developed, as the commercial success of a brand is usually based on product quality, successful promotion, or both, and, for this reason, will be especially valuable to the trade mark owner. This **added value** of a mark with reputation is precisely what Article 8(5) EUTMR intends to protect against undue detriment or unfair advantage.

Hence, the protection under Article 8(5) EUTMR extends to all cases where the use of the contested trade mark applied for is likely to have an adverse effect on the earlier mark, in the sense that it would diminish its attractiveness (detriment to distinctiveness) or devalue the image it has acquired among the public (detriment to repute), or where

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<sup>66</sup> For the purposes of these Guidelines, the term 'injury' covers taking 'unfair advantage' even though in such cases there is not necessarily an 'injury' in the sense of detriment either to the distinctive character or repute of the mark or, more generally, to its proprietor.

use of the contested mark is likely to result in misappropriation of its powers of attraction or exploitation of its image and prestige (taking unfair advantage of the distinctive character or repute).

Given also that a **very strong reputation** is both easier to harm and more tempting to take advantage of, owing to its great value, the Court underlined that ‘the stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it’ (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 67, 74; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 41). Even though the Court did not say so expressly, the same must be accepted as regards the unfair advantage that the applicant might enjoy at the expense of the earlier mark.

### 3.4.2 Assessment of the risk of injury


In *Chevy (General Motors)*, the Court did not deal with the assessment of detriment and unfair advantage in great detail, as this issue was not part of the question referred to it. It only stated that it ‘is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an **association between the two trade marks ... and that the earlier trade mark may consequently be damaged**’ (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23).

Even though this statement is too limited to serve as a basis for a comprehensive analysis of the existence of a risk of injury, it gives at least a significant indication, namely that detriment or unfair advantage must be the **consequence of an association** between the conflicting marks in the minds of the public, made possible by the similarities between the marks, their distinctiveness, the reputation and other factors (see paragraph 3.3 above).

Thus, if the alleged detriment or unfair advantage is not the result of an association between the marks, but is due to other, extraneous reasons, it is not actionable under Article 8(5) EUTMR.

Furthermore, as the Court observed, an association between the marks requires that the part of the **public that is already familiar with the earlier mark** is also **exposed to the later mark**. This will be easier to establish where the earlier mark is known to the public at large, or where the consumers of the respective goods and services largely overlap. However, in cases where the goods and services are significantly different from each other and such a connection between the respective publics is not obvious, the opponent must justify why the marks will be associated, by reference to some other link between its activities and those of the applicant, for example where the earlier mark is exploited outside its natural market sector, for instance, by licensing or merchandising (see paragraph 3.3 above).

Earlier reputed sign	EUTM application	Case No
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TWITTER		16/03/2012, R 1074/2011-5, Twitter (fig.) / TWITTER
Repute for services in Classes 38, 42 and 45, inter alia, <i>a website for social networking</i>	Classes 14, 18 and 25	
<p>The Board defined the relevant public as the average European consumer of the goods applied for, which are ordinary goods meant for the general public.</p> <p>The Board found it likely that the applicant's goods could be seen as merchandising products coming from the opponent. Items such as t-shirts, key chains, watches, hand bags, jewellery, caps, etc., are very frequently used as marketing means bearing trade marks that relate to entirely distinct goods and services. Upon encountering the sign TWITTER used on a watch, a scarf or a t-shirt, the relevant consumer would inevitably make a mental connection with the opponent's sign and the services it offers, on account of the reputation of the opponent's mark. This would give the applicant a competitive advantage since its goods would benefit from the extra attractiveness they would gain from the association with the opponent's older mark. Buying a TWITTER watch as a present for someone who is known to be a TWITTER user is, for example, an action motivated by the fondness for the earlier mark (para. 40).</p>		

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 to it (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).

Therefore, the evaluation of detriment or unfair advantage must be based on an overall assessment of all the factors relevant to the case (including in particular the similarity of signs, the reputation of the earlier mark, and the respective consumer groups and market sectors), with a view to determining whether the marks may be associated in a way that may adversely affect the earlier trade mark.

In *MacCoffee/McDonald's*, the General Court found that the existence of a 'Mc' family of marks was a key factor to take into account when assessing whether there was an unfair advantage. (05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 103).

### 3.4.3 Types of injury

Article 8(5) EUTMR refers to the following types of injury: 'take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'. Therefore, Article 8(5) EUTMR applies if any of the following **three alternative requirements** is fulfilled, namely if use of the contested mark would:

- take unfair advantage of the distinctiveness, or the repute of the earlier mark;

- cause detriment to the distinctiveness;
- cause detriment to the repute.

As regards the first type of injury, the wording of Article 8(5) EUTMR suggests the existence of two kinds of unfair advantage, but settled case-law treats both as a single injury under Article 8(5) EUTMR (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 47). For the sake of completeness, both aspects of the same injury will be dealt with under paragraph 3.4.3.1 below.

As demonstrated in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, likelihood of confusion relates **only** to confusion about the commercial origin of goods and services. Article 8(5) EUTMR, in contrast, protects earlier **reputed** marks in cases of association or confusion that does not necessarily relate to the commercial origin of goods/services. Article 8(5) EUTMR protects the heightened effort and financial investment that is involved in creating and promoting trade marks to the extent that they become reputed by protecting these marks against later similar marks taking unfair advantage of, or being detrimental to, the distinctive character or the repute of the earlier trade mark. There is a rich lexicon of vocabulary that is used in relation to this area of trade mark law. The most common terms are set out below.

Terms in Article 8(5) EUTMR	Commonly used equivalents
Unfair advantage	Free-riding, riding on the coat-tails
Detriment to distinctiveness	Dilution by blurring, dilution, blurring, watering down, debilitating, whittling away
Detriment to repute	Dilution by tarnishing, tarnishment, degradation

### 3.4.3.1 Taking unfair advantage of distinctiveness or repute


#### The nature of the injury

The notion of taking **unfair advantage of distinctiveness or repute** covers cases where the applicant benefits from the attractiveness of the earlier right by affixing on its goods/services a sign that is similar (or identical) to one widely known in the market and, thus, misappropriating its attractive powers and advertising value or exploiting its reputation, image and prestige. This may lead to unacceptable situations of commercial parasitism, where the applicant is allowed to take a 'free ride' on the investment of the opponent in promoting and building up goodwill for its mark, as it may stimulate sales of the applicant's products to an extent that is disproportionately high in comparison with the size of its promotional investment.

In its judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, the Court indicated that unfair advantage exists where there is a transfer of the image of the mark or of the characteristics that it projects to the goods identified by the identical or similar sign. By

riding on the coat-tails of the reputed mark, the applicant benefits from the power of attraction, reputation and prestige of the reputed mark. The applicant also exploits, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the image of that mark (§ 41, 49).

Earlier reputed sign	EUTM application	Case No
Spa Les Thermes de Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
The concept of taking unfair advantage of the distinctive character or the repute of the earlier mark must be intended to encompass instances where there is clear exploitation and riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (see to that effect Opinion of Advocate General Jacobs in <i>Adidas</i> , para. 39) (para. 51).		

Earlier reputed sign	EUTM application	Case No
RSC-ROYAL SHAKESPEARE COMPANY 	Royal Shakespeare	06/07/2012, T-60/10, EU:T:2012:348
The unfair advantage taken of the distinctive character or the repute of the earlier trade mark consists in the fact that the image of the mark with a reputation or the characteristics that it projects will be transferred to the goods covered by the mark applied for, with the result that the marketing of those goods can be made easier by the association with the earlier mark with a reputation (para. 48).		

### Relevant consumer

The concept of 'unfair advantage' focuses on benefit to the later mark rather than harm to the earlier mark; what is prohibited is the exploitation of the earlier mark by the proprietor of the later mark. Accordingly, the existence of the injury consisting of unfair advantage obtained from the distinctive character or repute of the earlier mark must be assessed **by reference to average consumers of the goods or services for which the later mark is** applied for (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35-36; 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 46-48; 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 35).

### The assessment of unfair advantage

In order to determine whether the use of a sign takes unfair advantage of the distinctive character or repute of the mark, it is necessary to undertake an **overall assessment**, which takes into account all the factors relevant to the circumstances of the case (10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 53, confirmed 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146; see also 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 misappropriation of the distinctiveness and repute of the earlier mark presupposes an **association** between the respective marks, which **makes possible the transfer of attractiveness and prestige** to the sign applied for. An association of this kind will be more likely in the following circumstances.

1. Where the earlier mark possesses a **strong reputation or a very strong (inherent) distinctive character**, because in such a case it will be both more tempting for the applicant to try to benefit from its value and easier to associate it with the sign applied for. Such marks will be recognised in almost any context, exactly because of their outstanding distinctiveness or 'good' or 'special' reputation, in the sense that it reflects an image of excellence, reliability or quality, or some other positive message, which could positively influence the choice of the consumer as regards goods of other producers (12/07/2011, C-324/09, L'Oréal-eBay, EU:C:2011:474, § 44). The stronger the distinctive character of the earlier mark, the more likely it is that, when encountering a later identical or similar mark, the relevant public will associate it with that earlier mark (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 27).
2. Where the degree of similarity between the **signs** at issue is high. The more similar the marks are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 26; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 44).
3. Where there is a **special connection** between the goods/services, which allows for some of the qualities of the opponent's goods/services to be attributed to those of the applicant. This will be particularly so in the case of **neighbouring markets**, where a 'brand extension' would seem more natural, as in the example of *pharmaceuticals* and *cosmetics*; the healing properties of the former may be presumed in the latter when it bears the same mark. Similarly, the Court has held that certain drinks (Classes 32 and 33) commercialised as improving sexual performance were linked to the properties of the goods in Class 5 (pharmaceutical and veterinary products and substances) for which the earlier mark, Viagra, was registered (25/01/2012, T-332/10, Viaguara, EU:T:2012:26, § 74). Conversely, such a link was not found between *credit card services* and *cosmetics*, as it was thought that the image of the former is not transferable to the latter, even though their respective users largely coincide.
4. Where, in view of its special attractiveness and prestige, the earlier mark may be **exploited even outside its natural market sector**, for example, by licensing or merchandising. In this case, if the applicant uses a sign that is identical or similar to the earlier mark for goods for which the latter is already exploited, it will obviously profit from its de facto value in that sector (16/03/2012, R 1074/2011-5, Twitter (fig.) / TWITTER).

The applicant's intention is not a material factor. Taking unfair advantage of the distinctiveness or repute of a trade mark may be a **deliberate decision**, for example

where there is clear exploitation and 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).

Therefore, bad faith is not in itself a condition for the application of Article 8(5) EUTMR, which only requires that the advantage be '**unfair**', in that there is **no justification** for the applicant's profit. However, where the evidence shows that the applicant is clearly acting in bad faith, there will be a strong indication of unfair advantage. The existence of bad faith may be inferred from various factors, such as an obvious attempt by the applicant to imitate an earlier sign of great distinctiveness as closely as possible, or where there is no apparent reason why it chose for its goods a mark that includes such a sign.

Finally, the concept of unfair advantage in Article 8(5) EUTMR does not relate to the **detriment** caused to the reputed mark. Accordingly, advantage taken by a third party of the distinctive character or repute of the mark may be unfair even if the use of the identical or similar sign is not detrimental to the distinctive character or repute of the mark or, more generally, to its proprietor. It is, therefore, not necessary for the opponent to show that the applicant's benefit is detrimental to its economic interests or to the image of its mark (unlike with tarnishing, see below), as in most cases the 'borrowed' distinctiveness/prestige of the sign will principally affect the applicant's competitors, that is, traders dealing in identical/similar/neighbouring markets, by putting them at a competitive disadvantage. However, the possibility of simultaneous detriment to the opponent's interests should not be ruled out completely, especially in instances where use of the sign applied for could affect the opponent's merchandising schemes, or would hinder its plans to penetrate a new market sector.


#### Cases on unfair advantage

##### *Risk of unfair advantage established*

Earlier reputed sign	EUTM application	Case No
INTEL	INTELMARK	26/06/2008, C-252/07, EU:C:2008:370




In her opinion in the *Intel* preliminary ruling, Advocate General Sharpston referred to unfair advantage as follows: 'The concepts of taking unfair advantage of the distinctive character or repute of the mark in contrast must be intended to encompass "instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation". Thus by way of example Rolls Royce would be entitled to prevent a manufacturer of whisky from exploiting the reputation of the Rolls Royce mark in order to promote his brand. It is not obvious that there is any real difference between taking advantage of a mark's distinctive character and taking advantage of its repute; since however nothing turns on any such difference in the present case, I shall refer to both as free-riding' (para. 33).

Earlier reputed sign	EUTM application	Case No
CITIBANK et al.		16/04/2008, EU:T:2008:112 T-181/05,
<p>'... the reputation of the trade mark CITIBANK in the European Community in regard to banking services is not disputed. That reputation is associated with features of the banking sector, namely, solvency, probity and financial support to private and commercial clients in their professional and investment activities.'</p> <p>'...there is a clear relationship ... between the services of customs agencies and the financial services offered by banks such as the applicants, in that clients who are involved in international trade and in the import and export of goods also use the financial and banking services, which such transactions require. It follows that there is a probability that such clients will be familiar with the applicants' bank given its extensive reputation at international level.'</p> <p>'In those circumstances, the Court holds that there is a high probability that the use of the trade mark applied for, CITI, by customs agencies, and therefore for financial agency activities in the management of money and real estate for clients, may lead to free-riding, that is to say, it would take unfair advantage of the well-established reputation of the trade mark CITIBANK and the considerable investments undertaken by the applicants to achieve that reputation. That use of the trade mark applied for, CITI, could also lead to the perception that the intervener is associated with or belongs to the applicants and, therefore, could facilitate the marketing of services covered by the trade mark applied for. That risk is further increased because the applicants are the holders of several trade marks containing the component "citi"' (paras 81 to 83).</p>		


Earlier reputed sign	EUTM application	Case No
Spa	Mineral Spa	19/06/2008, EU:T:2008:215 T-93/06,

MINERAL SPA (for *soaps, perfumeries, essential oils, preparations for body and beauty care, preparations for the hair, dentifrices* in Class 3) could take unfair advantage of the image of the earlier trade mark SPA and the message conveyed by it in that the goods covered by the contested application would be perceived by the relevant public as supplying health, beauty and purity. It is not a question of whether toothpaste and perfume contain mineral water, but whether the public may think that the goods concerned are produced from or with mineral water (paras 43 and 44).

Earlier reputed sign	Case No
L'Oréal et al.	12/07/2011, C-324/09, EU:C:2011:474
<p>According to L'Oréal et al., the defendants manufactured and imported perfume that was a 'smellalike' of L'Oréal's fragrances but sold at a considerably lower price, using packaging that was reminiscent of the get-up covered by L'Oréal's marks. The defendants used comparison lists to present the perfumes, which they marketed as being imitations or replicas of goods bearing a trade mark with repute. Under Council Directive 84/450/EEC, comparative advertising that presents the advertiser's products as an imitation of a product bearing a trade mark is inconsistent with fair competition and thus unlawful. Therefore, any advantage gained by the advertiser through such advertising will have been achieved as a result of unfair competition and must be regarded as taking unfair advantage of the reputation of that mark).</p>	

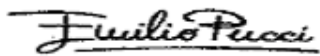

Earlier reputed sign	EUTM application	Case No
Nasdaq		10/05/2007, T-47/06, EU:T:2007:131
<p>'Taking account of the fact that the financial and stock market listing services supplied by the intervener under its trade mark Nasdaq and, therefore, the trade mark Nasdaq itself, undeniably present a certain image of modernity [the link between the signs] enables the transfer of that image to sports equipment and, in particular, to the high-tech composite materials which would be marketed by the applicant under the mark applied for, which the applicant appears to recognise implicitly by stating that the word 'nasdaq' is descriptive of its main activities.</p> <p>Therefore, in light of that evidence, and taking account of the similarity of the marks at issue, the importance of the reputation and the highly distinctive character of the trade mark Nasdaq, it must be held that the intervener has established prima facie the existence of a future risk, which is not hypothetical, of unfair advantage being drawn by the applicant, by the use of the mark applied for, from the reputation of the trade mark Nasdaq. There is therefore no need to set aside the contested decision on that point' (paras 60 and 61).</p>		

Earlier reputed sign	EUTM application	Case No
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RSC-ROYAL SHAKESPEARE COMPANY  	Royal Shakespeare	06/07/2012, EU:T:2012:348	T-60/10,
<p>There is a certain proximity and link between <i>entertainment services</i> and <i>beer</i>, even a certain similarity due to their complementarity. The public in the United Kingdom would be able to make a link with the Royal Shakespeare Company (RSC) when seeing a beer with the contested mark Royal Shakespeare in a supermarket or in a bar. The contested mark would benefit from the power of attraction, the reputation and the prestige of the earlier mark for its own goods and services, which would attract the consumers' attention thanks to the association with RSC, thereby gaining a commercial advantage over its competitors' goods. The economic advantage would consist of exploiting the effort expended by RSC to establish the reputation and the image of its earlier mark without paying any compensation in exchange. That equates to an unfair advantage (para. 61).</p>			

Earlier reputed sign	EUTM application	Case No	
Viagra	Viagura	25/01/2012, EU:T:2012:26	T-332/10,
<p>While recognising that the primary function of a trade mark was as an indicator of origin, the General Court held that a mark could also serve to transmit other messages, concerning particular qualities or characteristics of the designated goods or services, or the images and sensations projected by the mark itself, such as luxury, lifestyle, exclusivity, adventure or youth. In this sense, a trade mark possessed an intrinsic economic value that was autonomous and distinct to that of the goods or services for which it was registered (para. 57).</p> <p>The risk of taking unfair advantage encompasses cases of manifest exploitation or parasitism of a mark with reputation, namely the risk of transferring the image of the mark with reputation or the characteristics projected by it to the goods covered by the mark applied for, thus facilitating the marketing of those goods through association with the earlier mark with reputation (para. 59).</p> <p>The Court concluded that, even if the drinks claimed by the mark applied for would not in reality produce the same benefit as the 'immensely well-known' pharmaceutical for the treatment of erectile dysfunction, what was important was that the consumer, because of the transfer of positive associations projected by the image of the earlier mark, would be inclined to purchase such drinks in the expectation of finding similar qualities, such as an increase in libido (paras 52 and 67).</p>			

Earlier reputed sign	EUTM application	Case No	
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EMILIO PUCCI 		27/09/2012, T-373/09, Emidio Tucci, EU:T:2012:500 (18/06/2009, R 770/2008-2 & R 826/2008-2, EMIDIO TUCCI (fig.) / EMILIO PUCCI (fig.))
<p>Although the applicant's cosmetic products are dissimilar to the opponent's clothes, they both fall squarely within the realm of products that are often sold as luxury items under famous marks of well-known designers and manufacturers. Taking into account that the earlier mark is very well known and that the commercial contexts in which the goods are promoted are relatively close, BoA concluded that consumers of luxury clothes will make a connection between the applicant's mark for soaps, perfumery, essential oils, cosmetics and hair lotions in Class 3 and the famous mark 'EMILIO PUCCI', an association that will produce a commercial benefit as per the Board's findings (BoA para. 129).</p> <p>BoA concluded that there was a strong likelihood that the applicant could exploit the reputation of the opponent's mark for its own benefit. The use of the mark applied for in connection with the goods and services mentioned above will almost certainly draw the relevant consumer's attention to the opponent's highly similar and very well-known mark. The applicant will become associated with the aura of luxury that surrounds the 'EMILIO PUCCI' brand. Many consumers are likely to think that there is a direct connection between the applicant's goods on the one hand, and the famous Italian fashion house on the other, perhaps in the form of a licensing agreement. The applicant could take unfair advantage of the fact that the public knows the trade mark 'EMILIO PUCCI' well in order to introduce its own highly similar trade mark without incurring any great risk or the costs of introducing a totally unknown trade mark onto the market (BoA para. 130).</p> <p>The General Court confirmed the BoA findings.</p>		

### *Risk of unfair advantage denied*

Earlier reputed sign	EUTM application	Case No
O2 		03/07/2012, R 2304/2010-2, O2 0% MDI emission (fig.) / O2 et al.
<p>The Board of Appeal found that (1) the marks have very limited similarities and are dissimilar overall; (2) use of the common designation 'O2' is descriptive in the mark applied for; and (3) given the completely different areas of use — and the descriptive use of the common element — there can be no possibility of the applicant benefiting from the distinctive character of the earlier mark, even if there may be an overlap in the relevant public (para. 55).</p>		

Earlier reputed sign	EUTM application	Case No
Vips	Vips	22/03/2007, T-215/03, EU:T:2007:93
<p>The earlier mark Vips has a reputation for restaurants, in particular fast-food chains. However, it was not proven that it also enjoys any particular prestige. The term Vips is laudatory in itself and extensively used in this manner. There is no explanation as to how the sales of software products under the mark Vips could possibly benefit from their association with a fast-food chain, even if a link were made. Therefore, the Court rules out the risk that use of the mark applied for would take unfair advantage of the distinctive character or repute of the earlier mark.</p>		

Earlier reputed sign	EUTM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
<p>Spa has a reputation for <i>mineral water</i> in the Benelux. The contested mark, Spa-Finders, covers <i>publications, catalogues, magazines, newsletters, travel agency services</i>. The General Court declared that there was no detrimental link between the signs. The sign Spa is also used to denote the town of Spa and the racing circuit of the same name. There is no evidence of unfair advantage or any kind of exploitation of the fame of the earlier mark. The word Spa in the mark applied for only denotes the kind of publication concerned.</p>		

Earlier reputed sign	EUTM application	Case No
TDK	<b>TDK-EPC</b>	19/12/2014, R 2090/2013-2, TDK / TDK-EPC (fig.) et al.
<p>The earlier mark 'TDK' has a reputation within the European Union for 'audio and videotape goods'. The opponent argued that '[b]uilding and construction is a specific commercial area in which use of a TDK could diminish a reputation of the sort and nature of a company such as the opponent'. The Board found that this argument, which seems to be a mixture of allegations that there is detriment to the reputation and detriment to the distinctive character of the earlier mark, is no more than a mere statement, which is not corroborated by any evidence that would demonstrate <i>prima facie</i> a serious risk of change in economic behaviour or of a reduction in the trade mark's power of attraction.</p>		

### 3.4.3.2 Detriment to distinctiveness

#### The nature of the injury

Detriment to the distinctive character of an earlier reputed mark (also referred to as 'dilution', 'whittling away' or 'blurring') is caused when that mark's ability to identify the

goods/services for which it is registered and used as coming from its proprietor is weakened because use of a later similar mark leads to dispersion of the identity of the earlier reputed mark by making it less distinctive or unique (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 29).

Article 8(5) EUTMR states that a proprietor of a reputed mark may oppose EUTM applications that, without due cause, would be detrimental to the **distinctive character** of earlier reputed marks. Clearly, therefore, the object of protection is the **distinctiveness** of the earlier reputed mark. As demonstrated in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark, 'distinctiveness' refers to the greater or lesser capacity of a mark to identify the goods/services for which it has been registered as coming from a particular undertaking. Therefore, Article 8(5) EUTMR protects reputed marks against a reduction of their distinctive quality by a later similar mark even where the later mark relates to dissimilar goods/services.

Although the former wording of Article 8(5) EUTMR only referred to conflicts between dissimilar goods/services, in its judgments of 09/01/2003, C-292/00, Davidoff, EU:C:2003:9; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, the Court held that this Article also covers similar or identical goods/services.

The protection provided in Article 8(5) EUTMR, therefore, acknowledges that unrestrained use of a reputed mark by third parties, even on dissimilar goods, will eventually reduce the distinctive quality or uniqueness of that reputed mark. For example, if Rolls Royce were used on restaurants, pants, candy, plastic pens, yard brushes, etc., its distinctiveness would eventually be dispersed and its special hold upon the public would be reduced — even in relation to cars, for which it is reputed. Consequently, the Rolls Royce mark's ability to identify the goods/services for which it is registered and used as coming from its proprietor would be weakened in the sense that consumers of the goods for which the reputed mark is protected and reputed will be less inclined to associate it **immediately** with the owner that has built up the trade mark's reputation. This is because, for those consumers, the mark now has several or many 'other' associations, where it previously had only one.

#### Relevant consumer

Detriment to the distinctive character of the earlier reputed mark must be assessed by reference to the average consumers of the goods and services **for which that mark is registered**, who are reasonably well informed and reasonably observant and circumspect (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35).

#### The assessment of detriment to distinctiveness

Detriment to the distinctiveness of the earlier reputed mark occurs where use of a later similar mark reduces the distinctive quality of the earlier reputed mark. However, this cannot be found to occur merely because the earlier mark has a reputation and is identical with or similar to the mark applied for — such an approach would apply an automatic and indiscriminate finding of likelihood of dilution against all marks that are similar to reputed trade marks and would negate the requirement of proving detriment.

The Court held in *Intel* that Article 4(4)(a) of the First Council Directive 89/104/EEC (the equivalent of Article 8(5) EUTMR) must be interpreted as meaning that proof that use of the later mark would be detrimental to the distinctive character of the earlier mark requires evidence of a 'change in the economic behaviour' of the average consumer of the goods/services for which the earlier mark was registered, or a serious likelihood that such a change will occur in the future.

The Court has further elaborated on the concept of 'change in the economic behaviour of the average consumers' in its judgment of 14/11/2013, C-383/12 P, *Répresentation d'une tête de loup*, EU:C:2013:741. It indicated that it is an autonomous objective condition, which cannot be deduced solely from subjective elements such as how consumers perceive the dispersion of the reputed mark's image and identity. The mere fact that consumers note the presence of a new similar sign that is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the mark's proprietor, is not sufficient by itself to establish the existence of detriment or a risk of detriment to the distinctive character of the reputed mark (paras 35 to 40).

The Court insists on a 'higher standard' for establishing dilution. The following two **autonomous** conditions must be substantiated by the opponent and reasoned by the Office.

- Dispersion of the reputed mark's image and identity in the relevant public's perception (**subjective condition**).
- A change in the economic behaviour of this public (**objective condition**).

Whilst the opponent does not need to submit evidence of **actual** detriment, it must convince the Office by adducing evidence of a serious future risk — which is not merely hypothetical — of detriment. The opponent may do this by submitting evidence that proves a likelihood of detriment on the basis of logical deductions made from an analysis of the probabilities (and not mere suppositions), and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case (16/04/2008, T-181/05, *Citi*, EU:T:2008:112, § 78, as cited in 22/05/2012, T-570/10, *Répresentation d'une tête de loup*, EU:T:2012:250, § 52; confirmed 14/11/2013, C-383/12 P, *Répresentation d'une tête de loup*, EU:C:2013:741, § 42-43).

#### First use

Detriment to distinctive character is characterised by an 'avalanche effect', meaning that the first use of a similar mark in a distinct market may not, in itself, dilute the identity or 'uniqueness' of the reputed mark but, over time, this would be the result, because this first use may trigger further acts of use by different operators, thus leading to its dilution or detriment to its distinctive character.

The Court has held that the first use of an identical or similar mark **may** suffice, **in some circumstances**, to cause actual and present detriment to the distinctive character of the earlier mark or to give rise to a serious likelihood that such detriment will occur in the future (27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 75). In opposition proceedings before the Office, use of the contested sign may not have occurred at all. In this regard, the Office takes into account that future use of the

contested sign, even if it were first use, may trigger further acts of use by different operators, under particular circumstances that are to be provided by the opponent, therefore leading to dilution by blurring. As seen above, the wording of Article 8(5) EUTMR provides for this by stating that use of the mark applied for without due cause '**would ... be** detrimental to ... the distinctive character or the repute of the earlier trade mark'.

Nevertheless, as set out above, the opponent bears the burden of showing that actual or future use causes, or is likely to cause, detriment to the distinctiveness of the earlier reputed mark.

#### Inherent distinctiveness of the earlier mark

The Court has stated that 'the more "unique" the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character' (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 74; 28/10/2010, T-131/09, Botumax, EU:T:2010:458). Indeed, the earlier mark must possess an exclusive character in the sense that it should be associated by the consumers with a single source of origin — since it is only in this case that a likelihood of detriment to distinctiveness may be envisaged. If the same sign, or a variation thereof, is already in use in connection with a range of different goods, there can be no immediate link with any of the goods it distinguishes and, thus, there will be little or no room for further dilution.

Accordingly, '... the risk of dilution appears, in principle, to be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used, irrespective of the earlier mark consisting of the term at issue. In such a case, reuse of the term in question by the mark applied for is less likely to result in a dilution of the earlier mark' (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 38).

If, therefore, the mark is suggestive of a characteristic shared by a wide range of goods, the consumer is more likely to associate it with the specific feature of the product that it alludes to rather than with another mark.

In its judgment of 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, the General Court confirmed the finding that the use of the mark Spa-Finders for *publications* and *travel agency* services would neither blur the distinctiveness nor tarnish the reputation of the mark Spa for *mineral water*. The term 'spa' in Spa-Finders may be used otherwise than in a trade mark context since it 'is frequently used to designate, for example, the Belgian town of Spa and the Belgian racing circuit of Spa-Francorchamps or, in general, places for hydrotherapy such as hammams or saunas, [and consequently] the risk of detriment to the distinctive character of the mark SPA seems to be limited' (para. 44).

Thus, if the applicant shows that the earlier sign or the element that gives rise to similarity is commonplace and is already used by different undertakings in various sectors of the market, it may successfully refute the existence of a likelihood of dilution, because it will be difficult to accept that the attractiveness of the earlier mark risks being diluted if it is not particularly unique.

#### Cases on dilution by blurring



*Dilution established*

Earlier reputed sign	EUTM application	Case No
		28/01/2014, R 69/2013-4, CAMEL BRAND (fig.) / CAMEL (fig.) et al.
Reputed for tobacco products	Foodstuffs in Classes 29, 30 and 32	

First of all, taking into account the very high similarity between the conflicting marks and the high reputation of the earlier mark, there is a risk that the public will be led to believe that the CAMEL food products originate from, or that the mark is used with the consent of, the opponent. Moreover, the capacity of the reputed CAMEL mark to arouse immediate association with the opponent's business will be diminished by the use of the contested mark. The use of a highly similar mark for food products would be detrimental to the distinctive character of the reputed CAMEL trade mark for tobacco products, making this mark ordinary, which is in essence a diminution of the power of attraction of the mark. This will lead to dispersion of the identity and hold upon the public's mind of the earlier mark. The earlier mark, used to arouse immediate association with the goods for which it is registered, will no longer be capable of doing so. It follows that there is a clear probability of damage to the earlier mark's advertising function as a vehicle for building up and retaining brand loyalty, and that the economic value of the earlier reputed mark will be impaired, in the medium or long term, as a consequence of the use of the contested mark, in the sense that consumers of the goods for which the reputed mark is protected and known will be less inclined to associate it immediately with the undertaking that has built up the trade mark's reputation; this must be considered a change in their economic behaviour (para. 41).

*Dilution denied*

Earlier reputed sign	EUTM application	Case No
Vips	Vips	22/03/2007, T-215/03, EU:T:2007:93
Reputed for <i>fast food restaurant chain</i> in Class 42	<i>Computer programming for hotel services</i> in Class 42	



'So far as concerns, first, detriment to the distinctive character of the earlier mark by the use without due cause of the mark applied for, that detriment can occur where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used (*SPA-FINDERS*, paragraph 34 above, paragraph 43). That risk thus refers to the "dilution" or "gradual whittling away" of the earlier mark through the dispersion of its identity and its hold upon the public mind (Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas-Benelux*, paragraph 36 above, point 37)' (para. 37).

'As far as concerns, first, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark, in other words the risk of "dilution" and "gradual whittling away" of that mark, as explained in paragraphs 37 and 38 above, it must be pointed out that the term "VIPS" is the plural form, in English, of the abbreviation VIP ("Very Important Person"), which is widely and frequently used both internationally and nationally to describe famous personalities. In those circumstances, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark is limited' (para. 62).

'That same risk is also even less probable in the present case as the mark applied for covers the services "Computer programming relating to hotel services, restaurants, cafés", which are directed at a special and necessarily more limited public, namely the owners of those establishments. The consequence is that the mark applied for, if registration is allowed, will probably be known, through use, only by that relatively limited public, a factor that certainly reduces the risk of dilution or gradual whittling away of the earlier mark through the dispersion of its identity and its hold upon the public mind' (para. 63).

Earlier reputed sign	EUTM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
Reputed for <i>mineral waters</i> in Class 32	<i>Printed publications including catalogues, magazines, newsletters in Class 16, Travel agency in Class 39</i>	

'In the present case, the Court finds that the applicant does not put forward any evidence to support the conclusion that there is a risk of detriment to the distinctive character of the mark SPA by the use of the mark SPA-FINDERS. The applicant stresses the alleged immediate link that the public will establish between SPA and SPA-FINDERS. It infers from that link that there is detriment to the distinctive character. As the applicant acknowledged at the hearing, the existence of such a link is not sufficient to demonstrate the risk of detriment to the distinctive character. The Court notes, moreover, that since the term "spa" is frequently used to designate, for example, the Belgian town of Spa and the Belgian racing circuit of Spa-Francorchamps or, in general, places for hydrotherapy such as hammams or saunas, the risk of detriment to the distinctive character of the mark SPA seems to be limited' (para. 44).

Earlier reputed sign	EUTM application	Case No
		14/11/2013, C-383/12 P, EU:C:2013:741
Reputed for <i>machine tools</i> in Class 7	<i>Machines for professional and industrial processing of wood and green waste; professional and industrial wood chippers and shredders</i> in Class 7	

In the present case, the Court of Justice annuls the judgment of the General Court by stating that the detriment or the risk of detriment to the distinctive character of the earlier marks cannot be established without adducing the evidence of ‘change in the economic behaviour of the average consumer’ (para. 36). While the dispersion of the reputed mark’s image and identity in the public’s perception is a subjective condition, the change in the economic behaviour of this public is objective. It cannot be deduced from the mere fact that consumers note the presence of a new similar sign in a way that is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark (paras 37 and 39). The General Court should have examined whether any actual change in economic behaviour had occurred, or was likely to occur, on the basis of ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’ (para. 43). Since it failed to do so, the General Court violated Article 8(5) EUTMR.

### 3.4.3.3 Detriment to repute

#### The nature of the injury

The final type of damage under Article 8(5) EUTMR concerns harming the earlier mark by way of detriment to its repute. It can be seen as a step beyond blurring in that the mark is not merely weakened but actually degraded by the link that the public makes with the later mark. Detriment to repute, also often referred to as 'dilution by tarnishing' or simply as 'tarnishing', relates to situations where use of the contested mark without due cause is likely to devalue the image or the prestige that a mark with reputation has acquired among the public.

The reputation of the earlier trade mark may be tainted or debased in this way, either when it is reproduced in an obscene, degrading or inappropriate context, or in a context that is not inherently unpleasant but that proves to be incompatible with a particular image the earlier trade mark has acquired in the eyes of the public due to the

promotional efforts of its owner. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality that is liable to have a negative impact on the image of the mark (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 40). For example, if a reputed mark for gin were used by a third party on liquid detergent, this would reverberate negatively on the reputed mark in a way that makes it less attractive.

In short, tarnishment occurs where there is an association between the earlier reputed mark, at the level of either the signs or the goods, that is injurious to the earlier trade mark's repute.

#### Relevant consumer

As with dilution by blurring, detriment to the reputation of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35; 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 35).

#### The assessment of tarnishment

In order to establish detriment to the repute of an earlier mark, the mere existence of a connection in the mind of the consumer between the marks is neither sufficient nor determinative. Such a connection must certainly exist, but, **in addition**, either the signs or the goods/services covered by the later mark must provoke a negative or detrimental impact when associated with the reputed mark.

For example, if a mark that is associated in the minds of the public with an image of health, dynamism and youth is used for *tobacco products*, the negative connotation conveyed by the latter would contrast strikingly with the image of the former (see further examples below). For tarnishment to occur, therefore, the goods/services on which the contested mark is used must have characteristics or qualities that are potentially detrimental to the reputation of the earlier mark (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 67).


Frequently, opponents argue that the applicant's goods/services are of inferior quality or that the opponent cannot control the quality of such goods/services. The Office does not accept such an argument, per se, as a means of demonstrating detriment. Proceedings before the Office do not provide for assessing the quality of goods and services, which, apart from being highly subjective, would not be feasible in cases where the goods and services are not identical or in situations where the contested sign has not yet been put to use.



Therefore, when assessing whether use of the contested trade mark is likely to damage the reputation of an earlier trade mark, the Office can only consider the goods and services as indicated in the specification of each trade mark. Consequently, for the purposes of the Office's analysis, the harmful effects of use of the contested sign in connection with the goods and services applied for must derive from the nature and usual characteristics of the goods at issue in general, not their quality in particular instances. This approach does not leave the opponent without protection, because, where a later mark is used on low-quality goods/services in a manner that calls to mind


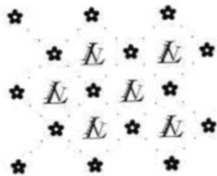
an earlier reputed mark, this would in any case normally take unfair advantage of the distinctive character or repute of the earlier trade mark or be detrimental to its distinctiveness.

### Cases on dilution by tarnishing

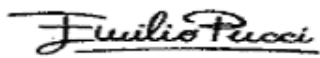
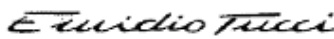
#### *Tarnishment established*

Earlier reputed sign	EUTM application	Case No
KAPPA 	KAPPA	12/03/2012, R 297/2011-5, KAPPA / KAPPA et al.
Reputed for <i>sports clothing and footwear</i>	<i>tobacco products, cigarettes, cigars, amongst others</i>	
The contested application was filed for tobacco and related goods in Class 34. Smoking tobacco is universally considered to be an extremely unhealthy habit. For this reason, use of the sign KAPPA for tobacco and related goods is likely to prompt negative mental associations with the respondent's earlier marks or associations, conflicting with and being detrimental to their image of a healthy lifestyle (para. 38).		



Earlier reputed sign	EUTM application	Case No
		22/07/2010, R 417/2008-1, SPACE NK (fig.) / SPA, LES THERMES DE SPA et al.
Reputed for <i>mineral waters</i>	<i>Scouring and polishing preparations and substances; pot pourri; incense; incense sticks; room fragrances and articles for perfuming rooms</i>	
<p>The pleasant notions conveyed generally by mineral water do not mix seamlessly with detergents and scouring preparations. Use of marks that contain the word SPA for goods conveying such different connotations is likely to damage, or tarnish, the distinctive character of the earlier mark (para. 101).</p> <p>'Mineral water is not pleasantly associated by most consumers with incense or pots pourris. The use, in order to distinguish fragrances and incense, of a mark containing a word (SPA) that Belgian consumers strongly associate to bottled drinking water is therefore likely to damage the attractive and suggestive power that the brand, according to the evidence, currently enjoys' (para. 103).</p>		

Earlier reputed sign	EUTM application	Case No
		06/10/2011, R 2124/2010-1, LN (fig.) / LV (fig.) et al.
Reputed for goods in Classes 18 and 25	<i>Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; amongst others.</i>	
<p>The opponent demonstrated that the prestigious image of its trade marks is linked to the traditional manufacturing method of its fine leather goods, which are handmade by master craftsmen who work only with top-quality raw materials. It is this image of luxury, glamour and exclusivity, combined with the exceptional quality of the product, that the opponent has always striven to convey to the public, as the evidence adduced testifies. This image would be quite incompatible with goods of a strongly industrial and technological nature, such as electric meters, scientific microscopes, batteries, supermarket cash registers, fire-extinguishing apparatus or other instruments, for which the applicant intends to use its trade mark (para. 28).</p> <p>What would be detrimental to the image of its trade marks, which the opponent has carefully fostered for decades, is the use of a trade mark that recalls its own and is applied to goods characterised, in the public's perception, by a significant technological content (whereas a fine-leather article is rarely associated with technology) or as having an industrial origin (whereas fine leather goods are traditionally associated with craftsmanship) (para. 29).</p> <p>The use of a trade mark that is practically identical to a trade mark that the public has come to perceive as synonymous with fine leather goods of excellent manufacture for technical apparatus or electrical tools of all kinds will diminish its attraction, that is, its reputation, amongst the public that knows and values the earlier trade marks (para. 30).</p>		

Earlier reputed sign	EUTM application	Case No
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EMILIO PUCCI 		
Reputed for <i>clothing and footwear for women</i>	Class 3: <i>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; (abrasive preparations) soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</i>  Class 21: <i>Materials for cleaning purposes and steelwool</i>	27/09/2012, T-373/09  (R 770/2008-2 & R 826/2008-2)
In its decisions of 18/06/2009 in R 770/2008-2 & R 826/2008-2, the Board stated that the risk of detriment to repute can occur where the goods and services covered by the mark applied for have a characteristic or a quality that may have a negative influence on the image of an earlier mark with a reputation on account of the mark applied for being identical or similar to the earlier mark with reputation. The General Court confirmed the Board's finding, adding that due to the great similarity between the signs at issue, the strong distinctive character of the Italian mark and its repute in the Italian market, it can be concluded that there is a link between the signs in conflict — a link that could damage the idea of exclusivity, luxury and high quality and therefore be detrimental to the repute of the Italian mark (para. 68).		

*Tarnishment denied*

Earlier reputed sign	EUTM application	Case No
		17/12/2010, T-192/09, EU:T:2010:553
Reputed for <i>organisation of sports competitions</i>	Class 9	
The Court noted that the opponent had not demonstrated any risk of injury to the reputation of the earlier marks, since it had not indicated how the attractiveness of the earlier marks would be diminished by use of the contested mark on the contested goods. Specifically, it did not allege that the contested goods have any characteristic or quality that could have a negative influence on the image of the earlier marks (para. 68).		

Earlier reputed sign	EUTM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
Reputed for <i>mineral waters</i> in Class 32	<i>Printed publications including catalogues, magazines, newsletters</i> in Class 16, <i>Travel agency</i> in Class 39	
<p>'In the present case, SPA and SPA-FINDERS designate very different goods consisting, on the one hand, in mineral waters and, on the other, in publications and travel agency services. The Court finds that it is therefore unlikely that the goods and services covered by the mark SPA-FINDERS, even if they turn out to be of lower quality, would diminish the power of attraction of the mark SPA' (para. 49).</p>		


Earlier reputed sign	EUTM application	Case No
Vips	Vips	22/03/2007, T-215/03, EU:T:2007:93
Reputed for <i>fast food restaurant chain</i> in Class 42	<i>Computer programming for hotel services</i> in Class 42	

The Court pointed out that, ‘although some fast food chain marks have an indisputable reputation, they do not, in principle and failing evidence to the contrary, convey a particularly prestigious or high-quality image, the fast food sector being associated with other qualities, such as speed or availability and, to a certain extent, youth, since many young people frequent that type of establishment’ (para. 57)

The Court further stated that ‘the services covered by the mark applied for do not have any characteristic or quality capable of establishing the likelihood of detriment of that type to the earlier mark. The applicant neither cited, nor a fortiori proved, any characteristic or quality of that kind. The mere existence of a connection between the services covered by the conflicting marks is neither sufficient nor determinative. It is true that the existence of such a connection strengthens the probability that the public, faced with the mark applied for, would also think of the earlier mark. However, that factor is not, in itself, sufficient to diminish the earlier mark’s power of attraction. Such an outcome can arise only if it is established that the services covered by the mark applied for have characteristics or qualities that are potentially detrimental to the reputation of the earlier mark. Such evidence has not been adduced in the present case’ (para. 67).

Earlier reputed sign	EUTM application	Case No
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WATERFORD		23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig.) / WATERFORD
Reputed for <i>crystal products, including glassware</i> in Class 21	<i>Alcoholic beverages, namely wines produced in the Stellenbosch district, South Africa</i> in Class 33	
<p>'In the present case, on the one hand, it is not possible to attribute from the outset either any specific image to the reputed trade mark or any <i>prima facie</i> evidence of its tarnishment. On the other hand, the opponent has confined itself to pleading that "use and registration of the [contested] trade mark will take unfair advantage of the opponent's trade mark", without giving any evidence or <i>prima facie</i> evidence, even only by way of logical deductions, of such tarnishment. On the contrary, the Board finds no antagonism between either the nature or the way of using glassware and wine, such as that the use of the contested mark might tarnish the earlier mark's image.' (para. 91).</p>		

### 3.4.4 Proving the risk of injury

#### 3.4.4.1 Standard and burden of proof

In opposition proceedings **detriment or unfair advantage may be only potential**, as confirmed by the conditional wording of Article 8(5) EUTMR, which requires that the use of the applied-for mark without due cause '**would take** unfair advantage of, **or be** detrimental to the distinctiveness or repute of the earlier mark'.

In opposition proceedings **actual detriment or unfair advantage** will occur only exceptionally, since in most cases the applicant will not have effectively used its mark when the dispute arises. Nevertheless, such a possibility should not be ruled out completely and if there is evidence of actual use or damage, it will have to be considered and given appropriate weight.

However, the fact that detriment or unfair advantage may be only potential does not mean that a mere possibility is sufficient for the purposes of Article 8(5) EUTMR. The risk of detriment or unfair advantage must be **serious**, in the sense that it is **foreseeable (i.e. not merely hypothetical) in the ordinary course of events**. Therefore, it is not enough to merely show that detriment or unfair advantage cannot be excluded in general, or that it is only remotely possible. The proprietor of the earlier mark **must adduce prima facie evidence** of a future risk, which is **not hypothetical**, of unfair advantage or of detriment (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53). As explained below, it is insufficient for the opponent only to refer in general terms to unfair advantage being taken of, or to detriment to, the distinctive character or reputation of its earlier marks without submitting convincing

evidence of actual detriment or cogent arguments establishing a serious, not merely hypothetical, potential risk of detriment.

As a rule, **general allegations** (such as merely citing the relevant EUTMR wording) of detriment or unfair advantage will **not be sufficient** in themselves for proving potential detriment or unfair advantage: the opponent must adduce evidence and/or develop a cogent line of argument to demonstrate specifically how the alleged injury might occur, taking into account both marks, the goods and services in question and all the relevant circumstances. **Merely showing the reputation and good image of the earlier marks, without further substantiation by way of evidence and/or reasoning is not sufficient** (15/02/2012, R 2559/2010-1, GALLO / GALLO (fig.) et al., § 38-39, and the Court case-law cited therein). This is shown in the following paragraphs.

The precise threshold of proof that must be satisfied to show that the risk of potential detriment or unfair advantage is **serious** and not merely hypothetical will be determined case by case, following the criteria indicated below.

As mentioned in paragraph 3.1.4.2 above when discussing the burden of proof for establishing reputation, Article 95(1) EUTMR requires the opponent to submit and prove all the facts on which its opposition is based. Moreover, Article 7(2)(f) EUTMDR requires the opponent to **submit evidence or arguments** showing that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, within the period for completing the substantiation of the opposition, the **opponent bears the burden** of showing that actual or future use of the mark applied for has caused, or is likely to cause, detriment to the distinctiveness or the repute of the earlier mark, or that the mark applied for has taken, or is likely to take, unfair advantage of the earlier mark.

In discharging this burden of proof, the opponent cannot merely contend that detriment or unfair advantage would be a necessary consequence flowing automatically from use of the sign applied for, owing to the strong reputation of the earlier mark. Even where the earlier mark is highly reputed, unfair advantage or detriment must be **properly proved and/or argued**, taking into account both marks and the relevant goods and services, since, otherwise, marks with reputation would enjoy blanket protection against identical or similar signs for virtually any kind of product. This would be clearly inconsistent with the wording and spirit of Article 8(5) EUTMR, because in such a case reputation would become the sole requirement, rather than being only one of several conditions provided for therein.

Therefore, where the opponent claims **actual detriment or unfair advantage**, it must submit indications and evidence of the **kind** of detriment suffered, or of the nature of the unfair advantage taken by the applicant. The opponent must also show that this **resulted from use** of the sign applied for. In doing so, the opponent may rely on a variety of indications, depending on the kind of detriment or unfair advantage pleaded, such as a considerable decrease in sales of the goods bearing the mark, or a loss of clientele, or a decline of the degree of recognition of the earlier mark among the public.

However, in the case of **potential detriment or unfair advantage**, the exercise will necessarily be more abstract, as the detriment or unfair advantage in question has to be evaluated *ex ante*.

To that end, the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark. When it is foreseeable that such injury would ensue from the use that might be made of the EUTM application, the proprietor of the earlier mark is not required to wait for it actually to occur in order to be able to prohibit registration of the EUTM application. The proprietor of the earlier mark must, however, prove that there is a **serious risk** that such an injury will occur in the future (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 38; 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 33; 29/03/2012, T-369/10, Beatle, EU:T:2012:177, § 61 (appeal dismissed 14/05/2013, C-294/12 P, Beatle, EU:C:2013:300); 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53; 25/01/2012, T-332/10, Viaguara, EU:T:2012:26, § 25).

Such a finding may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case (10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 54, upheld on appeal 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146; 16/04/2008, T-181/05, Citi, EU:T:2008:112, § 78; 14/11/2013, C-383/12 P, Répresentation d'une tête de loup, EU:C:2013:741, § 42-43).

However, considering that in such cases what has to be proved is the likelihood of a future event and that, by definition, the opponent's arguments cannot in themselves amount to evidence, it will often be necessary to base certain conclusions on **legal presumptions**, that is, on logical assumptions or deductions resulting from the application of the rules of probability to the facts of the specific case. One such presumption was mentioned by the Court, when it stated that 'the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it' (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 30).

It is also clear from case-law that the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that current or future use of the sign takes, or will take, unfair advantage of the distinctive character or the repute of the mark (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 54; 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 44; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 67-69).

These are rebuttable presumptions, which the applicant may contest and disprove by submitting appropriate evidence; they are not conclusive.

In addition, if the type of detriment or unfair advantage argued in the specific case is of such a nature to presuppose the fulfilment of certain **particular conditions of fact** (e.g. exclusive character of the earlier mark, qualitative aspects of reputation, a given image, etc.), these facts will also have to be proven by the opponent by submitting appropriate evidence.

Finally, as noted by the Court in its judgment of 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 57, 58, although likelihood of confusion between the

two marks at issue is not required to demonstrate that the later mark takes unfair advantage of the earlier mark, where such likelihood is established on the basis of facts, this will be taken as proof that unfair advantage has been taken or that, at least, there is a serious risk of such injury in the future.

#### 3.4.4.2 Means of evidence

Where the opponent claims **potential** detriment or unfair advantage, it must prove any conditions of fact that might be necessary in particular cases for giving rise to a serious, non-hypothetical risk of detriment or unfair advantage, by submitting evidence of the kind mentioned in the paragraph below on proving actual detriment or unfair advantage.

Conclusions as to the risk of future injury may also be established on the basis of **logical deductions** made from an analysis of the probabilities and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 82; 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53; 14/11/2013, C-383/12 P, Répresentation d'une tête de loup, EU:C:2013:741, § 42-43).

Where the opponent claims **actual** detriment or unfair advantage, it can use all the means of evidence provided for in **Article 97 EUTMR** for proving this. For example, it may prove an actual decrease of trade mark awareness by reference to opinion polls and other documentary evidence. The rules governing the evaluation and probative value of such evidence are the same as those mentioned in paragraph 3.1.4.3 and paragraph 3.1.4.4 above in relation to evidence required for proving reputation.

### 3.5 Use without due cause

The last condition for the application of Article 8(5) EUTMR is that use of the sign applied for should be without due cause.

However, if it is established that none of the three types of injury exists, the registration and use of the mark applied for cannot be prevented, as the existence or absence of due cause for use of the mark applied for is, in those circumstances, irrelevant (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 60; 07/07/2010, T-124/09, Carlo Roncato, EU:T:2010:290, § 51).

The existence of a cause justifying use of the trade mark applied for is a **defence** that the applicant may raise. Therefore, it **is up to the applicant to show that it has due cause to use the mark applied for**. This is an application of the general rule according to which 'he who asserts must prove', which is the expression of the ancient rule *ei qui affirmat incumbit probatio* (01/03/2004, R 145/2003-2, T CARD OLYMPICS (fig.) / OLYMPIC, § 23). Case-law clearly establishes that when the proprietor of the earlier mark has shown that there is either actual and present injury to its mark or, failing that, a serious risk that such injury will occur in the future, it is for the proprietor of the later mark to establish that there is due cause for the use of that mark

(06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 67; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 39).

In the absence of any indications in the evidence providing an apparent justification for the applicant's use of the contested mark, lack of due cause must be generally **presumed** (29/03/2012, T-369/10, Beatle, EU:T:2012:177, § 76 and case-law cited therein; 14/05/2013, C-294/12 P, Beatle, EU:C:2013:300, dismissing the appeal). However, the applicant may avail itself of the possibility of rebutting such a presumption by showing that it has a legitimate justification that entitles it to use the mark.

For example, such a situation could be envisaged if the applicant had been using the sign for dissimilar goods in the relevant territory before the opponent's mark was applied for, or acquired a reputation, especially where such coexistence has not in any way affected the distinctiveness and repute of the earlier mark.

Interpreting Article 5(2) of Council Directive 89/104/EEC (whose legislative content is essentially identical to that of Article 8(5) EUTMR), the Court ruled that the proprietor of a trade mark with a reputation might be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate use by a third party of a sign similar to that mark in relation to a product that was identical to that for which that mark had been registered, if it was demonstrated that the sign was being used before the mark had been filed and that use of the sign in relation to the identical product was in good faith (06/02/2014, C-65/12, Leidseplein Beheer and de Vries, EU:C:2014:49, § 60). The Court gave further detailed factors to be considered when assessing due cause on account of prior use.

The case-law below shows that due cause may be found where the applicant establishes that it cannot reasonably be required to abstain from use of the mark (for example, because its use of the sign is a generic use to indicate the type of goods and services — whether by generic words or generic figurative devices), or where it has some specific right to use the mark for the goods and services (for example, it shows that a relevant coexistence agreement permits its use of the sign).

The condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used this sign for these products or similar products within and/or outside the relevant territory of the European Union, or (c) the applicant invokes a right ensuing from a filing over which the filing of the opponent's trade mark takes precedence (inter alia 23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig.) / WATERFORD; 15/06/2009, R 1142/2005-2, (fig.) MARIE CLAIRE (fig.) / MARIE CLAIRE et al.). Mere use of the sign is not enough — what must be shown is a valid reason justifying that use.

## 3.5.1 Examples of due cause

## 3.5.1.1 Due cause was accepted

Case No	Comment
02/06/2010, R 1000/2009-1, GigaFlex / FLEX (fig.) et al., § 72	The Board confirmed that the applicant had a due cause within the meaning of Article 8(5) EUTMR for inserting the term FLEX in the mark applied for, holding that this term was free from monopolies, since nobody holds exclusive rights in it and it is a suitable abbreviation, in many languages of the EU, to indicate that beds and mattresses are flexible.
26/02/2008, R 320/2007-2, GULLON Mini O2 (3D) / GALLETA (3D)	The Board held that the applicant had due cause to represent the series of sandwich-type biscuits in the three-dimensional mark applied for, namely, to indicate to consumers the type of biscuits concerned, as defined by the relevant Spanish legislation.
30/07/2007, R 1244/2006-1, MARTINI FRATELLI (fig.) / MARTINI	The Board confirmed that the applicant had two good reasons to use the name MARTINI in the mark applied for: (i) MARTINI is the family name of the founder of the applicant's company, and (ii) a coexistence agreement was signed in 1990.
20/04/2007, R 710/2006-2, SPA et al. / CAL SPAS	The Board confirmed that the applicant had due cause to use the term SPAS as it corresponds to one of the generic uses of the term 'spa' as indicated by the Court of First Instance in the judgment of 19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215.
23/01/2009, R 237/2008-1 & R 263/2008-1, CARLO RONCATO / RONCATO et al.	The business affairs of the Roncato family, showing that both parties had the right to use the name RONCATO as a trade mark in the suitcase and trunk sector, were held to constitute 'due cause' for use of the RONCATO name in the contested trade mark.

Case No	Comment
25/08/2011, B 1 708 398, Posten AB v Česká pošta s.p.	It was held that the applicant had due cause to use the figurative element of a postal horn since that device is widely used as a long-standing and historical symbol of postal services (trade mark registrations and internet evidence were submitted showing 29 European countries use the postal horn as a symbol for their postal services).

### 3.5.1.2 Due cause was not accepted

Case No	Comment
06/07/2012, T-60/10, Royal Shakespeare	The General Court held that, in order to establish due cause, it is not use per se of the contested trade mark that is required, but a reason justifying use of the trade mark. In this case, the applicant merely claimed to have 'demonstrated how and for which product the contested trade mark has been used in the past' but, even assuming that that aspect is relevant, provided no additional indication or explanation. Accordingly, the Court held that the applicant had not established due cause for such use.
25/03/2009, T-21/07, Spaline, EU:T:2009:80	The General Court held that there was no due cause, since it had not been shown that the word 'spa' had become so necessary to the marketing of cosmetic products that the applicant could not reasonably be required to refrain from use of the mark applied for. The argument that 'spa' was of descriptive and generic character for cosmetic products was rejected, since such character does not extend to cosmetic products 'but only to one of their uses or destinations'.

Case No	Comment
16/04/2008, T-181/05, Citi	The General Court held that the use of the trade mark Citi in just one EU Member State (Spain) could not constitute due cause because, first, the extent of geographical protection of the national trade mark did not correspond to the territory covered by the trade mark applied for, and, second, the legal validity of that national registration was subject to dispute before the national courts. By the same token, the ownership of the domain 'citi.es' was held to be irrelevant.
10/05/2007, T-47/06, Nasdaq; confirmed 12/03/2009, C-320/07 P, Nasdaq	The Court held that the only argument put forward before the Board of Appeal in respect of due cause (namely, that the word Nasdaq had been chosen because it is an acronym for 'Nuovi Articoli Sportivi Di Alta Qualità') was not convincing, noting that prepositions are not generally included in acronyms.



Case No	Comment
23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig.) / WATERFORD	<p>Contrary to the applicant's arguments that there was due cause because the term WATERFORD was allegedly very common in names and trade marks, the Board held that the applicant had failed to give any evidence of market coexistence of WATERFORD marks or to submit any element from which it would be possible to infer that the relevant general public (in the UK) considers Waterford as a commonplace geographical name.</p> <p>To the extent that such arguments play a role in assessing the uniqueness of a sign in order to establish whether the necessary link exists in the mind of the relevant public between the signs at issue, the Board held that, nevertheless, once such uniqueness had been established, such arguments cannot serve as due cause.</p> <p>Furthermore, the Board noted that the condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used the sign for these products or similar products within and/or outside the relevant territory of the European Union, or (c) the applicant invokes a right ensuing from a filing over which the filing of the opponent's trade mark takes precedence.</p>
22/01/2015, T-322/13, KENZO	<p>According to the Court, the fact that the applicant's forename is Kenzo is not enough, for the purposes of Article 8(5) EUTMR, to constitute due cause for use of the mark applied for.</p>

Case No	Comment
06/10/2006, R 428/2005-2, TISSOT / TISSOT	The Board held that the applicant's claim (unsubstantiated by any evidence) that the sign TISSOT is derived from the name of a trading company associated with the applicant's company since the early 1970s, would, even if proven, not amount, on its own, to 'due cause' within the meaning of Article 8(5) EUTMR. People who inherit a surname that happens to coincide with a famous trade mark should not assume that they are entitled to use it in business in a manner that would unfairly take advantage of the reputation that has been built up by the efforts of the brand owner.
18/08/2005, R 1062/2000-4, GRAMMY / GRAMMY	The applicant argued that GRAMMY is an internationally easy and nice-sounding abbreviation of the applicant's family name (Grammatikopoulos). The Board rejected this argument as insufficient to establish the due cause that could prevent the application of Article 8(5) EUTMR.

Case No	Comment
<p>15/06/2009, R 1142/2005-2, MARIE CLAIRE (fig.) / MARIE CLAIRE et al.</p>	<p>Due cause under Article 8(5) EUTMR means that, notwithstanding the detriment caused to, or unfair advantage taken of, the distinctive character or reputation of the earlier trade mark, registration and use by the applicant of the mark for the goods applied for may be justified if the applicant cannot be reasonably required to abstain from using the contested mark, or if the applicant has a specific right to use the mark for such goods that takes precedence over the earlier trade mark invoked in the opposition proceedings. In particular, the condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used the sign for these products or similar products within and/or outside the relevant territory of the EU, or (c) the applicant invokes a trade mark with a filing date that is earlier than the opponent's trade mark (decision of 25/04/2001, R 283/1999-3, HOLLYWOOD).</p> <p>As regards the tolerance of the proprietor of the earlier mark, the Board held that such tolerance was merely for magazines and not for goods closer to its market sector (i.e. textiles). It noted that national case-law showed that while protection exists for each party within its own field of business, extension should be refused when they come closer to the other party's field of activities and could infringe upon their rights.</p> <p>In light of these factors, the Board held that the coexistence did not constitute due cause permitting registration of a EUTM.</p>

Case No	Comment
26/09/2012, T-301/09, Citigate, § 116, 125 and 126	<p>Regarding the applicant's argument that it has due cause to use the mark applied for (Citigate), because it has used a variety of marks consisting of or containing Citigate in relation to the goods and services for which registration is sought, the Court stated the following: it should be noted that the documents produced by the applicant simply show that there are various companies whose business name contains the word Citigate and a number of domain names that also contain that word. That evidence is not sufficient to establish due cause, because it does not demonstrate actual use of the Citigate mark.</p> <p>As regards the applicant's argument that it has due cause to use the mark applied for since <b>the interveners have acquiesced to the use</b> of Citigate in relation to the goods and services covered by the application for registration, the Court stated that the <b>possibility cannot be excluded that, in certain cases, the coexistence of earlier marks on the market could reduce (...) the likelihood of a connection being made between two marks in accordance with Article 8(5) EUTMR.</b></p> <p>In the present case, coexistence was not proven.</p>