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

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

Part C

Opposition

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Opposition

Section 0

Introduction

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1 Overview of Opposition Proceedings — the Difference Between ‘Absolute Grounds’ and ‘Relative Grounds’ for Refusal of an EUTM Application

‘Opposition’ is a procedure that takes place before the EUIPO when a third party requests the Office to reject a European Union trade mark application (EUTM application) or an international registration designating the EU on the basis of the earlier rights it holds.

When an opposition is filed against an international registration designating the EU, any reference in these Guidelines to EUTM applications must be read to cover international registrations designating the EU. The Guidelines, Part M, International Marks, cover the specific details of oppositions related to international registrations.

Under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, an opposition must be based on rights held by the opponent in an earlier trade mark or other form of trade sign. The grounds on which an opposition may be based are called ‘relative grounds for refusal’, and the relevant provisions are found in Article 8 EUTMR, which bears that title. Unlike absolute grounds for refusal, which are examined *ex officio* by the Office (and which may take into account third parties’ observations although third parties do not become parties to the proceedings), relative grounds for refusal are *inter partes* proceedings based on likely conflict with earlier rights. Such relative grounds objections are not raised *ex officio* by the Office. The onus is therefore on the proprietor of the earlier right to be vigilant concerning the filing of EUTM applications by others that could clash with such earlier rights, and to oppose conflicting marks when necessary.

When an opposition is filed within a prescribed time limit and the relevant fee has been paid, the proceedings are managed by the Office’s specialist service (the Opposition Division). The Opposition Division will first examine the admissibility of the opposition. If the opposition is found admissible, normally an exchange of observations from both the opponent and the applicant (the ‘parties’) will follow. After considering these observations, and if agreement has not been reached between the parties, the Opposition Division will decide (in an appealable ‘decision’) either to reject the contested application totally or in part or to reject the opposition. If the opposition is not well founded, it will be rejected. If the EUTM application is not totally rejected, and provided there are no other oppositions pending, it will proceed to registration for the goods and/or services for which it is not rejected.

2 The Grounds for Opposition

The grounds on which an opposition may be made are set out in Article 8 EUTMR.

Article 8 EUTMR enables the proprietors to base oppositions on their earlier rights to prevent the registration of EUTMs in a range of situations progressing from that of double identity both between goods and/or services and between marks (**Article 8(1)**)

(a) **EUTMR**, where likelihood of confusion is presumed, and need not be proved) to that of identity only in one factor and similarity in the other, or similarity in both (**Article 8(1)(b) EUTMR**, where a likelihood of confusion must be established) (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion).

Article 8(3) EUTMR allows the proprietor of a mark to prevent the unauthorised filing of its mark by its agent or representative (see the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor).

Article 8(4) EUTMR enables the proprietor of earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance to prevent registration of a later EUTM application if the proprietor has the right to prohibit the use of the EUTM application. It enables rights holders to invoke a wide variety of rights protected under EU legislation or Member State laws, subject to the conditions of their acquisition and scope of protection under the applicable laws, and further provided that the right invoked also fulfils the EU law condition of use in the course of trade of more than mere local significance (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and (6) EUTMR).

Article 8(5) EUTMR enables the proprietors of an earlier reputed registered trade mark to prevent registration of a later similar or identical EUTM application that, without due cause, would encroach on the earlier reputed mark. Likelihood of confusion is not a condition for the application of this article. This is because Article 8(5) EUTMR specifically (but not exclusively) protects functions and uses of trade marks that fall outside the ambit of the badge of origin protection offered by likelihood of confusion and, as such, is more directed at protecting the heightened effort and financial investment that is involved in creating and promoting trade marks to the extent that they become reputed and to facilitate full exploitation of the value of the marks (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)).

Article 8(6) EUTMR enables beneficiaries of the protection of designations of origin and geographical indications under the Union legislation or Member State laws to oppose the registration of a later EUTM application even beyond the limited scope of *ex officio* protection of such rights on absolute grounds (Article 7(1)(j) EUTMR). In order to be eligible as a 'relative' ground for refusal, the right invoked must vest in its beneficiary a direct right of action against unauthorised use (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and (6) EUTMR).

3 The 'Earlier Rights' upon which an Opposition must be Based

An opposition must be based on at least one earlier right owned by the opponent.

The meaning of 'earlier' rights for Article 8(1) and (5) EUTMR is defined in **Article 8(2) EUTMR**, meaning such rights having an earlier date (not hour or minute, as confirmed by the Court in its judgment of 22/03/2012, C-190/10, Rizo, EU:C:2012:157) of application for registration than the EUTM application, including applicable claimed

priority dates, or have become well known in a Member State before the EUTM application or, if appropriate, its claimed priority date. See the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings.

In essence, these rights consist of EU registered trade marks and applications for such, and 'well-known' marks in the sense of Article 6*bis* of the Paris Convention (which need not be registered). For a detailed explanation of these 'well-known' marks under Article 8(2)(c) EUTMR, and how they differ from Article 8(5) EUTMR marks with reputation, see the Guidelines, Part C, Opposition, Section 5: Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 2.1.2.

Under Article 8(3) EUTMR, the opponent must show that it is the proprietor of a trade mark, acquired anywhere in the world by registration or by use (to the extent that the law of the country of origin recognises this kind of trade mark right), for which an agent or representative of the proprietor has applied for registration in its own name without the proprietor's consent.

Article 8(4) EUTMR is the ground for opposition based on earlier non-registered trade marks or other signs used in the course of trade of more than mere local significance protected under EU legislation or Member State laws that confer on their proprietor the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that it acquired the right invoked, which may be use or registration based, before the application date or, as the case may be, before the priority date of the contested mark, in accordance with the conditions of protection of the applicable law. In addition, the opponent must also prove use of more than mere local significance of such a right before the date of priority of the contested mark.

Article 8(6) EUTMR is the ground for opposition based on designations of origin or geographical indications protected under EU legislation or Member State laws that confer on the person authorised under such laws the right to prohibit the unauthorised use of a subsequent trade mark. The opponent must prove that the designation of origin or geographical indication invoked is earlier than the date of application or, as the case may be, the priority date of the contested mark.

Various legal grounds, based on different earlier rights, may be alleged in either the same or multiple oppositions against the same EUTM application.

The Office's practice is based on the legal provisions of the EUTMR applied directly or by analogy, as confirmed by the case-law of the General Court (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, T-194/05, Teletch International, EU:T:2006:124). Namely:

- **multiple oppositions.** Article 9(2) and (3) EUTMDR allows the Office to examine only the 'most effective' opposition(s), suspending the rest and eventually deeming them to have been dealt with if the application is rejected on the basis of the chosen opposition. With regard to the 'most effective' opposition, see below.
- **multiple earlier rights in one opposition.** The Court has observed that grouping various earlier rights in one opposition is, for practical purposes, the same as presenting multiple oppositions, making it possible for the Office to base the

rejection of the application on the ‘most effective’ right(s). With regard to the ‘most effective’ earlier right, see below.

- **multiple legal grounds in opposition(s).** If the opposition is successful in its entirety on the basis of the ‘most effective’ legal ground(s), it is not necessary to examine the remaining legal grounds. If a necessary requirement of a legal ground is not fulfilled, it is not necessary to examine the remaining requirements of that provision. With regard to the ‘most effective’ legal ground(s), see below.

4 The Purpose of Opposition Proceedings and the Most Expedient Way to Treat Them

The Court of Justice has stated that the sole purpose of opposition proceedings is to decide whether the application may proceed to registration and not to pre-emptively settle potential conflicts (e.g. at a national level arising from the possible conversion of the EUTM application) (11/05/2006, T-194/05, Teletch International, EU:T:2006:124, § 25-27).

4.1 Examination of the most effective opposition, ground and bases

The Court of Justice has confirmed clearly that the Office is under no obligation to examine all the earlier oppositions, rights and legal grounds invoked against the same EUTM application, if one of them suffices to reject the EUTM application. Nor is it obliged to choose the earlier right with the widest territorial scope so as to prevent the eventual conversion of the application in as many territories as possible (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268; 11/05/2006, T-194/05, Teletch International, EU:T:2006:124).

This principle allows for a more expedient treatment of oppositions. The Office is free to choose what it regards as the ‘most effective’ opposition(s), earlier right(s) and legal ground(s) and which one to examine first in light of the principle of procedural economy.

The ‘most effective’ opposition can normally be defined as the opposition that allows the Office to refuse the registration of the opposed EUTM application to the broadest possible extent and in the simplest manner.

The ‘most effective’ earlier right can normally be defined as the most similar (the closest) sign covering the broadest scope of goods and services and/or the right covering the most similar goods and services.

The ‘most effective’ legal ground can normally be defined as the opposition ground that presents the Office with the simplest manner of refusing the registration of the opposed EUTM application to the broadest possible extent.

Generally speaking, if applicable, Article 8(1)(a) EUTMR will be the simplest ground in terms of procedural economy on which to reject an EUTM application, since the Office

will not need to enter into an analysis of similarities and differences between the signs or goods/services, nor will a finding of likelihood of confusion be necessary. Failing that, the factual circumstances of each opposition will determine whether Article 8(1)(b), Article 8(3), (4), (5) or (6) EUTMR are the next ‘most effective’ grounds (e.g. if the goods and services of the earlier right and the EUTM application are dissimilar, Article 8(1)(b) and Article 8(3) EUTMR cannot serve as a valid basis for opposition).

4.2 No need to examine proof of use

If evidence of use has been requested by the applicant in relation to some of the earlier rights, the Office will normally firstly consider if the opposition can be fully upheld on the basis of one or more earlier rights not subject to the requirement to prove use. In such a case, the EUTM application will be rejected without it being necessary to consider proof of use. Only if no such earlier right(s) is (are) available, will the Office consider those earlier rights for which proof of use was requested.

For further examples of where the assessment of the proof of use may be dispensed with, see the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 2.12.2.

4.3 Restricting the examination to part of the relevant public

When an opposition is filed pursuant to Article 8(1)(b) EUTMR and a likelihood of confusion can be found on the basis of a (substantial) part of the public, the reasoning of the decision should concentrate on that part of the public that **is most prone to confusion** and the analysis should not extend to all parts. This would apply in particular in the following situations.

- Where there is likelihood of confusion in a specific linguistic area, the Office’s analysis need not extend to the whole EU but may instead focus on that part (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 1.3, Relevant territory and relevant public). For example, if the degree of similarity between the marks is higher from the perception of a particular language, the examination of the perception of the marks by the public in other language areas (e.g. examining specific pronunciations or meanings of marks in several languages) is redundant.
- Where the relevant public consists of both general and professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold an opposition. Usually it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals.

In such circumstances, it should be explained from the beginning of the decision why such a focus has been chosen.

4.4 Examining the likelihood of confusion without undertaking a comparison of goods and services

When the opposition is based on Article 8(1)(b) EUTMR and the likelihood of confusion cannot be ruled out on the basis of a 'dissimilarity of the goods and services' or 'dissimilarity of the signs', the Office could decide, for reasons of procedural economy, to proceed on the basis of the **assumption that all the goods and services at issue are identical** (20/09/2019, T-367/18, UKIO / <IO (fig.), EU:T:2019:645, § 27-28, 31, 63). The comparison of the goods and services may be dispensed with, even in the absence of any identical pair of goods and services, if upon examining all the other relevant factors (such as the degree of similarity of the signs, distinctiveness of the earlier mark, degree of attention of the relevant public and the principle of interdependence) **any likelihood of confusion can be ruled out**.

4.5 No need to examine evidence of enhanced distinctiveness

The Office may decide not to examine the opponent's claim and evidence of enhanced distinctiveness of the earlier marks, if based on the other relevant factors a **likelihood of confusion can be established** on the basis of the inherent distinctiveness of the marks.

Where appropriate, the Office may decide to proceed on the basis of the **assumption that the earlier marks enjoy enhanced distinctiveness**. The examination of the claim and evidence of enhanced distinctiveness of the earlier marks may be dispensed with if upon examining all the other relevant factors **any likelihood of confusion can be ruled out**.

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Part C

Opposition

Section 1

Opposition proceedings

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Obsolete

1 Introduction — General Outline of Opposition Proceedings

Opposition proceedings start upon receipt of the notice of opposition, of which the applicant is informed and which can be accessed in the electronic file accessible on the Office's website.

Once the notice of opposition is received, the Office checks that the corresponding opposition fee has been paid. If the fee has not been paid, the opposition is deemed not to have been filed.

Next, the Office verifies the admissibility of the opposition. There are two kinds of admissibility deficiencies.

1. **Absolute deficiencies:** deficiencies that cannot be remedied after the expiry of the opposition period. If the opponent does not remedy these deficiencies on its own initiative within the opposition period, the opposition is inadmissible.
2. **Relative deficiencies:** deficiencies that can be remedied after the expiry of the opposition period. The Office invites the opponent after the expiry of the opposition period to remedy the deficiency within a non-extendable time limit of 2 months, failing which the opposition will be rejected as inadmissible.

It is important to note that, in order to safeguard the principle of impartiality, the Office will not send any communication concerning the payment of the opposition fee or admissibility deficiencies during the opposition period. The admissibility of the opposition will be determined only once the opposition period is over.

After the examination of admissibility of the opposition, a notification is sent to both parties to set the time limits for the proceedings. These start with a period during which the parties are encouraged to negotiate an agreement because, if certain conditions are met, the opposition fee will be refunded — this is known as the 'cooling-off' period. The cooling-off period is set to expire 2 months from the notification of admissibility. It can be extended once by 22 months and can last up to a total of 24 months. The notice of opposition and other documents received are sent together with the notification to the applicant.

Once the cooling-off period has expired, the adversarial part of the proceedings begins. The opponent is then allowed 2 more months to submit all evidence and observations it considers necessary to make its case. After these 2 months have lapsed, and once the submitted evidence and observations (if any) have been forwarded, the applicant has 2 months to reply to the opposition.

At this stage, the applicant can file a request for proof of use, requiring the opponent to prove that any earlier marks registered for more than 5 years have been used. If such a request is filed, the applicant may wait until the opponent has adduced such proof before filing its evidence and observations. The opponent is then given the opportunity to comment on the applicant's observations.

If the applicant does not request proof of use but submits evidence and observations, the opponent is given 2 months to comment on the applicant's submissions and after these exchanges the opposition is normally ready for decision.

In some cases, it may be necessary or useful to have another exchange of observations. This may occur when the case deals with complex issues or when the opponent raises a new point that is admitted to the proceedings. In this case the applicant may be given a possibility of replying. It is then up to the examiner to decide if another round should be given to the opponent.

The Office may request the parties to restrict their observations to particular issues, permitting observations on other issues at a later point in time.

Once the parties have submitted their observations, the proceedings are closed, the file is ready for a decision on substance and the parties are informed accordingly.

When an opposition is filed against an international registration designating the EU, the references in the Guidelines to EUTM applications must be read as including international registrations designating the EU, unless indicated otherwise. The Guidelines, Part M, International Marks, cover the specific details of oppositions related to international registrations.

2 Notice of Opposition

2.1 Notice of opposition in writing

Article 46 EUTMR

Article 4 and Article 63(1)(a) EUTMDR

Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means

The notice of opposition has to be received by the Office in written form within the opposition period, namely within 3 months from the publication of the contested EUTM application.

A notice of opposition may be filed by using the electronic form available in the User Area of the Office's website. Once submitted, the electronic form will be processed automatically and a receipt will be issued for the opponent. If filed by post or courier, the receipt will be issued after the notice of opposition has been keyed into the Office's IT system.

2.1.1 Early oppositions against an international registration

Article 196(2) EUTMR

Article 77(3) EUTMDR

An opposition against an international registration designating the EU (IR) may be filed within a period of 3 months starting 1 month after the date of first republication. For example, if first republication is on 15/04/2016, then the opposition period starts on 15/05/2016 and ends on 15/08/2016.

For international registrations whose date of first republication falls before the entry into force, on 23/03/2016, of the amendment of Article 196(2) EUTMR brought about by Regulation (EU) 2015/2424, the previous time limit applies, according to which an opposition must be filed within a period of 3 months starting 6 months after the date of first republication. For example, if first republication is on 22/03/2016, then the opposition period starts on 22/09/2016 and ends on 22/12/2016.

However, oppositions filed after the republication of the IR but prior to the start of the opposition period will be kept on hold and be deemed to have been filed on the first day of the opposition period. The opponent will be informed accordingly. If the opposition is withdrawn before that date, the opposition fee will be refunded.

2.1.2 Early opposition against an EUTM application

Articles 44 and 46 EUTMR

Any notice of opposition against an EUTM application received before commencement of the opposition period will be kept on hold and be deemed to have been filed on the first day of the opposition period, namely the first day after the publication of the EUTM application in Part A.1 of the EUTM Bulletin. The opponent will be informed accordingly. If the opposition is withdrawn before that date or the EUTM application is refused or withdrawn before publication, the opposition fee will be refunded.

2.2 Payment

For general rules on payments, refer to the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges.

2.2.1 Notice of opposition late, payment within the opposition period

Article 5(2) EUTMDR

If the payment was received by the Office within the opposition period but the notice of opposition was received late, the opposition is inadmissible. In this case the Office will

keep the opposition fee. The opponent must be notified and may comment on the finding of inadmissibility within the time limit set by the Office.

If the opponent submits convincing evidence, such as confirmation of receipt by messenger and/or delivery slips for registered mails, that proves that the notice of opposition was not late and was in fact correctly received by the Office within the 3-month opposition period, the Office must reconsider its finding and accept the opposition as having been received within the opposition period. In this case the admissibility check can continue. If the evidence submitted by the opponent does not prove that the notice of opposition was received within the opposition period or if the opponent does not reply within the set time limit, a decision ruling the opposition inadmissible has to be taken. When notifying the opponent of the decision, the applicant must be sent a copy.

2.2.2 Time of payment

Article 46(3) and Article 180 EUTMR

Article 5(1) EUTMDR

The Office has to receive the full amount of the opposition fee within the opposition period. If the opposition fee was not received within the opposition period, the notice of opposition is deemed not to have been entered.

2.2.2.1 Payment by bank transfer

Payments by bank transfer received after the opposition period are considered to be made within the opposition period if the opponent (i) files evidence showing that it gave the transfer order to a banking establishment within the opposition period and (ii) pays a surcharge of 10 % of the opposition fee. No surcharge will be payable if the evidence shows that the order to the bank was given no less than 10 days before the expiry of the opposition period.

2.2.2.2 Payment by current account

Articles 179(1) and 180(1) EUTMR

Decision No EX-21-5 of the Executive Director of the Office of 21/07/2021 concerning methods of payment of fees and charges and determining the insignificant amount of fees and charges

If the opponent or its representative holds a current account, the payment is considered effective on the day the opposition is received.

Since a payment by current account is considered to have been made on the date of receipt of the opposition, if the notice of opposition arrived late, the payment is also late. Therefore, the opposition is deemed not to have been entered.

Failure to indicate or to correctly indicate the amount of the opposition fee does not have any negative effect on the opposition, because it is clear that the opponent wanted to pay the amount of the opposition fee.

Even if there is no express request from the opponent, the existence of a current account will be sufficient for the account to be debited. This is true regardless of whether the opposition form is used or not.

The only exception to this rule is when the holder of a current account who wishes to exclude use of the current account for a particular fee or charge informs the Office thereof in writing (e.g. indicating bank transfer).

Fee payment by debiting a current account held by a third party

Payment of an opposition fee by debiting a current account held by a third party requires the explicit authorisation of the holder of the current account that its account can be debited for that particular fee. In such cases the opponent must file an authorisation within the opposition period.

Payment is considered to be made on the date the Office receives the authorisation.

2.2.3 Consequences in the event of non-payment

Article 99 EUTMR

Article 5(1) EUTMDR

An opposition for which the payment is not made within the opposition period will be deemed not to have been entered and the opponent must be notified of this finding.

A copy of this letter must be sent to the applicant for information purposes at the same time.

If, within the time limit allowed, the opponent submits evidence that convinces the Office that the loss of rights was incorrect and proves that the payment was made on time, a notification has to be sent, with a copy to the applicant; the applicant will also be sent the evidence submitted by the opponent.

If an opposition is deemed not to have been entered, the opponent has the right to request a formal decision within 2 months. If it does so, the decision must be sent to both parties.

For cases in which the opposition fee has not been paid in full or has not been paid until after the opposition period, see paragraph 6.4.1 below.

2.3 Languages and translation of the notice of opposition

Article 146(5), Article 146(6)(a) and Article 146(7) EUTMR

Article 5(3) and (4) and Article 65 EUTMDR

2.3.1 Language of proceedings

The notice of opposition must be filed in one of the five languages of the Office. The rules regarding the language of proceedings are explained in detail in the Guidelines, Part A, General Rules, Section 4, Language of Proceedings.

According to these rules, in opposition proceedings there are cases where the opponent has a choice between two possible languages of proceedings (the first and second languages of the contested EUTM application, both being languages of the Office), and cases where there is only one possible language of proceedings (when the first language is not one of the five languages of the Office, the language of the opposition proceedings can only be the second language of the contested EUTM application).

In cases where there is a choice, the language of proceedings will be that expressly indicated by the opponent in the notice of opposition or, in the absence of an express indication, the language in which the notice of opposition was filed, provided in both cases that it is one of the possible languages of proceedings.

Where the wrong language of proceedings is chosen by the opponent, the EUTMR distinguishes between two different scenarios: where the incorrect language is a language of the Office, and where the incorrect language is one of the official languages of the European Union (but not one of the Office). Depending on which of the above applies, there are different consequences and time limits for the opponent to respect when choosing the correct language of the proceedings and submitting the translation of the notice of opposition.

- If the language chosen by the opponent is a **language of the Office**, but not one of the possible languages of the proceedings, the opposing party must produce, at its own expense, a translation of the notice of opposition into the first language, providing it is a language of the Office, or into the second language. The translation must be produced **within 1 month from the expiry of the 3-month opposition period**. The language into which the notice of opposition has been translated will then become the language of the proceedings. Where the opposing party does not submit the translation within this time limit, the opposition will be rejected as inadmissible. Article 146(7) EUTMR and Article 5(3) and (4) EUTMDR apply.
- If the language chosen by the opponent is **not a language of the Office**, the opposing party must produce, at its own expense, a translation of the notice of opposition into the first language, providing it is a language of the Office, or into the second language. The translation must be produced **within the 3-month opposition period**. Where the opposing party does not submit the translation within

the opposition period, the opposition will be rejected as inadmissible. Article 146(5) EUTMR applies as it clearly specifies that the notice of opposition must be filed in a language of the Office. If it is not filed in a language of the Office, the 1-month period to remedy the deficiency of Article 146(7) and Article 5(3) EUTMDR does not apply.

In the event that the language chosen by the opponent is not one of the possible languages of the proceedings, any correspondence issued by the Office in the opposition will be in the first language of the contested mark, providing it is a language of the Office, or in the second language if the first one is not one of the five languages of the Office.

The language requirement of the notice of opposition is an absolute admissibility requirement and will be dealt with as explained under paragraph 2.4.1 below.

Concerning the use of official forms, the second sentence of Article 146(6) EUTMR states that when the form provided by the Office is used, it may be used in any official language of the European Union, provided that it is completed in one of the languages of the Office as far as textual elements are concerned.

Where the opponent uses the official form in a language that cannot be the language of the proceedings, all textual elements are in the wrong language and a language has been chosen that cannot be the language of the proceedings, the above principles apply: where the incorrect language chosen is a language of the Office, the opponent has 1 month to file a translation on its own motion; where the incorrect language chosen is not a language of the Office, the deficiency cannot be remedied after the expiry of the opposition period and the opposition will be deemed inadmissible.

2.3.2 Examples

As an illustration of what is explained in paragraph 2.3.1 above, here are some examples.

1. The languages of the EUTM application are PT and EN. The opponent files an opposition in PT, choosing PT as the language of the proceedings. As the language of the proceedings has not been correctly chosen, since PT is not a language of the Office, the opponent must submit the translation of the notice of opposition into EN (the only correct language) before the expiry of the opposition period, and EN will therefore become the language of the proceedings.
2. The languages of the EUTM application are BG and EN. The opponent files an opposition in BG, and in BG expressly indicates that the language of the proceedings is EN. The Office cannot accept an indication in BG that the language should be EN. As the language of the proceedings has not been correctly indicated, since BG is not a language of the Office, the opponent must submit the translation of the notice of opposition into EN (the only correct language) before the expiry of the opposition period, and EN will therefore become the language of the proceedings.
3. The languages of the EUTM application are DE and EN. The opponent files an opposition in FR. As FR is a language of the Office and as the language of proceedings can be either DE or EN, the opponent must produce the translation

within 1 month of expiry of the opposition period into DE or EN, which will become the language of the proceedings.

In all of the above examples, if the opponent does not submit the translation into a correct language within the relevant time limit, the opposition will be rejected as inadmissible. However, in the above examples, if the official form had been used in PT, BG and FR respectively, but had been completed in its entirety in EN expressly indicating EN as the language of the proceedings, this would be admissible without any need for a translation into EN to be submitted. There would be no need to submit a translation of the official form if all the textual elements, and the indication of language, were in EN.

2.4 Admissibility check

Articles 2(2) and 5(3) and (5) EUTMDR

Once the opposition period is over, the Office checks the admissibility of any opposition received. The admissibility check covers both absolute and relative requirements:

- absolute requirements are the indications and elements that must be present in the notice of opposition or submitted by the opponent on its own initiative within the opposition period, as laid down in Article 2(2)(a) to (c) EUTMDR, and Article 146(5) and (7) EUTMR;
- relative requirements are the indications and elements that, if they are not submitted within the opposition period, trigger a deficiency notice from the Office, allowing the opponent to remedy the deficiency within a non-extendable time limit of 2 months, as laid down in Article 2(2)(d) to (h) EUTMDR.

In addition, there are optional indications laid down in Article 2(2)(i) and (4) EUTMDR, that do not lead to a finding of non-admissibility, namely the submission of a reasoned statement or an indication of the goods and services against which the opposition is directed.

For the purposes of assessing the admissibility of the opposition the Office must base itself solely on the claims contained in the documents submitted by the opponent within the opposition period (21/07/2014, R 1573/2013-4, OKAY / O-KEY (fig.)).

Identification elements are to be looked for not only in the notice of opposition, but also in annexes or other documents filed together with the opposition or any documents submitted within the opposition period. The same applies where the opponent provides evidence by making reference to an online source pursuant to Article 7(3) EUTMDR.

Extent of the admissibility check

The earlier marks/rights are examined to see if at least one is clearly identified. If the only earlier right on which the opposition is based is not duly identified, the opposition is inadmissible and the opponent is invited to comment on the inadmissibility before the decision on inadmissibility is taken. If the only earlier right on which the opposition is

based is duly identified (absolute requirements), the Office will examine whether it also meets the relative admissibility requirements.

If the opposition is based on more than one earlier right and at least one of them has been correctly identified, the examination of admissibility (relative requirements) can proceed based on that earlier right. The parties are informed thereof when notification of the time limits for the opposition proceedings is sent to the parties.

If necessary, the admissibility issue will be dealt with in the decision on the opposition.

2.4.1 Absolute admissibility requirements

Article 2(2)(a) to (c) and Article 5(3) EUTMDR

Article 94(1) EUTMR

Absolute admissibility deficiencies can only be remedied on the opponent's initiative during the 3-month opposition period; otherwise the opposition is inadmissible. The opponent will be invited to submit comments on inadmissibility before the decision on admissibility of the opposition is taken.

2.4.1.1 Identification of the contested EUTM application

Article 2(2)(a) and Article 5(3) EUTMDR

The mandatory elements for identifying the contested EUTM application are the application number and the name of the applicant.

If, for example, the application number indicated does not correspond to the name of the applicant indicated, the Office will decide if it can be established without any doubt which is the contested EUTM application. If the applicant's name is not indicated, it can be found in the Office's IT system.

The date of publication is an optional indication that helps to double-check the identification of the EUTM application. Even if it is missing, the EUTM application can be sufficiently identified through the other indications.

Only one EUTM application can be contested in one notice of opposition.

2.4.1.2 Identification of earlier marks or rights

Invoked rights that are not earlier

Articles 8(2) and 46(1) EUTMR

Sometimes an opposition is based on one or more marks or other rights that are not earlier than the EUTM application. Whether at least one of the rights invoked is earlier is established at the admissibility stage.

For an invoked right to be earlier it must have, in the absence of any priority, an application date that is prior to the day on which the contested EUTM application was filed. In the case of conflict between a national mark and an EUTM application, the hour and the minute of filing of the national mark is not relevant for determining which mark is earlier (22/03/2012, C-190/10, Rizo, EU:C:2012:157). If priority has been claimed, it should be determined to the extent that the relevant goods and services are earlier. For further information see also the Guidelines, Part B, Examination, Section 2, Formalities.

When the only invoked mark is not earlier, or when all the marks invoked are not earlier, the Office will inform the opponent of the inadmissibility and invite it to comment on that issue before a decision on inadmissibility is taken.

Where the opposition is based on more than one right, one being earlier and one or more not earlier, the Office will notify the admissibility of the opposition on the basis of the earlier one.

Earlier trade mark registrations or applications under Article 8(2)(a) and (b) EUTMR

Article 2(2)(b)(i) and Article 5(3) EUTMDR

Article 8(1), 8(5) and Article 8(2)(a) and (b) EUTMR

These rights are European Union trade mark registrations or applications, international registrations designating the European Union, national or Benelux trade mark registrations or applications (including 'ex-European Union trade marks' for which a request for conversion has been filed) and international registrations having effect in a Member State, invoked under Article 8(1) or 8(5) EUTMR.

The absolute identification elements for earlier trade mark registrations and applications are listed here.

- The registration/application number.
 - National applications deriving from the conversion of an earlier EUTM (application) are considered to come into existence as soon as a valid conversion request is submitted. Such rights will be properly identified for admissibility purposes if the opponent indicates the number of the EUTM (application) under conversion and the countries for which it has requested the conversion.
- An indication of whether the earlier mark is registered or applied for.
- The Member State, including Benelux, where the earlier mark is registered/applied for or, if applicable, an indication that it is an EUTM.
 - If the Member State is not indicated in the opposition notice but a certificate is attached, it is considered that the Member State is sufficiently identified, even if the certificate is not in the language of the proceedings. A translation of the certificate should not be asked for at this stage in the proceedings. Where a certificate of an international registration is concerned it is assumed that the opposition is based on this mark in all the designated Member States and/or the Benelux countries indicated in the certificate. However, the basic registration is an independent earlier right, which may be claimed separately.

In the absence of the previous indications, the relevant right will be inadmissible.

The seniority claimed in an EUTM can be taken into account within the meaning of Article 8(2)(a) EUTMR provided that the proprietor of the EUTM has surrendered the earlier mark or allowed it to lapse within the meaning of Article 39(3) EUTMR and that this fact is proved by the opponent.

In such a case, the opponent must base its opposition on the European Union trade mark, explicitly claiming within the 3-month opposition period that the national mark continues to exist through the seniority claimed in the EUTM. A clear link must be established between the EUTM indicated and the earlier mark for which the seniority was claimed in the EUTM. Within the time limit set according to Article 7(1) EUTMR, the opponent must submit sufficient proof, emanating from the administration by which the national trade mark was registered, that the national mark has been surrendered or allowed to lapse according to Article 39(3) EUTMR.

Earlier well-known marks under Article 8(2)(c) EUTMR

Article 2(2)(b)(i) and (ii) and Article 5(3) EUTMR

Article 8(2)(c) EUTMR

Article 8(2)(c) EUTMR protects well-known marks within the meaning of Article 6*bis* of the Paris Convention. This can be a registration or an application for registration, a non-registered mark, or a mark that is not registered in the territory where the well-known character is claimed (irrespective of registration in the territory of origin).

The absolute indications are:

- an indication of the Member State where the mark is claimed to be well known;
- a representation of the mark. For word marks, this is the indication of the word that makes up the mark. For figurative or other marks, the representation of the mark (in colour if applicable) as it is used and claimed to be well known must be provided. If the opposition is furthermore based on one registered trade mark, but no representation of the well-known mark is given, the Office assumes that both trade marks refer to the same sign and that the opponent claims the registered mark to be well known (17/10/2007, R 160/2007-1, QUART / Quarto).

In the absence of the previous indications, the relevant right will be inadmissible.

Trade marks filed by an agent under Article 8(3) EUTMR

Article 2(2)(b)(iii) and Article 5(3) EUTMR

Article 8(3) EUTMR

These are contested EUTM applications in relation to which the opponent claims that the applicant, who has or had an agent or representative relationship with the opponent, applied for the mark(s) without its consent.

The absolute indications for earlier trade mark registrations/applications are:

- an indication of the territory in which the earlier trade mark is protected;

- a representation of the earlier mark (in colour if applicable);
- an indication of whether the earlier mark is registered or applied for;
- the registration/application number.

The absolute indications for earlier non-registered trade marks are:

- an indication of the territory in which the earlier trade mark is protected,
- a representation of the earlier mark (in colour if applicable).

The representation of the mark (in colour if applicable) must be given only if the proprietor's earlier mark is a non-registered mark, because in this case no registration number can be provided to clearly identify the earlier mark. For non-registered word marks, the word that makes up the mark must be indicated. For non-registered figurative or other marks, the representation of the mark as it is used and claimed by the proprietor must be provided. See also the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR).

In the absence of the previous indications, the relevant right will be inadmissible.

Earlier non-registered marks and earlier signs used in the course of trade under Article 8(4) EUTMR

Article 2(2)(b)(iv) and Article 5(3) EUTMDR

Article 8(4) EUTMR

This category consists of signs that are not registered and used as trade marks and of a great number of different earlier rights, such as rights to a company name, trade name, business sign, ensigns, titles of protected literary/artistic works and the right to a sign under passing off.

The absolute indications are listed here.

- An indication of the kind or nature of the right.
 - The nature of the right determines the scope of the opposition and the applicant's defence depends on it. 'Trade name', 'company name', 'business sign', 'passing off', 'titles of protected literary/artistic works' are acceptable indications of the nature of rights. By contrast, general terms such as 'common law' and 'unfair competition' without an indication of the specific nature of the right are not accepted. This list is not exhaustive.
 - If the opponent bases its opposition on a right that cannot be an earlier right under Article 8(4) EUTMR, for example a copyright or a design, the opposition is admissible. However, after the proceedings have commenced, the opposition will be rejected on substance;
- An indication of the Member State where the right is claimed to exist.
- A representation of the earlier right (in colour if applicable).

In the absence of the previous indications, the relevant right will be inadmissible.

Protected designation of origin and/or geographical indications under Article 8(6) EUTMR

Article 2(2)(b)(v) and Article 5(3) EUTMDR

Article 8(6) EUTMR

Under Article 8(6) EUTMR, an opposition can be based on an earlier protected designation of origin or a geographical indication. The absolute indications are:

- an indication of the nature of the right, namely protected designation of origin or geographical indication;
- an indication of the territory where the protected designation of origin or geographical indication is claimed to be protected, namely the European Union or a Member State;
- a representation of the protected designation of origin or geographical indication (word only).

In the absence of the previous indications, the relevant right will be inadmissible.

2.4.1.3 Identification of grounds

Article 2(2)(c) and Article 5(3) EUTMDR

Article 46(3) EUTMR

An opposition without any indication of grounds is inadmissible if this deficiency is not remedied before expiry of the opposition period.

The specification of grounds should consist of a statement to the effect that the respective requirements under Article 8 EUTMR are fulfilled. Arguments and evidence are voluntary at this point in the proceedings.

In particular, the grounds are to be considered as properly indicated if one of the relevant options in the opposition form is selected or if this can be inferred from the opponent's arguments filed within the opposition period. In both cases, if it is possible to identify the grounds within the opposition period without any doubt, the opposition is admissible.

Before rejecting the opposition, a careful assessment of the entire notice of opposition and other documents submitted must be made: whether indicated in the opposition form, its annexes or its supporting documents, the grounds must be unequivocally clear.

2.4.2 Relative admissibility requirements

Article 2(2)(d) to (h) and Article 5(5) EUTMDR

Relative deficiencies are those that can be remedied after expiry of the opposition period. The Office invites the opponent to remedy the deficiency within 2 months from

notification of the deficiencies. If the opponent remedies the deficiencies, the opposition is considered admissible; if not, it will be rejected on the grounds of inadmissibility.

2.4.2.1 Dates

Article 2(2)(d),(e) and Article 5(5) EUTMDR

The dates to be indicated in the notice of opposition include the filing date and, where available, the registration date and priority date of the earlier mark.

This requirement applies to the following rights:

- earlier European Union or national or international trade mark applications or registrations invoked under Article 8(1)(a) or (b) EUTMR;
- earlier marks under Article 8(3) EUTMR if they are registered;
- earlier marks with a reputation invoked under Article 8(5) EUTMR

In notices of opposition based on protected designations of origin or geographical indications, the date of application for registration or, if that date is not available, the date from which protection is granted should be indicated.

These indications can be important for eliminating possible errors when identifying the abovementioned earlier marks/signs. It is sufficient that these elements can be found in enclosed documents.

2.4.2.2 Representation of earlier marks

Article 2(2)(f) and Articles 5(5) and 63(3) EUTMDR
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The relative admissibility requirement to submit a representation of the mark under Article 2(2)(f) EUTMDR applies to earlier national or international trade mark applications or registrations invoked under Article 8(1) or 8(5) EUTMR.

If no representation of the mark has been included in the notice of opposition, the opponent will be notified of the deficiency. The Office will also request a clear representation if the one submitted is incomplete or illegible. If the opponent does not comply within the 2-month time limit given, the opposition based on that earlier right will be rejected as inadmissible.

If the mark is a word mark, the word that makes up the mark must be indicated in the notice of opposition.

If the mark is a figurative, three-dimensional/shape, or other type of mark, a representation of the mark as applied for or registered must be submitted.

If the mark is protected as a mark in colour, the representation must be submitted in colour. Even if no colour representation of such a mark is available in official publications of the competent registration authority because, at the relevant point in time, that authority was not yet publishing marks in colour, a colour representation that corresponds to the colours claimed still has to be submitted. This is because, for the

purposes of **indicating** a mark in colour as the basis of an opposition, a colour representation of the mark must be submitted (not necessarily from an official source). On the other hand, **providing evidence** of such a mark (from an official source) is a question of substantiation, which is explained in detail in paragraph 4.2.3.6 below (25/10/2018, T-359/17, ALDI / ALDO (fig.), EU:T:2018:720, § 43-44; 04/06/2019, C-822/18 P, ALDI / ALDO (fig.), EU:C:2019:466, appeal dismissed).

If the notice of opposition or the documents attached to it contain an indication (available in or translated into the language of the proceedings) that the earlier mark is in colour, but are not accompanied by a representation of the mark in colour, the Office will notify this deficiency. If the opponent does not comply within the 2-month time limit given, the opposition based on that earlier right will be rejected as inadmissible.

2.4.2.3 Goods and services

Article 2(2)(g) and Article 5(5) EUTMDR

Article 2(2)(g) EUTMDR stipulates that the notice of opposition must contain an indication of the goods and services on which the opposition is based in the language of the proceedings for each of the grounds. This applies to all types of earlier rights.

The opposition can be based on all the goods and services for which the earlier mark is registered or applied for, or on only some of the goods and services. These goods and services must be listed in the language of the proceedings.

If the goods and services on which the opposition is based are fewer than the goods and services for which the mark is registered, the goods and services on which the opposition is **not** based need not be indicated, as they are irrelevant to the proceedings.

An indication of the class number(s) or a reference to 'all goods and services for which the earlier mark is registered' is accepted as sufficient indication of the goods and services of the earlier rights on which the opposition is based, provided that a registration certificate or extract from an official source, containing the list of goods and services covered by that mark, is attached (the registration certificate or extract must either be in the language of the proceedings or be translated into the language of the proceedings or make use of national or INID codes so as to clearly identify the relevant class number(s)).

If an indication such as 'the opposition is based on all the goods in Class 9' is used and no certificate in the language of the proceedings is attached, the Office will require a specification of the goods in the language of the proceedings. An indication of this type is only acceptable when the opponent replies that it owns a registration with a description that mentions that the sign is registered for 'all goods in Class 9'.

Additionally, where the opponent indicates in the opposition form that the opposition is based on 'all goods and services for which the earlier right is registered' but then lists only 'part' of these goods and services (when compared with the registration certificate or relevant official extract attached to the opposition form) the Office will, in order to

overcome the contradictory information contained in the notice of opposition, assume that the opposition is based on 'all goods and services for which the earlier right is registered'.

Even if the opponent has not indicated, or has not clearly indicated, on which goods and/or services it bases its opposition, it is sufficient if a registration certificate in the language of the proceedings is attached; it is then assumed that the opposition is based on the goods and services that appear in the certificate. However, if the certificate is in a language other than the language of the proceedings or if no certificate is attached, the deficiency must be notified.

If an opposition is based on 'all identical/similar goods and services', clarification must be requested since this wording is not sufficiently clear to identify the basis of the opposition.

For oppositions based on earlier non-registered trade marks or rights, the opponent must indicate the commercial activities in which they are used.

Specific aspects: oppositions filed against international registrations designating the EU

For admissibility purposes, with regard to oppositions filed against international registrations designating the EU, an indication of the class number(s) only in the notice of opposition is not sufficient to identify the goods and services on which the opposition is based. If the opposition is based on all or part of the goods and services for which the earlier mark(s) is/are registered/applied for, these goods and services need to be listed in the language of the opposition proceedings. This list must include all the goods or services covered by that mark or at least the relevant goods or services on which the opposition is based.

2.4.2.4 Earlier mark with a reputation: territorial scope of reputation

When the opponent invokes Article 8(5) EUTMR on the basis of a national trade mark, the Office assumes that reputation is claimed for the territory in relation to which the earlier national mark has protection.

When the opponent invokes Article 8(5) EUTMR on the basis of an international trade mark, the opponent will have to identify the territories for which it claims reputation for its mark. In the absence of that indication, the Office assumes that reputation is claimed for all the territories in relation to which the earlier mark has protection.

When the earlier mark is an EUTM, no indication is requested since it is considered that the reputation is claimed for the EU.

2.4.2.5 Identification of the opponent

Article 2(2)(h)(i) EUTMDR

Article 2(1)(b) EUTMIR

The opponent can either be a natural or a legal person. The name, address, legal form (for legal persons only) and contact details must be provided by the opponent. If it is unclear whether the opponent is a natural or a legal person, or when the legal form of the legal person (e.g. GmbH, KG, SA, Ltd) is not indicated, a deficiency will be notified.

Change of owner (transfer of earlier mark) before the opposition is filed

Where the earlier mark has been transferred before the opposition is filed, a distinction has to be made between oppositions based on an earlier EUTM and oppositions based on national trade mark registrations (or applications).

Oppositions based on an earlier EUTM

An opposition based on European Union registrations or applications may be entered by the successor in title of an EUTM only if the conditions set out in Article 20(12) EUTMR are met, namely, only if the opponent has submitted a request for the registration of the transfer when the opposition is filed. According to Article 20(12) EUTMR, where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

It is up to the opponent to provide this information, and it will not be checked by the Office during the admissibility check. However, if the opponent mentions in the explanation of its opposition that it is the new owner (or uses similar terms), the Office must request the opponent to indicate the date the request for registration of the transfer was sent to or received by the Office.

Oppositions based on a national registration or application

An opposition based on a national registration or application may be entered by the 'old' owner or by the successor in title, as there are different practices in the different Member States regarding the need to register the transfer in the national trade mark register in order to be able to claim rights arising from the registration.

In some cases, the opposition is filed by opponent A whereas, after a transfer of the earlier mark on which the opposition is based, the mark is owned by B. As A may still appear in the relevant register as the owner, the Office will accept the opposition as valid with A as opponent, even though it is no longer the owner of the earlier mark.

If the opposition is filed with B as opponent and a copy of the registration certificate shows A as owner of the earlier mark, the opposition is accepted as admissible on the assumption that the earlier mark was transferred to B before the opposition was filed. However, entitlement to file the opposition (e.g. evidence of the transfer before the opposition was filed) has to be proved within the time limit for substantiation.

2.4.2.6 Indication of entitlement

Article 46(1) EUTMR

Article 2(1) and Article 2(2)(h)(iii) EUTMDR

Single opponent

The following persons are entitled to file an opposition.

- An opposition pursuant to Article 8(1) or (5) EUTMR may be filed by the **owner** of the earlier mark, or by a **licensee**, provided it is authorised by the owner.
- An opposition pursuant to Article 8(3) EUTMR may only be filed by the **owner** of the earlier mark.
- An opposition pursuant to Article 8(4) EUTMR may be filed by the **owner** of the earlier right or by a **person authorised under the applicable law** to exercise that right.
- An opposition pursuant to Article 8(6) EUTMR may only be filed by a **person authorised under the applicable law** to exercise the rights to an earlier geographical indication.

The opponent does not have to indicate its entitlement if it is the **owner** of the earlier mark or right on which the opposition is based. If the opponent is an **authorised licensee** or a **person authorised under the applicable law** they must submit a **statement** to that effect and **specify the basis of their entitlement** (for example, licence agreement, specific authorisation from the proprietor, specific provision of the applicable law). If the basis of the entitlement is not specified, the Office will invite the opponent to remedy the deficiency. If the deficiency is not remedied, the opposition will be rejected as inadmissible for the earlier mark or right concerned.

Where an earlier mark has more than one proprietor ('co-ownership') or where an earlier right may be exercised by more than one person, the opposition may be filed by any one of them. Therefore, it is not necessary that all co-owners or authorised persons file the opposition together. Only one of them need to file the notice of opposition to avoid unnecessary complications resulting from 'multiple opponents' scenarios, particularly where the opposition is based on more than one earlier mark or right (see below).

Multiple opponents

If the opposition is filed by several opponents, they may do so only if **all of them** are entitled to do so for **all** of the earlier marks or rights.

Firstly, each opponent's **individual entitlement** in relation to each earlier mark or right must be clarified.

In the absence of any indication of entitlement, the multiple opponents will be considered to be **co-owners**, applying the rule that only licensees and persons authorised under the applicable law need to indicate their entitlement (Article 2(2)(h)(iii))

EUTMDR). If assumed ownership or any other indicated entitlement is contradicted by evidence attached to or relied on in the notice of opposition (e.g. online evidence shows that one of the opponents is not an 'owner' of one of the earlier marks) or by the particular ground or basis of opposition (e.g. geographical indications under Article 8(6) have no 'owners'; a 'licensee' is not entitled to invoke Article 8(3) EUTMR), the opponents will be invited to clarify their individual entitlement for each of the earlier marks or rights.

If the opponents fail to remedy the deficiency concerning the indication of their **individual entitlement**, the opposition will be deemed **inadmissible for the earlier marks or rights for which their entitlement has not been clarified**.

Secondly, the opponent's **joint entitlement** has to be verified, namely, whether they comply with the specific requirement laid down in Article 2(1) EUTMDR. If, based on the entitlements indicated, the opponents cannot be accepted as 'multiple opponents', they will be invited to remedy the deficiency (typically, to choose with which of the opponents the proceedings will continue — see below). The following are **examples** of acceptable and unacceptable scenarios of multiple opponent relationships.

Acceptable

Earlier trade marks	1	2
Co-owners	A/B	A/B

Earlier rights	1	2
Authorised persons	A/B	A/B

Earlier trade marks	1	2
Owner	A	A
Licensee	B	B

Earlier trade marks	1	2
Owner	A	B
Licensee	B	A

Earlier trade marks	1	2
Owner	A	A
Co-owner	B	(none)
Licensee	(none)	B

Not acceptable

Earlier trade marks	1	2
Owners	A	B

The opponents will be asked to indicate whether the proceedings should continue with 'A' as the sole opponent based on the first earlier mark only, or with 'B' as the sole opponent based on the second earlier mark only. The opposition will no longer be considered to be based on the earlier mark of the departing opponent.

Earlier trade marks	1	2
Owners	A/B	A

The opponents will be asked to indicate whether the proceedings should continue with 'A' as the sole opponent based on both earlier marks or with 'A' and 'B' as multiple opponents based on the first mark only. In the latter case, the opposition will no longer be considered to be based on the second earlier mark.

Earlier trade marks	1	2
Owner	A	A
Licensee	B	none

The opponents will be asked to indicate whether the proceedings should continue with 'A' as the sole opponent based on both earlier marks or with 'A' and 'B' as multiple opponents based on the first mark only. In the latter case, the opposition will no longer be considered to be based on the second earlier mark.

If the opponents do not remedy the deficiency concerning their **joint entitlement**, the opposition will be deemed **inadmissible in its entirety**.

2.4.2.7 Professional representation

Articles 119 and 120 EUTMR

Article 2(2)(h)(ii) and Article 73 EUTMDR

Article 2(2)(h)(ii) EUTMDR provides that if the opponent has designated a representative, it must provide the name and business address of the representative in accordance with Article 2(1)(e) EUTMIR.

If the opponent is obliged to be represented under Article 119 EUTMR, failure to appoint a representative, or failure to indicate the name or business address of the representative, constitutes a relative admissibility deficiency. The Office will invite the opponent to appoint a representative and/or to indicate the name and address of the representative, failing which the opposition will be rejected as inadmissible.

For further details on professional representatives, including the requirement of non-EEA-based opponents to appoint a representative, communication with the professional representative and the 'common representative', see the Guidelines, Part A, General Rules, Section 5, Professional Representation, paragraphs 1 and 4.

2.4.2.8 Signature

Article 63(1)(a) EUTMDR

A notice of opposition must be signed by the opponent or, if it is submitted by a representative, by the representative.

If a notice of opposition is filed by electronic means, the indication of the name of the sender is deemed equivalent to a signature.

For further details on signatures, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.4.

2.4.2.9 Relative admissibility requirements: sanctions

Article 5(5) EUTMDR

If relative admissibility requirements are missing or not complied with, the opponent or its representative is given 2 months to remedy the deficiency. This time limit cannot be extended.

If the deficiency is not remedied in time, the opposition must be rejected as inadmissible or, if the deficiency concerns some of the earlier rights, the opponent will be notified that the opposition is admissible but that the earlier rights concerned cannot be taken into account.

2.4.3 Optional indications

2.4.3.1 Extent of opposition

Article 2(2)(i) EUTMDR

The opposition may contain an indication of the goods and services against which the opposition is directed; in the absence of such an indication, the opposition will be considered to be directed against all of the goods and services of the opposed mark.

If the opponent indicates that the opposition is only directed against part of the goods and services of the EUTM application, it must list these goods **clearly**.

The extent of the opposition is correctly indicated where the goods are specific goods encompassed by a broader term used in the contested specification (e.g. opposition directed against *trousers* and the EUTM application is filed for *clothing* — in this example, the only contested goods are considered to be *trousers*). However, when the opponent uses ambiguous wording, such as ‘the opposition is directed against all goods similar to ...’, when the opponent’s goods are substituted for applicant’s goods, or when any other indication given does not clearly identify the contested goods and services, the opposition will be considered to be directed against all of the goods and services of the opposed mark.

Additionally, where the opponent indicates in the opposition form that the opposition is directed against ‘part of the goods and services of the contested mark’ but then lists ‘all’ of the goods and services in the notice of opposition or in the annexes, the Office will, in order to overcome the contradictory information contained in the notice of opposition, assume that the opposition is directed against ‘all the goods and services’.

2.4.3.2 Reasoned statement on grounds

Article 2(4) EUTMDR

A ‘reasoned statement’ means any facts and arguments on which the opposition relies as well as any evidence in support of the opposition.

It is optional when filing an opposition. It may be included in the opposition, but otherwise may be submitted after expiry of the cooling-off period (Article 7(1) EUTMDR), and concerns the substance, not the admissibility, of the opposition.

2.5 Notification of the admissibility of the opposition and the commencement of the adversarial part of the procedure

Articles 5 and 7 and Articles 6(1) and 8(2) and (9) EUTMDR

Decision No EX-20-9 of the Executive Director of the Office of 3 November 2020 on communication by electronic means

The Office notifies the parties when the opposition has been found admissible. That notification constitutes a decision (18/10/2012, C-402/11 P, Redtube, EU:C:2012:649, § 42-53). However, as it is a decision that does not terminate proceedings, it may only be appealed together with the final decision on the case (Article 66(2) EUTMR). Consequently, the Office is bound by this decision and may only revoke it, provided that the requirements of Article 103 EUTMR for the revocation of decisions are met.

By the same notification, the Office informs the parties that the adversarial part of the proceedings is deemed to commence 2 months after receipt of the notification. The notification will also set the time limit for the opponent to present the facts, evidence and arguments in support of its opposition, as well as the time limit for the applicant to submit its observations in reply.

In practice, rather than setting separate 2-month time limits (2 months for the cooling-off period, 2 months for completing the opposition, 2 months for replying), the opponent's time limit to complete the opposition will be set at 4 months, while the applicant's time limit to reply to the opposition will be set at 6 months, from the date of the notification. Therefore, opponents should be aware that the time limit for completing the opposition is not 2 months after expiry of the cooling-off period, but 4 months from the date of notification. Likewise, applicants should be aware that the time limit to reply to the notice of opposition is not 2 months after expiry of the opponent's time limit, but 6 months from the date of notification. In any event, the Office indicates in the notification the exact dates to be observed by the parties.

Once the opponent has completed its opposition, any time after notification and before expiry of the 4 months available to it, the additional material will be forwarded to the applicant without any change in the time limit available for responding to the opposition. However, if the additional material arrives at the Office without sufficient time to forward it to the applicant within the time limit set for the opponent, the additional material will be forwarded to the applicant with a new time limit of 2 months set for replying to the opposition. This separately set 2-month time limit will run from the date of receipt of the notification of the additional material in order to ensure that the applicant always has a full 2 months to prepare its reply.

In the case of different means of communication with the parties, the time limits set in the notification on the commencement of the adversarial part of the proceedings are set according to the 'slower' means of communication. Therefore, if the Office's notification is sent by post or courier to one of the parties but by electronic means to the other, the latter will also be granted the 10 additional days to which the former party

is entitled (instead of the 5 additional days due for communication by electronic means), so that the time limits set for the commencement of the adversarial part of the proceedings coincide for both parties. For more information on communication with the Office, please refer to the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

Whenever the opposition is based on an earlier trade mark registered or applied for in colour, the Office will ensure that the applicant receives the colour representation. In some cases this may require notification by post.

3 Cooling-off Period

3.1 Setting the cooling-off period

Article 6(1) EUTMDR

When the opposition is found admissible, the Office sends a notification to the parties to that effect, also informing them that the adversarial part of the proceedings is deemed to commence 2 months after receipt of the notification.

This 2-month period serves as a so-called ‘cooling-off’ period before commencement of the adversarial part of the proceedings. During this period, the parties are encouraged to negotiate an agreement in order to settle the opposition amicably. If certain conditions are met, the opposition fee will be refunded (see paragraphs 6.2.1.2 and 6.2.2.1).

3.2 Extension of the cooling-off period

Article 146(5) to (7) and (9) EUTMR

Article 6(1) EUTMDR

The cooling-off period may be extended up to a total of 24 months if both parties submit requests for an extension before the period expires. The Office will grant an extension of 22 months, irrespective of what length of extension is requested.

It is not possible to circumvent the limitation of the cooling-off period to 24 months by jointly requesting a suspension for negotiations. Such a suspension may be requested after expiry of the cooling-off period.

To extend the cooling-off period the following is necessary.

- A signed request from both parties. This may take the form of either two separate requests or one joint request. It is not necessary to state a reason for the extension.
- The request must be in the language of the proceedings. Alternatively, the request can be filed in one of the Office languages. However, a translation must be filed on

the parties' own initiative within 1 month of filing. The Office does not send any communication requesting a translation of the request for extension.

- The request must be filed before expiry of the cooling-off period. Any request filed after expiry of the cooling-off period will have to be rejected. If one party files the request within but the other after expiry of the cooling-off period, the extension is also to be refused.

The extension of the cooling-off period must be differentiated from requests for extension of a time limit or a suspension. In the event that the request for extension is inadmissible because it has been filed late or because the cooling-off period had already been extended, it will be treated as a request for suspension provided that the conditions of such a request are fulfilled.

The extension is granted for a period of 24 months from the date of the start of the cooling-off period. This procedure avoids multiple extensions and at the same time leaves the parties maximum freedom to decide when they want to continue with the adversarial stage of the proceedings.

Any party can then bring the extended cooling-off period to an end (opt out) by expressly indicating this in writing.

It is immaterial whether the other party agrees with this or not.

When one of the parties opts out before expiry of the extended cooling-off period, the Office will confirm this to both parties and set the cooling-off period to expire 2 weeks after the said notification. The adversarial part of the proceedings will commence the day after. The same notification will notify new time limits for substantiation of the opposition and the applicant's reply, which will be 2 and 4 months, respectively, from the end of the cooling-off period.

Opting out is irrevocable. Opting out during the last month before commencement of the proceedings will not be accepted.

4 Adversarial Stage

4.1 Completion of the opposition

Within 2 months of expiry of the cooling-off period, the opponent may submit additional facts, evidence and arguments in support of its opposition.

Within the same time limit, the opponent must prove the existence, validity and scope of protection of the earlier rights it invoked, and submit proof of its entitlement to file the opposition.

The request to the opponent is a **general invitation** to complete the file within the meaning of Article 7 EUTMDR. The Office will **not** indicate the nature and type of material necessary for completing the file (see expressly Article 8(9), second sentence, EUTMDR). Rather, it will be for the opponent to decide what it wishes to submit.

4.2 Substantiation

Article 46 EUTMR

Article 7 and Article 8(1) EUTMDR

Substantiation is defined by Article 7(2) EUTMDR and refers to the proof of existence, validity and scope of protection of the earlier mark(s) or right(s), and the proof of entitlement to file the opposition.

After the parties have been notified of the admissibility of the opposition, the opponent has 2 months from the end of the cooling-off period to complete its file. In particular, the opponent must prove the existence, validity and scope of protection of the earlier rights invoked and its entitlement to file the opposition. Where relevant for the opposition, the opponent must also submit evidence of reputation, enhanced distinctiveness or any other aspect affecting the scope of protection of its earlier right(s).

The evidence must be in the language of the proceedings or accompanied by a translation for substantiation purposes. The translation must be submitted within the time limit for submitting the original. For the specific rules on translation of substantiation evidence, reference is made to paragraphs 4.3.1.1 and 4.3.1.3 for facts, evidence and arguments that must be translated within the substantiation time limit, and to paragraph 4.3.1.2 for substantiation evidence that must be translated only upon the Office's request.

For the purpose of substantiation, the opponent must provide the Office with the necessary proof. Apart from submitting physical evidence of substantiation, in cases where evidence concerning the filing or registration of the earlier rights or concerning the contents of the relevant national law is accessible online from a source recognised by the Office, the opponent may formally declare to the Office that it relies on online evidence, and that this online evidence may take the place of any physical evidence.

It is understood from the wording of Article 7(3) EUTMDR that, in order to rely on online evidence, there must be a formal declaration from the opponent asking the Office to access the necessary information for the earlier trade mark from the relevant online official sources. Consequently, as this is optional, the opposing party should formally and proactively let the Office and the other party know it wishes to rely on this option. The declaration must be explicit and unconditional to be accepted. Therefore, the Office will not check the substantiation of any rights online where the opposing party has not expressly and unconditionally consented to the use of online evidence.

It is noted that, even if the opponent formally declares that online evidence may be relied on, it is the opponent's obligation to check that the online sources reflect the most accurate and up-to-date relevant information. Moreover, in the event that the opponent, after such a declaration, still submits physical evidence without formally revoking its previous declaration, and there is a contradiction between the online evidence and the physical evidence, the most recent up-to-date evidence will apply.

A declaration may be introduced by the opposing party at any time before expiry of the time limit of substantiation. In the absence of any formal declaration (including when such declaration has been withdrawn), the opposition should be rejected as non-substantiated if no physical evidence is presented in due time.

If the opponent has not proven the existence of at least one earlier right, the opposition will be refused as unfounded.

If the earlier right that has been found admissible is not substantiated at the substantiation stage and there is/are another/other earlier right(s) that is/are substantiated, the absolute admissibility requirements for that/those earlier right(s) will be checked.

In relation to the submission of supporting documents, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

4.2.1 EUTMs and EUTM applications

If the earlier mark or application is an EUTM, the opponent does not have to submit any documents as far as the existence and validity of the EUTM (application) is concerned. The examination of the substantiation will be done *ex officio* with respect to the data contained in the Office's database.

4.2.2 Converted EUTMs and EUTM applications

Article 139(1) EUTMR

This section will deal only with specific aspects of conversion in opposition proceedings. For further information on conversion, see the Guidelines, Part E, Register Operations, Section 2, Conversion.

4.2.2.1 Opposition based on EUTM (application) (to be) converted

National applications deriving from the conversion of an earlier EUTM or EUTM application are considered to come into existence as soon as a valid conversion request is submitted. Such rights will be properly substantiated under Article 7(2) EUTMDR if the opponent indicates the number of the EUTM (or EUTM application) under conversion and the countries for which it has requested conversion.

4.2.2.2 Opposition based on an EUTM (application) that is subsequently converted

When, during opposition proceedings, the EUTM application (or EUTM) on which the opposition is based ceases to exist (or the list of goods and services is restricted), and a request for conversion is submitted, the proceedings can continue. This is because national trade mark registrations resulting from a conversion of an EUTM application can constitute the basis of the opposition procedure originally made on the basis of that EUTM application (15/07/2008, R 1313/2006-G, CARDIVA (fig.) / CARDIMA (fig.)).

In such a case, the Office will request the opponent in writing to inform the Office whether it maintains the opposition in view of the withdrawal, surrender or rejection of the earlier EUTM application(s) or registration(s) and whether it intends to rely on the national applications that result from the conversion of the earlier EUTM. If the opponent does not inform the Office within the established time limit that it wishes to rely on the national applications, the opposition will be rejected as unfounded.

Evidence of the existence of the earlier national applications must be submitted by the opponent as soon as it becomes available.

4.2.3 Trade mark registrations or applications that are not EUTMs

Article 7(2)(a)(i) and (ii) EUTMDR

To substantiate an earlier trade mark application or registration, the opponent must provide the Office with evidence of its filing or registration. The Office accepts as evidence of the filing or registration of earlier marks the following documents:

- certificates issued by the competent registration authorities;
- extracts from the official databases of the competent registration authorities; and
- extracts from the official bulletins of the competent registration authorities.

As mentioned above, the opponent may instead ask the Office to access the necessary information for this trade mark from the relevant online official database (see paragraph 4.2.3.2 below).

4.2.3.1 Certificates issued by the appropriate official body

Any registration certificate or the most recent renewal certificate showing the validity of the earlier mark beyond the time limit that was given to the opponent to substantiate its opposition, whether issued by a national office or by WIPO (if it concerns an international registration), constitutes valid evidence. However, a renewal certificate is not sufficient on its own if it does not contain all the necessary data that determines the scope of protection of the earlier mark. For further requirements relating to evidence of renewal, see paragraph 4.2.3.4 below.

If the opposition is based on an application, the opponent must submit evidence that the application was filed at the national office or that an international application was filed with WIPO. Once the earlier application has proceeded to registration, the opponent must submit evidence of registration. If, after the adversarial part of the proceedings, the opponent submits evidence that the national application in fact proceeded to registration before the time limit set in Article 7(1) EUTMDR, the earlier mark will be rejected as unfounded under Article 8(7) EUTMDR. An application certificate is not sufficient to prove that the trade mark has been registered. In other words, it cannot serve to prove the existence of a trade mark registration.

Certificates have to be checked carefully since, in some cases, there are only a few differences between an application form and the registration certificate.

4.2.3.2 Extracts from official databases

The Office accepts, as evidence of the filing or registration of **national marks**, extracts from the official online databases of the competent registration authorities of Member States and, as evidence of **international registrations**, extracts from WIPO's Madrid Monitor database. Excerpts from unofficial databases are not acceptable.

Furthermore, the Office accepts, as evidence for **both national marks and international registrations**, extracts obtained through the Office's TMview portal (<https://www.tmdn.org/tmview/welcome>). Extracts generated through TMview reflect the information obtained **directly** from the competent registration authorities and therefore, qualify as documents equivalent to registration certificates from the competent registration authorities within the meaning of Article 7(2)(a) EUTMDR (by analogy, 06/12/2018, T-848/16, V (fig.) / V (fig.) et al., EU:T:2018:884, § 59-61, 70).

While the abovementioned database extracts can be obtained and annexed to the opponent's submission, it is more convenient to refer to the relevant online source pursuant to Article 7(3) EUTMDR. Any general reference to any of the abovementioned official online databases is acceptable; a direct link to the online source is not required. For opponents using the Office's opposition e-filing form, a claim to substantiate the marks by reference to the relevant official online database (through TMview) is set by default.

Opponents must carefully check that the relevant official online database is up to date and contains all the relevant information necessary to prove the validity and scope of protection of the earlier mark invoked in the opposition. When the extract from an official database or the database accessed online does not contain all the information required, the opponent must supplement it with other documents from an official source that show the missing information. Some examples of this situation are shown below.

- Database extracts sometimes do not contain the list of goods and/or services; in such cases, the opponent must submit an additional document (e.g. a publication in the official bulletin) showing the list of goods and services.
- For figurative marks, database extracts sometimes show the image on a separate page. Consequently, when opponents file an extract as evidence for a figurative mark, they must ensure that the representation of the mark appears on the same page. If it does not, an additional document/page showing the image must be filed. This can be from the database itself (which reproduces the image on a separate page that, when printed or saved as a PDF, for example, includes an identification of the source) or from another official source (such as its publication in the official bulletin). Copying the image from the database and including it electronically or otherwise in the notice of opposition form is not sufficient.
- When English is the language of the proceedings, and where the national office also provides an English version of the trade mark extract, no translation would in principle, be necessary. However, as regards the list of goods and/or services, where the extract itself only gives the class headings along with an indication that this reference to the class heading does not necessarily reflect the goods and/or services protected under the trade mark, the opponent must always file the original

list in the original language (from an official source) and, where the list does not consist of a class heading, an accurate translation into English. Such translations are also required if the opponent relies on evidence accessible online from a source recognised by the Office if such evidence or part of it (especially the list of goods and services) is not in the language of the proceedings.

4.2.3.3 Extracts from official bulletins of the relevant national trade mark offices and WIPO

In all Member States the trade mark application and/or registration is published in an official bulletin. Copies of the publication are accepted as long as the document (or the accompanying observations of the opponent) indicates the origin of the publication. If this indication is missing, the evidence is insufficient to prove the validity of the mark.

Furthermore, a copy of the publication of the application is not sufficient to prove that the trade mark has been registered. In other words, it cannot serve to prove the existence of a trade mark registration.

The Office accepts the first WIPO publication of the international registration as sufficient evidence of registration although, once registered, it can still be refused by national offices during the following 12 to 18 months. The Office will invite the opponent to submit evidence of grant of protection of the international registration (where online substantiation was not claimed) only if (i) the applicant contests the protection of the mark in question in a given territory or for certain goods and services or (ii) the Office intends to uphold the opposition on the basis of the international registration (or its particular territorial extension). Failure to provide such evidence will result in the international registration (or its particular territorial extension) being deemed not substantiated.

4.2.3.4 Evidence of renewal

Trade marks are registered for a period of 10 years from the date of filing of the application; registration may be renewed for further 10-year periods (Article 48 of Directive (EU) 2015/2436, as implemented in the respective national legislation).

If the registration is due to expire before the expiry of the time limit for substantiation, the opponent must file a renewal certificate or equivalent document in order to prove that the term of protection of the trade mark extends **beyond** this time limit or any extension given to substantiate its opposition. Such information must be accessible from a source recognised by the Office if the opponent relied on it. What counts is the date on which the registration would expire, and not the possibility of renewing the mark within the 6-month grace period under the Paris Convention.

When an earlier right on which the opposition is based reaches the end of protection after expiry of the time limit set by the Office to substantiate the opposition, the opposition is not automatically rejected in the absence of further communications or proof from the opponent. Rather a communication is issued to the opponent in which it is invited to submit evidence of renewal, which is then communicated to the applicant

(05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 68 et seq.).

If there is no proper evidence of renewal, the opposition based on that earlier right will be rejected as not substantiated.

4.2.3.5 Entitlement to file the opposition

Article 46 EUTMR

Article 2(2)(h)(iii) and Article 7(2) EUTMDR

The opponent must submit evidence concerning its entitlement as indicated in the notice of opposition (see paragraph 2.4.2.6 above).

Single opponent

If the opposition is filed with 'B' as the opponent and the evidence shows 'A' as the **owner** of the earlier mark, the opposition will be rejected as not substantiated, unless the opponent has submitted evidence of the transfer and, if already available, the registration of the transfer in the relevant register, or the opponent has shown that 'A' and 'B' are the same legal entity, which has merely changed its name. A difference in the legal form may, depending on the jurisdiction, indicate different legal entities.

If the opponent is a **licensee** of the trade mark proprietor, the extract of the registration will normally show when a licence has been registered. However, some Member States do not record licences in their registers. In all cases, it is up to the opponent to demonstrate that it is a licensee and also that it is authorised by the trade mark owner to file an opposition. This authorisation cannot be presumed from the licensee status (16/05/2019, T-354/18, SKYFi /SKY et al., EU:T:2019:33, § 21-26). There are no restrictions on what evidence can be submitted to support such an authorisation: for example, any express authorisation on behalf of the trade mark proprietor, such as the licence contract, is deemed sufficient, so long as it contains indications concerning the authorisation to file the opposition.

According to Articles 25, 26 and 29 EUTMR, the Office registers and publishes licences for EUTMs (see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 2, Licences, Rights *in Rem*, Levies of Execution, Insolvency Proceedings or Similar Proceedings). If the earlier mark is an EUTM, the registration of the licence in itself constitutes sufficient proof of the opponent's licensee status. On the other hand, the opponent will still have to submit evidence to prove that it is authorised to file the opposition. If the opponent's authorisation to file the opposition can be proved on the basis of a document previously submitted to the Office, pursuant to Article 25(5) EUTMR, the opponent is not required to submit the same document in oppositions it subsequently files. Nevertheless, the opponent must specifically rely on and clearly identify the document and the provision that proves its authorisation to file the opposition (registration number of the licence, date and title of the document, number of the relevant clause, etc). Once identified, that document will be included in the case file and forwarded to the applicant for observations.

If the opponent is a person authorised under the applicable law for the grounds of Article 8(4) and (6) EUTMR, it must prove its entitlement to file the opposition under the applicable European Union legislation or national law.

Multiple opponents

Multiple opponents are required to prove their individual entitlement to each of the earlier marks or rights relied on in the notice of opposition. If one of them fails to prove its entitlement in relation to any of the earlier marks or rights, the opposition will be rejected as non-substantiated in relation to this opponent. The opposition will continue with the other opponent and its earlier marks or rights.

For example, opponent 'A' has indicated and proves that it owns both earlier marks. Opponent 'B' has indicated that it is co-owner of the first earlier mark and licensee for the second. It proves co-ownership of the first earlier mark, but fails to submit evidence of its licensee status for the second one. As opponent 'B' has failed to substantiate its entitlement in relation to one of the earlier marks, the opposition will be rejected in relation to opponent 'B' for all its earlier marks. This is because the opponents no longer fulfil the requirement of 'multiple opponents' within the meaning of Article 2(1) EUTMDR (see paragraph 2.4.2.6 above). Nevertheless, the opposition may continue with opponent 'A' and its earlier marks.

4.2.3.6 Verification of the evidence

The Office verifies that the trade mark particulars **claimed** in the notice of opposition are **reflected** in the **evidence** submitted, as an official document originating from the competent registration authority, or in the evidence accessible online from a source recognised by the Office if the opponent relied on that.

The following details of the evidence will be checked ⁽²⁶⁾:

- the issuing authority;
- the filing [210] and/or registration numbers [111] (in certain countries these are, or were, different);
- the territorial extent for international registrations (i.e. in which countries the mark is protected and for what goods and services);
- the filing [220], priority [300] and registration dates [151] (in certain countries, e.g. France, the filing and registration dates found on the certificate are the same);
- the representation of the sign [531, 540, 541, 546, 554, 556, 557, 571, 591];

If the earlier mark is in colour, the opponent must submit evidence originating from an official source that contains a reproduction of the mark in colour.

If the opponent has indicated in the notice of opposition that the earlier mark is in colour, but submits evidence showing a black and white representation of the mark, the opposition based on that earlier right will be rejected as not substantiated (25/10/2018, T-359/17, ALDI / ALDO (fig.), EU:T:2018:720, § 45; 04/06/2019, C-822/18 P, ALDI /

²⁶ The numbers in square brackets stand for standard INID codes (see in paragraph 4.3.1 below).

ALDO (fig.), EU:C:2019:466, appeal dismissed; 27/03/2019, T-265/18, Formata (fig.) / Formata (fig.) et al., EU:T:2019:197, § 48-53).

The **only exception** is where a colour representation of the mark is not available in official publications of the competent registration authority because, at the relevant point in time, that authority was not yet publishing marks in colour. This is typically the case where the official online evidence contains a black and white representation of the mark accompanied by a colour claim indicating the colours in words. In such a case, notwithstanding the black and white representation of the mark, it will be accepted as proof of a mark in colour as long as the colour indications (available in or translated into the language of proceedings) correspond to the colours of the mark indicated in the notice of opposition. In the rare situation where the official online evidence contains a black and white representation of the mark accompanied by a colour claim in general terms (such as ‘colours claimed’) but no indication of the colours in words, this will also be accepted (so long as this claim is available in or translated into the language of proceedings).

The above exception does not cover the situation where what is available in official publications of the relevant registration authority is not a colour representation as such, but a **representation that includes the colours in words and their distribution within the mark** (e.g. using arrows). Such a representation, even if technically black and white, will be considered a ‘colour representation’, and the opponent is required to provide a translation of the colour indications into the language of proceedings. Indications within the representation regarding the colours and their distribution will not be considered to be part of the representation as such, but as elements that affect the scope of protection of the mark.

If the opponent has provided no indication in the notice of opposition that the earlier mark is in colour, but submits evidence showing a mark in colour, the opposition based on that earlier right will be rejected as not substantiated.

- the goods and services covered [511];
- the expiry date of the registration (if given);
- the owner [731, 732];
- other entries in the register affecting the legal or procedural status or the scope of protection of the mark (e.g. restrictions, renewals, transfers, pending actions, the fact that the mark was registered due to acquired distinctiveness through use, etc.).

4.2.4 Substantiation of well-known marks, claims of reputation, trade marks filed by an agent, earlier signs used in the course of trade, designations of origin or geographical indications

4.2.4.1 Well-known marks

Article 8(2)(c) EUTMR

Article 7(2)(b) EUTMDR

An earlier well-known mark is a trade mark that is well known in a Member State, in the sense in which the words 'well known' are used in Article 6*bis* of the Paris Convention. Such a mark may be non-registered, but it may also be registered.

The opponent needs to demonstrate that it is the owner of an earlier trade mark that has become well known, in the relevant territory, for the goods and services on which the opposition is based. In order to substantiate its mark, it will have to submit evidence of the mark being well known.

If the opponent invokes a registered trade mark and claims the same mark in the same country as a well-known mark, this will in general be taken as an additional claim that its registered mark has acquired a high degree of distinctiveness by use.

It is very common for opponents to confuse 'well-known' marks with 'marks with a reputation' under Article 8(5) EUTMR. Depending on the ground of opposition that is indicated, the case will have to be considered under Article 8(2)(c) and/or Article 8(5) EUTMR. See also the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

4.2.4.2 Marks with reputation

Article 8(5) EUTMR

Article 7(2)(f) EUTMDR

An opposition under Article 8(5) EUTMR is based on an earlier trade mark that has a reputation. See also the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

The earlier trade mark in these cases is a registered trade mark. The opponent therefore has to submit registration certificates, etc. or rely on online evidence as set out above.

In order to make its case under Article 8(5) EUTMR, the opponent has to submit evidence of reputation. In addition, the opponent has either to allege and demonstrate that use of the mark that is the subject matter of the contested EUTM application would take unfair advantage of, or be detrimental to, the distinctive character or the repute of

the earlier trade mark, or to indicate that this is probable in the ordinary course of events.

4.2.4.3 Non-registered trade mark or another sign used in the course of trade

Article 8(4) EUTMR

Article 7(3) EUTMDR

For these rights, the Office applies the protection provided by the relevant law.

Not all Article 8(4) EUTMR rights are non-registered (for example, in some countries company and commercial names are registered). Thus, when the relevant law requires these rights to be registered for protection, copies of the registration and, if applicable, documents such as renewal certificates are required. In the case of non-registered marks or signs, the opponent must submit evidence of acquisition of the earlier right. It must further show that it may prohibit the use of a subsequent trade mark. Furthermore, it also needs to provide a reference to and the wording of the provisions of the national law on which it bases its case by adducing official publications of the relevant provisions or jurisprudence, and to make out its case under that law.

Where the evidence concerning the filing or registration of the sign claimed or the evidence concerning the content of the relevant national law is accessible **online from a source recognised by the Office**, the opponent may provide such evidence by making a reference to that source. To prove the existence of **registered rights**, the Office will accept any reference to an online database of the competent registration authority which is publicly accessible and free of charge, as long as the search environment is in the language of the proceedings.

To prove the **content of national law**, a reference to any online database will be accepted to the extent that it provides official legal text originating from the government or official body of the Member State concerned, is publicly accessible, free of charge and its search environment is in the language of the proceedings. In that regard, the WIPO Lex database (available at wipo.lex.wipo.int) is a useful source as it compiles official texts for intellectual property legislation in the original language received from the Member States concerned or from other verified sources (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) EUTMR, paragraph 4.2.1), provided that the search environment coincides with the language of the proceedings.

Furthermore, if the original text of the law is not in the language of the proceedings, its translation must also be available at the indicated online source, or should be submitted separately within the time limit for substantiation of the opposition (see paragraph 4.3.1.1 below).

Finally, the opponent must submit evidence that the use of its right, either registered or not, has been of more than mere local significance. See the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) EUTMR.

4.2.4.4 Protected designations of origin, protected geographical indications

Article 8(6) EUTMR

Article 7(2)(e) EUTMDR

Under Article 8(6) EUTMR, protected designations of origin and protected geographical indications applied for prior to the date of application of the EUTM (or the date of priority claimed, if applicable) can be invoked as the basis for oppositions. For these rights, the Office applies the protection provided by the relevant European Union legislation or national law.

In order to substantiate these rights, the opponent must provide the Office with evidence of the existence, validity and scope of protection of the earlier right. It must further show that it may prohibit the use of a subsequent trade mark.

To prove the existence, validity and scope of protection of the earlier right, the opponent must submit pertinent documents emanating from the competent authority proving that the right in question has been applied for, registered or granted (if the protected designation of origin or protected geographical indication was granted through administrative means other than registration). If these documents do not provide sufficient information regarding the opponent's entitlement to file the opposition, further documents must be submitted.

Furthermore, to prove that it is entitled to prohibit use of a subsequent trade mark under the relevant law, the opponent must provide a reference to and the wording of any national law on which it bases its case. The wording is not required if the opposition is based on European Union legislation. The opponent must also prove that the case fulfils all the conditions under the relevant provisions.

Where the evidence concerning the filing or registration of the earlier protected designations of origin or protected geographical indications, or the evidence concerning the content of the relevant national law, is accessible from an online source recognised by the Office, the opponent may submit such evidence by making a reference to that source. Where geographical indications protected under European Union legislation are concerned, it is sufficient to refer to a relevant official European Union database (e.g. eAmbrosia). Where geographical indications protected under national law are concerned, all official publications and national databases are acceptable to the extent that they originate from the government or official body of the Member State concerned, provided they are publicly accessible and free of charge.

Unlike for earlier rights invoked under Article 8(4) EUTMR, the requirement to submit evidence that use of the sign has been of more than local significance does not apply to earlier rights invoked under Article 8(6) EUTMR.

For more details regarding substantiation of protected designations of origin and protected geographical indications, see the Guidelines, Part C, Opposition, Section 4, Other Earlier Rights, Chapter 2, Geographical Indications (Rights under Article 8(6) EUTMR), paragraph 5.

4.2.4.5 Mark filed by an agent or representative

Article 8(3) EUTMR

Article 7(2)(c) EUTMDR

This concerns the case where an agent or representative of the proprietor of a trade mark applies for registration of that trade mark at the Office. The proprietor can oppose the application of the disloyal applicant. See also the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR).

The opponent has to prove its ownership of the trade mark and the time of acquisition of that mark. As the trade mark can be either a registered trade mark or a non-registered trade mark, the opponent may submit either evidence of registration anywhere in the world or evidence of acquisition of rights through use. The opponent also has to submit evidence of an agent-representative relationship.

4.2.5 Non-compliance with the substantiation requirements

Article 46(4) EUTMR

Article 7 and Article 8(1) and (7) EUTMDR

The Office sets the opponent a time limit of **2 months**, starting on the date when the adversarial part of the proceedings is deemed to commence, to complete the opposition by submitting facts, evidence and arguments in support ('substantiation time limit'). This time limit can be extended pursuant to Article 68 EUTMDR or, if missed, the opponent can apply for a reinstatement into the missed time limit subject to the conditions of Article 104 EUTMR (*restitutio in integrum*) or Article 105 EUTMR (continuation of proceedings).

Article 8(1) EUTMDR provides that if the opponent has **not provided any evidence** by the time of expiry of the substantiation time limit, or the evidence provided is **manifestly irrelevant** or **manifestly insufficient** to meet the requirements laid down in Article 7(2) EUTMDR for any of the earlier rights, the opposition will be rejected as unfounded.

If none of the earlier rights on which the opposition is based has been substantiated, the Office **closes the adversarial part** of the proceedings without inviting the applicant to submit observations in reply. The Office is not required to inform the opponent what facts or evidence could have been submitted (17/06/2008, T-420/03, BoomerangTV, EU:T:2008:203, § 76). Subsequently, the opposition is rejected pursuant to Article 8(1) EUTMDR.

It follows that where the opponent has failed to submit **any evidence at all**, the opposition will be rejected. It must be deemed that no evidence has been submitted if the evidence is not accompanied by a translation into the language of the proceedings,

as such non-translated evidence cannot be taken into account pursuant to the last sentence of Article 7(4) EUTMDR.

The evidence submitted is '**manifestly irrelevant**' if, by its nature, it cannot serve to establish the validity and existence of the earlier right invoked (for example, if it proves the existence of an earlier right that was not invoked in the notice of opposition). The evidence submitted is '**manifestly insufficient**' if it does not meet the formal requirements of substantiation.

Upon expiry of the substantiation time limit, the Office carries out a preliminary examination of substantiation. If the opponent submitted evidence for at least one of the earlier rights invoked in the opposition that cannot be qualified as 'manifestly irrelevant' or 'manifestly insufficient', the Office **continues the adversarial part** of the proceedings by forwarding the opponent's submission to the applicant with an invitation to submit observations.

If, upon further examination of the file, the evidence submitted within the substantiation time limit is **still** deemed **insufficient** to meet the requirements laid down in Article 7(2) EUTMDR, the opposition will be rejected in relation to that earlier right pursuant to Article 8(7) EUTMDR.

Furthermore, since the initial substantiation check is limited to finding one substantiated earlier right on the basis of which the procedure can continue, if the opposition cannot be fully upheld on the basis of this substantiated earlier right, a further examination of the file in relation to the remaining earlier rights is required. If this examination reveals that the evidence relating to these earlier rights is non-existent, manifestly irrelevant, manifestly insufficient or otherwise insufficient to meet the requirements laid down in Article 7(2), the opposition will also be rejected in relation to these rights pursuant to Article 8(7) EUTMDR.

4.2.6 Facts and evidence submitted after the substantiation time limit

Article 95(2) EUTMR

Article 8(5) EUTMDR

All facts and evidence on which the opponent bases its opposition have to be submitted within the substantiation time limit established in Article 7(1) EUTMDR. Any fact or evidence submitted after the substantiation time limit is, therefore, late.

Nevertheless, if the opponent submits facts or evidence to substantiate the opposition after the substantiation time limit, the Office may take into account such facts or evidence in exercise of its discretionary power pursuant to Article 95(2) EUTMR, subject to the conditions of Article 8(5) EUTMDR.

In that context, it must be assessed **first**, whether the Office can exercise any discretionary power and, **second**, if so, how to exercise it, that is, whether to admit or reject such late facts or evidence.

4.2.6.1 Whether discretionary power can be exercised

According to Article 8(5) EUTMDR, first sentence, the Office may exercise its discretionary power if the late facts or evidence supplement relevant facts or evidence submitted by the opponent in due time ('initial facts or evidence').

It is clear therefore, that no discretionary power applies if the late facts or evidence relate to an earlier right or ground of opposition invoked in relation to which **no initial evidence** was filed at all within the substantiation time limit. The same applies regarding facts.

However, where **some initial fact or evidence** was submitted, the Office will exercise its discretionary power whether to admit late facts or evidence only if the following conditions are met:

- initial evidence submitted within the substantiation time limit is relevant and not manifestly insufficient; and
- the late fact or evidence relates to the same legal requirement that the initial fact or evidence purported to prove.

Registration certificates that do not contain all the information necessary to establish the existence, scope or validity of the earlier mark concerned would, in principle, be found to be manifestly insufficient evidence, since the content required is precisely and exhaustively established by the regulations.

The Office will find that the late fact or evidence relates to the same legal requirement as the initial fact or evidence only when both sets refer to the same earlier mark, to the same ground and, within the same ground, to the same requirement.

No discretionary power applies where the Office has informed the parties that the opposition will be rejected as unfounded under Article 8(1) EUTMDR. In those cases, the proceedings will be resumed only if the opponent requests continuation of proceedings in accordance with Article 105 EUTMR or *restitutio in integrum* in accordance with Article 104 EUTMR.

For further information on continuation of proceedings, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits; and for further information on *restitutio in integrum*, see the Guidelines, Part A, General Rules, Section 8, *Restitutio in Integrum*.

4.2.6.2 Whether late facts or evidence should be admitted or rejected

For the purposes of exercising its discretionary power, the Office must take into account, in particular, the **stage of proceedings** and whether the facts or evidence are, *prima facie*, **likely to be relevant** for the outcome of the case and whether there are **valid reasons** for the late submission of the facts or evidence.

- The **stage of the proceedings** indicates how advanced the proceedings are at the time of submitting the late evidence.

- The late evidence is *prima facie* relevant, if it appears to have an impact on the assessment and outcome of the case.
- **Valid reasons** are typically where the supplementing evidence was not yet available before the expiry of the substantiation time limit. There may be other valid reasons.

These factors are interdependent. The later the stage of proceedings, the stronger must be the reason for late submission or the relevance of the evidence. Therefore, additional facts or evidence can be accepted if, *prima facie*, they are likely to be relevant for the outcome of the case and are submitted at an early stage of the proceedings with a justification for why they are being submitted at this stage of the proceedings.

There may be **other relevant factors**. The intention to prolong the proceedings by submitting evidence in parts (delaying tactics), if the circumstances of the case permit this conclusion, argues against the admission of late evidence. Also, the fact that the requirements to be proven are circumscribed in detail in the law or that the Office has explicitly drawn the opponent's attention to those requirements argues against admitting late evidence.

The natural difficulties involved in obtaining the evidence are not, as such, a valid reason for its belated submission.

4.2.6.3 Treatment of late evidence in proceedings

Facts or evidence received after the set time limit will be forwarded to the other party for information purposes without any indication of whether it has been accepted or refused, and will be examined at a later stage, when taking the decision. The proceedings will be reopened and a second round of observations will be granted if necessary — namely, if the Office is considering accepting late facts or evidence and the applicant has not yet had the opportunity to comment on them.

Application of the discretionary power must be reasoned in the decision concluding the opposition. However, where the initial evidence is in itself sufficient to prove the earlier rights and grounds of opposition invoked, there is no need to consider late additional evidence.

4.3 Translation/changes of language during the opposition proceedings

Pursuant to general rules set in Article 146(9) EUTMR and Article 24 EUTMIR, most submissions of the parties in opposition proceedings have to be in the language of the proceedings in order to be taken into account. However, for different submissions there are different rules to be applied.

4.3.1 Translations of evidence submitted to substantiate the opposition and of facts, evidence and arguments submitted by the opponent to complete its file

Articles 7(4) and (5) and 8(1) EUTMDR

Article 25(1) EUTMIR

On the basis of Article 24 EUTMIR, a distinction should be made between 1) evidence of filing, registration or renewal certificates or equivalent documents, and any provisions of the applicable national law; 2) other evidence submitted to substantiate the opposition; and 3) facts and arguments submitted by the opponent to complete its file.

4.3.1.1 Translation of evidence of filing, registration or renewal certificates or equivalent documents, and provisions of the applicable national law

Pursuant to Article 7(4) EUTMDR, any filing, registration or renewal certificates or equivalent documents, as well as any provisions of the applicable national law governing the acquisition of rights and their scope of protection, submitted by the opponent to substantiate the opposition must be either in the language of the proceedings, or be accompanied by a translation into that language. Such translations must be submitted by the opponent on its own motion and within the time limit for substantiation of the opposition. Only what is submitted and translated within this time limit is taken into account.

The requirement for the evidence of substantiation to be translated also relates to online evidence referred to by the opponent, where the language of the online evidence is not the same as the language of the proceedings. This follows from Article 7(4) EUTMDR, which states that “evidence accessible online” ... shall [also either] be in the language of the proceedings or shall be accompanied by a translation into that language’.

Article 25(1) EUTMIR requires the translation to reproduce the structure and contents of the original document. For translations of online evidence of substantiation, submission of the translation without the original will be accepted, as long as the document to which it refers is identified correctly.

The Office does not consider that information already given in the language of the proceedings in the notice of opposition, or in documents attached thereto or submitted later (e.g. explanation of grounds, lists of earlier marks, etc.), amounts to a valid translation of a registration document, such as a registration certificate, even where such indications have been accepted for admissibility purposes. The translation has to be on a stand-alone basis and cannot be assembled from fragments taken from other documents.

Article 25(1) EUTMIR provides that the opponent may indicate that only parts of the document are relevant, and therefore the translation may be limited to those parts only.

However, only irrelevant administrative indications (e.g. previous transfers of ownership that do not affect the opposition, administrative entries on fees, etc.) with no bearing on the case may be omitted from the translation. The provisions of Article 25(1) EUTMIR do not imply that the opponent has discretion to decide not to translate the elements required by the Regulation, specifically those listed in Article 7(2) EUTMDR as required for substantiating the earlier rights. Where the Regulation establishes that an element must be proven, as is the case for existence, validity, scope of protection of earlier rights and entitlement to file the opposition, and these particular parts of the evidence are not translated, the opposition may be rejected as non-substantiated.

The Office accepts that no translation of the information headers in the extracts/certificates (such as, 'filing date' 'colour claim', etc.) is needed, provided that they are identified using standard INID codes or national codes.

The list of INID codes and their explanations are attached as Appendix 1 to Standard ST 60 ('Recommendation concerning bibliographic data relating to marks'), available on WIPO's website. The opponent is not required to submit an explanation of the codes.

Where the opposition is based on only some of the goods and services covered by the earlier right, it is sufficient to submit only a translation of the goods and services on which the opposition is based.

When the entire original document is in the language of the proceedings except for the list of goods and services, there will be no need to submit a complete translation following the structure of the original document. In this case, it is acceptable if only the goods and services on which the opposition is based have been translated separately in the notice of opposition or in documents attached thereto or submitted later within the time limit to substantiate the opposition. The same applies to extracts/certificates that make use of INID or national codes, where the only information that still needs to be translated into the language of the proceedings is the list of goods and services. Where the opponent submits a partial translation of the goods and services on which the opposition is based, only the translated goods and services will be deemed properly substantiated. No account will be taken of the goods and services that have not been translated.

When the evidence from an official source contains a representation of the earlier mark in colour accompanied by colour indications, a translation of the colour indications into the language of proceedings is not compulsory.

The Office accepts simple translations, drawn up by anybody. The Office normally does not make use of its faculty to require the translation to be certified by a sworn or official translator unless serious doubts arise regarding the accuracy or content of the translation. Where the representative adds a declaration that the translation is true to the original, the Office will, in principle, not question this. The Office even accepts handwritten text on the copies of the original certificates giving the meaning of the various entries in the language of the proceedings, provided of course that they are complete and legible.

Extracts from commercial databases cannot be considered valid translations of an official document, unless they reproduce the structure and contents of the original document.

If the translation does not reproduce the structure and content of the online database evidence relied upon pursuant to Article 7(3) EUTMDR, the opponent will be requested, pursuant to Article 97(1)(b)-(c) EUTMR, to submit a physical copy of the original database extract or an appropriate explanation of the discrepancy (such as that the structure of the database has changed in the meantime). In the absence of such evidence, or if the evidence shows a discrepancy between the translation submitted and the original extract as regards the structure and content, the earlier mark will be deemed to be non-substantiated.

4.3.1.2 Translations of evidence submitted to substantiate the opposition other than filing, registration or renewal certificates or equivalent documents, or provisions of the applicable national law

Article 7(4) EUTMDR also addresses the language regime applicable to evidence submitted by the opposing party to substantiate the opposition other than filing, registration or renewal certificates or equivalent documents, and provisions of applicable national law. Such evidence encompasses, for example, evidence of reputation (Article 8(5) EUTMR) and evidence of use of more than mere local significance (Article 8(4) EUTMR).

If the evidence is submitted in an EU language that is not the language of the proceedings, the Office may, pursuant to Article 24 EUTMR, and either of its own motion or upon reasoned request by the applicant, require the opponent to submit a translation of the evidence into the language of the proceedings within a specified time limit. In other words, the opponent has no obligation to submit the translation on its own motion, unless it is requested to do so by the Office. This language regime mirrors the one applicable to proof of use; hence, rules regarding the translation of proof of use apply equally to the abovementioned evidence for substantiation (see paragraph 5.6 below).

4.3.1.3 Translations of facts and arguments submitted by the opponent to complete its file

The Office may consider facts and arguments filed by the opponent in support of the opposition only if they are submitted in the language of the proceedings or are accompanied by a translation within the time limit for substantiation. The Office will not request the opponent to send a translation; it has to send one on its own initiative. If no translation or only a partial translation has been submitted within the time limit set, parts of written submissions that have not been translated into the language of proceedings will, pursuant to Article 7(5) EUTMDR, not be taken into account.

Articles 7(4) and (5) and 8(1) EUTMDR

If the submissions are not in the language of the proceedings, they must be translated within the time limit specified for submitting the original document, namely within the time limit for substantiation of the opposition.

If this is not done, the legal consequence is that written submissions, or parts thereof, that have not been translated in this time limit are not taken into account. However, if documents proving the existence and validity of the earlier right have not been translated, the opposition must be refused as unfounded straight away.

4.3.2 Translation of further observations**Article 146(9) EUTMR****Article 8(2), (4) and (6) EUTMDR**

According to Article 146(9) EUTMR, the applicant's first reply or the opponent's reply to the applicant's observations may be in any language of the Office.

It is to be noted that if the applicant's first reply or the opponent's counter-reply is not in the language of proceedings but in one of the languages of the Office, the submission will not be taken into account unless the applicant or the opponent submits a translation of these documents in the language of the proceedings within the time limit of 1 month from the date of receipt of the original by the Office. The Office will not request the parties to send a translation; the parties have to send one on their own initiative.

Example 1

The language of opposition is English and the applicant has until 26/06/2017 to submit observations in reply to the notice of opposition. If, on 20/06/2017, it submits its observations in reply to the opposition in German, it must file its translation by 20/07/2017. If it does file the translation on or before 20/07/2017, both the original submission and the translation must be taken into account, notwithstanding that the original time limit for filing observations expired on 26/06/2017.

Example 2

The language of opposition is English and the applicant has until 26/06/2017 to submit observations in reply to the notice of opposition. If, on 18/05/2017, it submits its observations in reply to the opposition in German, it must file its translation by 18/06/2017. However, as its time limit only expires on 26/06/2017, if it has not filed a translation by 18/06/2017, it can still validly file documents until 26/06/2017. If it then files the translations before the end of the time limit, the Office considers those translations as valid observations filed in the language of the proceedings within the set time limit.

Article 25(2) EUTMIR

If no translation has been submitted or the translation is received after the expiry of the relevant period, the observations are deemed not to have been received by the Office and they will not be taken into account.

4.3.3 Translation of supporting documents other than observations

Article 24 and Article 25(2) EUTMIR

All evidence, with the exception of the evidence that the opponent must submit within the time limit given to substantiate its opposition, can be submitted in any official language of the European Union, as Article 24 EUTMIR applies. This evidence concerns all documents, other than observations, submitted by the parties after the time limit for the opponent to complete its file.

Examples of this type of evidence are catalogues, magazine articles, decisions of national courts or signed agreements that are submitted by the applicant together with its observations in reply to the opposition.

For this evidence, a translation is needed only if the Office, on its own motion or upon reasoned request by the other party, requests it. Therefore, the parties are not automatically obliged to file a translation.

In principle, the Office does not *ex officio* require a translation. However, it is vital that the party to whom the documents are addressed should be able to understand the meaning of their substantive content. If this is doubtful or is contested by the party addressed, the Office requires a translation within a specified time limit.

Article 25(2) EUTMIR will apply only if the Office requires a translation, with the effect that translations that are filed late must be disregarded; likewise, the original for which a translation is filed late or not at all must also be disregarded.

Together with the invitation to file a translation, the Office will draw the attention of the party concerned to the fact that it is up to that party to evaluate whether a complete translation of all the evidence submitted may be necessary. However, the documents in question will only be taken into account insofar as a translation is submitted or insofar as the documents are self-explanatory, regardless of their verbal components.

Example

In the case of a national court decision it may be sufficient to translate only those parts that are relevant for the opposition proceedings.

4.3.4 Change of language during opposition proceedings

Article 146(8) EUTMR

Article 3 EUTMDR

According to Article 146(5) EUTMR the opposition should be filed in one of the languages of the Office. However, Article 146(8) EUTMR provides that the parties to opposition proceedings may agree to change the procedural language and choose any official language of the European Union for that purpose.

If the parties agree to change the procedural language, they are required, pursuant to Article 3 EUTMDR, to inform the Office accordingly prior to the commencement of the adversarial part of the opposition proceedings. A request to change the language after the commencement of the adversarial part will not be accepted by the Office.

According to Article 3 EUTMDR, when the opponent and the applicant agree to change the language of the proceedings before the start of the adversarial part of the proceedings, the applicant may request that the opponent files a translation of the notice of opposition in that language. In other words, the opponent only has to submit a translation of the notice of opposition if the applicant requests it. The request for translation must be received before the start of the adversarial part of the proceedings. If the translation request is not filed or is filed late, the language of the proceedings will be changed to the language requested.

If a request to submit a translation of the notice of opposition has been filed and it was filed on time, the Office will set the opponent a time limit during which the translation must be submitted, which will be 1 month from expiry of the cooling-off period. Where the translation is not filed or is filed late, the language of the proceedings will remain unchanged.

4.4 Requests and other documents related issues

4.4.1 Restrictions, withdrawals and requests for proof of use to be filed by way of a separate document

Articles 8(8) and 10(1) EUTMDR

Where the applicant wishes to withdraw or restrict a contested application, it must do so by way of a separate document, that is to say in a separate submission or in a separate annex of a submission. Requests merged into observations would not be looked for and will not be accepted, even if included under a separate section, paragraph or header and even if they appear on the first or last page of the observations.

The same applies to requests for proof of use of an earlier mark pursuant to Article 47(2) or (3) EUTMR; these are only admissible if they are submitted as an unconditional request in a separate document within the period specified by the Office pursuant to Article 8(2) EUTMDR.

The Office has made available, to that effect, specific 'e-action' options in the User Area of the Office's website. When a withdrawal or restriction of a contested application or a request for proof of use is submitted by selecting the relevant e-action option, the automatically generated submission will be considered equivalent to a request made by way of a separate document, without any further statement being necessary.

A request, even if spotted, will be refused if it is not submitted 'separately' as defined above. The refusal will confirm the reason for the rejection and will be an interim decision appealable together with the decision on the substance.

4.4.2 Documents not readable

Article 63(3) EUTMDR

Where a communication received by electronic means is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office will inform the sender accordingly and invite it, within a time limit to be specified by the Office, to retransmit the original or to submit the signed original by post or courier.

When this request is complied with within the time limit specified, the date of receipt of the retransmission is deemed to be the date of receipt of the original communication.

For more details, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

4.4.3 No return of original documents

Original documents become part of the file and therefore cannot be returned to the person who submitted them.

However, the party always has the possibility of obtaining a certified or uncertified copy of the original documents, subject to payment of a fee. For further details, see information displayed on the Office's web page under 'Inspection of files and copies'.

4.4.4 Confidential information

Article 114(4) EUTMR

Sometimes one of the parties requests the Office to keep certain documents confidential, even vis-à-vis the other party in the proceedings. Although the Office can keep documents confidential vis-à-vis third parties (inspection of files), it can under no

circumstances keep them confidential vis-à-vis the other party in *inter partes* proceedings.

Each party to the proceedings must always have a right to defend itself. That means that it should have full access to all material submitted by the other party.

It follows that all material submitted by a party should be disclosed to the other party of the proceedings. The Office has an obligation to communicate all material received to the other party. Therefore, if one of the parties requests certain documents be kept confidential without mentioning whether this should be vis-à-vis third parties, the Office will take it for granted that this is the case and will forward them to the other party and mark them as confidential in the electronic file.

If, in the course of opposition proceedings, the Office receives documents with a request that they be kept confidential *inter partes*, the sender should be informed that the documents cannot be kept confidential vis-à-vis the other party to the proceedings.

To this end, a letter has to be sent, clearly explaining that the sender may choose between disclosure of the documents or withdrawal of the documents. It is up to the party to decide which of these possibilities is appropriate for its case and inform the Office accordingly.

If it confirms confidentiality, the documents will not be sent to the other party and will not be taken into account. They will be marked as confidential in the electronic file.

If it wants the documents to be taken into account but not available for third parties, the documents can be forwarded to the other party, but must be marked confidential in the electronic file.

If it does not reply within the time limit specified, the documents will not be sent to the other party and will not be taken into account. They will be marked as confidential in the electronic file.

For more information on confidentiality claims, reference is made to paragraph 5.1.3 of the Guidelines, Part E, Register Operations, Section 5, Inspection of Files.

4.4.5 References made to documents or items of evidence in other proceedings

Article 115 EUTMR

Article 64(2) EUTMDR

Decision No EX-20-5 of the Executif Director of the Office of 15 June 2020 concerning the keeping of files

The Office may receive observations from the opponent or applicant in which they refer to documents or evidence submitted in other proceedings, for instance to evidence of use that has already been submitted in a different opposition.

Such requests are accepted when the opponent/applicant clearly identifies the documents that it refers to. The party must indicate the following: (1) the number of the

opposition it refers to; (2) the title of the document it refers to; (3) the number of pages of this document; and (4) the date this document was sent to the Office. For example, 'the statutory declaration that was submitted to the Office on dd/mm/yy in opposition proceedings B XXX XXX, together with exhibits 1 to 8, consisting of XX pages'.

Should the documents referred to by the opponent or the applicant consist originally of items of evidence not having been filed in paper format up to and including A3 size, and should this evidence not be available in the electronic file of the Office, the party concerned must, pursuant to Article 64(2) EUTMDR, submit by mail a second copy for transmission to the other party within the original time limit. If no copy is provided, these items of evidence will not be taken into account.

In addition, it should be noted that the documents or evidence referred to might need translation into the language of the opposition proceedings. Article 146(9) EUTMR, Articles 7(5) and 10(6) EUTMDR and Article 24 EUTMIR apply accordingly.

A general reference to documents or evidence submitted in other proceedings will not be accepted. In such a situation the party making general reference to other documents or evidence may be invited to be sufficiently specific within a given time limit. The party should be informed that the time limit granted by the Office is only meant for the clear and precise indication of the documents or evidence referred to and that under no circumstances will an extension of the original time limit be granted. Moreover, the party should also be informed that if it does not specify what documents are being referred to within the time limit set, those other documents will not be considered.

The parties should be aware that material submitted in other proceedings may have been destroyed 5 years after their receipt in accordance with Article 115 EUTMR and Decision No EX-20-5 of the Executif Director of the Office of 15 June 2020 concerning the keeping of files. In this case, the reference to documents or evidence submitted in other opposition proceedings has no effect.

4.5 Further exchanges

Article 8(2), (4), (6) and (9) EUTMDR

Article 24 and Article 25(2) EUTMIR

The Office invites the applicant to file observations within the time limit set by it in accordance with Article 8(2) EUTMDR.

The applicant can request proof of use of the earlier right with or without submitting observations at the same time on the grounds on which the opposition is based. In that case, the observations may be submitted together with the observations in reply to the proof of use.

In appropriate cases, the Office may invite the parties to limit their observations to particular issues. In that case, the party is allowed to raise the other issues at a later stage of the proceedings.

Once the applicant has submitted its observations in reply, the opponent is granted a final time limit to submit its counter-reply if the Office considers it necessary. After this, the adversarial part of the proceedings is usually closed, and the opposition is ready for decision.

The Office may, however, grant the possibility of another exchange of observations. This can occur when the case deals with complex issues or when the opponent raises a new point and it is admitted to the proceedings. In this case, the applicant must be given a possibility of replying. The Office may exercise its discretion in deciding whether another round of observations should be granted to the opponent (e.g. if the applicant raises new issues such as the coexistence of the marks, the invalidity of the earlier right or an agreement between parties).

4.6 Observations by third parties

Article 45 EUTMR

[Communication No 2/09](#) of the President of the Office of 9 November 2009

Third parties can make observations explaining why the EUTM application should not be registered under Article 5 EUTMR or on the basis of one of the absolute grounds of Article 7 EUTMR. For further details, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, and the Guidelines, Part B, Examination, Section 1, Proceedings.

Anybody can submit third-party observations; even the opponent is entitled to do so. However, it should do so in a manner that leaves no doubt that they are third-party observations. According to the abovementioned Communication of the President of the Office, the observations must be submitted separately. However, in practice (30/11/2004, R 735/2000-2, Serie A (fig.) / LEGA PALLAVOLO SERIE A), the 'separate submission' requirement is deemed to be satisfied when the observations are clearly separable from the grounds and arguments supporting the opposition, even if they are included in the same document. As long as the opponent expressly mentions that it wishes to make observations under Article 45 EUTMR, these will be dealt with, even if they are not submitted separately. However, if in its submission the opponent argues that the EUTM application should have been refused under Articles 5 and 7 EUTMR, without any reference to the contents of Article 45 EUTMR, this submission will not be regarded as third-party observations under Article 45 EUTMR.

When an opponent makes third-party observations, the Office will consider if the observations raise serious doubts as to the registrability of the EUTM application, or if they will only be sent to the applicant for information purposes.

If the observations raise serious doubts, the Office must suspend the opposition proceedings until a decision on the observations is taken. In cases where the observations do not raise serious doubts (i.e. when the observations have only been sent to the applicant for information purposes) or do not affect the contested goods or

services, the opposition proceedings will not be suspended. If the opposition proceedings need to be suspended, the suspension will take effect from the date when the Office issues the objection under Article 7 EUTMR, and proceedings will remain suspended until a final decision has been taken. Where the third-party observations are received within the 3-month opposition period, the Office will first deal with the admissibility of the opposition and, once the decision on admissibility has been notified, the opposition proceedings will be suspended.

For oppositions closed due to third-party observations, the opposition fee will not be refunded, as no provision for such refund is made in the regulations (see Article 6(5) EUTMDR).

5 Procedure related to the request for proof of use

5.1 Admissibility of the request for proof of use

According to Article 47(2) EUTMR, use of the earlier mark needs to be shown only if the applicant requests proof of use. The institution of proof of use is, therefore, designed in opposition proceedings as a **defence plea of the applicant**.

The Office may neither inform the applicant that it could request proof of use nor invite it to do so. In view of the Office's impartial status in opposition proceedings, it is left to the parties to provide the factual basis and to argue and defend their respective positions (see second sentence of Article 95(1) EUTMR). It follows that the applicant may also limit its request for proof of use to one or some of the earlier marks relied on (even if all would be subject to the genuine use requirement), or to only some of the goods or services on which the opposition is based. In such a case, the Office will require the opponent to prove genuine use of its mark within the limited scope requested by the applicant.

Article 47(2) EUTMR is not applicable when the opponent, on its own motion, submits material relating to use of the earlier mark invoked (for example, for the purposes of proving enhanced distinctiveness under Article 8(1) EUTMR, well-known character under Article 8(2)(c) EUTMR, or reputation under Article 8(5) EUTMR). As long as the EUTM applicant does not request proof of use, the issue of genuine use will not be addressed by the Office *ex officio*. In such cases, in principle, it is even irrelevant that the evidence produced by the opponent might demonstrate only a particular type or manner of use, or use that is limited to only part of the goods or services for which the earlier mark is registered.

5.1.1 Time of request

The request for proof of use must be made within the first time limit for the applicant to reply to the opposition (Article 10(1) and 8(2) EUTMDR).

Nevertheless, the Office also accepts requests for proof of use submitted during the cooling-off period or during the 2-month period given to the opponent to substantiate the opposition. If the request for proof of use is admissible, the Office will invite the opponent to submit proof of use, ensuring that it always has at least 2 months to do so.

5.1.2 Earlier mark registered for not less than 5 years (mark outside the 'grace period')

The owner must put the mark to genuine use within a period of 5 years following its registration (Article 18(1) EUTMR). However, the owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use of the mark in order to rely upon it. During the 'grace period', the mere formal registration gives the mark full protection. Once this period lapses, the proprietor may be required to prove genuine use of the earlier mark.

For oppositions filed **against EUTM applications**, the opponent may be required to prove genuine use if, on the date of filing or on the date of priority ⁽²⁷⁾ of the EUTM application, the earlier mark has been registered for not less than 5 years (Article 47(2) EUTMR).

For oppositions filed against **international registrations designating the EU**, the opponent may be required to prove genuine use if, on the date of registration of the IR (INID code 151) or on the date of its priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891) ⁽²⁸⁾, the earlier mark has been registered for not less than 5 years.

If the earlier mark is still within the grace period for non-use, any request for proof of use will be refused. This will be the case even if the applicant alleges that the earlier mark had been refiled with the intention of circumventing the limitation of the grace period, since such a claim cannot be examined in opposition proceedings (19/10/2017, T-736/15, SKYLITE (fig.) / SKY et al., EU:T:2017:729, § 20-28; 16/05/2019, T-354/18, SKYFi / SKY et al., EU:T:2019:33, § 41-43, 46-48).

5.1.2.1 Earlier EUTMs

The decisive date for establishing whether a trade mark has been registered for not less than 5 years at the relevant date is, according to Article 18(1) and Article 47(2) EUTMR, the **registration date** of the earlier EUTM, that is to say, the date of entry of the EUTM in the Register as published, pursuant to Article 111(2)(o) EUTMR, under INID code 151. If 5 years or more have elapsed between the registration date of the earlier EUTM and the relevant date, the applicant (or in the case of a contested IR, the holder) is entitled to request proof of use.

²⁷ For oppositions filed before 23/03/2016, the relevant date is the date of publication.

²⁸ For oppositions filed before 23/03/2016, the relevant date is the date of first publication of the contested IR or its subsequent designation in the EUTM Bulletin.

5.1.2.2 Earlier international registrations designating the European Union

For earlier international registrations designating the European Union, the date of **second republication of the EU designation** pursuant to Article 190(2) EUTMR marks the beginning of the calculation of the 5-year grace period for non-use (Article 203 EUTMR). This date corresponds to the date of publication of the EU designation in part M.3.1 of the EUTM Bulletin.

5.1.2.3 Earlier national marks

For national marks, the ‘date of completion of the registration procedure’, as provided for in Article 16(1) of Directive (EU) 2015/2436, serves for calculating the starting point of the 5-year grace period for non-use. That date is determined by each Member State according to its own procedural rules (14/06/2007, C-246/05, *Le Chef de Cuisine*, EU:C:2007:340, § 26-28).

Some Member States in particular provide for opposition proceedings **following registration** ⁽²⁹⁾. For these national marks, the ‘registration date’ cannot be the relevant date for calculating the 5-year grace period. Instead, the 5-year period must be calculated from the date when the mark can no longer be opposed or, in the event that an opposition has been lodged, from the date when a decision terminating the opposition proceedings becomes final or the opposition is withdrawn (Article 16(2) of Directive (EU) 2015/2436, as implemented in the respective national legislation).

Pursuant to Article 16(4) of Directive (EU) 2015/2436, Member States are required to enter the date of commencement of the 5-year period in the register. Until this information becomes readily available in the respective official trade mark databases, the relevant date in the respective jurisdictions can be consulted in the table in the Annex to this section. The Office will rely on the information in that table to determine whether a request for proof of use against a particular national mark is admissible.

5.1.2.4 Earlier international registrations designating a Member State

Article 16(3) of Directive (EU) 2015/2436 provides that, for international registrations having effect in a Member State, the relevant 5-year period must be calculated from the date when the mark can no longer be rejected or opposed. Where an opposition has been lodged or when an objection on absolute or relative grounds has been notified, the period must be calculated from the date when a decision terminating the opposition proceedings or a ruling on absolute or relative grounds for refusal becomes final or the opposition is withdrawn.

Under Article 5(2)(a) and (b) of the Madrid Protocol, the Designated Offices have a period of 12 or 18 months from the date of notification of the designation to issue provisional refusals. Where the Member State has not been designated in the international application but in a subsequent designation, the 12 or 18 months start

²⁹ Germany, Austria, Finland, Sweden, Latvia and in the case of marks registered via the ‘accelerated procedure’, in Benelux.

from the date the subsequent designation was notified to the Designated Offices. If no provisional refusal is notified to the International Bureau within the applicable time limit, the international registration is deemed to be protected in the designated country (principle of tacit acceptance, Article 4(1) of the Madrid Protocol).

Member States that use the **12-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia.

Member States that have opted for the **18-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Denmark, Estonia, Ireland, Greece, Lithuania, Finland and Sweden.

The applicable deadline (**12 or 18 months**) for Bulgaria, Italy, Cyprus, Poland and Slovakia when acting as a designated party depends on whether (i) such country was designated or subsequently designated before or after 01/09/2008 and (ii) the Office of origin is bound by both the Agreement and the Protocol (deadline: 12 months) or only the Protocol (deadline: 18 months).

See overview table below:

Designated country ⁽³⁰⁾	Country of origin	Deadline to issue a refusal
<i>Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia</i> (Contracting EU parties bound by both the Agreement and the Protocol)	<i>All contracting parties</i> [Status 01/03/2021: 107 members] ⁽³¹⁾ (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	12 months
<i>Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden</i> (Contracting EU parties bound by the Protocol only)	<i>All contracting parties</i> [Status 01/03/2021: 107 members] (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	18 months

³⁰ Malta is not part of the Madrid System.

³¹ For the full list of all Member States to the Madrid Agreement and to the Madrid Protocol see: http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

Designated country ⁽³⁰⁾	Country of origin	Deadline to issue a refusal
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated before 01/09/2008</i> ⁽³²⁾ (Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline)	<i>All contracting parties</i> [Status 01/03/2021: 107 members] (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	18 months
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated on or after 01/09/2008</i> (Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline)	<i>Contracting parties bound by both the Agreement and the Protocol</i> [Status 01/03/2021: 55 members]	12 months
	<i>Contracting parties bound by the Protocol only</i> [Status 01/03/2021: 52 members]	18 months

To determine whether the earlier international registration designating a Member State is subject to the requirement to prove use, the Office first verifies that the designation in question is not pending a provisional refusal of protection or has been refused by a final decision. If a provisional refusal is pending, the registration procedure cannot yet be deemed to be completed. If the provisional refusal has been confirmed by a final decision, the relevant designation cannot be taken into account as a basis of opposition, to the extent it has been refused.

Next, the Office checks whether a statement of grant of protection has been issued. If so, the Office will, on its own motion, consider the **date of publication of the statement of grant of protection** in the WIPO Gazette (indicated by INID code 450 under the relevant heading of the Madrid Monitor extract) as the start date for calculating the 5-year grace period (Rule 18ter(1) and (2) of the Regulations under the Protocol Relating to the Madrid Agreement).

Where no statement of grant of protection has been issued, the Office will, on its own motion, consider the **date of expiry of the time limit to notify a refusal** as the start date for calculating the 5-year grace period. That date is calculated by adding the relevant 12-month or 18-month period, according to the above rules, to the date of notification of the international registration or its subsequent designation from which the time limit to notify the refusal starts (indicated by INID code 580 under the relevant

³⁰ Malta is not part of the Madrid System.

³² The date of entry into force of Article 9sexies(1)(b) of the Protocol, which rendered inoperative any declaration under Article 5(2)(b) or (c) of the Protocol (extension of the time limit for notifying a provisional refusal) between Contracting Parties bound by both the Agreement and the Protocol.

heading of the Madrid Monitor extract, see Rule 18(1)(a)(iii) of the Regulations under the Protocol Relating to the Madrid Agreement).

Only when it is decisive for determining whether the earlier mark is subject to the requirement to prove use can the opponent claim a date that is **later** than the one taken into account by the Office on its own motion (e.g. when the designated country opted for a period even longer than 18 months for notifying a refusal based on an opposition pursuant to Article 5(2)(c) of the Madrid Protocol, or when all the procedures concerning the protection of the mark before the designated Office have been completed subsequent to the issuing of the statement of grant of protection, pursuant to Rule 18ter(4) of the Regulations under the Protocol Relating to the Madrid Agreement). This is also true should the applicant or holder wish to claim a date that is **earlier** than these dates (e.g. the date following the expiry of the opposition period, where no opposition has been filed — see Article 16(3) of Directive (EU) 2015/2436). Conclusive evidence to support these claims must be submitted to the Office.

5.1.2.5 Summary of calculation of the beginning of the grace period

Earlier mark	Calculation of the beginning of the 5-year grace period
EUTM	Date of registration.
IR designating the EU	Date of the second republication of the EU designation in part M.3.1 of the EUTM Bulletin.
National mark	The date of completion of the registration procedure, as defined in national law (see table in Annex).
IR designating Member States	By default, the date of publication of the statement of grant of protection in the WIPO Gazette (INID code 450 of the relevant heading).

5.1.3 Request must be unconditional, explicit and unambiguous

The applicant's request is a formal declaration with important procedural consequences.

Pursuant to Article 10(1) EUTMDR, the request has to be **unconditional**. Phrases such as 'if the opponent does not limit its goods/services in Classes 'X' or 'Y', we demand proof of use', 'if the Office does not reject the opposition because of lack of likelihood of confusion, we request proof of use' or 'if considered appropriate by the Office, the opponent is invited to file proof of use of its trade mark' contain conditional or auxiliary claims and, therefore, are not valid requests for proof of use (26/05/2010, R 1333/2008-4, RFID SOLUTIONS (fig.) / rfid (fig.)).

Moreover, the request has to be **explicit and unambiguous**. In general, the request for proof of use must be expressed in positive wording. As use or non-use can be an issue in manifold constellations (for example, to invoke or deny a higher degree of distinctiveness of the earlier mark), mere observations or remarks by the applicant in respect of the (lack of) use of the opponent's mark are not sufficiently explicit and do not constitute a valid request for proof of genuine use (16/03/2005, T-112/03, Flexi Air, EU:T:2005:102).

Examples

Sufficiently explicit and unambiguous request:

- 'I request the opponent to submit proof of use ...';
- 'I invite the Office to set a time limit for the opponent to prove use ...';
- 'Use of the earlier mark is hereby contested ...';
- 'Use of the earlier mark is disputed in accordance with Article 47 EUTMR.';
- 'The applicant raises the objection of non-use.' (05/08/2010, R 1347/2009-1, CONT@XT / CONTEXTA).

Not sufficiently explicit and unambiguous request:

- 'The opponent has used its mark only for ...';
- 'The opponent has not used its mark for ...';
- 'There is no evidence that the opponent has ever used its mark ...';
- '[T]he opponents' earlier registrations cannot be "validly asserted against the [EUTM] application...", since "...no information or evidence of use ... has been provided..." (22/09/2008, B 1 120 973).

Not only the request, but also the scope of the request, has to be explicit and unambiguous. The Office will accept the request only for goods and services listed literally in the specification of the earlier mark and on which the opposition is based. The following are examples where the scope of the request is not explicit and unambiguous:

- 'I request that the opponent prove genuine use of the earlier mark for the goods applied for in the contested mark' — the applicant cannot request that the opponent prove use of the applicant's own goods (see, for example, 24/09/2008, R 1947/2007-4, HOKAMP / HOLTKAMP, § 20);
- 'I request that the opponent prove genuine use of the earlier mark for goods that are identical or similar to the goods applied for' — the scope of the request cannot be defined by reference to the applicant's goods and cannot be subject to interpretation;
- 'I request that the opponent prove genuine use for *trousers* and *shirts*' — where the goods of the earlier mark are *clothing, footwear and headgear*. The scope of an explicit request cannot be subject to interpretation. Neither the Office nor the opponent is required to determine whether an item is covered by a broader category of the specification of the earlier mark. Furthermore, the opponent cannot be required to prove use of a specific item within a category because he may prove genuine use for that category by other items included therein (see, for example, 24/09/2008; R 1947/2007-4, HOKAMP / HOLTKAMP, § 23; 07/07/2009,

R 1294/2008-4, ORDACTIN / Orthangin, § 16; 08/10/2010, R 1316/2009-4, miha bodytec / bodytec, § 18).

The Office will refuse a request for proof of use whose scope is not explicit and unambiguous.

5.1.4 Request made in a separate document

Pursuant to Article 10(2) EUTMDR, the request for proof of use must be submitted in a separate document. For more information, see paragraph 4.4.1 above.

5.1.5 Applicant's interest to deal with proof of use first

Under Article 10(5) EUTMDR a request for proof of use may be submitted at the same time as observations. The applicant may limit its first observations to requesting proof of use. It must then reply to the opposition in its second observations, namely when it is given the opportunity to reply to the proof of use submitted. It may also do this if only one earlier right is subject to the use requirement, as the applicant should not be obliged to split its observations.

If, however, the request is completely invalid, the Office will close proceedings without granting the applicant a further opportunity to submit observations (see paragraph 5.1.6).

5.1.6 Reaction if request is invalid

If the request is invalid on any of the above grounds or if the requirements of Article 47(2) and (3) EUTMR are not met, the Office nevertheless forwards the applicant's request to the opponent but advises both parties of the invalidity of the request.

The Office will immediately terminate the proceedings if the request is completely invalid and not accompanied by any observations by the applicant. However, the Office can extend the time limit established in Article 8(2) EUTMDR if such an invalid request was received before expiry of the time limit set for the applicant but was not dealt with by the Office until after expiry thereof. Because refusal of the request for proof of use after expiry of the time limit will disproportionately harm the interests of the applicant, the Office extends the time limit by the number of days that were left when the party submitted its request. This practice is based on the rules of fair administration.

If the request is only invalid as regards part of the earlier rights on which the opposition is based, the Office expressly limits the invitation to the opponent to submit proof of use to the rights that are subject to the use requirement.

5.2 Express invitation by the Office

If the applicant's request for proof of use is valid, the Office gives the opponent two months to submit proof of use or show that there are proper reasons for non-use. Taking a decision on use in the absence of an explicit invitation by the Office to submit proof of use constitutes a substantive procedural violation, even if the applicant's request is clear, and the opponent understands it and submits the requested evidence of use (28/02/2011, R 16/2010-4, COLORPLUS, § 20; 19/09/2000, R 733/1999-1, AFFINITÉ / AFFINAGE).

In cases where the request for proof of use arrives during the cooling-off period and is communicated to the opponent during that period, the deadline for submitting proof of use will coincide with the deadline for providing initial or additional facts, evidence and arguments. The time limit will be extended automatically if the cooling-off period is extended.

If the request reaches the Office before the end of the period for submitting or amending facts, evidence and arguments, and is dealt with in this period, the deadline for submitting such facts, evidence and arguments will be extended to coincide with the deadline of 2 months for submitting proof of use.

5.3 Reaction from the opponent: providing proof of use

5.3.1 Time limit for providing proof of use

The Office gives the opponent 2 months to submit proof of use. The opponent may request an extension of the deadline in accordance with Article 68 EUTMDR. The common practice on extensions is applicable to these requests (see paragraph 7.2.1 below).

Article 10(2) EUTMDR expressly states that the Office will reject the opposition if the opposing party does not provide proof of use before the time limit expires.

Three scenarios are to be differentiated.

- Any evidence that has been submitted by the opponent at any time during the proceedings before the expiry of the time limit for providing proof of use, even before the applicant's request for proof of use, has to be automatically taken into account when assessing proof of use.
- The opponent has not submitted **any or any relevant indication or evidence** within the time limit: the submission of relevant indications or evidence of proof of use for the first time after the expiry of the time limit results in rejection of the opposition **without the Office having any discretionary powers**. Article 10(2) EUTMDR is an essentially procedural provision and it is apparent from the wording of that provision that when no proof of use of the mark concerned is submitted within the time limit set by the Office, the opposition must automatically be

rejected. However, if the opposition is also based on other earlier marks that are not subject to the proof of use requirement, the proceedings will continue based on those earlier marks.

- The opponent has submitted **relevant indications or evidence** within the time limit and presents **additional indications or evidence** after the time limit has expired. The Office may take into account the evidence submitted out of time by **exercising the discretion** conferred on it by Article 95(2) EUTMR.

In that context, it must be assessed **first**, whether the Office may exercise discretion, and, if so, **second**, how to exercise its discretion, that is, whether to admit or reject such late facts or evidence.

According to Article 10(7) EUTMDR, the Office must exercise its discretion if the late indications or evidence merely supplement, strengthen and clarify the prior relevant evidence submitted within the time limit with the purpose of proving the same legal requirement laid down in Article 10(3) EUTMDR, namely, place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which opposition is based. It follows that the Office may not exercise any discretion if the late evidence intends to prove a legal requirement for which no initial evidence at all had been submitted. For example, if no indications or evidence related to the place of use were submitted at all within the relevant time limit, any evidence submitted in this respect after the time limit must be discarded.

When exercising its discretion, the Office must take into account, in particular, the **stage of proceedings** and whether the facts or evidence are, prima facie, **likely to be relevant** for the outcome of the case and whether there are **valid reasons** for the late submission of the facts or evidence.

These factors are interdependent. The later the stage of proceedings, the stronger must be the reason for late submission or the relevance of the evidence. Therefore, additional indications or evidence can be accepted if, prima facie, they are likely to be relevant for the outcome of the case and are submitted at an early stage of the proceedings with justification for why they are submitted at this stage of the proceedings.

There may be **other relevant factors**. The intention to prolong the proceedings by submitting evidence in parts (delaying tactics), if the circumstances of the case allow that conclusion, argues against the admission of late evidence.

The natural difficulties in obtaining the evidence are not, as such, a valid reason for its belated submission.

The Office will duly provide reasons for why it rejects or takes into account 'additional evidence' in the decision.

5.3.2 Means of evidence

5.3.2.1 Principles

The evidence of use must be provided in a structured manner.

Article 95(1) EUTMR provides that ‘... in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties ...’ The filing of evidence must be sufficiently clear and precise to enable the other party to exercise its right of defence and the Office to perform its examination, without reference to extraneous or supportive information.

Essentially, the Office is prevented from making the case for one or other party and cannot take the place of the opponent, or its counsel, by itself trying to locate and identify among the documents on file the information that it might regard as supporting proof of use. This means that the Office should not seek to improve the presentation of any party's evidence.

Responsibility for putting evidence in order rests with the party. Article 10(4) EUTMDR provides that the evidence of use must be submitted in accordance with Article 55 EUTMDR, which defines the basic structure and format of written evidence. This provision means that the submission must clearly identify the evidence and arguments raised by the parties and thus assure expeditious proceedings.

For further information on the format and structure requirements for annexes to communications, and recommendations on the structure of written evidence, refer to the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits, paragraph 3.1.3.

The recommendations together with the requirements for written evidence set in Article 55(2) EUTMDR are sent to the opponent together with the Office's communication of the applicant's request for proof of use.

According to Article 10(4) EUTMDR, the evidence is to be submitted in accordance with Article 55(2) and Articles 63 and 64 EUTMDR and, in principle, is confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR. Article 10(4) EUTMDR also allows market surveys and quotations of the mark in lists and publications of associations of the relevant profession as suitable means of evidence (14/03/2011, B 1 582 579; 18/06/2010, B 1 316 134).

Price lists and catalogues are examples of ‘material stemming directly from the party itself’. A company's annual report and accounts would also come under that heading.

Article 10(4) EUTMDR is to be read in conjunction with Article 64 EUTMDR. This means that annexes to communications may be submitted on data carriers in accordance with technical specifications determined by the Executive Director. Nevertheless, material that cannot be scanned or photocopied (such as CDs, physical items) cannot be taken into account unless submitted in two copies so that one can be forwarded to the other party.

The requirement of proof of use always raises the question of the **probative value** of the submitted material. The evidence must at least have a certain degree of reliability. As a general rule, the Office considers material produced by third parties as being of a higher probative value than material produced by the owner itself or by its

representative. Reference by the opponent to internal printouts or hypothetical surveys or orders is particularly problematic. However, where material must regularly be produced for use by the public and/or authorities according to statutory rules, for instance, company law and/or stock exchange regulations, and where it may be assumed that such material is subject to certain official verification, its probative value is certainly higher than ordinary 'personal' material produced by the opponent (see also paragraph 5.3.2.3, 'Declarations', below).

5.3.2.2 References

The opponent may avail itself of findings of national offices and courts in parallel proceedings. Although the Office is not bound by findings of the national offices and courts, such decisions must be taken into account and may influence the Office's decision. It is important for the Office to have the possibility of considering the kind of evidence that led to the relevant decision at national level. The Office takes into account the different procedural and substantive requirements that may exist before the respective national body (25/08/2003, R 1132/2000-4, VANETTA / VIENNETTA (fig.), § 16; 18/10/2000, R 550/1999-3, (DUKE) (fig.) / DUKE, § 23).

The opponent may wish to refer to material submitted as proof of use in previous proceedings before the Office (confirmed by the General Court in 'ELS' quoted above). The Office accepts such references on condition that the opponent clearly identifies the material referred to and the proceedings in which it was submitted. If the reference does not sufficiently identify the relevant material, the Office requires the opponent to clearly specify the material referred to or to file it (30/11/2010, B 1 080 300). For further details on the conditions for identifying relevant material, see paragraph 4.4.5 above.

The onus of providing proof of use is on the opponent and not on the Office or the applicant. Therefore, a mere indication of the website where the Office can find further information is insufficient, as this does not provide the Office with sufficient indications about place, nature, time and extent of use (31/10/2001, B 260 192).

5.3.2.3 Declarations

Whereas the means of evidence listed, such as packages, labels, price lists, catalogues, invoices, photographs and newspaper advertisements, do not present any particular problems, it is necessary to consider in some detail declarations as referred to in Article 97(1)(f) EUTMR.

The opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. It is up to the opposing party to select the form of evidence that it considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 37).

The role of the affidavit is to give facts or an explanation of the supporting documents, not to give a legal opinion (06/11/2014, T-463/12, MB, EU:T:2014:935, § 56).

Distinction between admissibility and relevance (probative value)

The importance of declarations has been much debated. In this regard, there must be a clear differentiation between the admissibility and the probative value of such evidence.

As far as **admissibility** is concerned, Article 10(4) EUTMDR expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1) EUTMR cites means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. Therefore, it has to be evaluated whether the statement submitted constitutes a statement within the sense of Article 97(1)(f) EUTMR. Only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 40; confirmed 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 49). Where there are doubts as to whether a statement has been sworn or affirmed, it is up to the opponent to submit evidence in this regard. Failing this, the statement will not be considered a statement within the sense of Article 97(1)(f) EUTMR.

Article 97(1)(f) EUTMR does not specify by whom these statements should be signed, so there is no reason to consider that statements signed by the parties to the proceedings themselves are not covered by this provision (16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 46).

The EUTMR, the EUTMDR and the EUTMIR do not support the conclusion that the evidential value of items of evidence of use of the mark, including affirmations, must be assessed in the light of the national law of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33; 09/12/2014, T-278/12 PROFLEX, EU:T:2014:1045, § 53). The probative value of a statement depends first and foremost on the credibility of the account it contains. 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, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42).

As far as the **probative value** of this kind of evidence is concerned, the Office, following the established case-law, makes a distinction between statements coming from the sphere of the opponent themselves or their employees and statements drawn up by an independent source (09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 51; 06/11/2014, T-463/12, MB, EU:T:2014:935, § 54).

Declarations by the proprietor or its employees

Statements coming from the sphere of the owner of the earlier mark (drawn up by the interested parties themselves or their employees) are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter (11/01/2011, R 490/2010-4, BOTODERM / BOTOX, § 34; 27/10/2009, B 1 086 240 and 31/08/2010, B 1 568 610).

Such a statement cannot in itself sufficiently prove genuine use (09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 54) However, this does not mean that such statements

are totally devoid of all probative value (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 30). Generalisation should be avoided, since the exact value of such statements always depends on their concrete form and content. Statements including detailed and concrete information have a higher probative value than very general and abstractly drafted statements.

The final outcome depends on the overall assessment of the evidence in each individual case. In general, further material is necessary for establishing evidence of use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources. Therefore, the probative strength of the further material submitted is very important. An assessment should be made of whether the content of the affidavit is sufficiently supported by the further material (or vice versa). The fact that the national office concerned may adopt a certain practice in assessing such kind of evidence of use does not mean that it is applicable in proceedings concerning European Union trade marks (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 41 et seq.).

A change of ownership after the filing or priority date of the EUTM application may render declarations made by the new owners void as the latter generally do not have any direct knowledge to form a basis for making declarations concerning use of the mark by the previous owner (17/06/2004, R 16/2004-1, REPORTER / REPORTER).

Nevertheless, in the case of a transfer or other succession in title, any new owner may rely on use by their predecessor(s) within the grace period concerned. Use made by the predecessor may be evidenced by the predecessor and by all other reliable means, for instance, information from business records if the predecessor is not available.

Declarations by third parties

Statements (such as e.g. surveys) drawn up **by an independent source**, for example by experts, professional organisations, Chambers of Commerce, suppliers, customers or business partners of the opponent, are given more probative weight (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (fig.), § 31).

This practice is in line with the case-law of the Court of Justice in the *Chiemsee* judgment (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230), where the Court gave some indications of appropriate evidence for proving the acquired distinctiveness of a mark in the market place. Although acquisition of distinctiveness is not per se the same as genuine use, the former does comprise elements of evidence of use of a sign on the market. Consequently, case-law relating to these can be used by analogy.

Statements drawn up by the parties themselves are not ‘third-party evidence’ whereas all other evidence, such as opinion polls, statements from Chambers of Commerce, or from professional organisations or from experts, does originate from third parties.

5.4 Reaction from the applicant

5.4.1 Forwarding of evidence

After having received the evidence of use submitted by the opponent, the Office forwards the complete evidence to the applicant.

The Office, in general, allows the applicant 2 months to file its observations in reply to the evidence of use (and to the opposition).

5.4.2 No evidence or no relevant evidence submitted

However, the Office may close the proceedings immediately if, within the time limit given, the opponent has submitted **no evidence, or the evidence is manifestly of no relevance**, and all earlier trade mark registrations are affected. The rationale behind this practice is to avoid the continuation of proceedings when their outcome is already known, that is, the opposition is to be rejected for lack of proof of use (principle of economy and good administration of proceedings).

Where only some of the earlier marks are subject to the proof of use requirement and the opponent submits no evidence, or the evidence is manifestly irrelevant, the applicant will be invited to submit observations to the opposition in relation to the remaining earlier marks, irrespective of whether it had limited its first observations to requesting proof of use or whether it had also submitted initial observations to the opposition.

In all other cases the evidence is forwarded to the applicant, which is given 2 months to file its observations. The Office must not indicate to the opponent that the sufficiency of the evidence is doubtful, or even invite the opponent to file further evidence in such cases. Such acts would be against the impartial position of the Office in adversarial proceedings (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.), § 19).

5.4.3 No reaction from applicant

If the applicant does not react within the time limit, the Office will give a decision on the basis of the evidence before it. The fact that the applicant does not reply does not mean that it accepts the submitted evidence as sufficient proof of use (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 79).

5.4.4 Formal withdrawal of the request

Where the applicant reacts to the proof of use by formally withdrawing its request for proof of use, the issue will no longer be relevant. As it is the applicant who sets in motion the respective procedure, the applicant logically is in a position to bring an end to this part of the proceedings by formally withdrawing its request (21/04/2004, R 174/2003-2, SONNENGARTEN / SOMMERGARTEN, § 23).

5.5 Further reaction from the opponent

The opponent is entitled to file observations in reply to the applicant's observations. This is of particular importance in cases where the decision to be taken might be based in part on the arguments put forward by the applicant to the effect that the evidence does not prove the use of the mark.

The Board of Appeal has regarded failure to allow the opponent to comment in such a case as a substantial procedural violation (28/02/2011, R 16/2010-4, COLORPLUS, § 20).

For further details on the submission of additional evidence, see paragraph 5.3.1 above.

5.6 Languages in proof of use proceedings

According to Article 10(6) EUTMDR, where the evidence submitted pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office **may** require the opponent to submit a translation of that evidence in that language, within a period specified by the Office.

It is left to the discretion of the Office whether the opponent has to submit a translation of the evidence of use into the language of the proceedings. In exercising its discretion, the Office balances the interests of both parties.

It has to be borne in mind that it might be extremely costly and burdensome for the opponent to translate the evidence of use submitted into the language of the proceedings.

On the other hand, the applicant has the right to be informed about the content of the evidence submitted in order to be capable of defending its interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use submitted by the opponent. In this regard, the nature of the documents submitted has to be taken into account. For example, it might be considered that 'standard' invoices and samples of packaging do not require a translation in order to be understood by the applicant (15/12/2010, T-132/09, Epcos, EU:T:2010:518, § 51 et seq.; 30/04/2008, R 1630/2006-2, DIACOR / DIACOL PORTUGAL, § 46 et seq. (appealed 24/01/2017, T-258/08, DIACOR / DIACOL, EU:T:2017:22); 15/09/2008, R 1404/2007-2 & R 1463/2007-2, FAY (fig) / FAY & CO, § 26 et seq.).

If the applicant explicitly requests a translation of the evidence in the language of the proceedings and provides reasons for its request (see Article 10(6) EUTMDR in conjunction with Article 24 EUTMIR), 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 translation of the evidence, it gives the opponent a period of 2 months to submit it. Where the evidence of use submitted by the opponent is voluminous, the Office may explicitly invite the opponent to translate only the parts of the submitted material that the opponent regards as sufficient for establishing genuine use of the mark within the relevant period. It is in general up to the opponent to evaluate whether a complete translation of all the evidence submitted is necessary. The evidence will only be taken into account insofar as a translation has been produced or insofar as it is self-explanatory regardless of its textual components.

If the opponent submits evidence of use in a language other than the language of the proceedings within the time limit established for submitting proof of use and then on its own initiative submits a translation of this evidence into the language of the proceedings after the expiry of that time limit, this evidence will be taken into account and forwarded to the applicant for its observations. This applies even if the Office has not required the opponent to file a translation and even if the applicant has not yet contested the evidence.

6 Termination of Proceedings

6.1 Friendly settlement

Article 47(4) EUTMR

Article 6(2) EUTMDR

The parties are free to decide on the measure that brings the opposition proceedings to a conclusion. While they can decide to withdraw the opposition, they can also simply ask the Office to close the case without giving specific reasons. It suffices to communicate the written signed agreement of the parties, which does not have to include a statement of grounds. The Office then takes the steps needed to close the proceedings on the basis of this agreement.

Regarding the refund of fees and decision on costs in case of friendly settlement, please see the relevant paragraph below.

The Office may, if it thinks fit, invite the parties to make a friendly settlement. The Office, as well as the parties, may therefore initiate a settlement procedure.

To this end the Office may issue proposals for friendly settlement. As, in principle, the Office cannot (and does not wish to) replace the parties, it will only take action in very rare cases where a settlement between the parties appears desirable and if there are good reasons for considering that the proceedings can be ended by a settlement.

If expressly requested by the parties, the Office can also offer assistance with their negotiations, for instance by acting as an intermediary or by providing them with any material resources that they need. Any costs incurred are borne by the parties. Friendly settlement may be preceded by a request for suspension.

6.2 Restrictions and withdrawals

Articles 66(1) and 71(3), Article 146(6)(a), Article 146(9) and Article 109 EUTMR
Article 6(2), (3) and (4) EUTMDR

6.2.1 Restrictions and withdrawals of EUTM applications

Article 49 EUTMR
Article 6(5) EUTMDR

It is possible for the applicant to restrict the goods and services of its application or to withdraw the entire application at any stage of the opposition proceedings.

Such requests must be filed by way of separate documents as stated above under paragraph 4.4.1.

Withdrawals and restrictions must be explicit and unconditional. Silence on the part of the EUTM applicant during the proceedings will never be considered as a tacit withdrawal.

A conditional or ambiguous withdrawal or restriction will not be accepted and will be forwarded to the other party merely for information purposes, with the parties being informed that it will not be taken into account.

The Office does not accept conditional restrictions. For example, the applicant argues in its observations in reply to the opposition that the signs are dissimilar but adds that, if the examiner finds them similar, it will restrict the list of goods and services of the EUTM application. In this case, the restriction is not acceptable, and the applicant must be informed that the restriction must be express and unconditional.

If the restriction is not acceptable, even if only in part, the Office will invite the applicant to remedy the deficiency. If the applicant remedies the deficiency, the restriction will be recorded with the effective date of the initial request. If the applicant does not remedy the deficiency, the restriction will be refused in its entirety and the proceedings will continue on the basis of the original list of goods and services (Guidelines, Part B, Examination, Section 3, Classification, paragraph 5.3.3). The opponent will be informed about the above steps.

If the opponent withdraws its opposition after an unacceptable restriction has been filed, the withdrawal will not be taken into account if it clearly refers to the unacceptable restriction. Once the restriction has become acceptable, the opponent will be informed of the new list of goods and services and will be granted a new time limit to confirm the withdrawal of the opposition.

If the restriction is acceptable, confirmation is sent to the applicant.

Depending on the moment in the proceedings, the restriction or withdrawal has different consequences, described below.

For further information on restrictions of an EUTM application, see the Guidelines, Part B, Examination, Section 3, Classification and Part B, Examination, Section 1, Proceedings, paragraphs 5.1 and 5.2.

6.2.1.1 Withdrawal or restriction before the admissibility check is made

Restriction covers the whole extent of opposition/withdrawal

When the EUTM application is withdrawn or restricted to non-contested goods and services before notification regarding admissibility of the opposition has been issued, the opposition proceedings are closed, and the opposition fee is refunded. In other words, dealing with the withdrawal or restriction in such cases takes priority over the admissibility of the opposition.

No decision on costs will be taken.

Restriction does not (seem to) cover the whole extent of the opposition

In the case of a restriction that may still include contested goods and services, an admissibility check is done.

The restriction is notified to the opponent together with the notification regarding admissibility or the communication informing the opponent of an absolute or relative admissibility deficiency.

If the opposition is withdrawn, the opposition fee is refunded. This is the case even if irremediable deficiencies exist.

The opponent's letter does not have to expressly refer to the restriction, as long as it is received on or after the date of the applicant's restriction.

No decision on costs will be taken.

6.2.1.2 Restrictions and withdrawals of EUTM applications before the end of the cooling-off period

Restriction covers the whole extent of the opposition/withdrawal

When it is absolutely clear that the restriction covers the whole extent of the opposition, or when the EUTM application is withdrawn, this is notified to the parties and the proceedings are closed. The opponent is refunded the opposition fee.

No decision on costs will be taken.

Restriction does not (seem to) cover the whole extent of opposition/withdrawal

If it is not completely clear that the restriction covers the whole extent of the opposition or the restriction does not cover the whole extent of the opposition, the opponent is invited to inform the Office whether it wishes to maintain or withdraw its opposition. The parties are notified of its reply. If the opposition is withdrawn, the opposition fee is refunded to the opponent.

No decision on costs will be taken.

As long as the applicant's restriction is received before the expiry of the cooling-off period, the opposition fee will be refunded, even if the consequent withdrawal of the opposition is received and the proceedings are closed after expiry of the cooling-off period.

Furthermore, if the withdrawal of the opposition is received by the Office before the official notification of the restriction is forwarded to the opponent, the withdrawal is considered to have been made in consequence of the restriction and the opposition fee is also refunded.

The opponent's letter does not have to expressly refer to the restriction, as long as it is received on or after the date of the applicant's restriction.

The initial reaction of the opponent to the notification does not matter, as long as the withdrawal is declared later.

Examples

- The opponent does not reply within the time limit given to it but subsequently withdraws its opposition within the cooling-off period (which has been extended).
- The opponent responds by maintaining its opposition, but nevertheless withdraws the opposition still within the extended cooling-off period.

6.2.1.3 Restrictions and withdrawals of EUTM applications after the end of the cooling-off period

Restriction covers the whole extent of the opposition/withdrawal

When it is absolutely clear that the restriction covers the whole extent of the opposition, or when the EUTM application is withdrawn, this is notified to the parties and the proceedings are closed.

Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 6.5.3 below.

Restriction does not (seem to) cover the whole extent of opposition/withdrawal

If it is not completely clear that the restriction covers the whole extent of the opposition or the restriction does not cover the whole extent of the opposition, the opponent is invited to inform the Office whether it wishes to maintain or withdraw its opposition. The parties are notified of any reply. If the opposition is maintained, the proceedings continue. If the opposition is withdrawn, the opposition proceedings are closed. If the opponent first maintains its opposition and then subsequently withdraws, this is treated as a withdrawal of the opposition in accordance with paragraph 6.2.2.2 below.

Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 6.5.3 below.

6.2.1.4 Restrictions and withdrawals of EUTM applications after a decision has been taken

Following the decision of the Grand Board of Appeal of 27/09/2006 in R 331/2006-G, Optima, the Office accepts withdrawals and restrictions received during the appeal period after a decision on the opposition has been rendered, even if no appeal has been filed.

The Office will take note of the withdrawal and close the case. Confirmation of the withdrawal is sent to the parties (however, no decision on costs is included in this communication). The part on costs of the initial decision remains valid and could be enforced by the winning party unless a different agreement is reached. The Office's database is updated accordingly to reflect the withdrawal of the EUTM application.

For further information, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1 and Part E, Register Operations, Section 2, Conversion, paragraph 4.3.

An EUTM application cannot be withdrawn once a decision rejecting the EUTM application in full has become final.

If the decision rejected the opposition, the application can be withdrawn or restricted at any time.

The **withdrawal of any pending appeal** (before the Boards of Appeal, the General Court or the Court of Justice) means that the **contested decision becomes final**. Consequently, the contested EUTM application may no longer be withdrawn thereafter.

6.2.1.5 Language

Article 146(6)(a) EUTMR

During opposition proceedings a restriction may be submitted either in the first or the second language of the EUTM application.

When the restriction is submitted in the first language of the EUTM application, which is not the language of proceedings, and when the restriction does not cover the whole extent of the opposition, the restriction is forwarded to the opponent, requesting it to inform the Office whether or not it maintains its opposition. The opponent can object to the language of the restriction and ask for a translation into the language of proceedings. The Office will then provide for the translation.

If an acceptable restriction is submitted in the first and the second language, the examiner must reflect this restriction in the two languages in the Office's database and confirm the new list of goods and services in the two languages to the applicant.

6.2.2 Withdrawal of oppositions

The opponent can withdraw its opposition at any time during the proceedings.

A withdrawal of the opposition must be explicit and unconditional. A conditional or ambiguous withdrawal will not be accepted and will be forwarded to the applicant merely for information purposes, with the parties being informed that it will not be taken into account.

If the opponent withdraws its opposition independent of any restriction of the EUTM application, three situations can arise depending on the status of the opposition. For information about the consequences of the withdrawal of an opposition because of a restriction of the EUTM application, see paragraphs 6.2.1.1-6.2.1.3 above.

6.2.2.1 Withdrawal of the opposition before the end of the cooling-off period

If the opposition is withdrawn before the end of the cooling-off period, the parties are notified. Unlike in the event of a withdrawal of the opposition following a restriction of the EUTM application during the cooling-off period (see paragraph 6.2.1.2 above), the Office neither refunds the opposition fee nor takes a decision on costs.

6.2.2.2 Withdrawal of the opposition after the end of the cooling-off period

If the opposition is withdrawn after the end of the cooling-off period the parties are notified. The opposition fee is not refunded. Unless the parties submit an agreement on costs, the Office will take a decision on costs. For information on the apportionment of costs, see paragraph 6.5.3 below.

6.2.2.3 Withdrawal of the opposition after a decision has been taken

Following the decision of the Grand Board of Appeal of 27/09/2006 in R 331/2006-G, Optima, the Office accepts withdrawals of the opposition received during the appeal period after a decision on the opposition has been taken, even if no appeal has been filed.

The Office will take note of the withdrawal and close the case. Confirmation of the withdrawal is sent to the parties, without any decision on costs being included in this communication. The part on costs of the initial decision remains valid and can be enforced by the winning party. The Office's database is updated accordingly to reflect the withdrawal of the opposition, and the application proceeds to registration.

The **withdrawal of any pending appeal** (before the Boards of Appeal, the General Court or the Court of Justice) means that the **contested decision becomes final**. Consequently, the opposition may no longer be withdrawn thereafter.

For further information on withdrawals during appeal proceedings, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.

6.2.2.4 Language

Article 146(9) EUTMR

A withdrawal of the opposition must be in the language of the proceedings. Should the withdrawal be submitted in a language that is not the language of proceedings a translation must be filed within 1 month from the date of submission of the original document. Otherwise, the withdrawal will be refused.

6.2.3 Withdrawals of withdrawals/restrictions

A party is only permitted to withdraw a previously submitted withdrawal/restriction if the Office receives its letter withdrawing the earlier withdrawal/restriction on the same day as the first submission (see also the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.2.1).

6.3 Decision on substance

The decision on substance is taken only once the parties have submitted all that is required, and should deal only with those issues or earlier rights that are relevant for the outcome.

There are two exceptions, which are when:

- the earlier right is not proven;
- the earlier right has ceased to exist.

6.3.1 Earlier right not proven

Article 8(1) EUTMDR

If proof of existence, validity and scope of protection has not been filed properly for any of the earlier rights invoked, the opposition is rejected as soon as the time limit given to the opponent to complete its file has expired.

However, if the existence, validity and scope of protection of at least one earlier right have been proven, the proceedings will continue normally, and the non-substantiated rights will not be taken into account in the final decision on substance.

6.3.2 Earlier right has ceased to exist

If, in the course of the proceedings, the earlier right ceases to exist (e.g. because it has been declared invalid, or it has not been renewed), the final decision cannot be based on it. The opposition may only be upheld with respect to an earlier right that is valid at the moment when the decision is taken. This is because the requirement to refuse registration of a trade mark if any of the grounds of opposition applies is worded in the

present tense in Article 8 EUTMR, which requires the presence of a conflict at the time when the decision is taken. The reason why the earlier right ceases to have effect does not matter.

Invalidation of any earlier right other than an EUTM cannot be detected by the Office. However, if one of the parties informs the Office of such invalidation, the other party must be heard, and it may be that the opposition will not be able to proceed on the basis of that earlier right.

Before the decision is taken, the Office will check whether the earlier right invoked has become due for renewal in the meantime. If so, the Office will invite the opponent to prove the renewal of the mark. This applies even if the mark is still within the grace period for renewal, if applicable. If the opponent does not submit the proof, the opposition will not be able to proceed on the basis of that earlier right.

Before the decision is taken, the Office may also check the documents on file to see whether the earlier right invoked is the subject of national post-registration proceedings. If so, the Office will invite the opponent to submit evidence of the final outcome of the national proceedings. If the opponent submits evidence showing that the national proceedings are still pending, the Office may suspend the opposition proceedings until a final decision has been taken in the proceedings that led to the suspension.

6.4 Fee refund

6.4.1 Opposition deemed not entered

Articles 46(3) and 181(1) EUTMR

Article 5(1) EUTMDR

If an opposition is deemed as not entered because of late or insufficient payment (see paragraph 2.2.2 above), the opposition fee, including any surcharge, must be refunded to the opponent.

6.4.1.1 Opposition and withdrawal of the opposition filed the same date

In cases where the opposition is withdrawn the same day it was filed, the Office refunds the opposition fee.

6.4.1.2 Refund after republication

If, after republication of the EUTM application in Part A.2 of the Bulletin due to a mistake by the Office, a 'first publication opponent' wishes to withdraw its opposition as a consequence of the republication, the proceedings should be closed. As the Office made a mistake with the first publication, the opposition fee will be reimbursed.

6.4.2 Refund in view of withdrawals/restrictions of the EUTM application

Article 6(2), (3), (4) and (5) EUTMDR

6.4.2.1 EUTM application withdrawn/restricted before end of cooling-off period

If the applicant withdraws its EUTM application or withdraws all those goods and services against which the opposition is directed before or during the cooling-off period, the opposition proceedings are closed, there is no decision on costs, and the opposition fee must be refunded (see paragraphs 6.2.1.1 and 6.2.1.2 above).

6.4.2.2 Opposition withdrawn due to restriction of EUTM application within cooling-off period

If the applicant withdraws some of the goods and services against which the opposition is directed during the cooling-off period, the Office invites the opponent to state whether it maintains the opposition (and, if so, against which of the remaining goods and services) or whether it withdraws it in view of the restriction.

If the opposition is then withdrawn, the opposition proceedings are closed, there is no decision on costs, and the opposition fee must be refunded (see paragraphs 6.2.1.1 and 6.2.1.2 above).

6.4.3 Multiple oppositions and refund of 50 % of opposition fee

Article 9(4) EUTMDR

In certain special cases concerning multiple oppositions, it is possible to refund 50 % of the opposition fee to an opponent. Two conditions must be met, as illustrated in the following example.

- One of the opposition proceedings was terminated by the rejection of the contested EUTM application in parallel opposition proceedings. For example, there are four oppositions A, B, C and D (opponents A, B, C, D) against EUTM application X, and EUTM application X is rejected due to opposition A.
- The other oppositions (B, C and D) had been suspended before the commencement of the adversarial part (because a preliminary examination revealed that EUTM application X would probably be rejected in its entirety because of opposition A).

In this case, opponents B, C and D are refunded 50 % of the opposition fee.

6.4.4 Cases where the opposition fee is not refunded

6.4.4.1 Opposition withdrawn before the end of the cooling-off period NOT due to a restriction

Article 6(3), (4) and (5) EUTMDR

If the opponent withdraws its opposition before the end of the cooling-off period and there has been no restriction of the EUTM application, the Office neither refunds the opposition fee nor takes a decision on costs (see paragraph 6.2.2.1 above).

6.4.4.2 Opponent's withdrawal is earlier

Article 6(3) and (5) EUTMDR

When the opposition is withdrawn before the applicant restricts its application, the fee is not refunded (see paragraphs 6.2.1.1 and 6.2.1.2 above). Additionally, if the applicant withdraws its application following (e.g. as a reaction to) the withdrawal of the opposition, the fee is not refunded.

The same applies when the applicant restricts the application following a partial withdrawal of the opposition.

6.4.4.3 Settlement between the parties before commencement of proceedings

Article 6(2), (4) and (5) EUTMDR

As regards the refund of the opposition fee, Article 6(5) EUTMDR only mentions this possibility if there is either a withdrawal or a restriction of the EUTM application. Therefore, if the proceedings end by an agreement that contains a mention of a withdrawal or restriction of the EUTM application, the opposition fee is refunded. In the other cases, the opposition fee is not refunded.

6.4.4.4 Termination of proceedings for other reasons

Articles 7 and 45 and Article 119(2) EUTMR

Articles 5 and 6 EUTMDR

In cases where the application is rejected in accordance with:

- Article 7 EUTMR (rejection of an application on absolute grounds; on the Office's own initiative or because of third party observations), or
- Article 119(2) EUTMR (representation for non-EEA applicants),

the opposition fee is not refunded as none of these situations is contemplated in the EUTMDR as a reason for refunding the opposition fee.

6.5 Decision on the apportionment of costs

6.5.1 Cases in which a decision on costs must be taken

Article 109 EUTMR

Article 6(4) EUTMDR

A decision on costs is taken in opposition proceedings that have passed the cooling-off period, that is to say, where the adversarial part of the proceedings has both started and come to an end.

If a decision on substance is taken, the decision on apportionment of costs is given at the end of the decision. In all other cases where the Opposition Division closes the case, a decision on costs is issued together with the closure letters unless the parties have informed the Office about an agreement on costs.

6.5.2 Cases in which a decision on costs is not taken

No decision on costs is taken for oppositions that are closed before or during the cooling-off period.

6.5.2.1 Agreement on costs

Article 109(6) EUTMR

Whenever the parties have settled the opposition proceedings with an agreement that includes the costs, the Office will not issue a decision on costs. The same is true if the Office receives information signed by both parties stating that the parties have agreed on costs. Such a request can also be sent in two separate letters to the Office. This information must be received before the Office has confirmed the closure of the proceedings.

If the parties settle the opposition by mutual agreement, they are free not to include the cost issue. If no indication is given as to whether the parties have agreed on the costs, the Office will take a decision on costs immediately, together with its confirmation of the withdrawal/restriction. If the parties inform the Office that they have reached an agreement on costs after the withdrawal/restriction, the decision already issued on costs will not be revised by the Office. It is left to the parties to respect the agreement and not to 'execute' the Office's decision on costs.

6.5.2.2 Information from potential 'successful party'

When the party that would be entitled to be awarded costs according to the general rules described in paragraph 6.5.3 below informs the Office that it accepts each party bearing their own costs, no decision on costs is necessary. The Office will refrain from taking a decision on costs whenever the potential 'successful party' informs the Office that it agrees to share the costs, even if the 'losing party' does not confirm its agreement. The latest letters from both parties therefore have to be checked carefully before issuing a decision.

However, any such request sent by the losing party to the Office will simply be forwarded to the other party, and the decision on costs will be taken *ex officio* under normal rules.

6.5.3 Standard cases of decisions on costs

Article 109 EUTMR

The general rule is that the losing party or the party that terminates the proceedings, whether by withdrawing the EUTM application (wholly or partially) or by withdrawing the opposition, will bear the fees incurred by the other party as well as all costs incurred by it that are essential to the proceedings.

If both parties lose in part, a 'different apportionment' has to be decided. As a general rule, it is equitable that each party bears its own costs.

A party that terminates the proceedings is deemed to have given in. The hypothetical outcome of the case if a decision on substance had become necessary is absolutely irrelevant.

In standard cases the result is the following.

- The applicant withdraws or restricts its application to the goods and services the opposition is not directed at (partial withdrawal). In these cases the applicant has to pay the costs.
- The opponent withdraws its opposition without any restriction of the EUTM application as regards the contested goods and services after the cooling-off period. The opponent has to pay the costs.
- Restriction of the application followed by withdrawal of the opposition (28/04/2004, T-124/02 & T-156/02, Vitatoste, EU:T:2004:116, § 56). In principle each party bears its own costs.

A different apportionment of costs can, however, be justified for reasons of equity (for example, if the application was restricted only to a very small extent).

The Office will not take into account parties' arguments as to who should pay.

6.5.4 Cases that did not proceed to judgment

6.5.4.1 Multiple oppositions

Complete rejection of the EUTM application

In cases where there are multiple oppositions against the same EUTM application that have not been suspended by the Office in accordance with Article 9(2) EUTMDR, and one opposition leads to the rejection of the EUTM application, the Office does not take any action in the other oppositions until the appeal period has elapsed.

If the appeal period elapses without an appeal being filed, the Office closes the other opposition proceedings and the cases do not proceed to judgment.

In this case, the determination of costs is at the discretion of the Opposition Division (Article 109(5) EUTMR). The Office is not able to determine who the 'winning or losing party' is, and the applicant should not be required to pay the costs of several other opponents if it loses in one decision on substance. Therefore, applying a principle of equity, each party will be ordered to bear its own costs.

Partial rejection of the EUTM application

In cases of multiple oppositions that are partially directed against the same goods and services of the contested trade mark, the opposition decision taken first may affect the other oppositions.

Example

Opposition A is directed against Class 1 and opposition B against Classes 1 and 2 of the contested EUTM application. A decision is taken first in opposition A rejecting the contested application for Class 1. When the decision is notified to the parties of opposition A, opposition B must be suspended until the decision in opposition A is final and binding. Once the decision is final, the opponent of opposition B will be invited to inform the Office whether it wishes to maintain or withdraw its opposition in view of the amendment of the list of goods. If the opponent withdraws the opposition, the case is closed.

In this situation, and if the case is closed after commencement of the adversarial part of the proceedings, the Office will issue a decision on costs in accordance with Article 109(3) EUTMR. The opponent withdrew its opposition following the partial rejection of the contested trade mark. To this extent the opponent was successful in the proceedings. However, the partial rejection of the trade mark was more restricted than the scope of the opposition. To this extent the applicant/holder was also successful in the proceedings. Consequently, it is equitable that each party should bear its own costs.

If the opponent maintains its opposition after the partial rejection, the proceedings continue and in the final decision on the substance the decision on costs is taken according to the normal rules.

6.5.4.2 Rejection of an application on the basis of absolute grounds or formalities

An EUTM application can be rejected during an opposition procedure on absolute grounds for refusal (either on the basis of third party observations, Article 45 EUTMR, or *ex officio* if the case is reopened) or on formalities (e.g. if an applicant from outside the EEA is no longer represented under Article 119(2) EUTMR).

Once the rejection becomes final, the opposition proceedings are closed by issuing a notification.

In these situations the practice on costs is as follows.

If the refusal becomes final after the expiry of the cooling-off period, a decision on costs is taken pursuant to Article 109(5) EUTMR. If the same situation arises before commencement of the adversarial part, no decision on costs is to be taken.

6.5.4.3 Cases of joinder

Article 9 EUTMR

For further information on joinder, see paragraph 7.4.3, Joinder of proceedings, below.

In cases where the joint opposition succeeds in its entirety the applicant should pay the opposition fees paid by each of the opponents but representation costs only once. If the applicant wins, its representation costs will be awarded once but each of the joint opponents will be liable for them. A different apportionment of costs might be equitable. In cases of partial success or if equitable for other reasons, each party should bear its own costs.

6.5.4.4 The meaning of 'bear one's own costs'

The notion of costs comprises the opposition fee and the costs essential to the proceedings, as referred to in Article 109(1) EUTMR. In most cases the costs cover the remuneration of an agent within the limits of the scales set by the Regulation.

'Each party shall bear their own costs' means that no party has a claim against the other party.

6.6 Fixing of costs

Article 109(1), (2), (7) and (8) EUTMR
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Article 18 EUTMR

Where the costs are limited to representation costs and the opposition fee, the decision fixing the amount of costs will be included in the decision on the apportionment of the

costs (i.e. as a rule, in the decision on substance), except where the parties are ordered to bear their own costs.

This means that in the vast majority of cases, it will not be necessary to fix the amount of costs separately.

The only exceptions are:

- when an oral hearing took place;
- when the fixing of costs was inadvertently omitted ('forgotten') in the main decision.

6.6.1 Amounts to be fixed

The costs to be borne comprise (i) the opposition fee and (ii) the costs essential to the proceedings, as referred to in Article 109(1) EUTMR. They are always fixed in euros, regardless of the currency in which the party had to pay its representative.

The opposition fee is EUR 320 (as laid down in the Annex to the EUTMR).

The costs essential to the proceedings include the costs of representation, travel and subsistence. In the absence of an oral hearing, only the costs of representation are relevant.

As regards representation costs, the amount is limited to EUR 300. This applies both to the opponent and the applicant, provided that they were represented in the opposition procedure by a professional representative within the meaning of Article 120(1) EUTMR, irrespective of whether these costs have actually been incurred. If the winning party was represented at some stage of the proceedings by a professional representative, but is no longer represented at the time of taking the decision on costs, it is also entitled to an award of costs regardless of when in the proceedings professional representation ceased.

Representation costs for employees, even from another company with economic connections, are not reimbursable and will not be fixed. They will not be addressed in the decision on costs.

For further information on representation, see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

In the case of a joinder under Article 9(1) EUTMDR, where the oppositions are successful, the Office will fix both (or all) opposition fees (one for each opposition) but only one representation fee.

As regards the costs of the opposition procedure, one single decision on the apportionment and on the fixing of costs must be taken for the opposition procedure as a whole.

When a decision is annulled by the Boards of Appeal and remitted to the Opposition Division, the Opposition Division has to decide on the case again and will take a decision on and fix the costs in the usual way.

If this decision is appealed again (and not remitted for a second time) the Board will decide on and fix the costs in the usual way.

6.6.2 Procedure if the fixing of costs is contained in the main decision

Where the decision fixing the amount of costs is included in the decision on the apportionment of the costs, no bill or proof whatsoever is needed. The Office knows that the opposition fee was paid and, if there is a representative, EUR 300 must be awarded irrespective of any evidence.

Therefore, no correspondence with the parties about the amount to be fixed is necessary. The fixing of the amount is automatic.

6.6.3 Procedure if a separate fixing of costs is needed

The following procedural requirements apply in the rare cases where a separate fixing of costs must be made (including when it was inadvertently omitted, in which case the party concerned must also comply with the applicable requirements):

- admissibility
- evidence.

6.6.3.1 Admissibility

The request for fixation of costs is only admissible once the decision in respect of which the fixing of costs is required has become final and up to 2 months after that date.

6.6.3.2 Evidence

For awarding the opposition fee, no evidence is needed.

For awarding the representation costs at the standard rate, an assurance by the representative that the costs have been incurred is sufficient. A fortiori, if a bill is presented, it suffices that it shows at least the reimbursable amount; it does not matter whether or not it is addressed to the party to the proceedings, as submitting a bill equals an assurance.

For all other costs (which will apply in extremely rare cases), a bill and supporting evidence are needed, but it suffices that these make it plausible (rather than provide fully fledged proof) that the costs have been incurred.

6.6.4 Review of fixing of costs

If one of the parties disagrees with the amounts fixed, it can ask for a review of the decision. The request must state the reasons and be filed within 1 month of the date of notification of the fixation. The request is only deemed to be filed when the fee for review of EUR 100 has been paid.

There are no reimbursable costs in the review procedure (16/12/2004, R 503/2001-4, BIOLACT / BIO).

7 Other Procedural Issues

7.1 Correction of mistakes

Articles 49(2) and 102(1) EUTMR

7.1.1 Correction of mistakes in the notice of opposition

There are no special provisions in the Regulations regarding the correction of mistakes in the notice of opposition. Applying Article 49(2) EUTMR, which refers to the EUTM application, by analogy, obvious mistakes in the notice of opposition may be corrected.

The Office considers 'obvious error' in relation to Article 49(2) EUTMR and Article 102(1) EUTMR to be understood as meaning mistakes that obviously require correction, in the sense that nothing else would have been intended than what is offered as the correction.

For example, if the opponent's details appear where the representative's should appear, this can be considered an obvious mistake.

7.1.2 Correction of mistakes and errors in publications

Article 44(3) EUTMR

Where the publication of the application contains a mistake or error attributable to the Office, the Office will correct the mistake or error on its own initiative or at the request of the applicant.

The corrections effected under this rule have to be published. If the correction concerns mistakes that do not affect the opposition, it will be published when the EUTM is registered. Where the correction leads to an extension of the list of goods or services or concerns the representation of the mark, a new opposition period is opened, but only in respect of the corrected parts.

If oppositions were filed after the 'first' publication of the EUTM application, the opponents will have to be informed of the republication. The opponents that opposed the 'first' publication do not have to file a new opposition. The proceedings must be suspended until the opposition period following the 'second' publication has expired.

If a 'first publication opponent' wishes to withdraw its opposition as a consequence of the republication, the proceedings should be closed and the opposition fee should be refunded (see paragraph 6.4.1.2 above).

7.2 Time limits

Article 101 and Article 146(9) EUTMR

Articles 63 and 68 EUTMDR

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy, and rigorous compliance with them is necessary for ensuring clarity and legal certainty.

For general information on time limits and continuation of proceedings, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

7.2.1 Extension of time limits in opposition proceedings

7.2.1.1 Non-extendable and extendable time limits

A time limit cannot be extended if its length is set by the Regulations. Non-extendable time limits include:

- the 3-month opposition period to file an opposition (Article 46(1) EUTMR);
- the 3-month time limit to pay the opposition fee (Article 46(3) EUTMR);
- the 1-month time limit to pay the surcharge when payment arrives late and no proof is made that it was initiated at least 10 days before expiry of the time limit for payment (Article 141(3) EUTMR);
- the 2-month time limit to remedy deficiencies (Article 5(5) EUTMDR).

The length of **extendable** time limits is specified by the Office. For example, the time limit to submit observations in reply to the notice of opposition is an extendable time limit.

7.2.1.2 Conditions of the request

Note that extensions of the cooling-off period have a special regime. For further details, see above under paragraph 3.2, Extension of the cooling-off period.

The request for extension has to fulfil the following conditions:

- the time limit must be extendable;
- the extension has to be requested by the party concerned;
- the request has to be signed (if submitted by electronic means, the indication of the name of the sender is deemed to be equivalent to its signature);
- the request must be received by the Office at the latest on the date of expiry of the time limit;
- the language regime must be respected (i.e. if the request is not in the language of the proceedings, a translation must be submitted within 1 month of filing; otherwise the request will not be taken into account).

An extension will only be possible if the relevant request is filed and received before the expiry of the original term. If a request for extension is received by the Office after the expiry of the time limit, it must be rejected.

As a general rule, the first request for an extension that is received in time will be considered appropriate and will be granted for a period of 2 months (or less, if so requested). However, any subsequent request for an extension of the same time limit will be refused, unless the party requesting it duly explains and justifies the exceptional circumstances that prevented it from meeting the original time limit and the first extension, and why a further extension is necessary. General or vague explanations will not justify a second extension. The request must always be accompanied by evidence and/or supporting documentation.

Circumstances that are within the control of the party concerned are not 'exceptional circumstances'. For example, last-minute discussions with the other party are not 'exceptional circumstances'. They are within the control of the parties.

The request has to be filed by the party affected by the time limit. For example, if the applicant has to submit observations in reply to the notice of opposition, it can only be the applicant that asks for an extension.

This does not preclude the requesting party from obtaining the other party's written consent to the request. However, **consent** provided by the other party does not divest the Office of its **power of discretion** as to whether to allow such extension. In any event, the consent given by the other party will be duly considered by the Office in the exercise of its discretion.

For the consent of the other party to be taken into account, it is not sufficient that the requesting party assures the Office that such consent was given. The other party must express its consent by separate submission or by signing the requesting party's submission. In the latter case, if submitted by electronic means, the indication of the name of the sender is deemed to be equivalent to its signature; however, the signature of the other party must be present in order for the consent to be acceptable.

For more information on extensions of time limits, consult the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

7.2.1.3 Extension of a time limit by the Office on its own initiative

The Office can extend a time limit on its own initiative, if and when particular reasons make it necessary. For example, a request to extend a time limit without any justification is received by the Office 20 days before the end of the time limit to file observations but is not dealt with until after expiry of the time limit. Because refusal of the request after expiry of the time limit will disproportionately harm the interests of the party who requested the extension, the Office extends the time limit by the number of days that were left when the party submitted its request, in this case 20 days. This practice is based on the rules of fair administration.

Where a request for extension of an extendable time limit is filed and received before expiry of the time limit, the party concerned will be granted at least 1 day, even if the request for extension arrived on the last day of this time limit.

7.3 Suspension

Article 71 and Article 9(2) EUTMDR

The Office can suspend opposition proceedings either *ex officio* or at the request of either one or both parties.

7.3.1 Suspension requested by both parties

According to Article 71(2) EUTMDR, if both parties request the suspension of the proceedings after expiry of the cooling-off period, the suspension will be granted, without any need for the request to be justified. In this case, and regardless of the period requested by the parties, the first suspension will be granted for a period of 6 months, with the parties being given the possibility of opting out. The process for opting out is the same as for the extension of the cooling-off period: if one party opts out, the suspension will end 14 days after the parties have been informed thereof. The proceedings will resume the day after, and the party whose time limit was pending at the moment of suspension will be granted the same period of time in full. It is not possible to opt out during the last month of the suspended period, and any requests to do so will be rejected.

A joint request for suspension will not be granted if it is received within the cooling-off period, because the purpose of the cooling-off period is to set a time frame for negotiations before the adversarial stage begins.

Upon a joint request by the parties, the suspension will be extended, without any need for the request to be justified.

However, the maximum duration of this suspension of the proceedings is limited to **2 years**, as set out in Article 71(2) EUTMDR — a duration that is to be understood as 2 years cumulative over the course of the proceedings.

Such joint requests for the extension of a suspension will be granted for further 6-month periods (regardless of the period requested by the parties, but with the possibility of opting out) or for the remaining time if less than 6 months remain out of the total maximum of 2 years. A joint request for suspension will be rejected as inadmissible if the parties have used up the total maximum of 2 years.

7.3.2 Suspensions by the Office *ex officio* or at the request of one of the parties

The Office may suspend the opposition proceedings *ex officio* or at the request of one party under a variety of circumstances, for example where:

- the opposition is based on an application for registration of a trade mark (including conversion);
- the opposition is based on an application for registration of a geographical indication or designation of origin.
- the earlier right is at risk (under opposition or cancellation);
- there are third-party observations that raise serious doubts as to the registrability of the EUTM application (see paragraph 4.6 above);
- there are errors in the publication of a contested application that require the mark to be republished;
- a transfer is pending on earlier EUTMs/EUTM applications or contested EUTM applications;
- a deficiency has been raised in connection with the restriction of a contested application;
- a deficiency has been raised in connection with professional representation.

It should be noted that there is no obligation in any of the abovementioned cases to suspend the proceedings. The Office will decide whether suspension is appropriate under the circumstances of each case. Therefore, the decision is at the Office's discretion. If requested by one of the parties, the request must be duly justified. Ongoing negotiations between the parties do not constitute an appropriate justification for a suspension requested by only one of the parties.

The proceedings will normally be suspended until the completion of the proceedings that led to the suspension. The limitation as to the total duration of suspension set out in Article 71(2) EUTMDR does not apply.

7.3.2.1 Explanation of the basic principle, timing of suspension

Article 71(1)(a) and (b) EUTMDR

In principle, oppositions based on (i) applications or (ii) earlier rights that are at risk are not to be suspended **ex officio** at the very beginning of the proceedings. The assumption is that in most cases applications mature into registrations, and oppositions or cancellation actions against earlier rights might be solved during the proceedings.

In these cases, the opposition proceeds until a decision is ready to be taken. Consideration must then be given as to whether the earlier right in question could make a difference, in a prima facie opinion, to the outcome of the opposition. If the opposition is deemed to be successful or rejected anyway, regardless of the fate of the earlier right at risk, the proceedings should not be suspended. If, in contrast, the earlier right at risk must necessarily be taken into account in the decision on the opposition, the proceedings will be suspended and, in the case of a national application or an earlier national mark at risk, the opponent must be requested to provide information on the status of the application or registration. For earlier EUTMs, the Office has this information at its disposal.

However, the Office may suspend the proceedings earlier if this is **requested by one of the parties** and the earlier right is an application or is at risk. If the earlier right is a

national one, the parties must submit evidence that it is facing problems. In this case the outcome of the proceedings against the earlier mark must have some impact on the opposition. Therefore, the probable outcome of the opposition will be considered in order to decide on suspension — in particular, whether the final decision on the opposition cannot be issued without taking into account the earlier application or earlier registration. This will be the case if the circumstances of the case do not allow the Office to say that the opposition will be rejected (e.g. because there is no likelihood of confusion) or upheld (because there are other earlier rights that are sufficient to reject the contested mark for all the contested goods and services).

When an opposition is based on an application for registration, it may be appropriate to suspend the opposition proceedings under Article 71(1)(a) EUTMDR to await registration of the opponent's earlier mark. However, if an opposition is to be rejected, either for formal or for substantive reasons, a suspension would be meaningless and would simply prolong the proceedings unnecessarily.

When there are no other earlier rights to take into account (because there are no other earlier rights or they were not substantiated) or when the application or registration must nevertheless be taken into account (because the other earlier rights are not 'winners'), an assessment must be made of whether the opposition will be successful on the basis of the application, in order to decide on the suspension. Proceedings will only be suspended if it is found that the earlier application, if registered, will lead to the total or partial rejection of the contested EUTM application.

7.3.2.2 Earlier EUTM applications or registrations

In this case, the opposition is based on an application but is not suspended because there is another earlier right (a registered trade mark) on the basis of which the contested application may be rejected. If the opponent fails to substantiate this other earlier right, the earlier application becomes crucial for the decision. If, according to the records, the only earlier application or registration is facing problems, the opposition should be suspended.

7.3.2.3 Earlier national/international marks (applications or registrations/rights)

In this case, the issue of suspension will have to be raised by the parties (normally the applicant) and evidence will have to be submitted that the earlier mark (application or registration/right) is facing problems. This evidence must be official, it must clearly identify the proceedings leading to the suspension, and it must indicate the relief sought. In particular, the evidence must be clear as to the possible consequences for the earlier right on which the opposition is based. If necessary, the party concerned may be requested to submit a translation of the evidence.

Upon such a request the Office will consider whether, under the circumstances of the case, it is advisable to suspend the proceedings.

If no party raises the question of suspension, then the general principle applies and the Office only has to decide on suspension if the proceedings reach the end of the

adversarial part and there is no information that the application has matured to registration or that national proceedings against the earlier mark have come to an end. In this case the opponent should be required to inform the Office of the status of its earlier application or registration.

7.3.2.4 Examples

Here are some examples where, according to the general practice indicated above, the situation apparently does not require the proceedings to be suspended but they can be if the Office finds it appropriate.

- The opposition is based on a French mark and on an EUTM application, neither of which faces problems. Both cover the same sign and the same goods, which are confusingly similar to the contested trade mark. Therefore, the opposition may be dealt with on the basis of the French mark only. If likelihood of confusion can occur only in Member States other than France, the decision will be more solid if based on the EUTM application. Therefore, it is appropriate to suspend the proceedings to await the outcome of the EUTM application.
- The earlier application does not make any difference to the outcome, but the applicant requests a suspension. If the earlier right is an EUTM application and the Office concludes that it is facing problems or, in the case of a national application, if the applicant submits evidence that the opponent's application is facing problems, the proceedings may be suspended.

The following examples fall into the category of earlier national marks facing problems:

- the applicant (or a third party) has filed an action or a counterclaim seeking the invalidation or revocation of the earlier registration;
- the applicant (or a third party) has filed an action or a counterclaim seeking the transfer of the earlier right to its own name.

7.3.3 Multiple oppositions

Article 9(2) EUTMDR

Except under exceptional circumstances, such as where one opposition clearly leads to the rejection of the contested mark including all goods and services, the Office will not suspend the other proceedings.

7.3.3.1 After rejection of the EUTM application

When the EUTM application is subsequently rejected because of an 'active' opposition, the suspended oppositions are deemed to have been disposed of after the decision becomes final. If the decision has become final, the parties to the other proceedings must be informed, the oppositions that were suspended at an early stage (before the cooling-off period) will be closed, and 50 % of the opposition fee will be refunded to each opponent, in accordance with Article 9(4) EUTMDR.

If an appeal has been filed against the decision, the oppositions remain suspended. If the Board of Appeal reverses the decision, the other proceedings will be resumed immediately, without having to wait for that decision to become final.

7.3.4 Procedural aspects

Letters suspending the proceedings should always indicate the date the suspension takes effect — generally the date when a valid request was submitted.

7.3.4.1 Monitoring suspended files

In cases where the proceedings are suspended for an undefined period, the Office will monitor the opposition every 6 months.

Where the earlier right is an application for a national registration or a national/international registration at risk, the parties are expected to promptly inform the Office about any change in the status of the proceedings affecting the application or registration and submit evidence to this effect. Nevertheless, the Office will consult the online evidence referred to in the notice of opposition every 6 months. Where it appears that the pending proceedings affecting the earlier right have concluded, it will resume the proceedings. Alternatively, it will request the parties to provide an update.

7.3.4.2 Resuming the proceedings

In all cases the parties will be informed of the resumption of the proceedings and of any pending time limit, if applicable. Any time limit that was pending at the moment of the suspension will be re-set in full, with the exception of the cooling-off period, which can never exceed 24 months according to Article 6(1) EUTMDR.

Proceedings must be resumed as soon as a final decision has been rendered in the course of the national proceedings or an earlier application has been registered or refused. If a decision taken in national proceedings invalidates, revokes, or in some other way extinguishes a right, or transfers an opponent's earlier right, the opposition is deemed unfounded insofar as it is based on that earlier right. If all the earlier rights on which an opposition is based cease to exist, the opponent will be granted the opportunity to withdraw its opposition. If it does not do so, the Office will take a decision rejecting the opposition.

7.3.4.3 Calculation of time limits

If the suspension is decided for a definite period of time, the Office's notification must also indicate the date when the proceedings are to be resumed, and what happens after that. When the suspension is requested by both parties because there are ongoing negotiations, the period will always be 6 months, regardless of the period requested by the parties.

For example, if a request for a 2-month suspension signed by both parties and submitted on 15/01/2017 (5 days before the expiry of the time limit of the opponent for completing the opposition — 20/01/2017) is dealt with on 30/01/2017, the result will be that:

- the Office has suspended the opposition proceedings at the request of both parties;
- the suspension takes effect as from 15/01/2017 (the date when the suspension request was received at the Office) and will expire on 15/07/2017;
- the proceedings will be resumed on 16/07/2017 (6 months, irrespective of the period requested by the parties), with no further notification from the Office;
- the time limit for the opponent is now 15/09/2017 (two full months for the opponent to complete the file);
- the time limit for the applicant is now 15/11/2017 (two full months after the opponent's time limit).

7.4 Multiple oppositions

Article 9 EUTMDR

Multiple oppositions are when different oppositions are filed against the same EUTM application.

In the case of multiple oppositions, some extra factors have to be taken into account.

Firstly, unless there is a major delay during the admissibility stage concerning one of the oppositions, the practice is to notify the applicant of the admissibility of all the oppositions at the same time. Secondly, multiple oppositions may lead to some of them being suspended for reasons of economy of proceedings. Thirdly, a restriction made by the applicant in the course of one of the proceedings may have an impact on the other oppositions. Furthermore, it may be practical to take the decisions in a certain order.

Finally, under certain circumstances, multiple oppositions may be joined and dealt with in one set of proceedings.

7.4.1 Multiple oppositions and restrictions

When there are multiple oppositions and the applicant restricts the goods and services in one of the opposition proceedings, all the other opponents will have to be informed by means of an appropriate letter insofar as the restriction concerns the goods or services contested by the other oppositions.

However, if there is no connection between the goods or services in the restriction and the contested goods and services, the opponent need not be informed.

For example, there are four oppositions against the same EUTM application, applied for in respect of goods in Classes 3, 14, 18 and 25. The oppositions are directed against the following classes:

Opposition	Extent
No 1	Class 3
No 2	Class 25
No 3	Classes 18 and 25
No 4	Classes 14 and 25

The applicant sends a restriction affecting opposition 2, deleting *clothing* and *headgear*. The relevant letters should be sent not only in opposition 2, but also in oppositions 3 and 4. As the restriction does not affect the contested goods of opposition 1, no action is necessary in this opposition.

7.4.2 Multiple oppositions and decisions

Once an opposition reaches the decision stage, it is important to take account of any other multiple oppositions pending against the same EUTM application. Before a ruling can be given on an opposition, the stage of proceedings of the multiple oppositions must be analysed and, depending on the situation, a decision may be taken or the opposition must be suspended. The general principle to be applied is that contested goods and services should not be rejected more than once at different points in time. The three situations that may occur are described in the following.

7.4.2.1 All oppositions against the same EUTM application are ready for decision at the same time

The order in which the decisions are taken is at the discretion of the examiner. However, the following has to be taken into account.

If all oppositions will fail, the decisions can be taken in any order, as the rejection of the opposition does not affect the EUTM application. Even if one of the decisions were to be appealed before the others are taken, it would seem preferable not to suspend the oppositions as the procedure before the Board of Appeal can take some time.

If several oppositions will be successful against overlapping goods and services, first the decision eliminating most goods and services of the EUTM application (the widest extent of the opposition) should be taken and the remaining oppositions suspended. Once the first decision is final, the opponents in the remaining oppositions must be consulted on whether they wish to maintain or withdraw their oppositions.

Assuming that the oppositions are maintained, the next 'widest' opposition is decided and the same process continues until all of the oppositions are dealt with.

When two oppositions are of the same extent, the general principles apply when taking the decisions.

In the example mentioned above under paragraph 7.4.1, the first decision should either be taken in opposition 3 or in opposition 4. Opposition 1 has no overlapping goods and services and can therefore be taken independently.

Suppose the first decision is taken in opposition 4, and the EUTM application is rejected for Classes 14 and 25. In this case, oppositions 2 and 3 need to be suspended.

If the appeal period has expired and no appeal is filed, opposition 2 is disposed of, as it no longer has an object. The parties should be informed and the opposition must be closed. The case is considered to have not proceeded to judgment within the meaning of Article 109(5) EUTMR. Consequently, the costs are at the discretion of the Office. If the parties inform the Office that they agree on the costs, a decision on costs will not be taken. Generally, the decision will be that each party bears its own costs.

7.4.2.2 Only one opposition is ready for decision and the other oppositions are still in the adversarial phase of the proceedings

If the opposition is to be rejected, a decision can be taken without further impact on the pending multiple oppositions because the rejection does not have any effect on the EUTM application.

If the opposition is successful and the decision rejects the contested EUTM application in its entirety, the pending multiple oppositions must be suspended until the decision is final. Once the appeal period has expired and no appeal has been filed, the multiple oppositions are disposed of, as they no longer have an object. The parties should be informed and the opposition must be closed. The case is considered to have not proceeded to judgment within the meaning of Article 109(5) EUTMR. Consequently, the costs are at the discretion of the Office. If the parties inform the Office that they agree on the costs, a decision on costs will not be taken. Generally, the decision will be that each party bears its own costs.

The same applies if the decision on the opposition rejects **part** of the goods and services of the contested EUTM application but **all** of the goods and services against which the multiple oppositions are directed.

However, multiple oppositions must be suspended if the decision on the opposition rejects **part** of the goods and services of the contested EUTM application but only **part** of the goods and services against which the multiple oppositions are directed. The suspension will last until the decision has become final. If this is the case, the opponents of the multiple oppositions will be invited to inform the Office whether they wish to maintain or withdraw the opposition. In the case of a withdrawal of the opposition, the proceedings are closed and both parties are informed. If the proceedings are closed after the expiry of the cooling-off period, the Office will decide, in accordance with Article 109(3) EUTMR, that each party bears its own costs. If the parties inform the Office before the closure of proceedings that they agree on the costs, a decision on costs will not be taken.

7.4.2.3 Two or more oppositions are ready for decision and others are still in the adversarial phase of the proceedings

It may happen that some of the oppositions against an EUTM application are ready for a ruling and some are still at different stages of the adversarial phase. In this situation the principles described under 1 and 2 apply in combination. It depends on the outcome of the decisions and on the scope of the pending cases whether a decision may be taken in some oppositions and whether the multiple oppositions must be suspended.

7.4.3 Joinder of proceedings

Article 9(1) EUTMDR

Article 9(1) EUTMDR allows the Office to deal with multiple oppositions in one set of proceedings. If it is decided to join the oppositions, the parties must be notified.

Oppositions may be joined upon the request of one of the parties if they are directed against the same EUTM application. It is more likely that the Office would join them if, in addition, they were filed by the same opponent or if there were an economic link between the opponents, for example a parent and subsidiary company. The oppositions must be at the same procedural stage.

When the Office decides to join the oppositions, it should verify whether the opponents have the same representative. If not, they must be asked to appoint one single representative. In addition, the earlier rights must be identical or very similar. If the representatives do not reply or do not want to appoint a single representative, the joinder must be undone and the oppositions dealt with separately.

If at any stage these conditions are no longer fulfilled, for example the one and only earlier right of one of the joined oppositions is transferred to a third party, the joinder may be undone.

Unless the joinder is undone before the decision is taken, only one decision is taken.

7.5 Change of parties (transfer, change of name, change of representative, interruption of proceedings)

7.5.1 Transfer and opposition proceedings

7.5.1.1 Introduction and basic principle

Article 20 EUTMR

A transfer or assignment of an earlier right is a change of ownership of this right. For further information see the Guidelines, Part E, Register Operations, Section 3, EUTMs and RCDs as Objects of Property, Chapter 1, Transfer.

The basic principle is that the new owner substitutes the old owner in the proceedings. The Office's practice for dealing with transfers is described in paragraphs 7.5.1.2 (the earlier registration is an EUTM), 7.5.1.3 (the earlier registration is a national registration), 7.5.1.4 (the earlier registrations are a combination of EUTM registrations and national registrations) and 7.5.1.5 (transfer of a contested EUTM application during opposition proceedings).

A transfer can be made in several ways, including the simple sale of an earlier mark from A to B, a company C being bought (trade marks included) by company D, a merger of companies E and F into company G (universal succession), or legal succession (after the owner has died, the heirs become the new owners). This is not an exhaustive list.

When a transfer is made during opposition proceedings, several situations can arise. Whereas, for earlier EUTM registrations or applications on which the opposition is based, the new owner can only become party to the proceedings (or file observations) once the request for registration of the transfer has reached the Office, for earlier national registrations or applications it suffices that the new owner files evidence of the transfer.

7.5.1.2 Transfer of earlier EUTM

Article 20(11) and (12) EUTMR

For earlier EUTMs or EUTM applications, Article 20(11) EUTMR provides that, as long as a transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the EUTM (application). However, in the period between the date of receipt of the request for registration of the transfer and the date of registration of the transfer, the new owner may already make statements to the Office with a view to observing time limits.

Opposition based on one EUTM only

When an opposition is based on one earlier EUTM only and this EUTM is/has been transferred during the opposition proceedings, the new owner becomes the new opponent. The new owner will substitute the old owner.

To this end, either the old or the new owner will have to inform the Office that the EUTM on which the opposition is based has been transferred and submit a request for registration of the transfer. As mentioned above, as soon as the request is received by the Office, the new owner may already make statements. However, it only becomes party to the proceedings once the transfer is registered.

In practice, once the Office is informed that a request for registration is received, the proceedings can continue with the new owner. Nevertheless, the transfer has to be registered before a decision on the opposition is taken. If the opposition is ready for decision but the transfer has not been registered, the opposition must be suspended.

If the new owner informs the Office that it does not want to continue the proceedings, the opposition is considered withdrawn.

Partial transfer of the only EUTM on which the opposition is based

In cases of a partial transfer, one part of the earlier EUTM remains with the original owner and another part is transferred to a new owner. The same principles apply to partial transfers as to the transfer of only one of a number of EUTM registrations on which the opposition is based, as described in the paragraph immediately below.

Opposition based on more than one earlier EUTM

When an opposition is based on more than one earlier EUTM and all these marks are/ have been transferred to the same new owner during the opposition proceedings, the situation is the same as for an opposition based on a single EUTM, as described above.

The situation is, however, different when only one of the earlier EUTMs is/has been transferred. In this case, the new owner may also become an opponent, with the result that there are two opponents. The new opponents will be treated as 'joint opponents', meaning that the Office will continue dealing with the case in exactly the same way as before, that is to say, as **one** opposition, albeit with more than one opponent. Moreover, the Office will consider the original representative as the 'common' representative for both opponents and will not invite the new opponent to appoint a new representative. However, the new opponent always has the option of appointing a representative of its choice.

Common representation does not mean that opponents may not act independently, to the extent that their earlier rights remain independent: if, for instance, one of the opponents enters into a friendly settlement with the applicant, the opposition will be treated as partially withdrawn in respect of the earlier rights owned by this opponent.

If one of the joint opponents wants to withdraw, this will be accepted independently of whether the other wants to continue. Should the proceedings be continued, they will only be based on the rights of the opponent that did not withdraw. No separate decision on costs will be taken.

7.5.1.3 Transfer of earlier national registration

Opposition based on one national registration only

When an opposition is based on one earlier national registration only and this registration is/has been transferred during the opposition proceedings, the new owner also becomes the new opponent. The new owner will substitute the old owner.

To this end, either the old or the new owner will have to inform the Office that the earlier national registration on which the opposition is based has been transferred and must file evidence thereof, that is, the deed of transfer or any other evidence showing the agreement of the parties to the transfer/change of ownership.

The Office does not require the new owner to confirm that it wishes to continue the proceedings. As long as the evidence of the transfer is in order, the new owner is accepted as the new opponent. If it informs the Office of the transfer, but does not submit (sufficient) evidence thereof, the opposition proceedings have to be suspended while the new owner is given a time limit within which to submit evidence of the transfer.

As there are different national practices, it is not always obligatory to submit a copy of the request to register the transfer with the national office. Nevertheless, in those Member States where a transfer must be registered in order to have effect against third parties, the transfer must have been registered before a decision on the opposition is taken. If the opposition is ready for decision but the transfer has not been registered, the opposition must be suspended and the opponent required to submit evidence of registration of the transfer.

If the new owner does not submit the required evidence, the proceedings must be continued with the old owner. If the old owner maintains that it is not the owner any more, the opposition has become unfounded, as the opponent is no longer the owner of the earlier right. The old owner must be informed that the opposition will be rejected as such unless it withdraws the opposition.

If the new owner submits the required evidence and informs the Office that it does not want to continue the proceedings, the opposition is considered withdrawn.

Partial transfer of the only national registration on which the opposition is based

In cases of a partial transfer, one part of the earlier national registration remains with the original owner and another part with a new owner. The same principles apply to partial transfers as to transfers of only one of a number of national registrations on which the opposition is based, as described in the paragraph immediately below.

Opposition based on more than one earlier national registration

When an opposition is based on more than one earlier national registration and these are/have been transferred to the same new owner during the opposition proceedings, the situation is the same as for the transfer of a single mark upon which an opposition is based, as described above.

The situation is, however, different when only one of the earlier national rights is/has been transferred. In this case the new owner may also become an opponent, with the result that there are two opponents. The new opponents will be treated as 'joint opponents', meaning that the Office will continue dealing with the case in exactly the same way as before, that is to say, as **one** opposition, albeit with more than one opponent. Moreover, the Office will consider the original representative as the 'common' representative for both opponents and will not invite the new opponent to appoint a new representative. However, the new opponent always has the option of appointing a representative of its choice.

If one of the joint opponents wants to withdraw, this is to be accepted independently of whether the other wants to continue. Of course, if the proceedings are continued it will be based only on the rights of the opponent that did not withdraw. No separate decision on costs will be taken.

7.5.1.4 Opposition based on a combination of EUTM registrations and national registrations

When an opposition is based on one or more EUTM registrations **and** one or more national registrations at the same time and one of these marks is/has been transferred to the same new owner during the opposition proceedings, the principles set out above apply *mutatis mutandis*.

In all of these situations, once the Office becomes aware of the transfer of ownership, it will update the official database to include the new opponent/both opponents and will inform the parties for information purposes only. However, the mere fact that the earlier registrations have been transferred will never justify the granting of a new time limit for submitting observations or any other documents once the original time limit has expired.

7.5.1.5 Transfer of the contested EUTM application

When during opposition proceedings the contested EUTM application is/has been transferred, the opposition follows the application, that is to say, the opponent is informed of the transfer and the proceedings continue between the new owner of the EUTM application and the opponent.

7.5.1.6 Partial transfer of a contested EUTM application

Article 14(2) EUTMIR

When there has been a partial transfer of a (contested) EUTM application, the Office must create a separate file for the new registration (application) with a new registration (application) number.

In this case, when the transfer is recorded in the Register and a new EUTM application is created, the opposition examiner also has to create a new opposition file against the

new EUTM application, since it is not possible to deal with one opposition against two separate EUTM applications.

However, this is only the case when some of the originally contested goods and services are maintained in the 'old' EUTM application and some in the newly created EUTM application. For example: Opponent X opposes all the goods of EUTM application Y, applied for in Class 12 for *apparatus for locomotion by land and air*, and for *clothing and footwear* in Class 25. EUTM application Y is partially transferred, and split into old EUTM application Y for *apparatus for locomotion by land and clothing*, and new EUTM application Y for *apparatus for locomotion by air*, and *footwear*.

Articles 20 and 27 EUTMR

Since there was only one opposition fee to be paid when the opponent filed its opposition, a second fee for the new opposition created after the split of the EUTM application is not required because, at the time of filing, the opposition was only directed against one EUTM application.

Regarding the apportionment of costs, the opposition examiner will take into account the fact that only one opposition fee was paid.

Moreover, depending on the circumstances of the case, it could be possible to join the proceedings (e.g. when the representative of the 'old' and 'new' applications is the same).

7.5.2 Parties are the same after transfer

In the event that, as a result of a transfer, the opponent and applicant become the same person or entity, the opposition becomes devoid of any purpose and will accordingly be closed *ex officio* by the Office.

7.5.3 Change of names

As mentioned above, a change of name does not imply a change of ownership.

7.5.4 Change of representatives

Article 119 EUTMR

When there is a change of representative during opposition proceedings, the other party will have to be informed by sending it a copy of the letter and of any authorisation submitted.

For detailed information please refer to the Guidelines, Part A, General Rules, Section 5, Professional Representation.

7.5.5 Interruption of the proceedings due to death or legal incapacity of the applicant or its representative

Article 106 EUTMR

Article 72 EUTMDR

Article 106 EUTMR deals with interruption of proceedings. Paragraph 1 distinguishes three situations:

Opposition proceedings before the Office will be interrupted:

1. when the EUTM **applicant** has died or is under legal guardianship;
2. when the EUTM applicant is subject to bankruptcy or any similar proceedings;
3. when the representative of an applicant has died or is otherwise prevented from representing the applicant. For further information see the Guidelines, Part A, General Rules, Section 5, Professional Representation.

Article 106 EUTMR only refers to the applicant and its representative and does not mention anything about other parties, such as opponents. In the absence of relevant provisions, the Office will apply this provision only to cases where the applicant (or its representative) is not able to continue the proceedings. Therefore, if, for example, the opponent is declared bankrupt, the proceedings will not be interrupted (even where the opponent is the applicant/proprietor of an earlier EUTM application/EUTM). The uncertainty of the legal status of an opponent or its representative will not be to the detriment of the applicant. In such a case, when the notification is returned to the Office as undeliverable, the normal rules for public notification apply.

7.5.5.1 Death or legal incapacity of the applicant

In the event of the death of the applicant or of the person authorised by national law to act on their behalf because of the legal incapacity of the applicant, the proceedings are only interrupted when this is requested by the representative of the applicant/ authorised person or when the representative resigns.

7.5.5.2 Applicant prevented from continuing the proceedings before the Office owing to legal reasons (e.g. bankruptcy)

Article 106(1)(b) EUTMR

Article 72(3) EUTMDR

Article 106(1)(b) EUTMR applies from the point in time from which the party to the proceedings is no longer entitled to dispose of the procedure, i.e. to dispose of its assets, until the point in time a liquidator or trustee is appointed who will then continue to represent the party under the law.

When the applicant is represented by a professional representative who has not resigned, there is no need to interrupt the proceedings. The Office considers the applicant's representative to be entitled to represent the applicant until the Office is informed otherwise by the representative itself, by the designated trustee or the court dealing with the legal action in question.

If the representative informs the Office that it is resigning, how the Office proceeds will depend on whether the representative also indicates who will act as trustee or liquidator in the bankruptcy.

- If the representative does indicate a trustee or liquidator, the Office will continue to correspond with that trustee or liquidator. If there were time limits affecting the applicant that had not yet expired when it went bankrupt, the Office will re-start these time limits. Therefore, in this case, the proceedings are interrupted and immediately resumed. For example, if the applicant still had ten days to file observations when it went bankrupt, the new letter of the Office to the trustee will give a fresh time limit of 2 months to file those observations.
- If the representative does not give any information regarding a liquidator or trustee, the Office has no choice but to declare an interruption of the proceedings. A communication to that effect will be sent to the bankrupt applicant directly and to the opponent. Although it is not up to the Office to investigate who the liquidator is, the Office will keep on trying to communicate with the bankrupt applicant with the aim of resuming the proceedings. This is because, although the bankrupt applicant is not allowed to undertake binding legal acts, generally it still receives correspondence, or, if not, the correspondence is delivered automatically to the trustee as long as there is one. The Office might also consider information on the identity of the trustee provided by the opponent.

When the notification is returned to the Office as undeliverable, the normal rules for public notification apply.

Evidence submitted about the appointment of the liquidator or trustee need not be translated into the language of the proceedings.

Once the Office has been informed of who the liquidator or trustee is, the proceedings are resumed from a date to be fixed by the Office. The other party must be informed. In the absence of this information, the proceedings will remain interrupted.

Time limits that had not yet expired when the proceedings were interrupted start running again when the proceedings are resumed. For example, if the proceedings were interrupted ten days before the applicant had to submit observations, a new time limit will start — of 2 months rather than the ten days left at the time of the interruption. For clarification, the letter sent by the Office informing the parties about the resumption will fix a new time limit.

7.5.5.3 Death or legal incapacity of the applicant's representative

Article 106(1)(c) and Article 119(2) EUTMR
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In the case referred to in Article 106(1)(c) EUTMR, the proceedings must be interrupted and will be resumed when the Office is informed of the appointment of a new representative of the EUTM applicant.

This interruption will last a maximum of 3 months and, if no representative is appointed before the end of this period, the proceedings will be resumed by the Office. When resuming the proceedings, the Office will proceed as follows.

- If the appointment of a representative is compulsory under Article 119(2) EUTMR because the applicant has neither its domicile nor its seat in the EEA, the Office will contact the applicant and inform it that the EUTM application will be refused if it does not appoint a representative within a specified time limit.
- If appointment of a representative is **not** compulsory under Article 119(2) EUTMR, the Office will resume the proceedings and will send all the communications to the applicant directly.

In both cases, resuming the proceedings will mean that any time limits pending for the applicant when the proceedings were interrupted start running again once the proceedings are resumed.

Annex — Calculation of the grace period for non-use in the case of national marks

The following table sets out the **national provisions** defining the date of commencement of the 5-year grace period for non-use for **national marks** (last general update on 15/09/2020). The abbreviations 'TMA' or 'IPL' have been used as a generic reference to the relevant legislative act (Trade Mark Act or IP Law). The table also provides the **headings** of the national database extracts where the relevant date can be found.

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Austria	Article 33a(1a) AT-TMA ‘5 years after the end of the opposition period or after the final decision on opposition or after the closure of opposition procedure ... ’	The beginning of the use period (Fristbeginn für Benutzung)	
Benelux	Article 2.23bis(1) BX-TMA ‘... 5 years following the date of completion of the registration procedure ... ’ Article 2.23bis(2) BX-TMA ‘... the 5-year period ... shall be calculated from the date when the mark can no longer be subject of a refusal on absolute grounds or an opposition or, in the event that a refusal has been issued or an opposition has been lodged, from the date when a decision lifting the Office’s objections on absolute grounds or terminating the opposition proceedings became final or the opposition was withdrawn.’	Regular registration proceedings: Registration date (Inschrijvingsdatum / Date de l’enregistrement) Accelerated registration proceedings: Status accelerated registration (Status van spoedinschrijving / Phase d’enregistrement accéléré)	In accelerated registration , Benelux applies a post-registration opposition procedure and, therefore, the date of completion of the registration procedure is the date appearing under a separate heading ‘status accelerated registration’.
Bulgaria	Article 21(1) BG-TMA ‘... within a period of 5 years as from the date of registration ... ’	Registration date (Дата на регистрация)	

Mem ber State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Croatia	Article 20 HR-TMA ‘... 5 years from the date of completion of the registration procedure ...’ Article 47(1) HR-TMA ‘... during the 5-year period preceding the date of filing the application or the date of claiming the priority right of the trade mark, the earlier trade mark has been in genuine use ..., the earlier trade mark has been registered for not less than 5 years.’	Registration Date (Datum priznanja) (INID code 151)	
Cyprus	Article 39(1)(a) CY-TMA ‘... within a period of five consecutive years from the registration ...’ Article 33(3) CY-TMA ‘A mark ... is considered to have been registered on the date of completion of the registration procedure .’	Date of registration (Ημερομηνία Εγγραφής)	In TMview , the relevant date is not the ‘Registration date’ (which, according to a previous legal definition, coincided with the ‘Application date’). The relevant date can often be found in the ‘Recordals’ section, under ‘Event description: Trade mark registered on ...’.

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Czech Republic	<p>Article 13(1) CZ-TMA ‘... 5 years following the registration ...’</p> <p>Article 28(1), (3) CZ-TMA ‘(1) ... The Office will register the trade mark in the Register together with stating the registration date therein ...’</p> <p>(3) The registration of the trade mark in the Register takes effect as of the registration date.’</p>	<p>Registration date (Datum zápisu) (INID code 151)</p>	
Denmark	<p>Article 10c(1) DK-TMA ‘... for a continuous period of 5 years from the date of completion of the registration procedure ...’</p> <p>Article 10c(2)(i) DK-TMA ‘The registration procedure shall be deemed completed when a trade mark is registered ...’</p>	<p>Registration procedure terminated (Reg. procedure slut)</p>	<p>Trade marks registered as of 01/01/2019: Date of registration</p> <p>Trade marks registered before 01/01/2019: Where no opposition has been filed: First day after the end of the opposition period.</p> <p>Where an opposition has been filed: (a) date when the decision terminating the opposition proceedings became final, or (b) date of withdrawal of the opposition.</p>
Estonia	<p>Article 17(3) EE-TMA ‘... 5 years have passed since the registration of the earlier trade mark.’</p>	<p>Registration date (Registreerimise kuupäev)</p>	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Finland	Article 46 FI-TMA ‘... 5-year period shall be calculated from the date on which the mark can no longer be opposed ... if an opposition has been lodged, from the date when a decision terminating the opposition proceedings became final or the opposition was withdrawn .’	Trade marks filed as of 01/05/2019: Date of commencement of 5-year use period (5 vuoden käyttämisaian alkamisaika) Trade marks filed before 01/05/2019: (a) <u>where no opposition was filed:</u> First day after the date under ‘Opposition end date’ (‘Väiteajan päättymispäivä’) (b) <u>where an opposition was filed :</u> See section ‘Applications, appeals and oppositions relating to the trade mark’ / ‘Event: Opposition’ / ‘Status: Closed’ / ‘Status date’ (‘Tavaramerkkiin liittyvät hakemukset, valitukset, väitteet’ / Tapahtuma’: ‘Väite’ / ‘Tila’: Loppuunkäsitelty’ / Tapahtumapäivä)	
France	Article R 712-23 FR-IPL ‘The date on which a mark is deemed to be registered, in particular for the purposes of applying Articles ... L. 714-5, is, for French marks, the date of the ‘Bulletin officiel de la propriété industrielle’ in which the registration has been published. ’	History / Registration without modification (Historique / Enregistrement sans modification)	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Germ any	<p>Article 26(5) DE-TMA</p> <p>Where no opposition has been filed:</p> <p>‘... 5 years from the date when the mark can no longer be opposed.’</p> <p>Where opposition has been filed:</p> <p>‘... 5 years from the date when the decision terminating the opposition proceedings became final or the opposition was withdrawn.’</p>	<p>Trade marks filed as of 14/01/2019:</p> <p>Start of grace period for use (Beginn der Benutzungsschonfrist)</p> <p>Trade marks filed before 14/01/2019:</p> <p>(a) <u>where no opposition against the earlier mark was filed and the opposition against the EUTM based on that earlier mark was filed before 14/01/2019 :</u></p> <p>Date of entry into register (Tag der Eintragung im Register) (INID code 151)</p> <p>(b) <u>where no opposition against the earlier mark was filed and the opposition against the EUTM based on that earlier mark was filed on or after 14/01/2019:</u></p> <p>First day after the date of the ‘End of opposition period’ (EWT) (‘Ablauf der Widerspruchsfrist’)</p> <p>(c) <u>where an opposition against the earlier mark was filed :</u></p> <p>‘Date of conclusion’ (‘Abschlussdatum’) in details for the section ‘Opposition proceedings’* (‘Widerspruchsverfahren’)</p>	<p>* See section ‘Kind of procedure’ / ‘Opposition proceedings’ – ‘Display details’ (‘Verfahrensart’ / ‘Widerspruchsverfahren’ – ‘Details anzeigen’) (line with the entry related to the closure of the opposition proceedings, e.g. ‘Opposition proceedings’ – ‘Trade mark cancelled in part’ (‘Widerspruchsverfahren’ – ‘Marke teilweise gelöscht’)) / ‘Date of conclusion’ (‘Datum des Abschlusses’)</p> <p>Article 158 DE-TMA</p> <p>Transitional provisions</p> <p>‘...’</p> <p>(5) If use of a trade mark on which an opposition is based is contested in opposition proceedings lodged prior to 14/01/2019, Article 26 and Article 43(1) in the version in force until 13/01/2019 shall apply.’</p> <p>Article 26(5) DE-TMA (in the version in force until 13/01/2019):</p> <p>‘Insofar as use within 5 years from the point in time of the registration is necessary, in cases in which an opposition has been lodged against the registration, the time of the registration shall be substituted by the point in time of the conclusion of the opposition proceedings.’</p>

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Greece	Article 28(1) GR-TMA: ‘... provided that the earlier trade mark has been registered for at least 5 years ...’	N/A	No official public online trade mark database exists in Greece. Official information on trade marks protected in Greece is accessible online only through TMview. The relevant information may be found in TMview under the heading ‘Registration date’.
Hungary	Article 18(1) HU-TMA ‘... within a period of 5 years following the date of registration ...’ Article 64(1) HU-TMA ‘ The date of the decision on registration shall be the date of registration of the trade mark.’ Article 18(2) HU-TMA ‘... in the case of a trade mark registered in ‘special expedited procedure’ [Article 64/A(7)], the date of registration shall be the date: a) following the expiry of the period pursuant to Article 61/B(1) [3-month opposition period]; or b) in the case of an opposition, when the decision on the opposition becomes final .’	Starting date of the 5-year period within which the trade mark must be put to use (Védjegyhasználat megkezdésére nyitva álló ötéves időszak kezdő időpontja)	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Ireland	Article 16A(1) IE-TMA ‘... within the period of 5 years following the date of completion of the registration procedure ...’ Article 45(5) IE-TMA ‘The registration procedure shall be regarded as completed on the date of publication under subsection (4); and that date shall be entered in the register.’	Date of publication of registration	The relevant date can be found in TMview under the headings ‘Publication’ / ‘Publication section: Registration’ / ‘Publication date’ (i.e. <u>not</u> under ‘Registration date’).
Italy	Article 24(1) IT-IPL ‘... within 5 years from the registration .’	Registration date (Data registrazione)	The relevant date of registration is that of the original registration of the mark.
Latvia	Article 26 LV-TMA ‘(1) ... within 5 years from the completion of the registration procedure ...’ (2) The period of 5 years ... shall run from the date on which the opposition to the trade mark in question is no longer available or, if an opposition has been received, of the decision closing the opposition proceedings or withdrawn .’	Trade marks registered as of 20/09/2020: Registration finish date (Reģ. procedūras pabeigšanas datums) (INID code 451) Trade marks registered before 20/09/2020: Registration date (Reģistrācijas datums) (INID code 151)	
Lithuania	Article 20 LT-TMA ‘... within a period of 5 years following registration ...’	Registration date (Registracijos data) (INID code 151)	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Malta	<p>Article 26(1) MT-TMA</p> <p>‘... within a period of 5 years following the date of completion of the registration procedure ...’</p> <p>Article 56(4) MT-TMA</p> <p>‘On the registration of a trademark the Comptroller shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.’</p>	<p>Registration date (Data tar-Registrazzjoni)</p> <p>(INID code 151)</p>	
Poland	<p>Article 169(1)(i) PL-IPL</p> <p>‘... for a period of five consecutive years after the decision on the grant of a right of protection has been taken ...’</p>	<p>Date of grant (Data udzielenia prawa)</p>	
Portugal	<p>Article 268(1) PT-IPL</p> <p>‘... the registration shall lapse if the trade mark is not put to genuine use over a period of five consecutive years.’</p> <p>Article 268(5) PT-IPL</p> <p>‘The 5-year period starts running as from the date of registration .’</p>	<p>Date of the decision (Data do Despacho)</p>	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Romania	<p>Article 55(1)(a) RO-TMA</p> <p>‘... within a continuous 5-year period calculated from the date of completion of the registration procedure ...’</p> <p>Article 32 RO-TMA</p> <p>‘(1) OSIM shall enter in the trade marks register those marks admitted for registration for which the registration procedure has been completed ... The date of completion of the registration procedure shall be entered in the register.</p> <p>(2) The procedure for registration of a trade mark shall be deemed to be completed on the date on which the trade mark application admitted to registration may no longer be the subject of an opposition or, in the case where an opposition has been filed, on the date on which the opposition decision became final or opposition has been withdrawn.’</p>	<p>For marks filed as of 13/07/2020:</p> <p>Date of completion of the registration procedure (Data inchidere procedura)</p> <p>For marks filed before 13/07/2020:</p> <p>Granting date (Data acordare)</p>	The implementation of the new heading ‘Date of completion of the registration procedure’ still pending at the time of the last general update of this table.
Slovakia	<p>Article 7c(1) SK-TMA</p> <p>‘... <i>within a period of 5 years from the date of registration of the trade mark...</i>’</p>	<p>Registration date (Dátum zápisu)</p> <p>(INID code 151)</p>	

Mem ber State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Slov enia	Article 52.b(1) SI-IPL '... within 5 years from the date of entry of the mark in the register ... '	Registration date (Datum registracije) (INID code 151)	

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Spain	<p>Article 39(1) ES-TMA</p> <p>‘... within a period of 5 years from the date of registration ...’</p> <p>Article 39(2) ES-TMA</p> <p>‘The 5-year date referred to in the previous paragraph shall begin on the day on which the registration of the trade mark becomes final . This date shall be entered in the Register of Marks.’</p>	<p>If the opposition against the EUTM application was filed on or after 14/01/2019:</p> <p>(a) <u>Where no appeal against the first instance decision concerning the registration of the earlier mark was filed:</u></p> <p>1 month after the date indicated in the left-column ‘Date’ (‘Fecha’) in section ‘Acts of processing’ (‘Actos de tramitación’) / ‘Act performed’ (‘Acto de tramitación’) / ‘PUBLIC. CONCESION DE F. RESOL. [DATE]’.</p> <p>(b) <u>Where an appeal was filed against the first instance decision concerning the registration of the earlier mark, as a result of which the mark is granted:</u></p> <p>2 months after the date indicated in the left-column ‘Date’ (‘Fecha’) in section ‘Acts of processing’ (‘Actos de tramitación’) / ‘Act performed’ (‘Acto de tramitación’) / ‘PUBL. ESTIMAC. RECURSO DE FECHA [DATE]’ or ‘PUBL. DESESTIM. RECURSO DE FECHA [DATE]’ or ‘PUBL. INADMIS. RECURSO DE FECHA [DATE]’.</p> <p>(c) <u>Where an appeal was filed before the Court against the second instance decision of the Spanish national office (OEPM) concerning the registration of the earlier mark, as a result of which the mark is granted:</u></p> <p>Unless the opponent proves a later date, 30 business days after the date indicated in section ‘Acts of processing’ (‘Actos de tramitación’), in the right-column ‘Act performed’ (‘Acto de tramitación’) / ‘PUBL. CONCE. V. RESPON. FECHA [DATE]’.</p>	<p>Page 809</p> <p>01/03/2021</p>
FINAL			

Member State	Relevant legal provisions	Relevant heading in the official database extract	Comments
Sweden	Chapter 3, Article 2 SE-TMA ‘... within a period of 5 years following the date of the completion of the registration procedure .’	Legal effect date (Dag för laga kraft)	<p>Where no opposition has been filed:</p> <p>First day after the 3-month opposition period lapsed (the information on the lapse of the opposition period may be found in TMview under the heading ‘Opposition period end date’).</p> <p>Where an opposition has been filed:</p> <p>The date when the decision on the opposition has become final.</p>

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

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

Part C

Opposition

Section 2

Double identity and likelihood of confusion

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GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

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Double identity and likelihood of confusion

Chapter 1

General principles

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1 Introduction

This chapter provides an introduction to and overview of the concepts of (i) double identity and (ii) likelihood of confusion that are applied in situations of conflict between trade marks in opposition proceedings under Article 8(1) EUTMR.

The paragraphs below set out the nature of these concepts and their legal underpinning as determined by the relevant laws and as interpreted by the Court of Justice of the European Union (the ‘Court’)⁽³³⁾.

The legal concepts of double identity and likelihood of confusion are used to protect trade marks and, at the same time, to define their scope of protection. It is thus important to bear in mind what aspects or functions of trade marks merit protection. Trade marks have various functions. The most fundamental one is to act as ‘indicators of origin’ of the commercial provenance of goods/services. This is their ‘essential function’. In the *Canon* judgment the Court held that:

... according to the settled case-law of the Court, the **essential function of the trade mark is to guarantee the identity of the origin of the marked product** to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin (emphasis added).

(29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 28).

The essential function of trade marks as indicating origin has been emphasised repeatedly and has become a precept of European Union trade mark law (18/06/2002, C-299/99, *Remington*, EU:C:2002:377, § 30; 06/10/2005, C-120/04, *Thomson Life*, EU:C:2005:594, § 23).

Whilst indicating origin is the essential function of trade marks, it is not the only one. Indeed, the term, ‘essential function’ implies other functions. The Court alluded to the other functions of trade marks several times (16/11/2004, C-245/02, *Budweiser*, EU:C:2004:717, § 59; 25/01/2007, C-48/05, *Opel*, EU:C:2007:55, § 21) but addressed them directly in the *L’Oréal* judgment, where it stated that the functions of trade marks include:

... **not only the essential function** of the trade mark, which is to guarantee to consumers the origin of the goods or services, **but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising** (emphasis added).

(18/06/2009, C-487/07, *L’Oréal*, EU:C:2009:378, § 58-59; 23/03/2010, C-236/08 – C-238/08, *Google-Louis Vuitton*, EU:C:2010:159).

In examining the concepts of double identity and likelihood of confusion, this chapter touches upon several themes that are explained comprehensively in the chapters of

³³ The Court was, in fact, often interpreting Articles 4 and 5 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, which for the purposes of interpretation are broadly comparable to Articles 8 and 9 EUTMR.

the Guidelines that follow. A summary of the key cases from the Court dealing with the core principles and concepts of likelihood of confusion is added in the Annex.

2 Article 8(1) EUTMR

Article 8 EUTMR enables the proprietor of an **earlier right** to oppose the registration of later EUTM applications in a range of situations. The present chapter will concentrate on the interpretation of double identity and likelihood of confusion within the meaning of Article 8(1) EUTMR.

An opposition pursuant to Article 8(1) EUTMR can be based on earlier trade mark registrations or applications (Article 8(2)(a) and (b) EUTMR) and earlier well-known marks (Article 8(2)(c) EUTMR) ⁽³⁴⁾.

2.1 Article 8(1)(a) EUTMR — double identity

Article 8(1)(a) EUTMR provides for oppositions based on identity. It provides that, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) EUTMR, an EUTM application will not be registered ‘if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.’

The wording of Article 8(1)(a) EUTMR clearly requires identity between **both** the signs concerned **and** the goods/services in question. This situation is referred to as ‘double identity’. Whether there is double identity is a **legal finding** to be established from a direct comparison of the two conflicting signs and the goods/services in question ⁽³⁵⁾. Where double identity is established, the opponent is not required to demonstrate a likelihood of confusion in order to prevail; the protection conferred by Article 8(1)(a) EUTMR is absolute. Consequently, where there is double identity, there is no need to carry out an evaluation of the likelihood of confusion, and the opposition will automatically be upheld.

2.2 Article 8(1)(b) EUTMR — likelihood of confusion

Article 8(1)(b) EUTMR states that, upon opposition, an EUTM application will not be registered:

... if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks **there exists a likelihood of confusion** on the part of the public in the territory in which the earlier

³⁴ Further guidance on earlier well-known trade marks is found in the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

³⁵ Comprehensive guidance on the criteria to find identity between goods and services and between signs can be found in the respective paragraphs of the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services, and Chapter 4, Comparison of Signs.

trade mark is protected; the **likelihood of confusion includes the likelihood of association** with the earlier trade mark (emphasis added).

Hence, in contrast to situations of double identity as seen above, in cases of mere similarity between the signs and the goods/services, or identity of only one of these two factors, an earlier trade mark may successfully oppose an EUTM application under Article 8(1)(b) EUTMR **only if** there is a likelihood of confusion.

2.3 Interrelation of Article 8(1)(a) and (b) EUTMR

Although the specific conditions under Article 8(1)(a) and (b) EUTMR differ, they are related. Consequently, in oppositions dealing with Article 8(1) EUTMR, if Article 8(1)(a) EUTMR is the only ground claimed but identity between the signs and/or the goods/services cannot be established, the Office will still examine the case under Article 8(1)(b) EUTMR, which requires at least similarity between signs and goods/services and a likelihood of confusion. Similarity covers situations where both marks and goods/services are similar and also situations where the marks are identical and the goods/services are similar or vice versa.

Likewise, an opposition based only on Article 8(1)(b) EUTMR that meets the requirements of Article 8(1)(a) EUTMR will be dealt with under the latter provision without any examination under Article 8(1)(b) EUTMR.

3 The Notion of Likelihood of Confusion

3.1 Introduction

The assessment of the likelihood of confusion is a calculus applied in situations of conflict between trade marks in proceedings before the Office, the General Court and the Court of Justice as well as in infringement proceedings before the courts of the Member States. However, neither the EUTMR nor Directive 2015/2436 ⁽³⁶⁾ contains a definition of likelihood of confusion or a statement as to precisely what ‘confusion’ refers to.

As shown below, it has been settled case-law for some time now that, fundamentally, the concept of likelihood of confusion refers to situations where:

1. the public directly confuses the conflicting trade marks, that is to say, mistakes one for the other;
2. the public makes a connection between the conflicting trade marks and assumes that the goods/services in question are from the same or economically linked undertakings (likelihood of association).

³⁶ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

These two situations are further discussed below (see paragraph 3.2 below). The mere fact that the perception of a later trade mark brings to mind an earlier trade mark does not constitute a likelihood of confusion.

The Court has also established the principle that ‘marks with a highly distinctive character enjoy broader protection than marks with a less distinctive character’ (see paragraph 3.3 below).

Finally, the concept of likelihood of confusion as developed by the Court must be regarded as a legal concept rather than purely an empirical or factual assessment despite the fact that its analysis requires taking into account certain aspects of consumer cognitive behaviour and purchasing habits (see paragraph 3.4 below).

3.2 Likelihood of confusion and likelihood of association

The Court considered likelihood of confusion comprehensively in *Sabèl* (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528). The Directives’ equivalents⁽³⁷⁾ of Article 8(1)(b) EUTMR and the recitals of the EUTMR clearly indicated that likelihood of confusion relates to confusion about the origin of goods/services, but the Court was required to consider what precisely this meant because there were opposing views on the meaning of, and the relationship between, ‘likelihood of confusion’ and ‘likelihood of association’, both of which are referred to in Article 8(1)(b) EUTMR.

This issue needed to be resolved because it was argued that likelihood of association was broader than likelihood of confusion as it could cover instances where a later trade mark brought an earlier trade mark to mind but the consumer did not consider that the goods/services had the same commercial origin⁽³⁸⁾. Ultimately, the issue in *Sabèl* was whether the wording ‘the likelihood of confusion includes the likelihood of association’ meant that ‘likelihood of confusion’ could cover a situation of association between trade marks that did not give rise to confusion as to origin.

The Court found that likelihood of association **is not an alternative** to likelihood of confusion, but that it merely serves to define its scope. Therefore, a finding of likelihood of confusion requires that there be confusion as to origin.

In *Canon* (paras 29-30), the Court clarified the scope of confusion as to origin when it held that:

... the risk that the public might believe that the goods and services in question come from the **same undertaking or, as the case may be, from economically linked undertakings**, constitutes a likelihood of confusion ... there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically linked undertakings (emphasis added).

As seen above, likelihood of confusion relates to confusion as to commercial origin including economically linked undertakings. What matters is that the public believes

³⁷ Articles 4 and 5 of Directive 2008/95/EC and Articles 5 and 10 of Directive 2015/2436.

³⁸ The concept came from Benelux case-law and applied, inter alia, to non-reputed marks.

that the **control** of the goods or services in question is in the hands of a single undertaking. The Court has not interpreted **economically linked undertakings** in the context of likelihood of confusion, but it has done so with respect to the free movement of goods/services. In *Ideal Standard* the Court held:

... A number of situations are covered: products put into circulation by the same undertaking, by a licensee, by a parent company, by a subsidiary of the same group, or by an exclusive distributor.

... In all the cases mentioned, control [is] in the hands of a single body: the group of companies in the case of products put into circulation by a subsidiary; the manufacturer in the case of products marketed by the distributor; the licensor in the case of products marketed by a licensee. In the case of a licence, the licensor can control the quality of the licensee's products by including in the contract clauses requiring the licensee to comply with his instructions and giving him the possibility of verifying such compliance. The origin that the trade mark is intended to guarantee is the same: it is not defined by reference to the manufacturer but by reference to the point of control of manufacture.

(22/06/1994, C-9/93, *Ideal Standard*, EU:C:1994:261, § 34, 37).

Consequently, economic links will be presumed where the consumer assumes that the respective goods or services are marketed under the control of the trade mark proprietor. Such control can be assumed to exist in the case of enterprises belonging to the same group of companies and in the case of licensing, merchandising or distribution arrangements as well as in any other situation where the consumer assumes that the use of the trade mark is normally possible only with the agreement of the trade mark proprietor.

Therefore, the likelihood of confusion covers situations where:

1. the consumer directly confuses the trade marks themselves; or where
2. the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

Hence, if the perception of a later trade mark merely brings to mind an earlier trade mark, but the consumer does not assume the same commercial origin, then this link does not constitute a likelihood of confusion despite the existence of a similarity between the signs ⁽³⁹⁾.

3.3 Likelihood of confusion and distinctiveness of the earlier mark

The distinctiveness of the earlier trade mark has been held by the Court to be an important consideration when assessing the likelihood of confusion, since:

- the more distinctive the earlier trade mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 24);

³⁹ Although such a situation could take unfair advantage of, or be detrimental to, the distinctive character or the reputation of an earlier mark under Article 8(5) EUTMR, see the Guidelines Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

- trade marks with a highly distinctive character enjoy broader protection than trade marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18);
- however, the scope of protection of trade marks with low distinctive character will be narrower.

One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22). When the distinctiveness of the earlier trade mark is low, this may be a factor weighing against the likelihood of confusion.

3.4 Likelihood of confusion: questions of fact and questions of law

The concept of likelihood of confusion is a legal concept rather than a mere factual evaluation of the rational judgments and emotional preferences that inform the consumer's cognitive behaviour and purchasing habits. Therefore, assessment of the likelihood of confusion depends on both legal questions **and** facts.

3.4.1 Fact and law — similarity of goods/services and of signs

Determining the relevant factors for establishing a likelihood of confusion and whether they exist is a question of law, that is to say, these factors are established by the relevant legislation, namely, the EUTMR and case-law.

For instance, Article 8(1) EUTMR establishes that the identity/similarity of goods/services is a condition for a likelihood of confusion. The identification of the relevant factors for evaluating whether this condition is met is also a question of law.

The Court has identified the following factors for determining whether goods/services are similar:

- their nature,
- their intended purpose,
- their method of use,
- whether they are complementary or not,
- whether they are in competition or interchangeable,
- their distribution channels/points of sale,
- their relevant public,
- their usual origin.

(29/09/1998, C-39/97, Canon, EU:C:1998:442).

All these factors are legal concepts and determining the criteria to evaluate them is also a **question of law**. However, it is a **question of fact** whether, and to what degree, the legal criteria for determining, for instance, 'nature', are fulfilled in a particular case.

By way of example, *cooking fat* does not have the same nature as *petroleum lubricating oils and greases* even though both contain a fat base. *Cooking fat* is used in preparing food for human consumption, whereas *oils and greases* are used for lubricating machines. Considering ‘nature’ to be a relevant factor in the analysis of similarity of goods/services is a matter of **law**. However, it is a matter of **fact** to state that cooking fat is used in preparing food for human consumption and that oils and greases are used for machines.

Similarly, when it comes to the comparison of signs, Article 8(1) EUTMR establishes that the identity/similarity of signs is a condition for a likelihood of confusion. It is a **question of law** that a conceptual coincidence between signs may render them similar for the purposes of the EUTMR, but it is a **question of fact**, for instance, that the word ‘fghryz’ does not have any meaning for the Spanish public.

3.4.2 Fact and law — evidence

In opposition proceedings, the parties must allege and, where necessary, prove the facts in support of their arguments. This follows from Article 95(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

Therefore, it is up to the opponent to state the facts on which the claim of similarity is based and to submit supporting evidence. For instance, where *wear-resistant cast iron* is to be compared with *medical implants*, it is not up to the Office to answer the question of whether *wear-resistant cast iron* is actually used for *medical implants*. This must be demonstrated by the opponent as it seems improbable (14/05/2002, R 684/2000-4, Tinox / TINOX).

An admission by the applicant of legal concepts is irrelevant. It does not discharge the Office from analysing and deciding on these concepts. This is not contrary to Article 95(1) EUTMR, which is binding on the Office **only** as regards the facts, evidence and arguments and does not extend to the legal evaluation of the same. Therefore, the parties may agree as to which facts have been proven or not, but they may not determine whether or not these facts are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the signs, and likelihood of confusion.

Article 95(1) EUTMR does not prevent the Office from taking into consideration, on its own initiative, facts that are already notorious or well known or that may be learnt from generally accessible sources, for example, that PICASSO will be recognised by EU consumers as a famous Spanish painter (22/06/2004, T-185/02, Picaro, EU:T:2004:189; 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25). However, the Office cannot quote *ex officio* new facts or arguments (e.g. reputation or degree of knowledge of the earlier mark).

Moreover, even though certain trade marks are sometimes used in daily life as generic terms for the goods and services that they cover, this should never be taken as fact by the Office. In other words, trade marks should never be referred to (or interpreted) as if they were a generic term or a category of goods or services. For instance, the fact that

in daily life part of the public refers to 'X' when talking about *yoghurts* ('X' being a trade mark for *yoghurts*) should not lead to using 'X' as a generic term for *yoghurts*.

4 Evaluation of the Relevant Factors for Establishing a Likelihood of Confusion

4.1 Relevant point in time

The relevant point in time for assessing the likelihood of confusion is the date the opposition decision is taken.

Where the opponent relies on **enhanced distinctiveness** of an earlier trade mark, the conditions for this must have been met on or before the filing date of the EUTM application (or any priority date) and must still be fulfilled at the point in time the decision is taken. Office practice is to assume that this is the case, unless there are indications to the contrary.

Where the EUTM applicant relies on a reduced scope of protection (weakness) of the earlier trade mark, only the date of the decision is relevant.

4.2 List of factors for assessing the likelihood of confusion

The likelihood of confusion is assessed in the following steps, taking into account multiple factors:

- comparison of goods and services;
- relevant public and degree of attention;
- comparison of signs;
- distinctiveness of the earlier mark;
- any other factors;
- global assessment of the likelihood of confusion.

A separate chapter of the Guidelines is dedicated to each of the above factors and its specifics.

Annex

General principles coming from case-law (these are not direct citations).

11/11/1997, C-251/95, Sabèl, EU:C:1997:528

- The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (para. 22).
- The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and on the degree of similarity between the signs and the goods (para. 22).
- The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components (para. 23).
- The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (para. 23).
- The more distinctive the earlier mark, the greater will be the likelihood of confusion (para. 24).
- It is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character (para. 24).
- However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion (para. 25).
- The concept of likelihood of association is not an alternative to likelihood of confusion, but serves to define its scope (para. 18).
- The mere association that the public might make between two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion (para. 26).

29/09/1998, C-39/97, Canon, EU:C:1998:442

- The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion (para. 29).
- By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically linked undertakings) (para. 30).
- In assessing the similarity of the goods and services, all the relevant factors relating to those goods or services themselves should be taken into account (para. 23).
- Those factors include, inter alia, their nature, the purpose for which they are used (the translation 'end users' in the official English language version is not correct) and their method of use, and whether they are in competition with each other or are complementary (para. 23).
- A global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between these goods or services. A lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and vice versa (para. 17).
- Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (para. 18).
- Registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive (para. 19).
- The distinctive character of the earlier mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion (para. 24).
- There may be a likelihood of confusion, even if the public thinks that these goods have different places of production (para. 30).

22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323

- The level of attention of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, varies according to the category of the goods and services in question (para. 26).
- However, account should be taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks and must trust in their imperfect recollection of them (para. 26).
- When evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed (para. 27).
- It is possible that mere aural similarity could lead to a likelihood of confusion (para. 28).
- In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, an overall assessment needs to be made of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking (para. 22).
- In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public who, because of the mark, identifies the goods and services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (para. 23).
- It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character (para. 24).

22/06/2000, C-425/98, Marca, EU:C:2000:339

- The reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense (para. 41).
- Article 5(1)(b) of Directive 2008/95/EC cannot be interpreted as meaning that where:
 - a trade mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public, and
 - a third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services that are identical with, or similar to, those for which the trade mark is registered, a sign that so closely corresponds to the mark as to give the possibility of its being associated with that mark,

the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the possibility of such association giving rise to confusion cannot be ruled out (emphasis added) (para. 42).

06/10/2005, C-120/04, Thomson Life, EU:C:2005:594

- Where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark that has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (para. 37).

Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 2

Comparison of goods and services

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1 Introduction

1.1 Relevance

The comparison of goods and services is primarily of relevance for the assessment of identity according to Article 8(1)(a) EUTMR and likelihood of confusion according to Article 8(1)(b) EUTMR. One of the main conditions for Article 8(1)(a) EUTMR is the identity of goods/services, while Article 8(1)(b) EUTMR requires the identity or similarity of goods/services. Consequently, if all goods/services are found to be dissimilar, one of the conditions contained in Article 8(1) EUTMR is not fulfilled and the opposition must be rejected without addressing the remaining sections of the decision ⁽⁴⁰⁾.

The criteria for the assessment of identity or similarity might also play a role when proof of use has been requested and the evidence has to be assessed in order to conclude whether the opponent has proven use for the goods/services as registered. In particular, it is important to determine whether the goods and services for which the mark has been used belong to the category of goods and services for which the trade mark was registered. This is because, under Article 47(2) EUTMR, proof of use for a product or service that is merely similar to the one registered does not prove use for the registered product or service (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Likewise, evidence of use of goods/services might also be relevant when examining a claim to enhanced distinctiveness. In such cases it is often necessary to examine whether the enhanced distinctiveness covers goods/services for which the earlier trade mark enjoys protection and that are relevant for the specific case, that is to say, that have been considered to be identical or similar to the goods/services of the contested EUTM (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

Furthermore, the outcome of the comparison of goods/services plays an important role in defining the part of the public for whom likelihood of confusion is analysed because the relevant public is that of the goods/services found to be identical or similar (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The comparison of goods/services may also be relevant under Article 8(3) EUTMR, which requires the identity or close relation or equivalence in commercial terms of goods/services (see the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR)), and under the applicable provisions of national law under Article 8(4) EUTMR, since identity or similarity of the goods/services is often a condition under which the use of a subsequent trade mark may be prohibited (see the Guidelines, Part C, Opposition, Section 4, Rights under

⁴⁰ Equally, the comparison of goods and services is of relevance in invalidity proceedings, since pursuant to Article 60(1)(a) EUTMR, a registered European Union trade mark is declared invalid where the conditions set out in Article 8(1) EUTMR are fulfilled.

Article 8(4) and 8(6) EUTMR). Furthermore, under Article 8(5) EUTMR, the degree of similarity or dissimilarity between the goods/services is a factor that must be taken into account when establishing whether or not the consumer will perceive a link between the marks. For example, the goods/services may be so manifestly dissimilar that use of the later mark on the contested goods/services is unlikely to bring the earlier mark to the mind of the relevant public (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)).

1.2 Nice Classification: a starting point

Article 33(1) EUTMR requires that the goods/services to be compared are classified according to the Nice Classification. Currently the Nice Classification consists of 34 classes (1-34) for categorising goods and 11 classes (35-45) for categorising services.

1.2.1 Its nature as a classification tool

The Nice Classification was set up with the aim of harmonising national classification practices. Its first edition entered into force in 1961. Although it has undergone several revisions, it sometimes lags behind the rapid changes in product developments in the markets. Furthermore, the wording of the headings is at times unclear and imprecise.

The Nice Classification serves purely administrative purposes and, as such, does not in itself provide a basis for drawing conclusions as to the similarity of goods and services.

According to Article 33(7) EUTMR, the fact that goods/services are listed in the same class of the Nice Classification is not, in itself, an indication of similarity.

Examples

- *Live animals* are dissimilar to *flowers* (Class 31).
- *Advertising* is dissimilar to *office functions* (Class 35).

The fact that two specific goods/services fall under the same general indication of a class heading does not per se make them similar, let alone identical: *cars* and *bicycles* — although both fall under *vehicles* in Class 12 — are considered dissimilar.

Furthermore, goods/services listed in different classes are not necessarily considered dissimilar (16/12/2008, T-259/06, Manso de Velasco, EU:T:2008:575, § 30-31).

Examples

- *Meat extracts* (Class 29) are similar to *spices* (Class 30).
- *Travel arrangement* (Class 39) is similar to *providing temporary accommodation* (Class 43).

1.2.2 Its structure and methodology

Classification may serve as a tool to identify the common characteristics of certain goods/services.

Many classes of the Nice Classification are structured according to factors such as function, composition and/or purpose of use, which may be relevant in the comparison of goods/services. For example:

- Class 1 comprises chemical goods based primarily on their chemical properties (nature), rather than on their specific application. By contrast, Class 3 covers all items that are either cleaning preparations or for personal hygiene or beautification. Although they can by their nature also be classified as chemical products, it is their specific purpose that allows a distinction and thus a different classification.
- Equally, it is because of their nature that most items made of leather are classified in Class 18, whereas clothing made of leather falls under Class 25 since it serves a very specific purpose, namely that of being worn by people and as protection from the elements.

1.2.3 Conclusions to be drawn from the structure of the Nice Classification

The structure of the class headings is not uniform and does not follow the same logic. Some classes consist of only one general indication that by definition already covers nearly all the goods/services included in this class (Class 15 *musical instruments*; Class 38 *telecommunications*). Others include many general indications — some very broad and others very specific. For example, the heading of Class 9 includes more than 30 terms, ranging from *scientific apparatus and instruments* to *fire-extinguishing apparatus*.

Exceptionally, there are class headings containing general indications that include another general indication and are thus identical.

Example: *materials for dressing* in Class 5 include *plasters* in Class 5.

Other specific indications in a class heading are only mentioned to clarify that they do not belong to another class.

Example: *adhesives used in industry* are included in *chemicals used in industry* in Class 1. Its mention is mainly thought to distinguish them from *adhesives* classified in Class 16, which are for stationery or household purposes.

To conclude, the Nice Classification gives indications that can be used in the assessment of identity or similarity of goods/services. However, its structure and content is not consistent. Therefore, each heading or specific term has to be analysed according to the specific class under which it is classified. As stated before, the Nice Classification mainly serves to categorise goods/services for administrative purposes and is not decisive for their comparison.

1.2.4 Changes in the classification of goods/services

Normally, each revision of the Nice Classification brings changes in the classification of goods/services (in particular transfers of goods/services between various classes) or in the wording of headings. In such cases the list of goods/services of both the earlier and

the contested mark must be interpreted according to the edition of the Nice Classification in force at the time of filing.

Example

- *Legal services* were transferred from Class 42 to Class 45 with the 8th edition of the Nice Classification. The nature of these services has not changed.
- *Vending machines* were transferred from Class 9 to Class 7 in the 10th edition of the Nice Classification, since a vending machine is basically a powered machine and as such was considered more appropriately classified in Class 7 with other machinery. However, since the nature of these goods has not changed, *vending machines* classified in different classes due to the different filing dates of the respective applications are regarded as identical.

1.3 The Similarity Tool (EUIPN) for the comparison of goods/ services

The [Similarity Tool](#) for the comparison of goods and services is a search tool to help and support examiners in assessing the similarity of goods and services. The Similarity Tool serves to harmonise practice on the assessment of similarity of goods and services and to guarantee the coherence of decisions. The Similarity Tool must be followed by examiners.

The Similarity Tool is based on comparing specific pairs of goods and services. A 'pair' compares two 'terms'. A 'term' consists of a class number from the Nice Classification (1-45) and a textual element, that is to say, a specific product or service (including general categories of goods and services, such as *clothing* or *education*). There are five possible results of the search: identity, high degree of similarity, similarity, low degree of similarity and dissimilarity. For each of the degrees of similarity, the tool indicates which criteria lead to each result.

The Similarity Tool is constantly updated and revised as necessary in order to create a comprehensive and reliable source of reference.

Since the tool gives, or will give, answers to specific comparisons, the Guidelines concentrate on defining the general principles and their application in practice.

1.4 Definition of goods and services (terminology)

1.4.1 Goods

The EUTMR does not give a definition of goods and services. Although the Nice Classification gives some general explanations to this effect in its introductory remarks, it refrains from clearly setting criteria for the distinction between goods and services.

In principle, the word 'goods' refers to any kind of item that may be traded. Goods comprise raw materials (unprocessed plastics in Class 1), semi-finished products

(plastics in extruded form for use in manufacture in Class 17) and finished products (plastic household containers in Class 21). They include natural and manufactured goods, such as agricultural products in Class 31 and machines and machine tools in Class 7.

However, sometimes it is not clear whether goods comprise only tangible physical products as opposed to services, which are intangible. The definition and thus the scope of protection are particularly relevant when it comes to ‘goods’, such as *electricity*, that are intangible. This question is already answered during the examination on classification and will not usually cause any problems in the comparison of goods and services.

1.4.2 Services

A service is any activity or benefit that one party can offer to another that is intangible and does not result in the transfer of ownership of any physical object. In contrast to goods, a service is **always** intangible.

Importantly, services comprise economic activities provided to **third parties**.

- Advertising one’s own goods is not a service but running an advertising agency (designing advertising campaigns for third parties) is. Similarly *shop window dressing* is only a service when provided for third parties, not when done in one’s own shop.
- Selling, storing or distributing one’s own goods is not a service. Retail services are meant to cover the services around the actual sale of goods, such as providing the customer with an opportunity to conveniently see, compare or test the goods. For more detailed information, see Annex II, paragraph 5.7, Retail Services.

One indication for an activity to be considered a service under trade mark law is its independent economic value, that is to say, it is usually provided in exchange for some form of (monetary) compensation. Otherwise, it could be a mere ancillary activity provided together with or after the purchase of a specific product.

Example

- Delivery, including the transport of furniture that has previously been purchased (either in a physical establishment or online), is not an independent service falling under *transport services* in Class 39.

However, the intention to make profit is not necessarily a criterion for defining whether an activity can qualify as a ‘service’ (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 16-18). It is more a question of whether the service has an independent market area and targeted public rather than the way or form in which compensation is made for it.

1.4.3 Products

In common parlance the term ‘products’ is used for both goods and services, for example, ‘financial products’ instead of financial services. Whether terms in common

parlance are described as 'products' is immaterial to them being classified as goods/services.

1.5 Determining the goods/services

1.5.1 Correct wording

As a preliminary, the correct wording of the lists of goods/services under consideration must be identified.

1.5.1.1 European Union trade marks

An application for an EUTM will be published in all the official languages of the European Union (Article 147(1) EUTMR). Likewise, all entries in the Register of European Union trade marks (the Register) will be in all these languages (Article 147(2) EUTMR). Both applications and entries in the Register are published in the EUTM Bulletin (Article 116(1)(a) and Article 116(2) EUTMR).

In practice, occasional discrepancies may be found between:

- the translation of the wording of the list of goods/services of an EUTM (application or registration) published in the EUTM Bulletin, and
- the original wording as filed.

In cases of such discrepancy, the definitive version of the list of goods and services is:

- the text in the first language, if the first language is one of the five languages of the Office.
- the text in the second language indicated by the applicant (Article 147(3) EUTMR), if the first language of the application is not one of the five languages of the Office.

This applies regardless of whether the EUTM (or EUTM application) is the earlier right or the contested application.

Where an incorrect translation of the list of goods and services is detected in an EUTM application that prevents the Office from carrying out a comparison of the goods and services, the list will either be sent for translation again or, in clear-cut cases, changed directly in the Register. The Office will take its decisions on the basis of the correct translation. Where an incorrect translation is detected in a registered EUTM, the Office will explain which language version of the goods and services is the definitive version for the purposes of the comparison. See also in this respect the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraph 7.1.2, Correction of mistakes and errors in publications.

1.5.1.2 Earlier national marks and international registrations

The list of goods and services of the earlier marks on which the opposition is based must be submitted in the language of the opposition proceedings (Article 7(4))

EUTMDR). The Office does not require any certified translation; it accepts simple translations, drawn up by the opponent or its representative. The Office normally does not exercise the option available under Article 26 EUTMIR of requiring the translation to be certified by a sworn or official translator. Where the representative adds a declaration that the translation is true to the original, the Office will in principle not question this. The other party may, however, question the correctness of the translation during the adversarial part of the proceedings. (See the Guidelines, Part C, Opposition, Section 1, Opposition proceedings.)

For international registrations under the Madrid Agreement or Protocol, the language in which the international registration was registered is definitive (French, English or Spanish). However, where the language of the opposition procedure is not the language of the international registration, a translation must be supplied, as for earlier national marks.

Where a clearly incorrect translation is detected in the list of goods and services covered by the earlier national or international mark that prevents the Office from carrying out a comparison of goods and services, the opponent may be required under Article 26 EUTMIR to submit a certificate from a sworn or official translator confirming that the translation corresponds to the original. Alternatively, in clear-cut cases, the Office may, for the purposes of the decision, replace a clearly incorrect translation of a certain term by a correct translation, adding an explanation to that effect. For example, where the term ‘bars’ in Class 43 is translated as *barras de cereales* (cereal bars), it is a clearly incorrect translation as this term could never fall within Class 43.

1.5.2 Scope of goods/services in comparison

Comparison of the goods and services must be based on the wording indicated in the respective lists of goods/services. Any actual or intended use not stipulated in the list of goods/services is not relevant for this comparison since it is part of the assessment of likelihood of confusion in relation to the goods/services on which the opposition is based and against which it is directed; it is not an assessment of actual confusion or infringement (16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 71).

However, if proof of use of the earlier mark is validly requested and the submitted evidence is sufficient for only part of the goods/services listed, the earlier mark is deemed to be registered for only those goods/services (Article 47(2) EUTMR); consequently, the examination is restricted to those goods/services (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Moreover, in the case of the earlier mark, only the goods and services on which the opposition is validly based are pertinent. Hence, no account will be taken of goods/services:

- that cannot be taken into account for reasons of admissibility;
- that have not been properly substantiated (e.g. only a partial translation of the list of goods/services was filed); or
- on which the opposition is not, or is no longer, based.

Similarly, only those goods and services of the contested application against which the opposition is directed are taken into consideration. Consequently, restrictions applied during the proceedings to either the list of goods/services of the application or the goods/services on which the opposition is based, or both, will limit the goods and services to be compared.

Furthermore, an analysis of the wording of the list of goods/services might be required to determine the scope of protection of those goods and services. This is especially true where terms such as **in particular**, **namely**, or equivalents are used in order to show the relationship of an individual product with a broader category.

The term **in particular** (or **for example**, **such as**, **including** or other equivalent) indicates that the specific goods/services are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of **in particular**, see the reference in 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

However, the term **namely** (or **exclusively** or other equivalent) is exclusive and restricts the scope of the registration to only the specifically listed goods.

For example, in the case of *chemicals used in industry, namely raw materials for plastics* only the *raw materials for plastics* need to be compared with the goods of the other mark.

The use of commas in the list of goods/services serves to separate items within the same or a similar category. The use of a semicolon means a separation between terms. The separation of terms by different punctuation can lead to changes in their meaning and may lead to a different assessment when comparing the goods/services. For more information on punctuation in lists of goods and services, see the Guidelines, Part B, Examination, Section 3, Classification.

For example, in *computer software for use with industrial machines; fire extinguishers* in Class 9, the inclusion of a semicolon means that the term *fire extinguishers* must be considered as an independent category of goods, regardless of whether the intention was to protect computer software to be used in the field of industrial machines and fire extinguishers.

1.5.2.1 Meaning of terms in list of goods/services

Once the wording of the goods/services to be considered has been identified, its meaning must be determined.

In some cases, the exact meaning is immediately obvious from the list of goods/services, where a more or less detailed description of the goods/services is generally given. For example, the wording *belts, being articles of clothing* excludes by definition safety and industrial belts.

In case of doubt about the exact meaning of the terms used in the list of goods/services, the terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective. Therefore, *belts* in Class 25 are, owing to their classification, *articles of clothing*.

Where the meanings of terms in a semantic context, a commercial context and/or under the Nice Classification are ambiguous or give rise to doubt, the meaning under the Nice Classification prevails.

Clothing, for instance, refers to ‘clothes collectively’ (*Oxford Dictionaries* online edition) and thus to items worn to cover the body, such as shirts, dresses, trousers, etc. Although the definition found in standard dictionaries does not explicitly exclude *footwear*, the fact that the latter appears in the Nice Classification as a separate item in the same class (Class 25) leads to the conclusion that *clothing* and *footwear* are not identical but similar (13/07/2004, T-115/02, ‘a’ in a black ellipse, EU:T:2004:234, § 26).

However, this does not mean that two general indications in one class heading can never be considered identical. As mentioned above, the structure of the class headings is not uniform. Some general indications included in the class headings may encompass others.

Example

- *Meat* and *poultry* (Class 29) are identical.

1.5.2.2 Unclear and imprecise terms

An analysis of the wording of the list of goods/services is also required where the wording or term used is **not sufficiently clear and precise** to enable the competent authorities and economic operators to determine, on that sole basis, the scope of protection given to the mark. This is the case where the wording or term used is too general and covers goods/services that are too variable to be compatible with the trade mark’s function as an indication of origin (19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54). This means that it is not possible to infer with a reasonable degree of certainty which specific goods/services are actually covered, as the wording or general term does not, in itself, sufficiently reveal the commercial nature and attributes of the goods/services to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin.

In such cases the Office will first verify whether goods/services are considered to be unclear or imprecise due to an incorrect translation of the original list. If so, the Office will take different steps depending on whether the unclear or imprecise term is contained in the specification of the EUTM (regardless of whether the EUTM (or EUTM application) is the earlier right or the contested application) or of the national or international mark on which the opposition is based. The provisions contained in paragraphs 1.5.1.1 and 1.5.1.2 apply.

If the lack of clarity and precision is not the result of an incorrect translation but the term is unclear or imprecise in itself and does not sufficiently reveal the commercial nature and attributes of the goods/services to be covered, and if there is no limitation (or partial surrender) enabling the Office to clearly determine the exact scope of protection, different steps must be taken, depending on whether the unclear or

imprecise term is contained in the earlier mark or the contested mark (see paragraphs 1.5.2.2.1 and 1.5.2.2.2 respectively).

The general indications from the Nice Class Headings and other examples of terms and expressions lacking clarity and precision can be found in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7. General indications considered to lack the necessary clarity and precision have been identified by the Office in conjunction with the national offices of the European Union (see European Trade Mark and Design Network, Common Communication on the Common Practice on the General Indications of the Nice Class Headings v1.1, 20/02/2014). Furthermore, the requirement of clarity and precision of the specification of goods and services has been clarified in case-law interpreting the Harmonisation Directive (07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 49, 51; 19/06/2012; C-307/10, IP Translator, EU:C:2012:361, § 38-49). Consequently, even if the earlier mark is a national (or Benelux or international) registration, it is within the Office's competence to interpret its scope of protection in relative grounds proceedings before the Office. As such, when the Office concludes that a particular term covered by an earlier national mark does not meet the requirement of clarity and precision, it will apply the necessary consequences accordingly, as set out in paragraph 1.5.2.2.1.

In any event, it is in the interests of trade mark holders (applicants or owners) to clarify unclear or imprecise terms and thus precisely determine the scope of protection; they can do this through explicit restriction or partial surrender. See also the Guidelines, Part B, Examination, Section 3, Classification, paragraphs 5.3.1 – 5.3.3.

1.5.2.2.1 Unclear or imprecise term(s) in list of goods/services covered by earlier mark

Unclear or imprecise terms in the earlier mark may not be excluded from the outset in the comparison of goods and services simply by invoking a lack of clarity and precision (04/03/2020, Joined Cases C-155/18 P – C-158/18 P, BURLINGTON / BURLINGTON ARCADE, EU:C:2020:151, § 134). However, these terms can only be taken into account in their most natural and literal sense. Unclear or imprecise terms may not be construed as constituting a claim to goods/services that cannot be covered by this meaning without further specification. As a result, unless the same (or a synonymous) unclear and imprecise term is used in the specification of both marks (see paragraph 2.1), lack of clarity and precision of wording is not a sufficient basis in itself for arguing in support of identity or similarity where the Office is unable to clearly determine the exact scope of protection of unclear or imprecise terms. Nor may an unclear or imprecise term be interpreted in relation or by reference to other goods/services within the same class or different classes.

Consequently, while unclear or imprecise terms in the earlier mark will be compared with the contested goods/services, taking into account the similarity factors (as specified in detail in paragraphs 3.1 to 3.3), no similarity can be found when the natural and literal meaning of an unclear or imprecise term cannot be understood to lead to a coincidence in relevant similarity factors with the contested goods/services.

For example, while the unclear and imprecise term *machines* can be understood in its natural meaning as ‘equipment which uses electricity or an engine in order to do a particular kind of work’ (*Collins English Dictionary*), this abstract meaning does not sufficiently reveal its specific commercial nature, that is to say what machines or types of machines are meant to be covered. Machines can have different characteristics or different purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers and be sold through different sales channels, and therefore relate to different market sectors.

As a result, when comparing the unclear and imprecise term *machines* with, for example, *dual combustion machines for use in agriculture*, the lack of clarity and precision of the first term cannot be used on its own for arguing identity or similarity; nor can the term be construed as relating to ‘dual combustion’ machines or to machines ‘for use in agriculture’ when such qualities or methods of use have not been expressly identified in the specification and cannot be understood from its natural and literal meaning. It follows that, while the terms may be compared and be considered to have the same abstract nature insofar as they are machines, they cannot, on the basis of the insufficient information and facts provided by the imprecise specification of the earlier mark, be considered to have the same purpose or methods of use, or to be complementary to each other or in competition. Furthermore, they cannot be considered to target the same relevant public, share the same distribution channels or be usually produced by the same undertakings. Consequently, unless the unclear and imprecise term *machines* is further specified, the goods cannot be considered either identical or similar.

However, if an unclear or imprecise term is followed by another term that expressly identifies goods/services by way of an example (e.g. *machines, in particular agricultural machines* or *repair services, in particular vehicle repair*), a comparison may also be made between that specific term (*agricultural machines* or *vehicle repair*) and the goods/services of the contested mark (25/06/2020, T-114/19, B (fig.) / b (fig.), EU:T:2020:286, § 51, 53). This could lead to coincidence in relevant similarity factors between that specific term and the contested goods/services.

Unclear or imprecise terms in the earlier mark can also be clarified by means of a partial surrender by the trade mark proprietor, which would facilitate comparison with the goods/services of the contested mark, and might lead to identity or similarity being found between the goods/services under comparison, based on the relevant criteria as specified in paragraphs 3.1 to 3.3. If the earlier mark is a European Union trade mark registration, (partial) surrender is governed by the rules set out in Article 57 EUTMR. For national marks, a partial surrender should be filed with the corresponding authority, which will be responsible for determining whether it can be accepted.

Furthermore, if an earlier mark that contains an unclear or imprecise term is subject to proof of use, and proof of use is requested in accordance with Article 47(2) – and (3) – EUTMR, the evidence submitted establishing genuine use of the mark in relation to specific goods/services may also clarify the scope of goods/services covered by an otherwise unclear and imprecise term (29/01/2020, C-371/18, SKY, EU:C:2020:45, § 70). In such circumstances, a comparison will be made on the basis of the specified

scope of goods/services for which genuine use has been proven. See also the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 2.8.4.1.

1.5.2.2.2 Unclear or imprecise term(s) in list of goods/services covered by contested mark

As set out in Article 33(2) EUTMR, the EUTM applicant must identify the goods and services for which trade mark protection is sought with sufficient clarity and precision. According to Article 193(1) EUTMR, this applies equally to the holder of an international registration designating the European Union.

Therefore, unless the same (or a synonymous) unclear and imprecise term is used in the specification of both marks (see paragraph 2.1), the Office will, where the contested mark contains an unclear or imprecise term, reopen examination of the classification of the mark under Article 33 EUTMR (or where applicable under Article 193 EUTMR and if possible) and suspend the opposition proceedings accordingly (27/02/2014, T-229/12, *Vogue*, EU:T:2014:95, § 55). See also the Guidelines, Part B, Examination, Section 3, Classification, paragraph 5.5.

The applicant may at any time clarify an unclear or imprecise term by restricting the list of goods/services contained in the application, as long as the ensuing specification is sufficiently clear and precise and does not extend the scope of protection (Article 49 EUTMR). The holder of an international registration designating the European Union may also restrict the list of goods/ services in accordance with Article 9*bis*(iii) of the Madrid Protocol; the restricted list will then be examined in the same way as one for an EUTM application. See also the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.2 and the Guidelines, Part M, International Marks, paragraph 3.8.

1.6 Objective approach

The comparison of the goods/services in question must be made **without** taking into account the degree of similarity of the conflicting signs or the distinctiveness of the earlier mark. It is only in the overall assessment of a decision that the examiners will take into account all the relevant factors.

The classification of the goods/services is not conclusive, because similar goods/services may be classified in different classes, whereas dissimilar goods/services may fall within the same class.

Identity or similarity of the goods/services in question must be determined on an objective basis.

It is necessary to base the findings on the realities of the marketplace, such as established customs in the relevant field of industry or commerce. These customs, especially trade practices, are dynamic and constantly changing. For instance, mobile phones nowadays combine many functions, such as being communication tools as well as photographic apparatus.

The degree of similarity of the goods and services is a matter of law, which must be assessed *ex officio* by the Office even if the parties do not comment on it (16/01/2007, T-53/05, Calvo, EU:T:2007:7, § 59). However, the Office's *ex officio* examination is restricted to well-known facts, that is to say, 'facts which are likely to be known by anyone or which may be learned from generally accessible sources', which excludes facts of a highly technical nature (03/07/2013, T-106/12, Alpharen, EU:T:2013:340, § 51). Consequently, what does not follow from the evidence/arguments submitted by the parties or is not commonly known should not be speculated on or extensively investigated *ex officio* (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 31-32). This follows from Article 95(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. (See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 1, General Principles).

1.7 Statement of reasons

The examiner is required to state reasons for the outcome of the comparison (identity, similarity or dissimilarity) for each of the individual goods and services specified in the application for registration. However, the examiner may use only general reasoning for groups of the goods/services concerned as long as the goods/services present analogous characteristics (see, by analogy, 18/03/2010, C-282/09 P, P@yweb card / Payweb card, EU:C:2010:153, § 37-38; 12/04/2011, T-28/10, Euro automatic Payment, EU:T:2011:158, § 54; 17/10/2013, C-597/12 P, Zebexir, EU:C:2013:672, § 26-27).

2 Identity

2.1 General principles

Identity is generally defined as 'the quality or condition of being the same in substance, composition, nature, properties, or in particular qualities under consideration' (*Oxford Dictionaries* online edition).

Identity exists not only when the goods and services completely coincide (the same terms or synonyms are used), but also when and insofar as the contested mark's goods/services fall within the earlier mark's broader category, or when and insofar as — conversely — a broader term of the contested mark includes the more specific goods/services of the earlier mark. There might also be identity when two broad categories under comparison coincide partially ('overlap'). Hence a distinction can be made between cases of 'full identity' and 'partial identity'.

Identity should not be established on the basis of similarity factors (see paragraph 3.1.1) or on the basis of an unclear and imprecise term in an earlier mark, as it is not possible to infer with a reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by those

terms (see paragraph 1.5.2.2.1 and the list of examples of unclear and imprecise terms in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7). However, where the same (or a synonymous) unclear and imprecise term is used in both marks, such as *machines*, the terms coincide completely and therefore must be considered identical.

2.2 Identical terms or synonyms

Identity between the goods/services in dispute must be established on the basis of the wording of the relevant parts of the lists of goods/services of the two marks that have been identified in accordance with the general principles set out in paragraph 2.1. Identity is obvious where the goods/services to be compared are listed in exactly the same terms.

Example

- *Vehicles* are identical to *vehicles*.

Where this is not the case, the terms of the respective lists of goods/services must be interpreted in order to show that they are in fact synonyms, that is to say, that their meaning is the same. The interpretation can be made based on dictionary definitions, expressions from the Nice Classification and, in particular, by taking into account the commercial perspective.

Examples

- *Bicycle* is a synonym for *bike*. The goods are identical.
- The meaning of the words *smokers' articles* in Class 34 refers to individual objects that are used in close connection with tobacco or tobacco products. In former editions of the Nice Classification these products were called *smokers' requisites*. Therefore, despite a different term used in the current heading, these goods are identical.
- From a commercial perspective, *health spa services* and *wellness services* are the same and are therefore identical.

However, if identical wording is used but the goods are classified in different classes, this generally means that these goods are not identical.

Examples

- *Drills* (machine tools) in Class 7 are not identical to *drills* (hand tools) in Class 8.
- *Lasers* (not for medical treatment) in Class 9 are not identical to *lasers* (for curative purposes) in Class 10.

Even though they might be similar, the classification in different classes indicates that they have a different nature, purpose or method of use, etc.

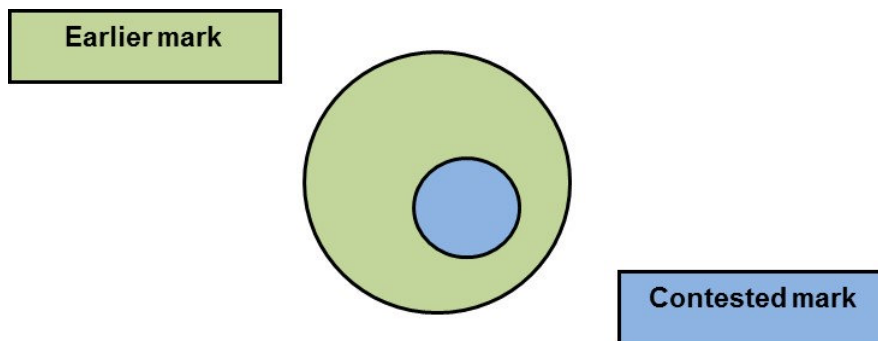
The same reasoning does not apply if the different classification is only due to a revision of the Nice Classification or where it is clear that the goods/services are wrongly 'classified' due to an obvious mistake.

Examples

- *Playing cards* (Class 16 — 7th edition) are identical to *playing cards* (Class 28 — 10th edition).
- *Pharmaceutical preparations* (Class 15) — an obvious typing error — are identical to *pharmaceutical preparations* (Class 5).

2.3 Terms included in the general indication or broad category

2.3.1 The earlier mark includes the goods/services of the contested mark



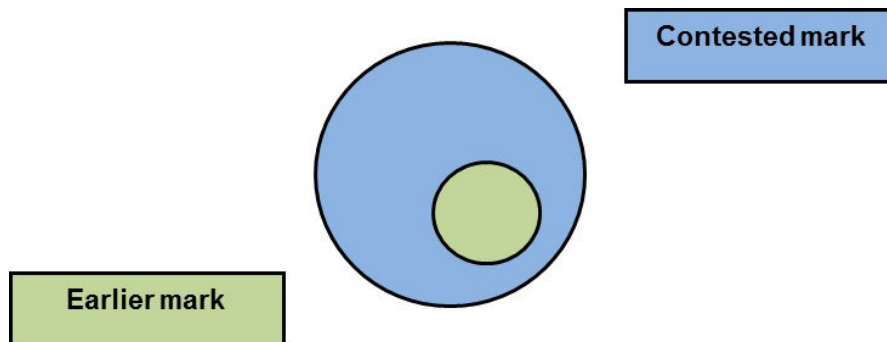
Where the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the contested mark in their entirety, the goods/services will be identical (17/01/2012, T-522/10, Hell, EU:T:2012:9, § 36).

Examples

- *Temporary accommodation* (earlier right, Class 43) includes *youth hostel services* (contested mark, Class 43). Therefore, the services are identical.
- *Pasta* (earlier right, Class 30) includes *spaghetti* (contested mark, Class 30). The conflicting goods are considered identical.

However, the same reasoning cannot apply where the earlier mark contains a general indication or other general term considered to lack the necessary clarity and precision (see the list of examples in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7). It is not possible, on the basis of an unclear and imprecise term, to infer with a reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by the term since the latter does not, in itself, sufficiently reveal the specific commercial nature and attributes of the goods/services that are meant to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin. Therefore, where the earlier mark contains an unclear and imprecise term, it should be interpreted accordingly (see paragraph 1.5.2.2.1).

2.3.2 The contested mark includes the goods/services of the earlier mark



If the goods/services designated in the earlier mark are covered by a general indication or broad category used in the contested mark, these goods/services must be considered identical since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods/services (07/09/2006, T-133/05, Pam-Pim's Baby-Prop, EU:T:2006:247, § 29).

Examples

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (contested mark, Class 25). The goods are considered identical.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The goods are considered identical.

The applicant/holder may, however, restrict the list of goods/services in a way that excludes identity, but could still lead to similarity (24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 22).

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (Class 25). The applicant/holder restricts the specification to *articles of clothing, excluding jeans*. The goods are no longer identical but remain similar.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The applicant/holder restricts the specification to *vehicles, namely automobiles*. The goods are no longer identical or similar.

If the applicant/holder does not restrict the list of goods/services, or does not do so sufficiently, the Office will treat the contested mark's general indication or broad term/category as a single unit and find identity.

If the contested mark covers a general indication or a broad term/category as well as specific items that fall under that general indication or broad term/category, all of these will need to be compared with the specific earlier goods/services. The result of identity found with the general indication or broad term/category does not automatically extend to the specific items.

Example

- The contested mark covers *vehicles* (general indication) as well as *bicycles, aircraft, trains* (included in vehicles). Where the earlier mark is protected for *bicycles*, identity will be found with respect to *vehicles* and to *bicycles* but not for *aircraft or trains*.

However, if the contested mark covers a general indication or broad term/category and specific terms that are not listed independently but only as examples, the comparison differs insofar as only the general indication or broad term/category has to be compared.

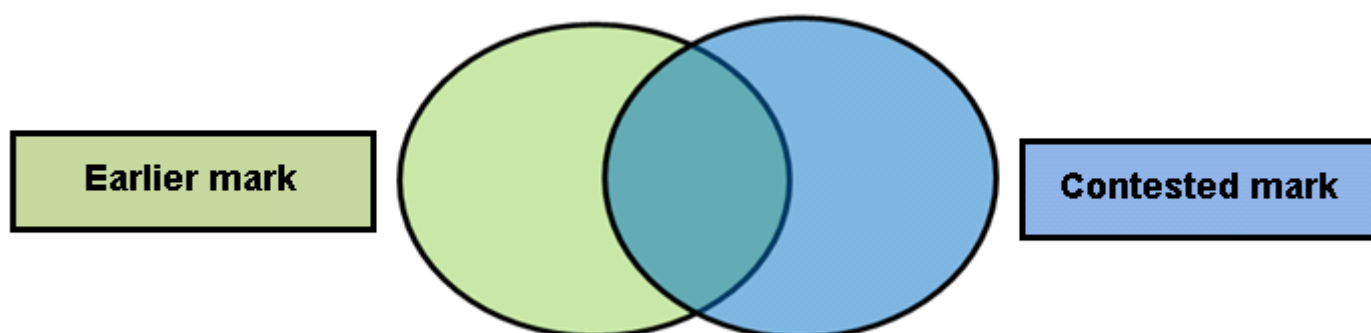
Example

- The contested mark covers *vehicles*, ***in particular bicycles, aircraft, trains***. The earlier mark is protected for *bicycles*. The goods in conflict are considered identical.

The applicant/holder can avoid this result by deleting the general indication *vehicles*, the expression *in particular*, and the specific category *bicycles*.

Where the list of goods/services of the contested mark reads: *vehicles, namely bicycles, aircraft, trains*, the comparison differs insofar as only the specific items have to be compared. In this case only the contested *bicycles* are identical to the earlier goods.

2.4 Overlap



If two categories of goods/services coincide partially ('overlap') there might be identity if:

1. they are classified in the same class; and
2. it is impossible to clearly separate the two goods/services.

Examples

Earlier goods	Contested goods	Coinciding part
<i>Outdoor clothing for women</i> (Class 25)	<i>Clothing made of leather</i> (Class 25)	Outdoor clothing made of leather for women
<i>Components and spare parts for land vehicles</i> (Class 12)	<i>Vehicle seats (*)</i> (Class 12)	Seats for land vehicles
<i>Bread</i> (Class 30)	<i>Long-life bakery products</i> (Class 30)	Long-life bread

<i>Soap</i> (Class 3)	<i>Cleaning preparations</i> (Class 3)	Soaps for cleaning purposes
<i>Scientific instruments</i> (Class 9)	<i>Optical instruments</i> (Class 9)	Scientific optical instruments, e.g. microscopes
<i>Online banking services</i> (Class 36)	<i>Commercial banking services</i> (Class 36)	Online commercial banking services
(*) 09/09/2008, T-363/06, Magic seat, EU:T:2008:319, § 22.		

In such cases, it is impossible for the Office to filter these goods from the abovementioned categories. Since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods, they are considered to be identical.

In the fourth example given above, the outcome changes, of course, if *soap* is limited to *soaps for personal use*. In this case the goods are no longer included in the heading *cleaning preparations* in Class 3 since the latter are only for household use.

Furthermore, where the earlier mark contains a general indication or other general term considered to lack the necessary clarity and precision, no overlap can be found on the basis of that term (see the list of examples in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7). It is not possible to infer with a reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by an unclear and imprecise term, as the latter does not, in itself, sufficiently reveal the specific commercial nature and attributes of the goods/services that are meant to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin. Therefore, where the earlier mark contains an unclear and imprecise term, it should be interpreted accordingly (see paragraph 1.5.2.2.1).

2.5 Practice on the use of general indications of the class headings

According to Article 33(3) EUTMR, the Office does not object to the use of any of the general indications of the class headings provided that this identification is sufficiently clear and precise ⁽⁴¹⁾.

According to Article 33(5) EUTMR, the use of general terms or general indications of the class headings will be interpreted as including all the goods/services clearly covered by the literal meaning of the indication or term. The use of such terms will not be interpreted as comprising a claim to goods/services that cannot be so understood.

In this respect, as regards the general indications of the class headings considered to lack the necessary clarity and precision (see Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7) it is not possible to infer with a

⁴¹ See the 'Common Communication on the Common Practice on the General Indications of the Nice Class Headings'.

reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by those general indications since the latter do not, in themselves, sufficiently reveal the specific commercial nature and attributes of the goods/services that are meant to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin. These specific general indications of the class headings should therefore be interpreted accordingly (see paragraph 1.5.2.2).

Under Article 33(8) EUTMR, during the 6-month period ending on 24/09/2016, proprietors of European Union trade marks filed before 22/06/2012 and registered for the entire heading of a Nice class had the opportunity to declare that their intention at the time of filing had been to cover goods/services going beyond the literal meaning of that class heading, provided that the goods/services declared were included in the alphabetical list for the class of the edition of the Nice Classification in force on the date of filing.

During that 6-month period, Communication of the President No 2/12 of 20/06/2012 remained in force and therefore trade marks filed before 22/06/2012 and registered for an entire class heading were considered to cover the literal meaning of the general indications, as well as the goods and services of the alphabetical list of that class, in the edition of the Nice Classification in force at the time of filing.

According to Article 33(8) EUTMR, last sentence, from the expiry of the 6-month period following the entry into force of the Amending Regulation, all European Union trade marks registered in respect of the entire heading of a Nice class for which no declaration has been filed, will be deemed to extend only to goods/services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

Declarations for European Union trade marks filed within the relevant period will take effect from the moment of their entry in the Register.

Where the declaration is accepted and the Register is amended, Article 33(9) EUTMR will apply.

According to Article 33(9) EUTMR, the amendment of a list of goods/services recorded in the Register following a declaration under Article 33(8) EUTMR made during the 6-month period after the entry into force of the Regulation, cannot give the proprietor of a European Union trade mark the right to oppose or to apply for a declaration of invalidity in respect of a later mark where and to the extent that (i) the later trade mark was in use for, or an application had been made to register the later trade mark for, goods/services before the Register was amended for the earlier mark and (ii) the use in relation to those goods/services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the record of the goods/services in the Register at that time.

In practice, this means that, where the earlier mark is a European Union trade mark and the contested mark was filed, or was in use, before the Register was amended under Article 33(8) EUTMR for the earlier European Union trade mark, the goods and services identified as going beyond the literal meaning of the class heading will not be

taken into account in oppositions or declarations of invalidity filed after the entry into force of the Amending Regulation.

As regards the scope of protection of national marks, the Office and all national trade mark offices of the European Union issued a Common Communication on the implementation of the *IP Translator* judgment. According to that Communication, the Office interprets the scope of protection of national marks containing class headings as follows:

- **Earlier national trade marks filed before the *IP Translator* judgment:** in principle, the Office accepts the filing practice of all national trade mark offices in the European Union. National trade marks filed before the *IP Translator* judgment have the scope of protection awarded by the national office(s) concerned. The majority of the national offices interpret the class headings of their marks literally. For those marks, the Office also interprets the class headings on the basis of the natural and usual meaning of each general indication.
- Only **eight** national trade mark offices do **not** interpret the class headings of their own marks filed before the *IP Translator* judgment on the basis of their natural and usual meaning: **Bulgaria, Greece, Italy, Lithuania, Hungary, Malta, Romania and Finland** (see Table 1 of the Common Communication). The Office interprets those national marks as covering the class headings plus the alphabetical list of the Nice edition at the time of filing (even if the national office interprets the class heading as covering all goods and services in the class).
- **Earlier national marks filed after the *IP Translator* judgment:** the Office interprets all goods and services covered by the national marks on the basis of their natural and usual meaning (see Table 5 of the Common Communication).

In order to determine the scope of protection the abovementioned principles have to be applied. Only those goods/services deemed to be covered following these principles will be considered when comparing the goods/services.

3 Similarity of Goods and Services

3.1 General principles

3.1.1 Similarity factors

Generally speaking, two items are defined as being similar when they have some characteristics in common. The similarity of goods and services does not depend on any specific number of criteria that could be determined in advance and applied in all cases.

The similarity of goods and services has been addressed in the case-law of the Court of Justice in *Canon* (29/09/1998, C-39/97, Canon, EU:C:1998:442). The Court of Justice held that in assessing the similarity of goods **all** the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia,

their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (para. 23).

The term **inter alia** shows that the enumeration of the above factors by the Court is only indicative. There may be other factors in addition to or instead of those mentioned by the Court that may be pertinent, depending on the particular case.

This leads to the conclusion that the following factors should be taken into account:

Canon factors

- nature
- intended purpose
- method of use
- complementarity
- competition.

Additional factors

- distribution channels
- relevant public
- the usual origin of the goods/services.

These factors will be further explained in paragraph 3.2; they are also used in the Office's database on the comparison of goods and services. It should be noted, however, that even though the database is restricted to these eight factors, there might be specific cases where other criteria are relevant.

3.1.2 Defining relevant factors

The comparison should focus on identifying the relevant factors that specifically characterise the goods/services to be compared. Therefore, the relevance of a particular factor depends on the respective goods/services to be compared.

Example

- When comparing *skis* and *ski-boots*, it is evident that they do not coincide in their nature or method of use and are not in competition. Therefore, the comparison should focus on their purpose, their complementary character, their distribution channels, their usual origin and/or the relevant public.

Therefore, the relevant factors and features characterising a product or a service may be different depending on the goods and services with which they have to be compared.

It is not necessary to list all possible factors. What does matter, however, is whether the connections between the relevant factors are sufficiently close to find similarity.

The following questions could be asked:

- How will the goods/services be used?
- What is their purpose?
- How likely is it that they coincide in producers?

- Are they usually found in the same outlet or department store, or in the same section of a supermarket?

If the factors cannot already be defined from the wording of the goods/services, information may be derived from dictionary entries. However, dictionary entries have to be analysed against commercial realities and in particular taking into account the Nice Classification.

Example

- According to the dictionary, *ice* is the singular of *ices* and means inter alia '(an) ice cream' or 'water ice' (*Oxford Dictionaries* online edition). If the comparison of *ices* and *ice* in Class 30 were made on the basis of the definition from the dictionary alone, it would lead to the erroneous conclusion that *ice* is identical to *ices*. However, since both *ices* and *ice* are mentioned in the list of goods in Class 30, *ices* are to be understood as 'edible ices', whereas *ice* is to be understood as 'cooling ice'. Although they coincide in the composition to the extent that both consist (partly) of frozen water, their commercial nature is different: while one is a foodstuff, the other is an auxiliary good for preserving and/or cooling foodstuffs. This shows that the Nice Classification, in conjunction with the commercial perspective, prevails over the dictionary definition.

Once the relevant factors have been identified, the examiner must determine the relation between and the weight attributed to the relevant factors (see paragraph 3.3).

3.2 The specific similarity factors

The following paragraphs define and illustrate the various factors for similarity of goods and services.

3.2.1 Nature

The nature of a product/service can be defined as the essential qualities or characteristics by which this product/service is recognised. Nature often corresponds to the particular type or sort of product/service or the specific category to which this product/service belongs and which is usually used to define it. In other words, it is the answer to the question 'What is it?'

Examples

- *Yoghurt* is a milk product;
- *Car* is a vehicle;
- *Body lotion* is a cosmetic product.

3.2.1.1 Indicative value of class headings and categories

The fact that goods/services to be compared fall under the same general indication of a class heading or broad category does not automatically mean that they are of the same nature. An example of such a broad category is *foodstuffs for human consumption*.

Examples

- *Fresh fruit* (Class 31) on the one hand and *coffee, flour, and bread* (Class 30) on the other hand are of a different nature despite being foodstuffs.
- *Meat, fish, poultry and game* (Class 29) are foodstuffs of animal origin. *Fruits and vegetables* (Class 31) are foodstuffs of plant origin. This slight connection, namely all being foodstuffs, does not preclude that their nature is different.

The fact that goods/services to be compared fall under a sufficiently narrow general indication of a class heading favours an identical or similar nature.

Example

- *Condensed milk* and *cheese* (both in Class 29) share the same nature because they belong to the same product category, namely milk products, which are a subcategory of foodstuffs (4/11/2003, T-85/02, Castillo, EU:T:2003:288, § 33).

3.2.1.2 Features of the goods defining their nature

A variety of features of the goods in question may be useful for defining their nature. These include the following:

Composition: for example, ingredients, materials of which the goods are made.

Example

- *Yoghurt* (Class 29) is a milk product (the nature of yoghurt may be defined by its basic ingredient).

Composition may be the most relevant criterion for defining nature. However, an identical or similar composition of the goods is not per se an indicator of the same nature.

Example

- A *chair* (Class 20) and a *doll* (Class 28) can both be made of plastic, but they are not of the same nature since one is a piece of furniture and the other is a toy. They belong to different categories.

Functioning principle: for example, mechanical functioning, with or without engine/motor; optical, electrical, biological, or chemical functioning.

Example

- *Telescope* (Class 9) is an optical device (the nature of a telescope may be defined by its functioning principle, which is optical).

Although the functioning principle may help to define the nature of some goods, it is not always conclusive. There are cases where goods, in particular technology-related ones, with the same functioning principle are of a different nature.

Example

- A *blender* and an *electric toothbrush* have the same functioning principle of rotation, but they are not of the same nature.

In contrast, there are goods with different functioning principles but the same nature.

Example

- The functioning principle of *washing machines using washing powder* is chemical, which is not the same as the functioning principle of *washing machines using magnetic waves*. However, these goods are of the same nature as they are both washing machines.

Physical condition: for example, liquid/solid, hard/soft, flexible/rigid.

The physical condition is another feature of the goods that may be used to define nature but, like the functioning principle, it is not conclusive.

Examples

- All drinks are liquid. Their nature is different from the nature of solid foodstuffs. However, when comparing two different drinks, their physical condition should not be conclusive: *milk* (Class 29) is not of the same nature as an *alcoholic beverage* (Class 33).
- *Yoghurt* is marketed both in solid and liquid form. However, the nature of this good is not defined by its physical condition, but — as mentioned above — by its basic ingredient (milk). In both cases, the nature of a solid yogurt and of a liquid yogurt is the same (a milk product).

3.2.1.3 Nature of services

When defining the nature of services, the composition of features, functioning principle and physical condition cannot be used since services are intangible.

The nature of services can be defined, in particular, by the kind of activity provided to third parties. In most cases, it is the category under which the service falls that defines its nature.

Example

- *Taxi services* (Class 39) have the same nature as *bus services* (Class 39) as they are both transport services.

3.2.1.4 Nature of goods versus nature of services

By their **nature**, goods are generally dissimilar to services. This is because goods are articles of trade, wares or merchandise. Their sale usually entails the transfer in title of something physical. Services, however, consist of the provision of intangible activities.

3.2.2 Intended purpose

‘Purpose’ is generally defined as ‘the reason for which something is done or made, or for which it exists’ (*Oxford Dictionaries* online edition).

As a Canon factor, purpose means the intended use of the goods/services and not any other possible use.

Example

- A *plastic bag* can be used as protection against the rain. However, its intended purpose is to carry items.

The purpose is defined by the function of the goods/services. In other words, it answers the questions: What need do these goods/services satisfy? What problem do they solve?

It is sometimes difficult to determine the proper level of abstraction in order to determine the purpose. As in the case of defining the nature, the purpose must be defined in a sufficiently narrow way.

Example

- In the case of *vinegar*, the intended purpose should not be defined as ‘human consumption’, which is the general purpose that all foodstuffs share, but as ‘everyday seasoning’.

3.2.3 Method of use

The method of use determines the way in which the goods/services are used to achieve their purpose.

The question to be asked is: How are these goods/services used?

Method of use often follows directly from the nature and/or intended purpose of the goods/services and therefore has little or no significance of its own in the similarity analysis.

Example

- The method of use of newspapers and books is the same in the sense that they are both read. However, similarity can already be concluded from the facts that they are both printed matter (same nature) and that they both serve to entertain or to inform (same purpose).

Notwithstanding the explanation above, the method of use may be important, independent of nature and purpose, where it characterises the goods.

Example

- *Pharmaceutical preparations for treating skin diseases* in Class 5 can take the form of creams. They have the same method of use as *cosmetic creams* in Class 3.

However, even where the method of use characterises the goods under comparison and where it is identical for both goods, this fact alone will not be sufficient to establish similarity.

Example

- *Chewing gum* (Class 30) and *chewing tobacco* (Class 34) have an identical method of use. However, this fact alone does not make them similar.

3.2.4 Complementarity

Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking (11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40; 21/11/2012, T-558/11, Artis, EU:T:2012:615, § 25; 04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 44).

3.2.4.1 Connection (link) between goods/services

The connection between the goods/services must be established with sufficient certainty. When the connection between the goods/services is not close enough for each to be indispensable (essential) or important (significant) for the use of the other, no complementarity can be found.

When assessing whether or not the consumer would usually expect there to be a link between the goods/services, it is appropriate to take into account the economic reality on the market as it currently exists (16/01/2018, T-273/16, METAPORN / META4 et al., EU:T:2018:2, § 41-42).

A **functional link** between goods/services will usually be a strong indication of complementarity: for instance when one product or service is required for the proper functioning of the other, one enables the use of the other, or one cannot be used without the other.

In the following cases there is complementarity between the goods under comparison.

Examples

- *Software, in particular for casino and amusement arcade games* in Class 9 is essential for the functioning of *games* (such as electronic or online games of chance) in Class 28 and there is complementarity between the goods (19/04/2016, T-326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 54).
- The sole purpose of *cord and cable management devices* (such as holders and clips for containing and organising audio and video cables) in Class 9 is for them to be used with *electric wires and cables* (such as AV cables) in Class 9, as the former are used for holding and organising the latter. It follows that there is an undeniable link of complementarity between them (24/04/2018, T-831/16, ZOOM / ZOOM et al., EU:T:2018:218, § 81-82).
- *Applicators for hair lotions* (Class 21) complement *hair lotions* (Class 3) and are used for applying the latter properly (16/12/2015, T-356/14, Kerashot / K KERASOL, EU:T:2015:978, § 37).

There may also be a link between a certain product on the one hand, and its parts, components and fittings on the other. There is therefore complementarity when the respective part/component/fitting is sold independently and is required for proper use of the final product and/or when the part/component/fitting cannot serve its intended

purpose if it is not included in the final product. In the following examples the goods are considered complementary.

Examples

- *electric toothbrushes* (Class 21) and *replacement brush heads* (Class 21);
- *power saws* (Class 7) and *saw blades* (Class 7);
- *lighting apparatus* (Class 11) and *lighting fittings* (Class 11).

Principles applicable to the comparison of various kinds of goods/services among themselves also apply to the comparison between goods on the one hand and services on the other. Moreover, there may be similarity based on complementarity between goods on the one hand and services that cover identical goods on the other (24/09/2008, T-116/06, O Store, EU:T:2008:399, § 54-56, 07/09/2016, T-204/14, VICTOR / VICTORIA et al., EU:T:2016:448, § 108-111).

In the following cases there is complementarity between the goods and services under comparison.

Examples

- *Installation, repair and maintenance of water based heating systems* in Class 37 ensure the proper functioning of *heating installations* in Class 11 (such as water-based heating installations); there is complementarity between them (06/06/2018, T-264/17, SMATRIX / AsyMatrix (fig.), EU:T:2018:329, § 49-50).
- *Design and development of computer hardware and software* in Class 42 are important for the functioning of *computers*; *portable communication devices* in Class 9; there is complementarity between them (27/09/2016, T-450/15, luvoworld / luvo, EU:T:2016:543, § 42, 46, 48-49).
- There is complementarity between, on the one hand, *soaps, perfumery, essential oils, cosmetics, hair lotions* in Class 3 and, on the other, *spas, Turkish baths, sauna services, health spa services* in Class 44. Treatments in spas, Turkish baths and health spas are usually followed by the application of body lotions and moisturising creams, and the public may expect to be treated with these products in such establishments (26/02/2015, T-388/13, SAMSARA, EU:T:2015:118, § 30). In that case, the goods in Class 3 are important for proper use of the services in Class 44.
- In the comparison of *retail services in stores of all kinds of foodstuffs, especially patisserie and confectionery* contained in Class 35, with various kinds of foodstuffs falling within Classes 29, 30 and 31, the retail services relate to a relatively broad category of goods that includes the goods covered by the other mark. Consequently, the retail services and the goods covered by the other mark were found to be complementary (05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 29-31). In this case the services in Class 35 are important for providing consumers with the goods in Classes 29, 30 and 31.
- *Medical services* in Class 44 are important, even indispensable, for the use of *pharmaceutical products* in Class 5. Similarly, administering pharmaceutical products is important, even indispensable, in providing the services in question.

There is a complementarity between these goods and services (14/06/2018, T-165/17, EMCURE / Emcur et al., EU:T:2018:346, § 60-61).

3.2.4.2 Additional factors for establishing a link between goods and services

There is complementarity between goods and services only when the consumers of the goods and services concerned may think that the same undertaking is responsible for producing those goods or providing those services. In that sense, the relevant public and usual commercial origin of the goods and services are important factors for establishing complementarity.

The relevant public

By definition, complementary goods or services must be capable of being used together, so that goods and services directed at different publics cannot be complementary (22/01/2009, T-316/07, easyHotel, EU:T:2009:14, § 57-58; 22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30; 12/07/2012, T-361/11, Dolphin, EU:T:2012:377, § 48; 26/04/2016, T-21/15, DINO (fig.) / DEVICE OF A DINOSAUR (fig.), EU:T:2016:241, § 22; 15/06/2017, T-457/15, climaVera (fig.) / CLIMAVER DECO, EU:T:2017:391, § 36), even if they are considered mutually indispensable (25/01/2017, T-325/15, Choco Love (fig.) / CHOCOLATE, EU:T:2017:29, § 40, 43, 46).

Examples

- *Textile products* in Class 24 (aimed at the public at large) and *treatment services relating to textile products* in Class 40 (aimed at professionals) cannot be complementary (16/05/2013, T-80/11, Ridge Wood, EU:T:2013:251, § 28-32). These goods and services are not similar.
- The relevant public of plastic or synthetic products used as raw or semi-finished material (e.g. *synthetic resin plastics* in Class 1 and *plastics in extruded form* in Class 17) consists of moulders and converters, whereas the finished products (e.g. *vehicles* made in Class 12) are directed at the general public. The goods at issue are not complementary (09/04/2014, T- 288/12, Zytel, EU:T:2014:196, § 28, 41). There is no similarity between them.

There will be no complementarity between a certain product on the one hand, and its parts, components or fittings on the other, when the goods in comparison do not target the same public (e.g. the component is meant for the manufacturer, but not for the consumer of the final product) and when the parts, components or fittings are not usually sold independently as replacement parts of the final product. Therefore, in the following examples, even though the parts or components are indispensable or important for the proper functioning of the final product, there is no complementarity between the goods in comparison.

Examples

- *fan blades* (Class 7) and *hair dryer* (Class 11);
- *electric cable* (Class 9) and *lamp* (Class 11);
- *balls for ball-point pens* (Class 16) and *ball-point pens* (Class 16).

The origin of the goods/services

Goods/services that are complementary usually share the same commercial origin, or give consumers some cause to believe that the same undertaking is responsible for both producing the goods and providing the services.

Examples

- *Skis* (Class 28) and *ski boots* (Class 25) are complementary because the use of one is indispensable for the use of the other. The relevant public may think that the production of these goods lies with the same undertaking. In addition, they share the same public and distribution channels. These goods are consequently considered similar.
- *Teaching materials* in Classes 9 and 16 (such as printed matter, pre-recorded data carriers and audio/video cassettes) are essential and thus complementary to *educational courses* in Class 41. Generally the materials are issued by the same undertaking, and share the same public and distribution channels. These goods are similar to the services in question (23/10/2002, T-388/00, ELS, EU:T:2002:260).
- *Services of an architect (designing of buildings)* (Class 42) are indispensable for *building construction* (Class 37). These services are often offered together through the same distribution channels, by the same providers and to the same public. Consequently, these services are complementary and similar (09/04/2014, T-144/12, Comsa / COMSA S.A., EU:T:2014:197, § 65-67).

Conversely, there is no complementarity between goods/services that are not expected to share the same commercial origin.

Example

- There is no complementarity between financial and banking services (Class 36) on the one hand and real estate services (Class 36) on the other hand. Banking services may play a significant role in the purchase of a property, but it cannot be inferred from that alone that consumers would be led to believe that the same undertaking was responsible for real estate services. To conclude otherwise would imply that any non-financial procedure that depends on the provision of financing is complementary to a financial service. Furthermore, the services do not have the same nature, the same intended purpose or the same method of use, and they are not provided on the same premises. Consequently, these services are not similar. (17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35, 37-38).

3.2.4.3 Types of interrelation between goods/services where complementarity is usually not found

In the following cases there is not usually any complementarity between the goods/services, as neither is indispensable or important for the use of the other, and any joint use of them is a question of convenience or of consumer habits or preferences.

Complementarity has to be clearly distinguished from **use in combination** where goods/services are merely used together, whether by choice or convenience, but can

be used also without the other or with different goods (e.g. bread and butter). Where their use together is merely optional and not indispensable or important, the necessary close link is missing (28/10/2015, T-736/14, *MoMo Monsters / MONSTER et al.*, EU:T:2015:809, § 29). In such cases similarity can be found on the basis only of other factors, not complementarity.

Example

- Even if the functioning of *transmission belts* in Class 12 can be measured with the help of a *device for motor-vehicle testing* in Class 9, this does not mean that the goods are complementary. It can be convenient in certain cases to measure the performance of one or the other parameter but simple convenience is not sufficient to conclude that one product is indispensable for the other (03/10/2013, R 1011/2012-4, *SUN (fig.) / SUN (fig.) et al.*, § 39).

Certain goods that are often coordinated with each other, for example because of fashion preferences, but for which no other similarity factors apply were determined by the Court to have '**aesthetic complementarity**' (01/03/2005, T-169/03, *Sissi Rossi*, EU:T:2005:72, § 62; 11/07/2007, T-150/04, *Tosca Blu*, EU:T:2007:214, § 35-39; 20/10/2011, T-214/09, *Cor II*, EU:T:2011:612, § 32-37). Such a relationship between the goods falls outside the existing definition of complementarity. The mere existence of 'aesthetic complementarity' between the goods is not sufficient to conclude that there is similarity between them (27/09/2012, T-39/10, *Pucci*, EU:T:2012:502, § 75).

When certain goods/services only support or supplement another product or service, they are not considered to be complementary within the meaning of the case-law. **Ancillary goods** are typically those used for packaging (e.g. bottles, boxes, cans) or for promotion (e.g. leaflets, posters, price lists). Equally, goods/services offered for free in the course of a merchandising campaign are usually not similar to the primary product or service.

Examples

- *Organisation and conducting of exhibitions* (Class 41) is not similar to *printed matter, including event notes* (Class 16), since the goods merely serve to promote and announce the specific event. These goods and services are not complementary.
- *Herbal nutritional supplements* in Class 5 are not indispensable or important for the use of *beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* in Class 32. Any combined consumption of those products is merely ancillary. Therefore, these goods are not complementary. Furthermore, since their purpose, distribution channels and usual producers are different, and they are not in competition, these goods are not similar (23/01/2014, T-221/12, *Sun fresh*, EU:T:2014:25, § 84).

Lastly, complementarity applies only to the use of goods, not to their production process. Goods cannot be regarded as complementary on the ground that one is used to manufacture the other (09/04/2014, T-288/12, *Zytel*, EU:T:2014:196; § 39; 25/09/2018, T-435/17, *HIPANEMA (fig.) / Ipanema (fig.) et al.*, EU:T:2018:596; § 71). Even when one product is used to manufacture another, this does not mean that the relevant public will assume they are offered by the same undertaking (06/04/2017,

T-39/16, NANA FINK (fig.) / NANA, EU:T:2017:263, § 89). A thorough case-by-case assessment has to be carried out (see specific examples in Annex I, Specific Questions on the Similarity of Goods and Services, paragraph 4.2, and Annex II, Specific Industries, paragraphs 5.4.1 and 5.5.2).

3.2.5 In competition

Goods/services are in competition with each other when one can substitute the other. That means that they serve the same or a similar purpose and are offered to the same actual and potential customers. In such a case, the goods/services are also defined as ‘interchangeable’ (04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 42).

Examples

- *Wallpaper* (Class 27) and *paints* (Class 2) are in competition because both cover or decorate walls.
- *Rental of movies* (Class 41) and *services of a cinema* (Class 41) are in competition because they both allow you to watch a film.
- *Electric shavers* and *razor blades* (both in Class 8) are in competition because they serve the same purpose.

In some cases the price of goods/services in competition may differ significantly, but this fact alone does not affect the analysis of whether they are in competition with each other or not.

Example

- *Jewellery made of gold* and *fashion jewellery* ⁽⁴²⁾ (both in Class 14) are in competition even though their price (and value) may greatly differ.

3.2.6 Distribution channel

Although ‘distribution channel’ is not explicitly mentioned in the *Canon* judgment, it is widely used internationally and nationally in the assessment of whether two goods/services are similar. It has been taken into account as an additional factor in several judgments of EU courts (21/04/2005, T-164/03, *monBeBé*, EU:T:2005:140, § 53). The reasoning for this is as follows.

If the goods/services are made available through the same distribution channels, the consumer may be more likely to assume that the goods/services are in the same market sector and are possibly manufactured by the same entity and vice versa.

The term ‘distribution channel’ does not refer so much to the way of selling or promoting a company’s product as to the place of distribution. For the analysis of the similarity of goods/services, the distribution system — whether direct or indirect — is not decisive. The question to be asked is rather: do the goods/services have the same points of sale, or are they usually provided or offered at the same or similar places?

⁴² Fashion/costume jewellery is understood to be jewellery made from inexpensive metals and imitation gems or semi-precious stones, worn for decorative purposes.

However, too much emphasis should not be placed on this factor as modern supermarkets, drugstores and department stores sell goods of all kinds. The relevant public is aware that the goods sold in these places come from a multitude of independent undertakings. Therefore, the point of sale is less decisive when deciding whether the relevant public considers that goods share a common origin merely because they are sold at the same outlet.

Only where the goods in question are offered in the same **section** of such shops, where homogeneous goods are sold together, will this favour similarity. In such cases it must be possible to identify the section by its territorial and functional separation from other sections (e.g. dairy section of a supermarket, the cosmetics section of a department store).

Similarly, this factor may apply in cases in which goods are sold exclusively or commonly in specialised shops. In that event, consumers may tend to believe the origin of the goods to be the same if they are both sold in the same specialised shops and may tend to deny that mutual origin if they are not usually sold in the same shops.

Conversely, different sales outlets may weigh against the similarity of goods.

Example

- *Wheelchairs* versus *bicycles*.

Although both fall under *vehicles* in Class 12, they will not be found at the same outlets. Bicycles are usually sold either in specialist bicycle stores or in a retail store where sporting equipment is available. By contrast, the distribution channels for *wheelchairs* are the specialised distributors of medical equipment and devices that supply hospitals, and specialised shops where devices for disabled or physically handicapped people are sold.

3.2.7 Relevant public

The relevant public, such as the actual and potential customers of the goods and services in dispute, constitutes another factor to be dealt with in the analysis of similarity (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The relevant public can be composed of:

- the general public (public at large) or
- a professional public (business customers or specialised public).

The relevant public does not necessarily mean the end user; for instance, the end users of *food for animals* in Class 31 are animals, not the relevant public. The relevant public in this case would be the general consumer.

The mere fact that the potential customers coincide does not automatically constitute an indication of similarity. The same group of customers may be in need of goods/services of the most diverse origin and nature. The fact that, for example, television sets, cars and books are bought by the same relevant public, namely the public at large, has no impact on the analysis of similarity. In many cases, either one or both lists

of goods/services under comparison target the public at large, but the purpose (of covering customers' needs) is different in each case. Such circumstances weigh against similarity.

While a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity.

Diverging customers can be found in the following cases, where:

1. the goods/services of both lists are directed at the public at large, who can, however, be clearly categorised by their different (personal) needs, ages, etc.
Example: *wheelchairs* versus *bicycles* (Class 12).
2. the goods/services of both lists target business customers, who may, however, be acting in a very different market sector.
Example: *chemicals used in forestry* versus *solvents for the lacquer industry* (Class 1).
3. one relevant public consists of general consumers and the other of business customers.
Example: *containers for contact lenses* (in Class 9) versus *surgical apparatus and instruments* (in Class 10).

3.2.8 Usual origin (producer/provider)

Although the Court of Justice did not explicitly mention this factor in its *Canon* judgment, it follows from the general concept of likelihood of confusion that the usual origin of the goods and services is of particular importance for the analysis of similarity. As the Court has stated, it is 'the risk that the public might believe that the goods/services in question come from the same undertaking or, as the case may be, from economically linked undertakings, [that] constitutes a likelihood of confusion' (29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 29). Hence, there is a strong indication of similarity when, in the mind of the relevant public, the goods/services have the same usual origin.

However, this should not be misinterpreted as turning the examination of likelihood of confusion and similarity of goods/services upside down: the finding of a likelihood of confusion depends on many other factors (such as the similarity of signs and the distinctiveness of the earlier mark) and is not exclusively determined by the usual origin, which as such is only one factor in the analysis of the similarity of goods/services.

A finding that consumers will not be confused about the origin of the goods/services is not an argument appropriate to the comparison of goods/services. This finding should be mentioned in the overall assessment of likelihood of confusion. Origin, in this context, relates mainly to the manufacturing sector (industry) or kind of undertaking producing the goods or offering the services in question rather than to the identity of the producer.

The 'origin' is not merely defined by the actual place of production/provision (e.g. factory, workshop, institute or laboratory) but primarily by taking into consideration who

manages and/or controls the production/provision of the goods/services. In other words, the question to be asked is: who is responsible for manufacturing the product or providing the service?

The geographical origin (e.g. China) is not relevant for the finding of similarity of goods/services.

The Court has held that even goods and services can have the same origin if it is common for the same type of company to produce/provide both. *Educational textbooks* (Class 16) were considered to have the same origin as *provision of correspondence courses* (Class 41) since ‘undertakings offering any kind of course often hand out those products to pupils as support learning materials’ (23/10/2002, T-388/00, ELS, EU:T:2002:260, § 55).

The criterion ‘usual origin’ has to be applied in a restrictive way in order not to dilute it. If all kinds of goods/services deriving from one large (multinational) company or holding were found to have the same origin, this factor would lose its significance.

Example

- *Cosmetics* (Class 3) and *foodstuffs* (Classes 29 to 31) may be produced under the umbrella of one company but this does not reflect common trade customs, according to which these types of goods have different producers, each belonging to a specific industry.

3.2.8.1 Features defining a common usual origin

When determining the usual origin of a product/service the following features might be relevant.

Manufacturing sites

Example

- *Varnishes, lacquers, colorants and mordants* (Class 2) are typically produced by the same production enterprises, normally specialised chemical companies.

The place of production can be a strong indicator that the goods/services in question come from the same source. However, while the same manufacturing sites suggest a common usual origin, different manufacturing sites do not exclude that the goods come from the same or economically linked undertakings. For instance, *books* (Class 16) and *electronic media* (Class 9) (goods in competition, with e-media substituting books) are both goods of a publishing house.

Methods of manufacture

Example

- *Leather belts* (Class 25) and *leather handbags* (Class 18) are not only manufactured in the same sites, for example, leather workshops, but are also manufactured using the same tools and machines for the treatment of leather.

(Technical) know-how

Example

- *Computer virus protection services* (Class 42) and *software design* (Class 42) involve similar technical know-how in the field of information technology.

Established trade custom known to the public

An established trade custom, such as when manufacturers expand their businesses to adjacent markets, is of particular importance for concluding whether goods/services of different nature have the same origin. In such situations, it is necessary to determine whether such expansion is common in the industry or, conversely, whether it may occur in exceptional cases only.

Example where extension has become customary

- *Shoes* (Class 25) and *handbags* (Class 18): it is customary in the market for the producers of shoes also to be involved in the manufacture of handbags.

Example where extension is not (yet) common

- *Clothing* (Class 25) and *perfumes* (Class 3): even though some designers that make fashion clothes nowadays also sell perfumes under their marks, this is not the rule in the clothing industry, and rather applies only to (economically) successful designers.

3.3 Relation between different factors

The Canon criteria were enumerated in the corresponding judgment without any indication of relationship or hierarchy (weight) among them. They were considered one by one. However, they cannot be considered independently since some criteria are interrelated and some criteria are more important than others, regardless of whether goods are being compared with goods, services with services or goods with services. As a result of weighing all these factors in accordance with their respective importance in relation to the goods/services at issue, similarity may be found to various degrees: low, average or high (see paragraph 3.3.4).

3.3.1 Interrelation of factors

In many cases there will be relationships between the factors in the sense that where one is shared, another one might coincide as well.

Examples

- Based on the purpose, it is also possible to determine who the actual and potential customers (i.e. the relevant public) are.
- The purpose, together with the relevant public, may also reveal whether goods/services are in competition.
- The same distribution channel goes hand in hand with the same public. In other words, where the distribution channels are different, the public may be different as well.
- Goods/services intended for different publics cannot be complementary (11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40, 22/06/2011; T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30).

- The method of use usually depends on the nature and purpose of the goods.

There are cases in which it is difficult to make a distinction between various factors. This is particularly true as far as 'nature', 'purpose' and 'method of use' are concerned. Where the examiner encounters such difficulties, it is sufficient to treat these factors jointly.

Example

- An *engine* is a machine for converting any of various forms of energy into mechanical force and motion. In such a case, it is difficult to distinguish the nature from the purpose of the product. Therefore, in this case, no distinction between what is nature and what is purpose is necessary.

3.3.2 Importance of each factor

In assessing the similarity of goods and services, **all** relevant factors characterising the relationship between them should be taken into account. However, depending on the kind of goods and services, a particular criterion may be more or less important. In other words, the various criteria do not have a standard value; rather, their specific importance should be determined in the context of each individual case.

In general, the weight of each factor will depend on the impact it has on possible confusion regarding origin. Criteria clearly suggesting that the goods/services come or do not come from the same undertaking or economically linked undertakings should take precedence.

Generally strong factors

- Usual origin (because it has a strong impact on likelihood of confusion, which relates to common commercial origin).
- Purpose (because it is decisive for the choice made by the customer buying or selecting goods/services).
- Nature (because it defines the essential qualities and characteristics of the goods/services).
- Complementarity (because the close connection between the use of the goods/services makes the public believe that they share the same source).
- In competition (usually goods/services that are in competition have the same purpose and target the same public).

Less important factors

- Method of use (even dissimilar goods can be used in the same manner, e.g. *baby carriages* and *shopping trolleys*).
- Distribution channels (even dissimilar goods can be sold in the same section of stores depending on different display practices, e.g. *chewing gum* (Class 30) and *cigarettes* (Class 34)).
- Relevant public.

3.3.3 Different types of comparisons: goods versus goods, services versus services and goods versus services

In principle, the same factors for comparing goods with goods are relevant for the comparison of services with services. However, in applying these factors, the basic difference between goods and services (tangible versus intangible) must be considered.

Furthermore, the same principles that apply for the comparison between goods and goods and between services and services also apply in cases where goods are compared with services.

By their nature, goods are generally dissimilar to services. They can, however, be complementary. Services can also have the same purpose and thus be in competition with goods. It follows that under certain circumstances similarity between goods and services can be found.

3.3.4 Degree of similarity

Goods/services can be found similar to different degrees (low, average or high), depending on how many factors they share and the weight given to each of them. The degree of similarity found between the goods and services is of relevance when making a final decision on the likelihood of confusion.

Generally, one factor on its own is not sufficient for finding similarity between the goods/services, even if it is a strong factor.

Examples of dissimilarity

- *Cars* and *bicycles* (both in Class 12) share the same purpose (taking oneself from A to B), but this does not make them similar.
- Although *window glass* (Class 19) and *glasses for spectacles* (Class 9) have the same nature, they are not similar, since they do not coincide in other relevant factors, such as purpose, producers, distribution channels and relevant public.

It is the combination of various factors and their weight that allows the final conclusion on similarity. The combination of two strong factors, such as nature and producer, or the combination of one strong and two weak factors will often lead to similarity. In contrast, the combination of two weak factors, such as distribution channel and relevant public are, in principle, not conclusive for a finding of similarity between the goods and services.

Examples of similarity

- *Milk* and *cheese* (both in Class 29) have a different purpose and method of use; they are not in competition or complementary. However, the fact that they share the same nature (dairy goods) and usual origin (dairy company) is decisive for a finding of similarity.
- Although *pharmaceuticals* and *plasters* (both in Class 5) have a different nature, they share a similar purpose: treating diseases, disabilities or injuries. Furthermore,

they have the same distribution channels and relevant public. Therefore, they are similar.

The number of coinciding factors found, together with their importance/weight, establishes the degree of similarity. Generally speaking, the higher the number of common factors, the higher the degree of similarity. A similarity found on the basis of only two factors would normally not be high, unlike in cases where the goods/services coincide in four or more relevant factors.

However, no mathematical analysis is possible since it always depends on the specific circumstances of each case.

Obsolete

4 Annex I: Specific Questions on the Similarity of Goods and Services

This part does not establish any new criteria for finding similarity between goods and services. It merely helps to clarify how to compare specific groups of goods and services for which, apart from the Canon criteria, some general rules and exceptions apply.

4.1 Parts, Components and Fittings

The mere fact that a certain product can be composed of several components does not automatically establish similarity between the finished product and its parts (27/10/2005, T-336/03, Mobilix, EU:T:2005:379, § 61).

Examples of dissimilarity

- *Fan blades* (Class 7) and *hair dryer* (Class 11)
- *Electric cable* (Class 9) and *lamp* (Class 11)
- *Balls for ball-point pens* (Class 16) and *ball-point pens* (Class 16)
- *Buttons* (Class 26) and *clothing* (Class 25).

Similarity will be found where at least some of the main factors for finding similarity (such as producer, public and/or complementarity) are present, taking into account the relationship between the factors and the importance of each factor for assessing similarity (see paragraph 3.3).

Such similarity is based on the fact that parts and fittings are often produced and/or sold by the same undertaking that manufactures the end product and target the same purchasing public, as in the case of spare or replacement parts which are also sold independently of the final product. Furthermore, there is complementarity between the goods in question when the respective part/component/fitting is required for proper use of the final product and/or when the part/component/fitting cannot serve its intended purpose if it is not included in the final product. In that case, the public may also expect part/component/fitting to be produced by, or under the control of, the 'original' manufacturer, which would also suggest that the goods were similar.

Examples of similarity

- *Electric toothbrush* (Class 21) and *replacement brush heads* (Class 21)
- *Printer* (Class 9) and *ink jet cartridges* (Class 2)
- *Sewing machines* (Class 7) and *walking feet for sewing machines* (Class 7).

4.2 Raw Materials and Semi-Processed Goods

In most cases, the mere fact that one product is used for the manufacture of another will not be sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct (13/04/2011, T-98/09, T

Tumesa Tubos del Mediterráneo S.A., EU:T:2011:167, § 49-51). According to case-law, the raw materials subjected to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose (03/05/2012, T-270/10, Karra, EU:T:2012:212, § 53).

Furthermore, they are not complementary on the ground that one is manufactured with the other, and raw material is in general intended for use in industry rather than for direct purchase by the final consumer. In that regard, *plastic or synthetic products used as raw or semi-finished material* (in Classes 1 and 17) cannot be regarded as complementary to *finished products* (made from these materials in Classes 9 and 12) on the ground that the raw materials are intended to be turned into finished products (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39-43).

Examples of dissimilarity

- *Leather, animal skins* (Class 18) and *clothing* (Class 25)
- *Precious metals* (Class 14) and *jewellery* (Class 14).

However, the final conclusion may depend on the specific circumstances of the case, such as the degree of transformation of the raw material and whether it can be obtained separately from the end product through the same distribution channels.

Example of similarity

- *Precious stones* (Class 14) and *jewellery* (Class 14). Contrary to *precious metals*, *precious stones* can be obtained in jewellery shops independently of the end product.

See also Annex II, paragraph 5.5.1, 'Ingredients of prepared food'.

4.3 Accessories

'Accessories' with no further qualification is an unclear or imprecise term as described in paragraph 1.5.2 'The relevant scope', and should be treated accordingly.

An accessory is something extra that improves or completes the main product it is added to, and usually fulfils a decorative purpose. Unlike parts, components and fittings, an accessory, while usually used in close connection with the main product, does not constitute an integral part of it.

The mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity (see, for example, 'aesthetic complementarity', paragraph 3.2.4).

Examples of dissimilarity

- *Clothing* (Class 25) and *hair ornaments* (Class 26)

However, it is common for some accessories also to be produced by the manufacturer of the main product. Consequently the consumer may expect the main product and accessories to be produced under the control of the same entity, especially when they

are distributed through the same channels of trade. In such cases, there is a strong indication of similarity.

Examples of similarity

- *Bicycles* (Class 12) and *panniers for bicycles* (Class 12)
- *Glasses* (Class 9) and *cases for glasses* (Class 9).

4.4 Installation, Maintenance and Repair Services

These services belong to the category of goods-related services.

Since, by nature, goods and services are dissimilar, similarity between goods and their installation, maintenance and repair can only be established when:

- it is common in the relevant market sector for the manufacturer of the goods to also provide such services; **and**
- the relevant public coincides; **and**
- installation, maintenance and repair of these goods are provided independently of the purchase of the goods (not aftersales services).

The installation of virtually all goods is classified in Class 37, such as *installation of air conditioning apparatus, consumer electric appliances, elevators or lifts, fire alarms, freezing machines, kitchen appliances*. The *installation and repair of computer hardware* is also in Class 37, as it is a physical repair and installation activity. However, *installation and repair of computer software* is classified in Class 42 because it involves computer programming without any physical installation or repair.

Examples of similarity

- *Data processing equipment and computers* (Class 9) and *installation and repair of computer hardware* (Class 37)
- *Air conditioning apparatus* (Class 11) and *installation, maintenance and repair of air conditioning apparatus* (Class 37)
- *Machinery for working metal* (Class 7) and *maintenance of machinery* (Class 37).

Examples of dissimilarity

- *Building materials* (Class 19) and *installation of building insulation* (Class 37)
- *Shoes* (Class 25) and *repair of shoes* (Class 37)
- *Vehicles* (Class 12) and *dent removal for motor vehicles* (Class 37) (15/12/2010, T-451/09, Wind, EU:T:2010:522, § 28-30).

4.5 Advisory, Consultancy and Information Services

Advisory services refer to providing advice that is tailored to the circumstances or needs of a particular user and that recommends specific courses of action for the user. *Provision of information*, however, refers to providing a user with materials (general or specific) about a matter or service but not advising the user on specific courses of action. With the 8th edition of the Nice Classification, *professional consultation services*

in Class 42 were eliminated. Since then consultation services — as well as *advisory and information services* — have been classified in the class of the service that corresponds to the subject matter of the consultation. For instance, *transportation consultancy* belongs to Class 39, *business management consultancy* falls under Class 35, *financial consultancy* is classified in Class 36 and *beauty consultancy* in Class 44. The rendering of the advice, information or consultancy by electronic means (e.g. telephone, computer) does not affect the classification of these services.

Advisory, consultancy and information services are covered by the services to which they relate, insofar as they are an inherent part thereof.

However, if the advisory, consultancy or information services are not provided by the same undertaking, they may only be similar if they are complementary and target the same public through the same channels of distribution, and may even be dissimilar if they do not share any relevant factors.

Examples

- Financial information services (Class 36) are included in *financial affairs* (Class 36) and are thus identical (27/02/2008, T-325/04, Worldlink, EU:T:2008:51, § 58).
- Computer software advisory services (Class 42) are similar to the installation and maintenance of software (Class 42) because, although they may not necessarily be included in installation and maintenance of software, they are often complementary.

When it comes to comparing advisory, consultancy and information services with goods, similarity can be found under conditions akin to those concerning maintenance, installation and repair (see paragraph 4.4).

Examples of similarity

- *Advisory services in computer technologies (hardware and software)* (Class 42) and *computer software* (Class 9)
- *Beauty consultancy* (Class 44) and *cosmetics* (Class 3).

Examples of dissimilarity

- *Information services concerning the purchase of fashion articles (shoppers guide information)* (Class 35) and *clothing, footwear and headgear* (Class 25), as it is not common in the market for the manufacturer of articles in Class 25 to provide such information services to consumers.
- *Providing information in the field of entertainment* (Class 41) and *toys* (Class 28), as it is not common in the market for the manufacturer of toys in Class 28 to provide such information services to consumers.

4.6 Rental and Leasing

Rental services are classified in the same classes as the service provided by means of the rented objects:

- *rental of telephones* is in Class 38 because *telecommunication services* are in Class 38;

- *rental of cars* is in Class 39 because *transport services* are in this class.

Leasing services are analogous to rental services and therefore are classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.

Based on the understanding that *leasing* in English means rental, these services must be clearly distinguished from any financial services. The comparison of rental and leasing services leads to the outcomes shown in the following paragraphs.

4.6.1 Rental/leasing versus related services

Even though rental services are classified in the same classes as the service provided by means of the rented objects, they are not automatically identical to this service. The comparison between these services has to be made applying normal criteria for identity and similarity.

Examples

- There is identity between *rental of flats* (Class 36) and *real estate affairs* (Class 36) because *rental of flats* is included in *real estate affairs*.
- The same reasoning cannot apply to *rental of bulldozers* (Class 37) and the related services of *building construction* (Class 37). *Rental of bulldozers* is not included in *building construction* and therefore these services are not considered to be identical.

4.6.2 Rental/leasing versus goods

Rental/leasing services are in principle always dissimilar to the goods rented/leased.

Examples

- *Vehicle rental* (Class 39) and *vehicles* (Class 12)
- *Rental of films* (Class 41) and *DVDs* (Class 9).

Exceptions exist where it is common for the manufacturer of the goods to provide rental services.

- *Rental and leasing of computer software* (Class 42) and *computer software* (Class 9) are considered to be similar.
- *Rental of automatic vending machines* (Class 35) and *automatic vending machines* (Class 7) are considered to be similar.

4.7 Examples of unclear and imprecise terms

General indications of class headings, from current and previous editions of the Nice Classification (the part shown in bold is the part which is seen as unclear and imprecise):

Class 6: **Goods of common metal not included in other classes**

Class 7: **Machines** and machine tools

Class 14: *Precious metals and their alloys and **goods in precious metals or coated therewith**, not included in other classes*

Class 16: *Paper, cardboard and **goods made from these materials [paper and cardboard]**, not included in other classes*

Class 17: *Rubber, gutta-percha, gum, asbestos, mica and **goods made from these materials [rubber, gutta-percha, gum, asbestos and mica]** and not included in other classes*

Class 18: *Leather and imitations of leather, and **goods made of these materials [leather and imitations of leather]** and not included in other classes*

Class 20: ***Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics***

Class 37: ***Repair***

Class 37: ***Installation services***

Class 40: ***Treatment of materials***

Class 45: ***Personal and social services rendered by others to meet the needs of individuals.***

Other terms lacking clarity and precision, regardless of the class for which they have been applied:

- *Merchandising articles*
- *Fair-trade goods*
- *Lifestyle accessories*
- *Gift articles*
- *Souvenirs*
- *Collectors' articles*
- *Housewares*
- *Electronic goods (01/12/2016, T-775/15, Ferli, EU:T:2016:699), electric/electronic apparatus/instruments*
- *Gadgets (electronic or not)*
- *Hobby articles*
- *Advertising articles*
- *Memorabilia*
- *Wellness goods*
- *Association services*

5 Annex II: Specific Industries

5.1 Chemicals, Pharmaceuticals and Cosmetics

5.1.1 Chemicals (Class 1) versus chemical products (Classes 3 and 5)

Although major chemical companies are usually involved in the production of all kinds of basic chemicals, speciality chemicals and life science products, including pharmaceuticals and pesticides, as well as consumer products, such as cleaning preparations and cosmetics, the mere fact that their nature coincides — as all of them can be broadly classified as chemical products — is not sufficient to find them similar. Special attention must be drawn to the specific purpose of these chemicals, as well as to their public and distribution channel. What has been said in paragraph 4.2 as to the relation between raw materials, semi-processed and finished products particularly applies to these products.

Consequently, although goods in Class 3 and Class 5 are usually combinations of various chemicals, they are in principle not considered similar to goods included in Class 1. Their purpose as a finished product usually differs from goods in Class 1, which are mainly in their raw, unfinished state and not yet mixed with other chemicals and inert carriers into a final product. The finished products in Class 3 and Class 5 usually also target a different public and do not share the same distribution channels.

However, it cannot be excluded that goods such as *chemicals used in agriculture, horticulture and forestry* require few processing steps to be considered finished products, such as *fungicides*. Such chemicals may be considered to already share the inherent purpose of *fungicides*: to kill or inhibit fungi or fungal spores, in particular when they consist of the fungicide's active ingredient. Furthermore, the same (agro-)chemical companies may produce the semi-processed goods, as well as the final product. There is therefore a low degree of similarity between *chemicals used in agriculture, horticulture and forestry* and *fungicides* (08/10/2013, R 1631/2012-1, QUALY / QUALIDATE, § 27-28).

Furthermore, there are also goods in Class 1 that are not mere chemicals but are semi-finished or even finished products with a specific purpose of use, which is an important factor that must be taken into account when comparing goods in Class 1 with goods in other classes.

For example *manures* in Class 1 on the one hand and *pesticides, fungicides and herbicides* in Class 5 on the other are not only chemical products but also finished products with a specific use in the agricultural industry. They therefore have a similar purpose since the specific goods in Class 5 can be considered growth-enhancing by preventing conditions that could inhibit plant growth. As such they are similar to a low degree.

5.1.2 Pharmaceuticals versus pharmaceuticals

A pharmaceutical preparation refers to any kind of medicine, that is to say, a substance or combination of substances for treating or preventing diseases in human beings or animals. From its definition it can already be concluded that *veterinary preparations* — though separately mentioned in the class heading — are included in the broader term of *pharmaceutical preparations*. Therefore, they are identical.

The same applies to herbal and homoeopathic medicines since they are included in the broad term of *pharmaceutical preparations*.

Equally, testing preparations, that is to say, chemical reagents for medical — including veterinary — purposes, also fall under the general indication of *pharmaceutical preparations*.

Specific pharmaceuticals are considered to be similar to other specific pharmaceuticals. This is because several, if not all, criteria for similarity are usually met: they share the same nature because they are specific chemical products; their purpose is, broadly speaking, healing and/or curing; they are sold in the same places, namely, pharmacies; and they come from the same source, which is the pharmaceutical industry. This industry manufactures a wide variety of drugs with various therapeutic indications, something the general public is aware of. Furthermore, their method of use can be the same and they can be in competition with one another (17/11/2005, T-154/03, Alrex, EU:T:2005:401, § 48).

However, the degree of similarity found between specific pharmaceuticals may vary depending on their specific therapeutic indications.

Example 1

- *Sedatives versus pain killers*. These pharmaceuticals are highly similar.

Example 2

- *Anti-epileptics versus pharmaceutical preparations, except medicines to combat diseases in connection with the central nervous system*. These pharmaceutical preparations are considered to be similar (24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 24-25).

Example 3

- *Cardiovascular preparations versus pharmaceutical preparations for the treatment of central nervous system [CNS] diseases*. These pharmaceutical preparations are only similar to a low degree. In this regard, it should be noted that a low degree of similarity should only be established in exceptional cases, for example, when it can be clearly established that they have different therapeutic indications and different methods of use.

Whether a specific pharmaceutical is sold under prescription is not of particular relevance for the comparison of the goods. Therefore, a prescription medicine is generally to be considered similar to an over-the-counter drug for the reasons stated above. (For information on the relevant public and the degree of attention in relation to

pharmaceuticals, see the Guidelines, Part C, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention.)

5.1.3 Pharmaceuticals versus dietetic substances adapted for medical use

Dietetic substances and food supplements adapted for medical use are substances prepared for special dietary requirements with the purpose of treating or preventing a disease. Bearing this in mind, their purpose is similar to that of *pharmaceutical products* (substances used in the treatment of diseases) insofar as they are used to improve a patient's health. The relevant public coincides and the goods generally share the same distribution channels. For the above reasons, these goods are considered to be similar.

5.1.4 Pharmaceuticals versus cosmetics

The general categories *pharmaceuticals* and *cosmetics* are considered to be similar. Cosmetics include preparations used to enhance or protect the appearance or odour of the human body and they are also often fragranced to add a pleasant smell. Pharmaceuticals, however, comprise products, such as skin or haircare preparations with medical properties. They may coincide in purpose with cosmetics. Moreover, they share the same distribution channels since they can be found in pharmacies or other specialised shops. They target the same public and are often manufactured by the same companies.

However, when comparing specific pharmaceuticals with cosmetics, they may only show a low degree of similarity or they may even be entirely dissimilar, depending on the specific drug and its specific purpose (medical indication/effect) or its method of use.

Example

- A *painkiller* is dissimilar to *nail polish*.

5.1.5 Pharmaceuticals versus services

With regard to the link between, on the one hand, *pharmaceutical products* in Class 5 and, on the other, *scientific and technological services and research* including, for example, biological and pharmaceutical research, it is known that pharmaceutical companies often try to improve their products through research, development and innovation. The fact that pharmaceutical companies do not generally provide such services to third parties does not preclude them from doing so. Therefore, it cannot be ruled out that the relevant public may believe that the same company is responsible for both the manufacturing of the pharmaceutical products and the research services, or that a company offering the services in question is economically linked to the manufacturing company. Moreover, pharmaceutical companies promote and administer pharmaceutical studies for consumers and undertake research and development in cooperation with third parties. The relevant public for these goods and services

overlaps insofar as professionals are concerned as they can be both users of the services and users of pharmaceutical products. Therefore, there is similarity between these goods and services due to the close connection between them (14/06/2018, T-165/17, EMCURE / Emcur et al., EU:T:2018:346, § 47, 49-51).

Medical services in Class 44 and pharmaceutical products in Class 5 are aimed at the same consumers, namely both professionals and the general public, and they pursue the same aim of treating disease. In hospitals, medical services often include the administration of pharmaceuticals. Food supplements may be sold in pharmacies, which offer healthcare services and advice. Similarly, veterinary services may also include the administration of veterinary products, and dentistry services may provide preparations for healthcare and pharmaceutical products. Thus, these goods and services may share the same distribution channels. Finally, these goods and services may be complementary insofar as the services are important or even indispensable for use of the goods. In particular, the provision of medical services may necessarily require the administration of pharmaceutical products. For this reason, the relevant public may believe that the same undertaking is responsible for both manufacturing the goods and providing the services. Taking all of the above factors into account, there is similarity between these goods and services (14/06/2018, T-165/17, EMCURE / Emcur et al., EU:T:2018:346, § 56-57, 60-62).

5.1.6 Medical and veterinary apparatus and instruments (Class 10) versus healthcare services (Class 44)

The same reasoning as above can be applied by analogy to *medical and veterinary apparatus and instruments, prosthetics and artificial implants, orthopaedic and mobility aids, and physical therapy equipment* in Class 10. These goods may also be complementary to *healthcare services* in Class 44, such as medical services, dentistry, and the services of hospitals and/or nursing homes, as the apparatus and instruments in Class 10 can be indispensable for carrying out said healthcare services. These goods and services are also aimed at the same public and serve the same purpose. Consequently, they are similar (18/10/2007, T-425/03, AMS Advanced Medical Services, EU:T:2007:311, § 64-66).

5.2 Automobile Industry

The automobile industry is a complex industry involving various kinds of companies, including car manufacturing companies as well as any suppliers that provide the car manufacturer with their raw materials (metal, aluminium, plastics, paints, etc.), parts, modules or complete systems. Several areas of production can be distinguished: drive engineering, chassis, electronics, interior and exterior.

The complexity of the industry and the fact that the final product incorporates some component parts and accessories complicate the examination of similarity between the end product (e.g. a car) and the various parts or materials used for its production. Furthermore, when purchasing a car, the general public knows that a car incorporates

many items from many sources and that the car manufacturer might assemble components that have been manufactured by others. However, as far as the consumer of a car is concerned, the goods are normally offered under only one sign, which makes it almost impossible for the general public to identify other manufacturers or to differentiate their source of production. Exceptions include car batteries or tyres, where other signs are usually visible.

As with other industries, the Canon criteria accordingly apply and in particular the general principles set out for the comparison of parts, components, and fittings have to be taken into consideration.

In particular, it should be kept in mind that there are goods that will only be purchased by the automobile industry without any possibility of them ever reaching or being purchased by the general public (end consumer). One example is the common metal (Class 6) used to form the chassis. Such goods are clearly dissimilar to the car and probably dissimilar to all other parts, components and fittings. However, there are spare parts that might also be purchased by the general public for repair or maintenance purposes. Assessment of the similarity of these goods will mainly depend on whether the specific spare part is commonly produced by the car manufacturer.

5.3 Electric Apparatus/Instruments

The expression *electric apparatus and instruments* in Class 9 is an unclear or imprecise term as described in paragraph 1.5.2. The relevant scope, and should be treated accordingly.

5.4 Fashion and Textile Industries

Goods classified in Classes 22, 23, 24 and 25 are textile related. There is a certain progression through these classes: *raw fibrous textile materials*, such as *fibres* (Class 22), are further made into *yarns and threads* (Class 23), then into *textiles*, such as *fabrics* (Class 24), and end up as *finished goods made of textile* (Class 24) or *clothing* (Class 25).

Moreover, Class 18 goods that are made of leather and/or imitations of leather are also related to the fashion and textile industries.

5.4.1 Raw or semi-processed materials versus finished goods

Since the relationship between Classes 22, 23, 24 and 25 is often based on the fact that one product is used for the manufacture of another (e.g. *textiles* in Class 24 are used for the manufacture of *clothing* in Class 25), in comparisons of this kind, general rules concerning raw materials apply (see Annex I, paragraph 4.2).

For example, raw materials such as *leather and imitations of leather, animal skins and hides* (Class 18) are dissimilar to clothing, footwear and headgear (Class 25). The

mere fact that leather is used for the manufacture of footwear (shoes made of leather) is not sufficient in itself to conclude that the goods are similar, as their nature, purpose and relevant public are quite distinct: raw materials are intended for use in industry rather than for direct purchase by the final consumer.

However, a low degree of similarity is found between *textiles* and *textile goods* such as *bed sheets* and *table covers*, in Class 24. In such cases, the degree of transformation required from material to end product is often insignificant: the fabric is merely cut into shape and/or sewn to obtain the finished product. Furthermore, many establishments allow customers to purchase the base material or ready-made cushions, etc. made from such material. Therefore, the relevant public may expect these goods to come from the same undertakings.

5.4.2 Textile goods (Class 24) versus clothing (Class 25)

When comparing *textile goods* in Class 24 with *clothing* in Class 25 it has to be considered that most items covered by *textile goods* in Class 24 are dissimilar to most items of *clothing* in Class 25 (for example *bed linen* in Class 24 and *skirts* in Class 25). The main commonality between them is that they are all made of textile, however they serve, in principle, completely different purposes: items of clothing are meant to be worn by people, or serve as fashion articles, whereas diverse textile goods are mainly for household purposes and interior decoration. Therefore, their method of use is different. Moreover, the distribution channels and sales outlets are different, and the relevant public will not think that they originate from the same undertaking.

However, some specific textile goods may be found similar to specific items of clothing. For example, *bath towels* in Class 24 and *bathrobes* in Class 25 are similar because these both sets of goods aim to absorb moisture from wet skin, they have a similar nature, purpose and are in competition. Additionally, the producers, distribution channels and end users may be the same (12/07/2019, T-54/18, 1st AMERICAN (fig.) / DEVICE OF A BIRD (fig.), EU:T:2019:518, § 72 and 73; 09/09/2020, T-50/19, Dayaday (fig.) / DAYADAY (fig.) et al, ECLI:EU:T:2020:407, § 128).

In view of the fact that *bathrobes* are included in the broad category of *clothing* (09/09/2020, T-50/19, Dayaday (fig.) / DAYADAY (fig.) et al, ECLI:EU:T:2020:407, § 128.) and *bath towels* are included in the broad category of *textile goods*, similarity must also be found between the broad categories of *textile goods* in Class 24 and *clothing* in Class 25.

Other specific textile goods may also be found similar to specific items of clothing if the same or similar circumstances apply to those specific goods; this needs to be assessed on a case-by-case basis.

5.4.3 Clothing, footwear and headgear (Class 25)

Class 25 goods, namely *clothing, footwear and headgear*, are of an identical or very similar nature. They serve the same purpose since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion

and are often found in the same retail outlets. Consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce all of the aforementioned items. Therefore, these goods are similar to each other.

5.4.4 Fashion accessories

As explained in the paragraph on ‘Accessories’ (see Annex I, paragraph 4.3), the mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity. However, it is common for some accessories to be produced by the manufacturer of the main product – at least the consumer might expect them to be produced under the control of the same entity. Furthermore, they can be distributed through the same trade channels. In such cases, there is a strong indication for similarity.

Goods such as (hand)bags, sports bags, briefcases, purses, in Class 18 are related to articles of *clothing, headgear and footwear* in Class 25, in the sense that they are likely to be considered by consumers as aesthetically complementary accessories to articles of outer clothing, headgear and even footwear. They are closely coordinated with these articles and may well be distributed by the same or linked manufacturers, and it is not unusual for clothing manufacturers to directly produce and market them. Moreover, these goods can be found in the same retail outlets. Therefore, these goods are considered to be similar to *clothing, headgear and footwear* (27/09/2012, T-39/10, Pucci, EU:T:2012:502, § 76).

In contrast, hair accessories such as *hair pins* and *ribbons* are dissimilar to *clothing*. Even though these goods might have some distant link to the fashion market, the mere fact that someone might want to match hair pins and clothing is not sufficient to conclude that these goods are complementary and therefore similar. The goods can only be considered to be complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other and is not merely ancillary. In the present case, these conditions are not fulfilled. Furthermore, the nature and method of use of these goods is different. They are not in competition with each other. The production of these goods involves different know-how, they do not belong to the same category of goods and they are not regarded as components of a general array of goods that potentially have the same commercial origin (03/10/2011, R 1501/2010-4, Wild Nature (fig.) / WILD NATURE, § 18).

Likewise, luxury goods such as glasses (Class 9) and jewellery (Class 14) are considered to be dissimilar to clothing, footwear and headgear. The nature and the main purpose of these goods are different. The main function of clothing is to dress the human body whilst the main purpose of glasses is to improve eyesight, and jewels are worn for personal adornment. They do not have the same distribution channels and they are neither in competition nor complementary (30/05/2011, R 106/2007-4, OPSEVEN2 / 7SEVEN (fig.), SEVEN (fig.), § 14; 12/09/2008, R 274/2008-1, Penalty / PENALTY, § 20; 05/10/2011, R 227/2011-2, OCTOPUSSY / OCTOPUSSY (fig.) et al., § 23-26).

The same reasoning applies to luxury goods, such as perfumes (Class 3) — the main purpose of which is to impart a long-lasting scent to the body, stationery, etc. — and goods such as travelling bags (Class 18), which are intended for carrying things when travelling. Even though nowadays, designers also sell perfumes, fashion accessories (such as glasses and jewellery) and travel accessories under their marks, this is not the rule, and rather applies only to (economically) successful designers.

5.4.5 Sports clothing, footwear and headgear (Class 25) versus sporting and gymnastic articles (Class 28)

The general category of *clothing, footwear and headgear* includes sports clothing, footwear and headgear, which are garments or items of apparel designed specifically to be used when performing an activity or sport. Although the nature of these goods is different from those of *sporting and gymnastic articles*, which are articles and apparatus for all types of sports and gymnastics, such as weights, halters, tennis rackets, balls and fitness apparatus, there are undertakings that manufacture both *sporting and gymnastic articles* as well as *sports clothing/sports footwear*. Therefore, the distribution channels can be the same. There is a low degree of similarity when *sports clothing/sports footwear* is compared with *sporting and gymnastic articles*.

5.4.6 Fashion design (Class 42) and tailoring services (Class 40) versus clothing (Class 25)

There is a low degree of similarity between *clothing* and *fashion design* and *tailoring* services since they share the same relevant public and might coincide in the same usual origin (producer/provider). Producers of ready-made clothing (especially suits and wedding dresses) frequently provide *tailoring* services, which are closely related to *fashion design*, which is an earlier step in the clothing production process.

5.5 Food, Beverages and Restaurant Services

5.5.1 Ingredients of prepared food

Ingredients used for the preparation of foodstuffs are a subcategory of raw materials and treated in the same way as raw materials in general. Consequently, the mere fact that one ingredient is needed for the preparation of a foodstuff will generally not be sufficient in itself to show that the goods are similar, even though they all fall under the general category of foodstuffs (26/10/2011, T-72/10, Naty's, EU:T:2011:635, § 35-36).

Examples of dissimilarity

- *Eggs* (Class 29) and *ice cream* (Class 30)
- *Yeast* (Class 30) and *bread* (Class 30).

5.5.2 Main ingredient

When the ingredient can be considered as being the main ingredient of the prepared dish, a similarity will exist only if the goods share some other relevant criterion or criteria, in particular the usual origin, nature, purpose or method of use.

Examples of similarity (main ingredient plus other criteria)

- *Milk* (Class 29) and *yoghurt* (Class 29)
- *Fish* (Class 29) and *fish sticks* (Class 29)
- *Dough* (Class 30) and *pizzas* (Class 30).

See also the judgment of the General Court of 04/05/2011, T-129/09, *Apetito*, EU:T:2011:193, where the Court confirms the finding of similarity between a particular foodstuff and prepared meals **mainly** consisting of the same particular foodstuff.

There is no complementarity in such cases simply because one ingredient is needed for the production/preparation of another foodstuff. Complementarity applies only to the use of goods and not to their production process (see paragraph 3.2.4 and 11/05/2011, T-74/10, *Flaco*, EU:T:2011:207, § 40; 11/12/2012, R 2571/2011-2, *FRUITINI*, § 18).

5.5.3 Non-alcoholic beverages (Class 32) versus alcoholic beverages (except beers) (Class 33)

In Case T-150/17 of 04/10/2018, *FLÜGEL / ... VERLEIHT FLÜGEL et al.*, EU:T:2018:641, § 77-84, the Court found that a very large number of alcoholic and non-alcoholic drinks are generally mixed, consumed, or indeed marketed together, either in the same establishments or as premixed alcoholic drinks. To consider that those goods should, for that reason alone, be described as similar, when they are not intended to be consumed in either the same circumstances, or in the same state of mind, or, as the case may be, by the same consumers, would put a large number of goods which can be described as 'drinks' into one and the same category for the purposes of the application of Article 8(1) EUTMR.

Thus, it cannot be considered that an alcoholic drink and an energy drink are similar merely because they can be mixed, consumed or marketed together, given that the nature, intended purpose and use of those goods differ, based on the presence of, or absence of alcohol in their composition ... Furthermore, it must be held that the undertakings which market alcoholic drinks premixed with a non-alcoholic ingredient do not sell that ingredient separately and under the same or a similar mark as the premixed alcoholic drink at issue'.

Therefore, most non-alcoholic drinks in Class 32 are considered to be dissimilar to most alcoholic drinks in Class 33 (see also Grand Board of Appeal decision R 1720/2017-G of 21/01/2019 in which, for example, mineral water, soft drinks and fruit juices were found to be dissimilar to vodka).

However, some specific non-alcoholic drinks may be similar to some specific alcoholic drinks. For example, *alcohol free wine* and *de-alcoholised wine* in Class 32 and *wine* in Class 33. There is a growing trend in the drinks market sector for winemaking

companies to also produce and offer non-alcoholic wine as an alternative to alcoholic wine. Indeed, non-alcoholic wine often goes through the same fermentation and ageing process as alcoholic wine, only to have the alcohol removed at the last stages (either through distillation or filtration). Furthermore, non-alcoholic wine is intended to be consumed in the same circumstances as alcoholic wine by consumers who cannot, or choose not to, consume alcohol. Since consumers will perceive them as alternative products they must also be considered to be in competition. In addition, it is not uncommon for non-alcoholic wine to be sold in wine shops or specialised wine sections in supermarkets. It follows that *non-alcoholic wine* is similar to *wine*. As a result, similarity must also be found between the broader categories of *non-alcoholic beverages* in Class 32 and *alcoholic beverages (except beers)* in Class 33, which include those specific goods respectively. Other specific non-alcoholic drinks may be found similar to specific alcoholic drinks if the same or similar circumstances apply to those specific goods; this needs to be assessed on a case-by-case basis.

5.5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)

There is a similarity between different alcoholic beverages in Class 33, as well as between the broad category of *alcoholic beverages* and *beer* in Class 32. Although their production processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if some distinction according to their respective subcategory can be made. Furthermore, some alcoholic beverages may originate from the same undertakings.

Examples

- *Beers* are similar to *alcoholic beverages (except beers)*
- *Wines* are similar to *alcoholic beverages (except wines)*.

5.5.5 Provision of food and drinks versus food and drinks

The provision of food and drinks in Class 43 mainly covers services of a restaurant or similar services, such as catering, cafeterias and snack bars. These services are intended for serving food and drinks directly for consumption.

The mere fact that food and drinks are consumed in a restaurant is not sufficient reason to find similarity between them (09/03/2005, T-33/03, Hai, EU:T:2005:89, § 45; 20/10/2011, R 1976/2010-4, THAI SPA / SPA et al., § 24-26).

Nevertheless, in certain situations these goods and services can be complementary (04/06/2015, T-562/14, YOO/ YO, EU:T:2015:363, § 25, 27; 17/03/2015, T-611/11, Manea Spa, EU:T:2015:152, § 52; 15/02/2011, T-213/09, Yorma's, EU:T:2011:37, § 46). As shown in paragraph 3.2.4, goods/services are complementary if one is indispensable or important for the use of the other in such a way that consumers may think that responsibility for the production of those goods or the provision of those services lies with the same undertaking.

The mere fact that food and/or drinks are essential to the services of restaurants, bars, cafeterias, etc. does not in itself lead consumers to think that responsibility for the production of those goods and provision of those services lies with the same undertaking (e.g. salt in restaurants).

However, consumers may think that responsibility does lie with the same undertaking if the market reality is that the provision of food and drinks and the manufacture of such goods are commonly offered by the same undertaking under the same trade mark (e.g. coffee in their coffee shops, ice cream in their ice cream parlours, beer in pubs). In such cases, there is a low degree of similarity.

5.6 Services to Support Other Businesses

All services listed in the class heading of Class 35 are aimed at supporting or helping other businesses to do or improve business. They are therefore in principle directed at the professional public.

When comparing specific services falling within Class 35 it is very useful to focus on the question: who is providing this kind of service? Is it an advertising agency, a management consultant, a human resources consultant, an accountant, an auditor, a sales agent or a tax advisor? Once the usual origin has been established, it is easier to find the general indication to which the specific service belongs.

Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client's position in the market and enabling them to acquire a competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by advertising companies, which study their client's needs, provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc.

Examples of advertising services are *rental of advertising time on communication media, telemarketing services, marketing, public relations and demonstration of goods*, since they are all intended to promote other companies' goods/services, albeit via different means.

However, when compared to the *organization of trade fairs for commercial or advertising purposes*, the latter consist of the arrangement of events, presentations, exhibitions or trade fairs to facilitate or encourage the promotion and sale of the client's goods and services. These services are normally provided by specialised companies in their specific field. As such, the services in question are to be considered similar to *advertising services* since these could be offered to third parties in the form of the organisation, arranging and conducting of an exhibition or trade fair on their behalf (01/12/2014, R 557/2014-2, TRITON WATER (fig.) / TRITON COATINGS TRITON (fig.) et al., § 31).

Example

Marketing research is the collection and analysis of information about a particular market to assess the viability of a product or service.

The nature and purpose of advertising services are fundamentally different from the manufacture of goods or from the provision of many other services. Therefore, advertising is generally dissimilar to the goods/services being advertised. The same applies to the comparison of advertising services with goods that can be used as a medium for disseminating advertising, such as DVDs, software, printed matter, flyers and catalogues.

Management services are in Class 35 when they relate to the business aspects of an entity. As there are management services in other classes, a management service in Class 35 is taken to relate to business purposes.

Business management services are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. They are usually rendered by companies specialised in this specific field such as business consultants. They gather information and provide tools and expertise to enable their customers to carry out their business or to provide businesses with the necessary support to acquire, develop and expand their market share.

Examples of business management are business research and appraisals, cost-price analyses and organisation consultancy, since they are all intended to help with the strategy of a commercial undertaking. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the management of a business, such as how to efficiently allocate financial and human resources, improve productivity, increase market share, deal with competitors, reduce tax bills, develop new products, communicate with the public, carry out marketing, research consumer trends, and launch new products; how to create a corporate identity, etc.

Examples

Business research is the analysis and interpretation of economic information, such as income, employment, taxes, and demographics. This research information is used by entrepreneurs for making business decisions such as establishing marketing strategies.

Business appraisals involve an investigation into the nature and potential of a business and an assessment of its performance in relation to its competitors.

A *cost-price analysis* is a combination of both an evaluation of the proposed total price of a project and the cost of the separate elements of that project (e.g. labour, materials) to determine if they are permissible, related to the project requirements and reasonable. It is used to determine whether going ahead with a project is a sound business decision. It is therefore considered as a service that helps with the management of the business affairs or commercial functions of an industrial or commercial enterprise. Using the information gained from a cost-price analysis, a business may then go on to make the financial decisions associated with engaging in the project.

When comparing *business management* with *advertising* it should be noted that advertising is an essential tool in business management because it makes the business itself known in the market. As stated above, the purpose of advertising services is 'to reinforce the [business] position in the market' and the purpose of business management services is to help a business in 'acquiring, developing and expanding market share'. There is not a clear-cut difference between 'reinforcing a business position in the market' and 'helping a business to develop and expand market share'. A professional who offers advice about how to efficiently run a business may reasonably include advertising strategies in that advice because there is little doubt that advertising plays an essential role in business management. Furthermore, business consultants may offer advertising (and marketing) consultancy as a part of their services, and therefore the relevant public may believe that these two services have the same professional origin. Consequently, considering the above, these services are similar to a low degree (22/11/2011, R 2163/2010-1, INNOGAME / INNOGAMES, § 13-17). This clear link between the two services also follows from the definitions given above of marketing research (an advertising service) and business research (a business management service).

Business administration services are intended to help companies with the performance of business operations and, therefore, the interpretation and implementation of the policy set by an organisation's board of directors. These services consist of organising people and resources efficiently so as to direct activities toward common goals and objectives. They include activities such as personnel recruitment, payroll preparation, drawing up account statements and tax preparation, since these enable a business to perform its business functions and are usually carried out by an entity that is separate from the business in question. They are rendered by, inter alia, employment agencies, auditors and outsourcing companies.

Example

Business auditing involves the evaluation of a variety of business activities. It encompasses a review of organisational structures, management, processes, etc.

When comparing *business administration* to *advertising* it should be noted that these services are usually dissimilar, since a professional who helps with the execution of business decisions or the performance of business operations will not offer advertising strategies.

The line between *business management* and *business administration* is blurred, and it is sometimes very difficult to clearly distinguish between them. They both fall under the broader category of business services. As a general rule, it can be said that business administration services are performed in order to organise and run a business, whereas business management follows a higher approach aimed at setting the common goals and the strategic plan for a commercial enterprise.

Office functions are the internal day-to-day operations of an organisation, including the administration and support services in the 'back office'. They mainly cover activities that assist in the operation of a commercial enterprise. They include activities typical of secretarial services, such as shorthand and typing, compilation of information in

computer databases, invoicing, and administrative processing of purchase orders, as well as support services, such as the rental of office machines and equipment.

Example

Book-keeping is the act of recording financial transactions.

5.7 Retail Services

Retail is commonly defined as the action or business of selling goods or commodities in relatively small quantities for use or consumption rather than for resale (as opposed to wholesale, which is the sale of commodities in quantity, usually for resale).

However, it should be noted that the sale of goods is not a service within the meaning of the Nice Classification. Therefore, the activity of retail in goods as a service for which protection of an EUTM can be obtained does not consist of the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are defined in the explanatory note to Class 35 of the Nice Classification by the terms ‘the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods’.

Moreover, the Court has held that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, *inter alia*, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor (07/07/2005, C-418/02, *Praktiker*, EU:C:2005:425, § 34).

Retail services allow consumers to satisfy different shopping needs in one place and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order.

The following principles apply as regards the similarity of the goods/services at issue.

5.7.1 Retail services versus any good

Retail services in general ⁽⁴³⁾ (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

5.7.2 Retail services of goods versus goods

In relation to retail services of specific goods, the similarity, or the lack thereof, between the goods to which the retail services relate and the goods themselves constitute an

⁴³ ‘Retail services’ as such are not acceptable for classification purposes by the Office, unless further specified (see the Guidelines, Part B, Examination, Section 3, Classification).

essential factor which needs to be taken into account. Retail services of specific goods can be similar to varying degrees, or dissimilar to specific goods depending on the degree of similarity between the goods themselves, but also taking into account other relevant factors.

5.7.2.1 Retail services of specific goods versus the same specific goods

Retail services concerning the sale of specific goods are similar to an average degree to these specific goods (20/03/2018, T-390/16, DONTORO dog friendship (fig.)/TORO et al., EU:T:2018:156, § 33; 07/10/2015, T-365/14, TRECOLORE / FRECCIE TRICOLORI et al., EU:T:2015:763, § 34). Although the nature, purpose and method of use of these goods and services are not the same, it should be noted that they display similarities, having regard to the fact that they are complementary and that the services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they are directed at the same public.

The goods covered by the retail services and the specific goods covered by the other mark have to be identical in order to find an average degree of similarity between the retail services of those goods and the goods themselves, that is to say, they must either be exactly the same goods or fall under the natural and usual meaning of the category.

Examples of an average degree of similarity

- *Retail of sunglasses v sunglasses* (the goods themselves are identical).
- *Retail of optical goods v sunglasses* (the goods themselves are identical).

5.7.2.2 Retail services of specific goods versus similar specific goods

There is a low degree of similarity between the retail services concerning specific goods and other specific similar or highly similar goods, because of the close connection between them on the market from the perspective of the consumer. Consumers are accustomed to the practice that a variety of similar or highly similar goods are brought together and offered for sale in the same specialised shops or in the same sections of department stores or supermarkets. Furthermore, they are of interest to the same consumer.

A low degree of similarity between the goods sold at retail and the goods themselves may also be sufficient to lead to a finding of a low degree of similarity with the retail services provided that the goods involved are commonly offered for sale in the same specialised shops or in the same sections of department stores or supermarkets, belong to the same market sector and, therefore, are of interest to the same consumer.

Such goods and services are dissimilar, when the goods at issue are not offered in the same places, do not belong to the same market sector and target a different consumer.

Examples of a low degree of similarity

- *Retail of sportswear v sports bags* (the goods themselves are highly similar).
- *Retail of clothing v headgear; footwear* (the goods themselves are similar).

- *Retail of computers v bags adapted for laptops* (the goods themselves are similar to a low degree, are commonly offered in the same specialised shops or in the same sections of department stores, and are of interest to the same consumer).

Example of dissimilarity

- *Retail of protective clothing v clothing* (the goods themselves pertaining to Classes 9 and 25 respectively are similar to a low degree, however, they are not commonly offered through the same channels of distribution and are of interest to different consumers).

5.7.2.3 Retail services of specific goods versus dissimilar specific goods

When goods sold at retail are dissimilar to the actual goods themselves, no similarity can be found between them.

Example of dissimilarity

- *Retail of furniture v pharmaceuticals*.

5.7.3 Retail services versus retail services or retail services of specific goods

Retail services in general (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

5.7.4 Retail services of specific goods versus retail services of other specific goods

Retail services of specific goods and retail services of other specific goods have the same nature as both are retail services, have the same purpose of allowing consumers to conveniently satisfy different shopping needs, and have the same method of use.

Similarity is found between the retail services of specific goods where the goods are commonly retailed together in the same outlets and they are directed at the same public. However, the degree of similarity between retail of specific goods on the one hand and retail of other specific goods on the other hand may vary depending on the proximity of the retailed goods and the particularities of the respective market sectors.

Similarity is, in principle, excluded where the goods concerned are not commonly retailed together and target different publics, or are dissimilar. Nevertheless, a degree of similarity may still be found if, because of the particularities of the market, such dissimilar goods are retailed together in the same outlets and target the same public.

Examples of similarity

- *Retail of clothing v Retail of handbags*.
- *Retail of computers v Retail of peripherals adapted for use with computers*.
- *Retail of distilled beverages v Retail of soft drinks* (despite the dissimilarity between the goods they are often retailed together and target the same public).

Example of dissimilarity

- *Retail of furniture v Retail of pharmaceuticals* (the goods are dissimilar, are not commonly retailed together and target different publics).

5.7.5 Services to which the same principles apply

The principles set out above in relation to retail services apply to the various services rendered that revolve exclusively around the actual sale of goods, such as **retail store services**, **wholesale services**, **internet shopping**, **catalogue or mail order services**, etc. (to the extent that these fall into Class 35).

5.7.6 Services to which the same principles do not apply

In contrast, the principles set out above in relation to retail services do not apply to other services that do not revolve exclusively around the sales of goods, or that do not fall into Class 35, such as **auctioneering services** (Class 35), **import and export services** (Class 35), **distribution and transport services** (Class 39) or **repair services** (Class 37), etc.

Example

- **Auctioneering services**

Auctions are public sales at which goods are sold to the highest bidder. Similarity between these services and the retail of specific products will only be found insofar as the retail services relate to goods that are commonly sold at auctions, such as objects of art.

Therefore, the specific retail or wholesale services of *pharmaceuticals, veterinary and sanitary preparations and medical supplies* for example, would be considered dissimilar to *auctioneering services*, since it is not common on the market for pharmaceuticals, etc. to be sold to the highest bidder.

Example

- **Import and export services**

Import and export services are not considered to be a sales service and thus cannot be subject to the same arguments as the comparison of goods with retail or wholesale services.

Import and export services relate to the movement of goods and normally require the involvement of customs authorities in both the country of import and the country of export. These services are often subject to import quotas, tariffs and trade agreements. While these services are aimed at supporting or helping other businesses to do business and are preparatory or ancillary to the commercialisation of goods, they do not relate to the actual retail or wholesale of the goods. For these reasons, goods are to be considered dissimilar to import and export services for those goods. The fact that the subject matter of the import/export services and the goods in question are the same is not a relevant factor for finding similarity.

Example

- *Import and export of tobacco products* (Class 35) is dissimilar to *tobacco products* (Class 34).

The judgment of 09/06/2010, T-138/09, Riojavina, EU:T:2010:226, is not followed, where a low degree of similarity was found between import/export of vinegar and wine.

5.8 Financial Services

Financial services concern the management of money, capital and/or credit and investments and are provided by the finance industry. The finance industry encompasses a broad range of organisations that deal with the management, investment, transfer, and lending of money. Among these organisations are, for example, banks, credit card companies, consumer finance companies, stock brokerages and investment funds.

5.8.1 Banking services (Class 36) versus insurance services (Class 36)

Providing *banking services* consists of the provision of all those services carried out for savings or commercial purposes concerning the receiving, lending, exchanging, investing and safeguarding of money, issuing of notes and transacting of other financial business.

Providing *insurance services* consists of accepting liability for certain risks and respective losses. Insurers usually provide monetary compensation and/or assistance in the event that a specified contingency occurs, such as death, accident, sickness, breaking of a contract or, in general, any event capable of causing damages.

Insurance services have different purposes from the services usually provided by banks, such as providing credit or asset management, credit card services, financial evaluation or stocks and bonds brokerage. Nevertheless, they have some significant aspects in common.

Insurance services are of a financial nature, and insurance companies are subject to licensing, supervision and solvency rules similarly to banks and other institutions providing financial services. Most banks also offer insurance services, including health insurance, or act as agents for insurance companies, with which they are often economically linked. Additionally, it is not unusual to see financial institutions and an insurance company in the same economic group.

Therefore, although *insurance services* and *banking services* have different purposes, they are of a similar nature, may be provided by the same undertaking or related undertakings and share the same distribution channels. These circumstances demonstrate that *insurance services* are similar to *banking services*.

5.8.2 Real estate affairs (Class 36) versus financial affairs (Class 36)

The term 'real estate affairs' comprises real estate property management and evaluation, and real estate agency services, as well as the consultancy and provision of related information. This mainly involves finding a property, making it available for potential buyers and acting as an intermediary. Consumers clearly distinguish real estate agents' services from those of financial institutions. They do not expect a bank to find housing or a real estate agent to manage their finances.

Financial and banking services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of managing their clients' funds and consist of, *inter alia*, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property. Furthermore, as regards the fact that the services in question might be found in the same distribution channels, it is clear that real estate services are not, in principle, provided on the same premises as financial services (17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 34-38).

Any other conclusion would mean that all non-financial transactions subject to funding would be complementary to a financial service. It must therefore be concluded that these services are dissimilar even if financial services are essential or important for the use of real estate. The consumers would not attribute responsibility for both services to the same company (11/07/2013, T-197/12, Metro, EU:T:2013:375, § 47-51).

5.8.3 Credit cards (Class 9) versus financial services (Class 36)

A credit card is a small plastic card issued to users as a system of payment. It allows its holder to buy goods and services based on the holder's promise to pay for these goods and services. The issuer of the card creates a revolving account and grants a line of credit to the consumer (or the user) from which the user can borrow money for payment to a merchant or as a cash advance to the user.

Financial services are offered by institutions like banks for the facilitation of various financial transactions and other related activities in the world of finance.

The intended purpose of credit cards is that they may be used in the course of financial transactions. If this were not the case, they would have no use and would serve no purpose. In this respect, it appears that credit cards have a dual nature: although they physically take the form of a plastic rectangle, they also correspond to a set of contractual relationships between, *inter alia*, an issuer or a supplier of financial services, which manages accounts and, as the case may be, grants credit, on the one hand, and clients, who use those cards to make payments or establish credit, on the other.

Although credit cards are generally manufactured by specialist undertakings, whose name may even appear on them, and other undertakings are also involved in the

service chain (from installing payment terminals to implementing compensation mechanisms), the fact nonetheless remains that their issuers are financial institutions and that the public will not usually consider who has actually produced a credit card, but rather who has issued it. The public will therefore believe that the financial institutions that issue credit cards are responsible for ensuring that they function correctly.

Furthermore, the sole objective of producing credit cards is for use in the course of financial transactions, so that it is of little importance whether they are manufactured by entities that are distinct from the financial institutions that issue them. These goods, which are developed in order to market certain specific services, would be meaningless in the absence of those services.

Accordingly, 'credit cards' are closely connected with 'financial services' and, hence, with 'financial affairs', with the result that those goods and services are complementary. (26/09/2017 T-83/16, WIBIDA / ING DiBa (fig.) et al., EU:T:2017:662 § 59-69).

Therefore, *credit cards* in Class 9 are considered similar to *financial, monetary and banking services* in Class 36 as they coincide in purpose and usual commercial origin insofar as their issuer/provider is concerned; as such, they are complementary.

5.9 Transport, Packaging and Storage

5.9.1 Transport of goods (Class 39) versus any product

Services of *transport* are not considered to be similar to goods. These services are provided by specialist transport companies whose business is not the manufacture and sale of the goods concerned. As regards the nature of the goods and services, *transport services* refer to a fleet of trucks or ships used to move goods from A to B.

Example

- *Pastry and confectionery* are dissimilar to *transport services*. They are different in terms of their nature, intended purpose and method of use; they are neither complementary nor in competition. All these differences explain why the service of transport and the goods of pastry and confectionery target different consumers. Transport is predominantly aimed at professionals (those who need to move goods) whereas pastry and confectionery target non-professional consumers (ordinary people who require food) (07/01/2014, R 1006/2012-G, PIONONO (fig.), § 28-36).

5.9.2 Packaging and storage of goods (Class 39) versus any product

Equally, *packaging and storage services* merely refer to the service whereby a company's or any other person's goods are packed and kept in a particular place for a fee. Those services are not similar to any kind of goods, including any of the goods that may be packaged and stored (07/02/2006, T-202/03, Comp USA, EU:T:2006:44; 22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 32; 07/01/2014, R 1006/2012-G, PIONONO (fig.), § 38).

5.10 Information Technology

5.10.1 Computers versus software

What we call a *computer* is actually a ‘system’, a combination of components that work together. The hardware devices are the physical components of that system. The hardware is designed to work hand in hand with *computer programs*, referred to as *software*. Computer hardware companies also manufacture software, share the same distribution channels and target the professional public (e.g. for use in banking and finance, education, medicine, business and entertainment/recreation) and/or the general public. Moreover, they are complementary. These goods are considered to be similar.

5.10.2 Software versus apparatus/services that use software

In today’s high-tech society, almost all *electronic or digital apparatus* function using integrated *software*. Also, many services in the financial or business sectors in the IT and telecommunication industries clearly depend on software or computer-aided software in order to be rendered. This does not, however, lead to the automatic conclusion that software is similar to goods/services that use software to function successfully.

Example of dissimilarity

- Although a *digital scale* functions using integrated *software*, this does not lead to the conclusion that software and scales are similar. One could argue that the software is important for the use of the scale; however, they are not complementary because they are not aimed at the same public. The digital scale is for the general public, whereas the software is aimed at the actual manufacturer of these scales. The producers are not the same, nor are the distribution channels, and they do not have the same purpose.
- Although many financial services are rendered with the use of software, for example online banking platforms, such software is an integral part of the financial services themselves and is not sold independently from them. Financial companies or institutions are not normally engaged in the development of highly specialised software. Rather, they would outsource the development of such software to IT companies. These goods and services are clearly provided by different undertakings with expertise in completely different areas, and at the same time target different users, which rules out any complementary relationship. Besides taking into account that by nature goods are different from services, they neither coincide in their purpose, method of use or channels of distribution.

However, when the software is not an integral part of an apparatus/service, can be purchased independently from it and serves, for example, to give more or different functionalities, similarity can be established.

Example of similarity

- A *digital camera* and *software*, insofar as their purpose is to increase the functionalities of the camera, are both aimed at the same public and produced by the same or related undertakings. They are distributed through the same channels and use of the one is indispensable for use of the other.
- Telecommunication services and software, insofar as they enable access to these services, are both aimed at the same public and are provided through the same channels of distribution. Clearly, these goods and services are complementary and serve the same purpose.

5.10.3 Software, downloadable ‘apps’ and downloadable electronic publications

Application software, also known as ‘an app’, is *computer software* that is designed to help the user perform various tasks on a computer. Application software differs from system software in that it can be accessed by the user and run on a computer. Application software is usually designed with the user in mind. The definition of *application* is used to refer to the small apps that are designed to be downloaded onto smartphones; however, the definition covers all applications on tablets, computers, etc. Consequently, *software*, *application software* and *downloadable applications* are considered to be identical.

Downloadable electronic publications are electronic versions of traditional media, like e-books, electronic journals, online magazines, online newspapers, etc. It is becoming common to distribute books, magazines and newspapers to consumers through tablet-reading devices by means of apps in the form of electronic publications. Consequently, there is a complementary relationship between software/apps and downloadable electronic publications. Their producers can be the same; they follow the same distribution channels and the public is generally also the same. These goods are considered to be similar.

5.10.4 Specific software versus specific software

There are many types of software, and although software by nature (a set of instructions that enables a computer to perform a task) is the same, this does not mean that their specific purpose is the same. This implies that very specific software could even be dissimilar to another type of software.

Example

The field of application of *computer games software* is not the same as *software for apparatus that diagnose diseases*. Due to these significantly different fields of application, the expertise needed to develop these types of software is not the same, nor are their end users or distribution channels. These goods are therefore dissimilar.

5.10.5 Computers and software (Class 9) versus computer programming (Class 42)

Computer programming consists, inter alia, of the process of writing source code (29/03/2012, T-417/09, Mercator Studios, EU:T:2012:174 § 26), and a computer program is a set of coded instructions that enables a machine, especially a computer, to perform a desired sequence of operations.

Computers are devices that compute, especially programmable electronic machines that perform high-speed mathematical or logical operations or that assemble, store, correlate, or otherwise process information. Computers need programs to operate.

Software is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation.

Therefore, *computer programming services* are closely linked to *computers* and *software*. This is because in the field of computer science, producers of computers and/or software will also commonly provide computer and/or software-related services (e.g. as a means of keeping the system updated).

Consequently, and in spite of the fact that the nature of the goods and services is not the same, both the end users and the producers/providers of the goods and services coincide. Furthermore, they are goods and services that are complementary. For these reasons, these goods and services are considered similar.

5.10.6 Communications equipment, computers and software (Class 9) versus telecommunication services (Class 38)

Communications equipment includes means, such as computer networking-, broadcasting-, data- and point-to-point communications equipment, antennas and aerials to enable remote communication.

Owing to rapid developments in the field of information technology, in particular the growing importance of the internet, the markets for communications equipment, IT hardware and software on the one hand, and telecommunications services on the other, have clearly become interlinked.

Goods such as modems, telephones, smartphones, computers, network routers and/or servers are used in close connection with telecommunication services because they are, or can be, absolutely necessary for performing these services and, from the viewpoint of the consumer, they are indispensable for accessing them. They are, moreover, regularly marketed together.

Nowadays, computers are generally networked and their autonomous use is actually the exception to the rule; the rule being that communications equipment, computers and software, insofar as they enable access to those services or provide the ability to perform them, renders them complementary. See decision of 25/04/2017, R 1569/2016-1, § 22-23; judgment of 15/10/2018, T-444/17, life coins / LIFE et al., EU:T:2018:681, § 37.

Therefore, these goods and services are similar, given their complementary character; although their nature is different, their purpose, consumers and distribution channels are the same.

By analogy, peripherals adapted for use with computers and other smart devices are to be found similar to telecommunication services insofar as they comply with the above rule that they enable access to telecommunication services, such as visual display screens would but, for example, mouse pads would not.

5.10.7 Data carriers and recorded content

Magnetic data carriers are carriers that use magnetic technology to operate, such as floppy discs, magnetic tapes or hard drives; *recording discs* are phonograph records. It follows that not all data carriers are covered by the general indication *magnetic data carriers, recording discs*; in particular, many of the more popular data carriers, such as CDs, solid-state memory devices or USB sticks, are not phonograph records and do not use magnetic technology; they are therefore not covered by this general indication.

Data carriers are all kinds of memory devices, whether removable, detachable or transportable. In particular, the term can cover diskettes as well as hard drives, which can be computer consumables, computer peripherals or parts of computers.

Where they are not further specified, data carriers (whether magnetic or digital, etc.) and discs (whether phonograph records or compact discs, etc.) must be considered to encompass both pre-recorded as well as blank media (05/10/2016, R 2096/2015-2, COYOTE UGLY (fig.) / COYOTE UGLY, § 24-36).

Therefore, for the purposes of comparison of goods and services, if data carriers or discs with pre-recorded content are similar to other goods/services, broader terms that are not specified any further, such as *data carriers* or *compact discs*, must also be found similar to those goods/services.

However, a distinction must still be made between one hand, *pre-recorded data carriers and discs* and, on the other, *blank data carriers and discs*.

Blank recording media and media that contain recorded data are very distinct products. For example, the difference between the market for blank recordable CDs and that for CDs pre-recorded with music is vast. In the latter, the subject matter recorded on the CD determines the fundamental characteristic of the product. The consumer is, in essence, purchasing the recorded data. Consumers looking for a CD of their favourite band would not buy a blank CD or another music CD instead. The recorded data characterises the product and the maker of the medium (CD) is irrelevant.

Therefore, for the purposes of comparison of goods/services, if magnetic data carriers and data carriers are specified as being blank, they cannot be found to be similar to magnetic data carriers and data carriers that are specified as being pre-recorded. There is no similarity between blank data carriers (of any kind) and pre-recorded data carriers (of any kind) merely on the basis that the latter goods have been stored or saved onto data carriers, as the latter are merely ancillary goods in this situation.

In particular, as regards goods in Class 16, these are printed on paper (*printed matter, teaching materials, printed publications, magazines*). They do not include electronic publications/books. No relevant Canon criteria apply to printed matter and blank data carriers. Consequently, blank digital or analogue recording and storage media in Class 9 and goods in Class 16 are dissimilar. However, *printed matter* in Class 16 and *data carriers* in Class 9 should be found similar insofar as the term *data carriers* encompasses data carriers with pre-recorded content, and these goods can therefore have the same purpose, target the same relevant public and originate from the same undertakings. Furthermore, they may be in competition.

Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 3

Relevant public and degree of attention

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1 Introduction

With regard to the relevant public, the Court of Justice has held that a likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29). The Court has also held that it is the **perception of marks in the mind of the relevant public of the goods or services in question** that plays a decisive role in the global assessment of the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; 22/06/1999, C-342/97, Lloyd Schufabrik, EU:C:1999:323, § 25).

Accordingly, the first task is to define the consumer circles that are relevant for the purposes of the case. The method for identifying the relevant public is discussed in paragraph 2 below. Thereafter, the relevant public's degree of attention and sophistication must be established. The impact of the relevant public's attention and sophistication on the assessment of the likelihood of confusion is discussed in paragraph 3.

In addition, the relevant public plays an important role in establishing a number of other factors that are relevant for the assessment of the likelihood of confusion.

1.1 Comparison of the goods and services

The actual and potential customers of the goods and services in dispute constitute one of the factors to be dealt with in the analysis of their similarity. While a coincidence in the relevant public is not necessarily an indication of similarity of the goods or services, largely diverging publics weigh heavily against similarity (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services).

Example

Leather, animal skins and hides are raw materials that go to industry for further processing, whereas *goods made of leather* are final products targeted at the general public. The relevant public is different, which is a fundamental factor in the assessment of similarity and which leads to the conclusion that the goods in question are dissimilar. Similar reasoning applies to *precious metals* and *jewellery*.

1.2 Comparison of the signs

The question of the relevant public also plays a role in the comparison of the signs. The same word may be pronounced differently depending on the relevant public. Conceptually, the public in one part of the European Union may understand the meaning of the sign, while consumers in other parts may not understand it (see the

Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs).

Example

The Court has already confirmed that the general public in the Scandinavian countries, the Netherlands and Finland has a basic understanding of English (26/11/2008, T-435/07, *New Look*, EU:T:2008:534, § 23).

1.3 Distinctive elements of the signs/distinctiveness of the earlier mark

The inherent distinctiveness of a sign or one of its elements also depends on the relevant public for the goods and services. For example, depending on the relevant public's knowledge, background and language, an element contained in a trade mark may be non-distinctive or have a low degree of distinctiveness, or it may be distinctive because, *inter alia*, it is perceived as a fanciful term without any meaning claimed (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

Example

The French word 'cuisine' will not be understood as a descriptive indication for goods in Classes 29 and 30 in some Member States (23/06/2010, R 1201/2009-1, *GREEN CUISINE / Cuisine* (fig.), § 29-33).

Example

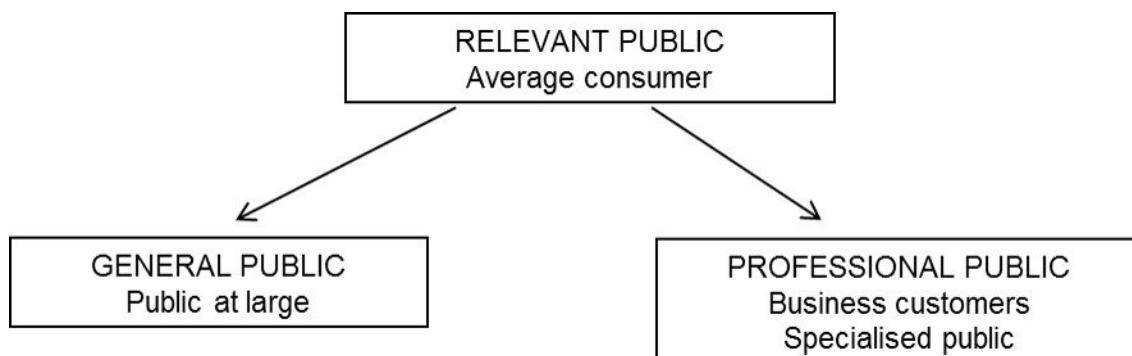
Professionals in the IT and scientific fields are in general more familiar with the use of technical and basic English words than the general public. In *Gateway v Activy Media Gateway*, the Court held that the common word 'gateway' directly evokes, in the mind of the relevant consumer, the concept of a gateway, which is commonly used in the computing sector (27/11/2007, T-434/05, *Activy Media Gateway*, EU:T:2007:359, § 38, 48; confirmed 11/12/2008, C-57/08 P, *Activy Media Gateway*, EU:C:2008:718).

2 Defining the Relevant Public

In accordance with Article 8(1)(b) EUTMR, it must be determined whether a likelihood of confusion exists 'on the part of the public in the territory where the earlier mark is protected'.

The term '**average consumer**' is a legal concept that is used in the sense of the '**relevant consumer**' or '**relevant public**'. It should not be confused with the 'general public' or 'public at large', although the Courts sometimes use it in this sense. However, in the context of relative grounds, the term 'average consumer' must not be used as a synonym of 'general public' as it can refer to both **professional** and **general public**. In this respect, in cases concerning the likelihood of confusion, the Court normally distinguishes between the **general public** (or **public at large**), and a **professional or**

specialised public (or **business customers**), based on the goods and services in question.



In order to properly define the relevant public in the context of relative grounds, two factors have to be taken into account:

- **the territory defined by the earlier mark:** the relevant public is always the public in the territory(ies) where the earlier right(s) is/are protected. Consequently, in the case of an earlier national right, the relevant public concerned is the one of that particular EU Member State (or Member States in the case of Benelux trade marks). For an earlier European Union trade mark, the public in the whole European Union has to be taken into account. For an international registration, it is the public in each of the Member States where the mark is protected.
- **the goods and services that have been found identical or similar:** likelihood of confusion is always assessed against the perception of the consumers of the goods and services that have been found identical or similar. Depending on the goods or services, the relevant public is the general public or a professional/specialised public.

The relevant public always includes both the **actual** and the **potential** consumers, that is, the consumers who are currently purchasing the goods/services or who may do so in the future.

If a **significant part of the relevant public** for the goods or services at issue may be confused as to the origin of the goods, this will be sufficient to establish a likelihood of confusion. It is not necessary to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

As stated by the Court, the relevant public for the assessment of the likelihood of confusion is composed of **users likely to use both the goods and services covered by the earlier mark and the product covered by the mark applied for that were found to be identical or similar** (01/07/2008, T-328/05, Quartz, EU:T:2008:238, § 23; appeal 10/07/2009, C-416/08 P, Quartz, EU:C:2009:450, dismissed).

When defining the part of the public **by reference to which a likelihood of confusion is assessed** the following applies:

- if the goods or services of both marks target the general public, the relevant public by reference to which a likelihood of confusion will be assessed is the general public.

Example

In a case in which both the earlier and the contested mark concerned articles of clothing, the Court held that ‘clothing for men and women are everyday consumer items and the trade mark on which the opposition is based is registered as a European Union trade mark. It follows that the relevant public by reference to which the likelihood of confusion must be assessed is composed of the general public in the European Union’ (06/10/2004, T-117/03 – T-119/03 & T-171/03, NL, EU:T:2004:293, § 25).

- If the goods and services of **both marks** are directed at the same or a similar **professional public**, the likelihood of confusion will be assessed from the perspective of those specialists.

Example

The relevant goods of both the earlier and the contested mark were raw plastic materials, chemical products, resins and the like. These are goods for industrial use. The targeted consumers are, therefore, engineers and/or chemists, that is to say, highly skilled professionals who will process these products and use them in manufacturing activities. The relevant public was considered to be professional (15/02/2012, R 2077/2010-1, PEBAFLEX / PEBAX, § 18; 16/09/2010, R 1370/2009-1, CALCIMATT / CALCIPLAST et al., § 20, confirmed 29/03/2012, T-547/10, EU:T:2012:178).

- If the goods or services of **both marks** target **both the general public and specialists**, the likelihood of confusion will be assessed against the perception of the part of the public displaying the lower degree of attentiveness as it will be more prone to being confused. If this part of the public is not likely to be confused, it is even more unlikely that the part of the public with a higher degree of attention will be.

Example

In a case in which both the earlier and the contested mark concerned goods in Classes 3 and 5 that targeted both the general public and professionals (e.g. doctors for pharmaceuticals in Class 5), the Court assessed the likelihood of confusion for the general public only, because it is the one displaying the lower degree of attention (15/07/2011, T-220/09, ERGO, EU:T:2011:392, § 21).

- If the goods and services of the earlier mark target the **general and professional public** and the contested goods and services target a **professional public** exclusively (or vice versa), the relevant public for assessing likelihood of confusion will be the professional public only.

Example

The goods of the earlier mark are *polish for metals*, while the goods of the application are *preparations for cleaning waste pipes for the metal-working industry*. As stated in the relevant GC judgment: ‘Although “polish for metals” can consist equally well of everyday consumer goods as of goods intended for a professional or specialised public, it is not disputed that the goods to which the trade mark application relates must be regarded as directed solely at persons operating in the metal-working industry.

Therefore, the only public likely to confuse the trade marks in question is formed of such operators' (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 81).

Example

Paints in general are sold both to professional painters (i.e. for business purposes) and to the public at large for 'do-it-yourself purposes'. By contrast, *paints for industry* do not target the general public. Therefore, when the specifications of the two marks cover paints in general and paints for industry respectively, only professionals constitute the relevant public since they are likely to be the only consumers who encounter both marks.

Example

The services of the earlier mark are *telecommunications*. The contested services are *telecommunication services, namely collocation, telehousing and interconnection services* addressed at professionals only. The definition of the relevant public must be adjusted to the more specific list, and likelihood of confusion should be assessed for professionals only (24/05/2011, T-408/09, ancotel, EU:T:2011:241, § 38-50).

- If the relevant goods are pharmaceuticals the following applies:
The relevant public of **non-prescription** pharmaceuticals (sold over the counter) is the general public, and the likelihood of confusion will be assessed in relation to that public.

According to the case-law, the general public cannot be excluded from the relevant public, also in the case of pharmaceuticals that require a **doctor's prescription** prior to their sale to end-users in pharmacies. Thus, the relevant public comprises both general public and health professionals, such as doctors and pharmacists. Consequently, even though the choice of those products is influenced or determined by intermediaries, a likelihood of confusion can also exist for the general public, since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products at various times (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 42-45; 26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 56-63). In practice, this means that the likelihood of confusion will be assessed against the perception of the general public, which is more prone to confusion.

In the case of pharmaceutical goods **targeted only at specialists** for professional use (e.g. *sterile solutions for ophthalmic surgery*), the likelihood of confusion must be assessed from the point of view of that specialist public only (26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 66).

In cases where the pharmaceutical goods of the EUTM application are **sold over the counter**, while the pharmaceutical goods covered by the earlier registration would **only be available on prescription, or vice versa**, the Office must assume that the relevant public consists of both qualified professionals and the general public, without any specific medical and pharmaceutical knowledge. The likelihood of confusion will be assessed in relation to the general public, which is more prone to confusion.

Example

The goods covered by the earlier mark were pharmaceutical preparations with *digoxin for human use for cardiovascular illnesses*, while the contested goods were *pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection*.

Although both the goods of the earlier mark and the goods of the contested mark are prescribed by and administered under the supervision of healthcare professionals, the GC held that the relevant public comprises both healthcare professionals and the general public.

(23/09/2009, T-493/07, T-26/08 & T-27/08, Famoxin, EU:T:2009:355, § 50-54; 09/07/2010, C-461/09 P, Famoxin, EU:C:2010:421).

3 Defining the Degree of Attention

The Court has indicated that for the purposes of the global assessment, the average consumer of the products concerned is deemed to be **reasonably well informed and reasonably observant and circumspect**, and that the relevant public's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

Whether its degree of attention will be **higher or lower will depend, inter alia, on the nature of the relevant goods and services and the knowledge, experience and purchase involvement of the relevant public**.

The fact that the relevant public consists of the **general public** does not necessarily mean that the degree of attention cannot be high (for instance, when expensive, potentially hazardous or technically sophisticated goods are purchased). Likewise, the fact that the goods at issue target **specialists** does not necessarily mean that the degree of attention is always high. It is true that, in principle, the professional public has a high degree of attention when purchasing a specific product. This is when these professional consumers are considered to have special background knowledge or experience in relation to the specific goods and services. Moreover, purchases made by professional consumers are often more systematic than the purchases made by the general public. However, this is not always the case. However, in some cases, for example, such as when the relevant goods or services are used by a given professional on a daily basis, the degree of attention paid may be average or even low even in relation to those professional consumers.

Properly defining the degree of attention of the relevant public is necessary, as this factor can weigh for or against a finding of a likelihood of confusion. Whilst the relevant consumer only rarely has the chance to make a direct comparison between the different signs and must rely on an imperfect recollection of them, a high degree of attention of the relevant consumer may lead to conclude that the relevant consumer will not confuse the marks, despite the lack of direct comparison between

the trade marks (22/03/2011, T-486/07, CA, EU:T:2011:104, § 95). Therefore, the degree of attention will be established in the decision.

However, **a high degree of attention does not automatically lead to a finding of no likelihood of confusion**. All the other factors have to be taken into account (**interdependence principle**) (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment). For example, in view of the specialised nature of the relevant goods and/or services and the high degree of attention of the relevant public, likelihood of confusion may be ruled out (26/06/2008, T-79/07, Polaris, EU:T:2008:230, § 50-51). However, a likelihood of confusion can exist despite a high degree of attention. For example, when there is a strong likelihood of confusion created by other factors, such as identity or close overall similarity of the marks and the identity of the goods, the attention of the relevant public alone cannot be relied upon to prevent confusion (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 53-56; 06/09/2010, R 1419/2009-4, Hasi (fig.) / Hasen IMMOBILIEN).

3.1 Higher degree of attention

A higher degree of attention is usually connected with the following types of purchases: expensive purchases, the purchase of potentially hazardous or technically sophisticated goods. The average consumer often seeks professional assistance or advice when choosing or buying certain types of goods and services (e.g. cars, pharmaceutical products).

A higher degree of attention can also apply to goods when brand loyalty is important for the consumer.

3.1.1 Expensive purchases

When purchasing expensive goods, the consumer will generally exercise a higher degree of care and will buy the goods only after careful consideration. Non-specialised or non-professional consumers often seek professional assistance or advice when choosing or buying certain types of goods and services. The attention may be enhanced in cases of luxury goods and where the specific product is regarded as reflecting the social status of its owner.

Examples

Cars. Taking into consideration their price, consumers are likely to pay a higher degree of attention than for less expensive purchases. It is to be expected that these consumers will not buy a car, either new or second-hand, in the same way as they would buy articles purchased on a daily basis. The consumer will be an informed one, taking all relevant factors into consideration, for example, price, consumption, insurance costs, personal needs or even prestige (22/03/2011, T-486/07, CA, EU:T:2011:104, § 27-38; 21/03/2012, T-63/09, Swift GTi, EU:T:2012:137, § 39-42).

Diamonds, precious and semi-precious stones. In its decision of 09/12/2010, R 900/2010-1, Leo Marco (fig.) / LEO, § 22, the Board held that consumers generally

put a certain amount of thought into the selection of these goods. In many cases the goods will be luxury items or will be intended as gifts. A relatively high degree of attention on the part of the consumer may be assumed.

Financial services. These services target the general public, which is reasonably well informed and reasonably observant and circumspect. However, since such services are specialised services that may have important financial consequences for their users, the consumers' degree of attention would be rather high when choosing them (T-220/11, F@ir Credit, EU:T:2012:444; 14/11/2013, C-524/12 P, F@ir Credit, EU:C:2013:874, appeal dismissed; 22/06/2010, T-563/08, Carbon Capital Markets, EU:T:2010:251, § 33).

Real estate services. The purchase and sale of property are business transactions that involve both risk and the transfer of large sums of money. For these reasons, the relevant consumer is deemed to possess a higher-than-average degree of attention, since the consequences of making a poor choice through lack of attentiveness might be highly damaging (17/02/2011, R 817/2010-2, FIRST THE REAL ESTATE (fig.) / FIRST MALLORCA (fig.) et al., § 21).

3.1.2 Potentially hazardous purchases

The impact on safety of goods covered by a trade mark (e.g. lights for vehicles, saws, electric accumulators, electric circuit breakers, electric relays) may result in an increase in the relevant consumer's degree of attention (22/03/2011, T-486/07, CA, EU:T:2011:104, § 41).

3.1.3 Brand loyalty

Furthermore, a higher degree of attention can be the consequence of brand loyalty.

Example

Although tobacco products are relatively cheap articles for mass consumption, smokers are considered particularly careful and selective about the brand of cigarettes they smoke, so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. Therefore, in the case of tobacco products a higher degree of similarity of signs may be required for confusion to occur. This has been confirmed by several Board decisions: 26/02/2010, R 1562/2008-2, victory slims (fig.) / VICTORIA et al., where it was stated that the consumers of Class 34 goods are generally very attentive and brand loyal, and 25/04/2006, R 61/2005-2, Granducato / DUCADOS et al.

3.1.4 Pharmaceuticals

It is apparent from the case-law that, insofar as pharmaceutical preparations are concerned, the relevant public's degree of attention is relatively high, whether or not issued on prescription (15/12/2010, T-331/09, Tolposan, EU:T:2010:520, § 26; 15/03/2012, T-288/08, Zydus, EU:T:2012:124, § 36 and quoted case-law).

In particular, *medical professionals* have a high degree of attentiveness when prescribing medicines. With regard to *non-professionals*, they also show a higher degree of attention, regardless of whether the pharmaceuticals are sold without prescription, as these goods affect their state of health.

3.2 Lower degree of attention

A **lower degree of attention** can be associated, in particular, with habitual buying behaviour. Purchase decisions in this area relate to, for example, inexpensive goods purchased on a daily basis (15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 43).

The mere fact that the relevant public makes an impulse purchase of some goods (e.g. sweets) does not mean that the degree of that public's attention is lower than average (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 34).

Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 4

Comparison of signs

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Obsolete

1 Introduction

Whether a likelihood of confusion exists depends on several interdependent factors, including (i) the similarity between the goods and services, (ii) the relevant public, (iii) the **similarity between the signs**, taking into account their distinctive and dominant elements, and (iv) the distinctiveness of the earlier mark.

This chapter deals with the comparison of signs. The purpose of comparing signs is to determine if the signs are identical (see paragraph 2 below), similar (see paragraph 3 below), or dissimilar (see paragraph 4 below).

Identity between the signs is a prerequisite for applying Article 8(1)(a) EUTMR if the goods or services are also identical ('double identity').

Similarity (or identity) between the signs is a prerequisite for applying Article 8(1)(b) EUTMR (likelihood of confusion).

Dissimilarity between the signs excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 8(1)(b) EUTMR.

1.1 General Principles of Trade Mark Comparison

If the signs are not identical, it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

It follows that signs are compared **visually** (see paragraph 3.4.1 below), **aurally** (see paragraph 3.4.2 below) and **conceptually** (see paragraphs 3.4.3 and 3.4.4 below). If it is not possible to compare the marks in any of these aspects, this will be stated in the decision.

Furthermore, when signs are compared, an assessment must be made of the distinctive character and dominance of their elements, if any, and the impact of these elements on the overall impression.

In light of the above, where the signs are not identical, they are, in principle, compared by assessing the distinctive and dominant character of the coinciding and differing elements, assessing the common features of and differences between the signs, and reaching a conclusion on similarity or dissimilarity.

The Court has stated that if there is **some similarity, even faint**, between the marks, a global assessment must be carried out in order to ascertain whether, notwithstanding the low degree of similarity, 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 between the marks (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 66).

In principle, the comparison has to lead to a finding on the **degree of similarity** in every aspect.

The degree of similarity between the signs may be decisive for the outcome of the decision. Even for identical goods and/or services, ‘any similarity’ may not be sufficient in itself to lead to a likelihood of confusion (interdependence principle, see Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 2). The degree of similarity must be established at the very least for the **visual** and **aural** aspects as these may be decisive for assessing the likelihood of confusion, depending on the circumstances in which the goods and services at issue are normally marketed (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 4).

In determining the degree of similarity, it is important to specify whether it is high (above average) or low (below average). However, even if it is average, the decision should say so, to avoid misunderstandings. A mere statement that ‘the signs are similar’ is not clear as it can be interpreted in two ways — either in the sense that they are similar to an average degree, or just in the general sense that there is (some) similarity allowing for further examination.

Accordingly, the degree of similarity must be specified as low, average or high. Synonyms can be used insofar as they are clear (e.g. average = medium). However, the term ‘enhanced’ is not a synonym for ‘high’. Further degrees of similarity may be specified, for example, expressions like ‘only very low’ or ‘nearly identical’, if this is supported by the facts of the case and is conducive of the outcome. The wording, however, must be as clear as possible. This is not the case for expressions like ‘not particularly high’, which can be understood either as average’ or just ‘low’.

However, it is not always necessary to specify the degree of **conceptual** similarity. Depending on the particular circumstances, it may be sufficient to acknowledge similarity resulting from a semantic overlap or a similarity in a concept. If similarity arises from concepts of low distinctive character, this must be clearly indicated so that its relevance can be considered in the global assessment of the likelihood of confusion.

1.2 Signs to be compared and negligible elements

The signs have to be compared in the form in which they are protected, that is, in the form in which they are registered/applied for. The actual or possible use of the registered marks in another form is irrelevant when comparing signs (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 38).



The comparison should **cover signs in their entirety**. Consequently, it is wrong to discard comparing elements of signs just because they are, for example, smaller than other elements in the signs (unless they are negligible as explained below) or because they are non-distinctive (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41-42; 13/12/2011, T-61/09, Schinken King, EU:T:2011:733, § 46).

Exceptionally, in the event of **negligible elements**, the Office may decide not to take such elements into consideration for the purposes of the actual comparison, after **having duly reasoned** why they are considered negligible (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). This is especially important where the negligible element is the common element in the signs. The notion of negligible elements should be interpreted strictly and, in the event of any doubt, the decision should cover the signs in their entirety.

The Office considers that a negligible element refers to an element that, due to its size and/or position, is not noticeable at first sight or is part of a complex sign with numerous other elements (e.g. beverage labels, packaging) and, therefore, very likely to be disregarded by the relevant public.

Examples

Earlier sign	Contested sign	Case No
	 (GREEN BY MISSAKO)	11/11/2009, T-162/08, EU:T:2009:432 The words 'by missako' are almost illegible: the size and script make them difficult to decipher.
	LUNA	12/12/2011, R 2347/2010-2 The element 'Rótulos Luna S.A.' was considered negligible.
MATHEUS MÜLLER		09/09/2010, R 396/2010-1 The Board did not assess the elements '50 cl', '50 % vol.' 'ANNO' or '1857' phonetically or conceptually.
MAGNA		17/05/2006, R 1328/2005-2 The Board described the contested sign in full, but negligible elements such as '70 cl' were not included in the comparison.

Earlier sign	Contested sign	Case No
		<p>03/09/2010, T-472/08, EU:T:2010:347</p> <p>The elements other than 'cachaça'/'pirassununga' and '51', the latter written in white within a circle that is itself partially within a broad band running from one side of the sign to the other, are negligible in the overall impression created by those marks (para. 65).</p>

It should also be noted that informative indications that the mark is registered (such as the symbols '™' and '®') are not considered part of the mark (see the Guidelines, Part B, Examination, Section 2, Formalities). Consequently, such symbols will not be taken into account in the comparison of the signs.

1.3 Relevant territory and relevant public

Similarity must be assessed for the territory in which the earlier mark is protected. The relevant territory must be indicated. Moreover, the perception of the relevant public plays an important role when comparing signs (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

Where the earlier mark is a national mark, the relevant criteria must be analysed for the relevant public in that particular EU Member State (or Member States in the case of Benelux trade marks). The perception of similarity may differ from one Member State to another because of differences in pronunciation and/or meaning/understanding.

When the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole** EU. However, in situations where there is likelihood of confusion in a part of the EU **and** when justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office's analysis need not extend to the whole EU but may instead focus on only one **part or parts** where there is a likelihood of confusion.

The unitary character of the EUTM means that an earlier EUTM can be relied on in opposition proceedings against any application for registration of an EUTM that would adversely affect the protection of the first mark, even if only in the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 56-57 and subsequent case-law; 18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 52 and the case-law quoted).

If the opposition is based on an international registration, the territory for which the basic mark is protected is not to be considered as the relevant territory of the earlier international registration designating or subsequently designating other relevant territories (except if the owner has protection in the whole EU — IR designating or subsequently designating the EU where the same country of the basic registration is covered).

Where the relevant public consists of both general and professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold the opposition. Usually it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals (see the Guidelines, Part C, Opposition, Section 0, Introduction, paragraph 4).

2 Identity between the Signs

2.1 The concept of identity

As indicated above, a finding of identity between signs will lead to the success of the opposition pursuant to Article 8(1)(a) EUTMR if the goods and services are also identical.

The differences between Article 8(1)(a) EUTMR and protection in the event of likelihood of confusion, pursuant to Article 8(1)(b) EUTMR, must be borne in mind in order to understand the concept of identity and its attached requirements.

Protection pursuant to Article 8(1)(a) EUTMR is absolute, because registration of a later identical sign for identical goods or services would compromise the function of the earlier mark as a means of identifying commercial origin. Where identical signs or marks are registered for identical goods or services, it is impossible to conceive of circumstances in which all likelihood of confusion could be ruled out. There is no need to consider any other factors, such as the degree of attention of the public or the distinctiveness of the earlier trade mark.

However, pursuant to Article 8(1)(b) EUTMR, the earlier trade mark is protected against the likelihood of confusion: even if the trade marks differ in some elements, their similarity — in combination with further elements that have to be assessed globally — may lead to the assumption that the relevant goods and services originate from the same or an economically linked undertaking.

Due to the absolute protection conferred by Article 8(1)(a) EUTMR, the concept of identity between trade marks must be interpreted strictly. The absolute protection in the case of an EUTM application ‘which is identical with the [earlier] trade mark in relation to goods or services which are identical with those for which the trade mark is registered [pursuant to Article 8(1)(a) EUTMR] cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by [Article 8(1)(b) EUTMR]’ (20/03/2003, C-291/00, Arthur et

Félicie, EU:C:2003:169, § 50-54 in relation to the corresponding provisions of the Directive).

2.2 Threshold for a finding of identity

The very definition of identity implies that the two signs should be the same in all respects. There is, therefore, identity between the signs where the EUTM application reproduces, without any modification or addition, all the elements constituting the earlier trade mark.

However, since the perception of identity between the two signs is not always the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between trade marks may go unnoticed by the average consumer.

Therefore, **the EUTM application should be considered identical to the earlier trade mark 'where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer'** (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54).

An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon examining the marks side by side. 'Insignificant' is not an objective term, and its interpretation depends on the level of complexity of the trade marks being compared. Insignificant differences are those that, because they concern elements that are very small or are lost within a complex mark, cannot be readily detected by the human eye upon observing the trade mark concerned, bearing in mind that the average consumer does not normally indulge in an analytical examination of a trade mark but perceives it in its entirety.

The finding that an element is 'insignificant' must be accompanied by sufficient reasoning for its lack of impact on the global perception of the trade mark.

It follows from the definition of identity above that the following conditions have to be met in order for trade marks to be considered identical in accordance with Article 8(1) (a) EUTMR.

- **Complete identity between the signs.** Partial identity is not sufficient under Article 8(1)(a) EUTMR, but may lead to similarity between the signs and should be addressed when carrying out the examination of Article 8(1)(b) EUTMR. Any additional element is sufficient for concluding that the marks are not identical; it is immaterial whether the added element is a word, a figurative device or a combination of the two.

Consequently, two word marks will not be considered identical if one is contained within the other but is accompanied by further characters (see paragraph 2.4 below) or by words — irrespective of distinctiveness or possible descriptive character.

Earlier sign	Contested sign and comments	Case No
Millenium	MILLENIUIM INSURANCE COMPANY LIMITED It was found that 'the signs at stake were obviously not identical', even if 'Insurance company limited' was descriptive in English for the related services.	24/11/2011, R 696/2011-1
INDIVIDUAL		18/12/2008, R 807/2008-4

- **Identity in all aspects of comparison.** There must be identity between the signs in all relevant aspects of trade mark comparison, that is, visual, phonetic and conceptual. If the trade marks are identical in some aspects but not in others, they are not identical overall. In the latter case, they may be similar and, therefore, likelihood of confusion must be examined.

2.3 Identity between word marks

Word marks are marks consisting of letters, numbers and other standard typographic characters (e.g. '+', '@', '!') reproduced in standard typeface. This means that they do not claim any particular figurative element or appearance. Where both marks are registered as word marks, the typeface actually used by the office concerned in the official publication is immaterial. Differences in the use of lower- or upper-case letters are, in general, immaterial. **Word marks** are identical if they coincide exactly in the string of letters, numbers or other typographic characters.

The following word marks are identical.

Earlier sign	Contested sign	Case No
BLUE MOON	Blue Moon	27/01/2011, R 835/2010-1
GLOBAL CAMPUS	Global Campus	23/01/2009, R 719/2008-2
DOMINO	Domino	18/03/2009, R 523/2008-2
Apetito	APETITO	04/05/2011, T-129/09, EU:T:2011:193

In general, it should be checked whether the sign has been registered as a word mark. For example, examining only the graphic representation of the trade mark (e.g. in the

Madrid System) can be misleading because, depending on the graphic representation of the signs used in the certificates, bulletins, etc., a mark **claimed as** a word mark may include figurative or stylised elements or fonts. In these cases, the claim will prevail over the exact reproduction in the certificate, bulletins, etc.

Marks in non-Roman characters must be considered as word marks in the designated jurisdictions where those characters are officially used (e.g. Cyrillic in the case of an EUTM or an IR designating Bulgaria or the EU, in accordance with the indication of category No 28.05 'inscriptions in Cyrillic characters' of the Vienna Classification of figurative elements). The following Cyrillic word marks are identical.

Earlier sign	Contested sign	Case No
ВАСИЛЬКИ	Васильки	31/01/2012, B 1 827 537

A difference of just one letter is sufficient for a finding of non-identity.

Earlier sign	Contested sign	Case No
NOVALLOY	NOVALOY	17/12/1999, B 29 290
HERBO FARMA	HERBOFARM	14/07/2011, R 1752/2010-1

Whether or not a space, a punctuation mark (e.g. hyphen, full stop) or an accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, introduces a difference so insignificant that it may go unnoticed by the consumer in accordance with the 'Arthur et Félicie' judgment (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54) is assessed on a case-by-case basis, taking into consideration the relevant language. In some languages, a term can be written either together or with a space or hyphen (e.g. weekend versus week-end) so the public will not notice the difference. However, the use of a space, hyphen or accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, may change the meaning of the word element and therefore influence how the sign is perceived. The following word marks **are not** identical.

Earlier sign	Contested sign	Case No
She, SHE	S-HE	23/09/2009, T-391/06, EU:T:2009:348

2.4 Word marks and figurative marks

A **word mark** and a **figurative mark**, even when both consist of the same word, will not be identical unless the differences are so insignificant that they may go unnoticed by the relevant public.

In the following examples the signs are clearly **not identical**.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
	ELCO	13/03/2009, R 803/2008-1
eClear		09/02/2012, R 1807/2010-1
BIG BROTHER		10/05/2011, R 932/2010-4


However, the finding that trade marks are not identical can be more difficult if the figurative trade mark is written in normal typeface. Nevertheless, in the following examples the trade marks were found **not** to be **identical**.

Earlier sign	Contested sign	Case No
	THOMSON	22/04/2009, R 252/2008-1
	Klepper	24/02/2010, R 964/2009-1

2.5 Identity between figurative marks

Two figurative marks are identical when both signs match in all their elements (shape, colours, contrast, shadowing, etc.).

It goes without saying that use of the same word will not suffice for a finding of identity when the figurative element is not the same. The following marks **are not** identical.

Earlier sign	Contested sign	Case No
		09/02/2012, R 558/2011-1
		31/03/2011, R 1440/2010-1
		12/04/2013, 7078 C

However, since in the following case the difference in the presentation of the letters 'TEP' in italics would go unnoticed by the public, the marks were considered **identical**.





Earlier sign	Contested sign	Case No
		28/02/2013, B 2 031 741

2.6 Identity of an earlier black and white (B&W) or greyscale mark with a colour mark application





In the framework of the European Trade Mark and Design Network, the Office and a number of trade mark offices in the European Union have agreed on a Common Practice with regard to the scope of identity of earlier B&W or greyscale marks with coloured versions of the same sign.

According to this Common Practice, the **differences** between an earlier B&W or greyscale mark and a coloured version of the same sign **will normally be noticed** by the average consumer, with the consequence that the marks are not considered identical. It is only under **exceptional circumstances** that the signs will be considered identical, namely where the differences in the colours or in the contrast of shades are so **insignificant** that a reasonably observant consumer will perceive them only upon examining the marks side by side. In other words, for the finding of identity the differences in the colour of the signs in question must be hardly noticeable by the average consumer.



Invented examples of **significant** differences with the consequence of no identity.

Earlier sign	Contested sign
	
	

Invented examples of **insignificant** differences with the consequence of identity.

Earlier sign	Contested sign
	
	

In relation to the findings above, the issue as to whether a trade mark registered in B&W or greyscale should be considered to cover all colours has also been addressed by the Court in a subsequent judgment (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199).

Earlier sign	Contested sign	Case No
		09/04/2014, EU:T:2014:199 T-623/11,
<p>The Court considered that the fact that 'the proprietor of a mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions ... does not mean ... that the registration of a mark which does not designate any specific colour covers all colour combinations which are enclosed with the graphic representation' (para. 39).</p> <p>In this particular case, the Court considered that the Board was right in finding 'that one difference between the mark applied for and the first and second earlier marks lay in the fact that the mark applied for consisted, in part, of a yellow background with white vertical stripes' (para. 40).</p>		

3 Similarity between the Signs

3.1 Introduction

The similarity of signs depends on the distinctiveness (see paragraph 3.2 below) and dominant character (see paragraph 3.3 below) of their components, and on other possible relevant factors. When comparing signs, their visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance (see paragraph 3.4 below) as well as whether and to what extent these elements determine the overall impression conveyed by the marks.

3.2 Distinctive elements of the marks

In the *Sabèl* judgment (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 23), the Court held that '... (the) global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components'. Therefore, the degree of distinctiveness of the various components of composite marks is an important criterion that must be considered within the trade mark comparison.

When assessing the similarity of signs, the degree of distinctiveness of their coinciding and differing components should be established because distinctiveness is one of the factors that determine the importance of those elements in each sign and, accordingly, their impact in the overall impression of the signs. A coincidence in a distinctive element and/or a difference in an element with no or little distinctiveness tend to

increase the degree of similarity. A difference in a distinctive element tends to decrease the degree of similarity. The same applies where the coincidence found concerns an element with no or reduced distinctiveness.

Consequently, although trade mark proprietors commonly use non-distinctive or weak elements as part of a trade mark to inform consumers about certain characteristics of the relevant goods or services, it may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non-distinctive or weak elements.

Therefore, in principle, the distinctiveness of all components of both the earlier **and** of the contested mark should be examined.

It is important to distinguish between the analysis of the distinctive character of (i) the component of a mark and (ii) the earlier mark as a whole. Analysing the components determines whether the signs in conflict coincide in a component that is distinctive (and therefore important), non-distinctive or weak (therefore being of less importance in the trade mark comparison). The analysis of the earlier mark as a whole determines the scope of protection afforded to that mark, which is a separate consideration within the likelihood of confusion, independent from the comparison of the trade marks (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

However, if either mark consists of one element only, the decision in the part dealing with the comparison of signs will establish whether the distinctiveness of that element is normal or lower than normal. In this case, it cannot be found that the element lacks distinctiveness. Regarding the earlier mark, this would amount to denying its distinctive character (for details, see paragraph 3.2.3.4 below). As regards the contested sign, this would mean that a new examination of absolute grounds would have to be carried out.

3.2.1 What is a component of a sign?

The Court has not defined what is to be regarded as a ‘component’ or ‘element’ of a sign. It is easy to identify components when a sign is visually divided into different parts (e.g. separate figurative and verbal components). However, the term ‘component’ encompasses more than these visual distinctions. Ultimately, the perception of the sign by the relevant public is decisive and a component exists wherever the relevant public perceives one. For example, the relevant public will often regard one-word signs as being composed of different components, in particular, where one part has a clear and evident meaning while the rest is meaningless or has a different meaning (e.g. in the mark EUROFIRT, ‘Euro’ will be widely understood as referring to Europe whereas ‘Firt’ is meaningless, giving this word mark two components: ‘Euro’ and ‘Firt’). In such cases, the elements of one-word signs could be regarded as ‘components’ in the terminology of the Court.

However, **words should not be artificially dissected**. Dissection is not appropriate unless the relevant public will clearly perceive the components in question as separate elements. A case-by-case assessment is required as to whether the division of a sign into components is artificial (e.g. whether splitting the word ‘LIMEON’ for fruit into the

components 'LIME' and 'ON' would be artificial or not) (see also paragraphs 3.4.3.2 and 3.4.5.1 below).

3.2.2 Examination of distinctiveness

3.2.2.1 What is distinctiveness?

The Court has defined distinctiveness in the following manner:

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings** (emphasis added).

(22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies whereby a component of a sign can lack distinctiveness entirely, be fully distinctive (to a normal degree) or be at any point in-between.

At this point, it must be noted that it is not, in principle, the Office's practice to recognise a higher than average degree of inherent distinctiveness for individual components of signs. Any higher degree of distinctiveness (enhanced distinctiveness, reputation) is related to actual recognition of the mark by the relevant public, and is eventually examined only with respect to the earlier mark (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark). A mark or, by analogy, its components will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H / Eich, EU:C:2013:317, § 71).

An element of a sign is **not distinctive** if it is exclusively descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.) and/or if its use in trade is common for those goods and services. Similarly, an element of a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness.

An element of a sign may be **distinctive to a low degree (weak)** if it refers to (but it is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods might not materially affect distinctiveness, as in the following examples.

- 'Billionaire' for *gaming services* is allusive in a manner that would affect distinctiveness, because it implies, for instance, that you may become a billionaire.
- 'Billy O'Naire', which sounds identical to 'billionaire' in English, would be allusive for *gaming services* as a clever word-play on Irish names, in a manner that would not

affect distinctiveness in a material way; it would be considered to have a 'normal' degree of distinctiveness.

An element of a sign that is neither non-distinctive nor weakly distinctive possesses a **'normal' degree of inherent distinctiveness**. This means that the element of a sign in question is fully distinctive, in the sense that its capacity to identify the goods and services covered by the mark as coming from a particular undertaking is not in any way diminished or impaired.

One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has a low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of registered data only, it cannot be assumed that all the trade marks have been effectively used.

It follows that the evidence submitted must demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that the element in question has a low degree of distinctive character (13/04/2011, T-358/09, Toro de Piedra, EU:T:2011:174, § 35; 08/03/2013, T-498/10, David Mayer, EU:T:2013:117, § 77-79).

3.2.2.2 Relevant point in time

The inherent distinctiveness of the components should be assessed at the time of the decision.

Establishing the precise point in time for evaluating distinctiveness is important because the degree of distinctiveness of the marks is not constant, but varies depending on the perception of the public. This perception may change not only due to the nature of the use of the specific mark, but also due to other factors (all these elements can only be considered from the evidence submitted by the parties). For instance, the public's perception may change where a mark or some component thereof has been used in the meantime in a similar way by various businesses/traders in the relevant market sector. This common use of a sign can erode the uniqueness of a sign and, consequently, its ability to indicate the origin of the goods and services. In this context, it is important to assess carefully whether the situation described exists in all the relevant geographical areas and with regard to all the relevant goods and services.

As an example, due to technological changes in the field of IT, there has been an increased number of instances where components such as 'I' (internet), 'E' (electronic) and 'M' (mobile) are used adjoined to a meaningful word. In the context of electronic communications, they are currently found to be descriptive (19/04/2004, R 758/2002-2, ITUNES, § 11), whereas previously they were considered distinctive.

3.2.2.3 Relevant goods and services

The assessment of the **inherent distinctiveness** of the components is carried out only for the goods or services that are identical or similar, that is:

- the earlier mark is assessed with respect to the registered goods and services that are identical or similar to the contested goods and services;
- the contested trade mark is assessed with respect to the contested goods or services that are identical or similar to those of the earlier mark.

3.2.2.4 General principles of examination of distinctiveness

The examination of inherent distinctiveness is carried out in two phases: first, it should be determined whether the relevant public recognises semantic content of the element at issue and, second, whether or not the semantic content perceived is related to and/or commonly used in trade for the identical or similar goods and services.

As regards the **first phase**, that is to say, whether the relevant public recognises a semantic content, the inherent distinctiveness of the components of the marks has to be evaluated by taking into account (each of) the relevant geographical area(s) and their different linguistic and cultural backgrounds. As such, the public in some parts of the relevant territory might not understand the descriptive content that a mark may have in other parts. In these cases, the distinctiveness of the mark in one area is not affected by the fact that it may be perceived differently in other areas.

Below is an example of a case where linguistic considerations were vital to the issue of distinctiveness.

Earlier sign	Contested sign	Case No
FRUTISOL	Solfrutta	27/01/2010, T-331/08, EU:T:2010:23
<p>G&S: Classes 29, 30 and 32</p> <p><i>Territory: EU</i></p> <p><i>Assessment of the components 'frut' and 'sol':</i> '... it is necessary to distinguish between the perception by the public in those Member States, such as Italy and Spain, where the elements "sol" and "frut" are generally recognisable and can be understood as alluding to "sun" and "fruit" respectively, and the perception by the public in those Member States, such as Hungary, Finland and Lithuania, where those elements have no such close equivalent in their national languages'. In the first category of Member States, consumers are liable to associate both marks with the notions of 'fruit' and 'sunshine'. There will consequently be a certain level of conceptual similarity between them. In Member States of the second category, consumers will not perceive any conceptual similarity between the signs since they will not attach any particular meaning to the constituent parts of either sign (paras 21-24).</p>		

The **second phase** consists of correlating any meaning that the public perceives in the components with the identical or similar goods and services in dispute. If the relevant public perceives this meaning as descriptive, laudatory or allusive (in a manner that materially affects distinctiveness), etc. for these goods and services, then its distinctiveness will be diminished accordingly. It may be necessary to distinguish between the various goods and services involved because the finding of no or limited distinctiveness might relate to only part of those goods and services. In the event that no meaning can be attributed to a verbal element, it cannot be descriptive, laudatory or allusive in any way and as such is considered distinctive.


The criteria applied to examining the inherent distinctiveness of a component of a sign are the same as the relevant principles applied when examining marks on absolute grounds (see the Guidelines, Part B, Examination) ⁽⁴⁴⁾. However, in relative grounds disputes, the question is not merely whether a component is distinctive or not (i.e. whether it reaches the minimum distinctiveness threshold for registration), but also to what degree it is distinctive within the sliding scale previously mentioned. Therefore, for instance, a term that is not descriptive but merely allusive for the goods or services in question might be distinctive enough to pass the absolute grounds test, but still have less than normal distinctiveness for the purposes of relative grounds.

The outcome of the examination of inherent distinctiveness will be one of the following.







- The component has **no distinctiveness** or has **less than normal distinctiveness**. See the examples below.
- The component has normal distinctiveness because it is neither non-distinctive nor weak for identical or similar goods or services.

As noted in paragraph 2.1 above, word marks consisting of a single word may still contain various components, some of which may be more distinctive than others (27/01/2010, T-331/08, Solfrutta, EU:T:2010:23).

3.2.2.5 Examples of descriptive components

Earlier sign	Contested sign	Case No
BYLY		14/04/2010, T-514/08, EU:T:2010:143
<p>G&S: Class 3</p> <p>Territory: EU</p> <p><i>Assessment of the element 'products': '... the term "products" is not distinctive enough to be taken into consideration by the consumers' (para. 39).</i></p>		


⁴⁴ See also Objective 2 of the Common Practice on the Impact of Non-Distinctive/Weak Components on Likelihood of Confusion agreed in the framework of the European Trade Mark and Design Network.

Earlier sign	Contested sign	Case No
Earlier sign	Contested sign	Case No
		22/06/2010, T-490/08, EU:T:2010:250
<p>G&S: Class 36</p> <p>Territory: EU</p> <p><i>Assessment of 'CAPITAL MARKETS':</i> 'the relevant public, consisting of consumers who are very attentive, well-informed and familiar with basic English financial terminology, will attach little significance to the meaning of the words "capital" and "markets", which are descriptive of those services and which do not enable the commercial origin of the trade marks at issue to be identified' (para. 59).</p>		
Earlier sign	Contested sign	Case No
		11/01/2010, R 834/2009-1
<p>G&S: Classes 3 and 5</p> <p>Territory: EU</p> <p><i>Assessment of the earlier right:</i> even though the signs have some similarities, the expression 'NATURAL BRONZE' is descriptive of the purpose of the goods (tanning) for the goods in Class 3 (para. 31).</p>		
Earlier sign	Contested sign	Case No
 (CINEDAY <i>et al.</i>)	CINETAIN	16/11/2010, R 1306/2009-4
<p>G&S: Classes 38 and 41</p> <p>Territory: Spain</p> <p><i>Assessment of the element 'CINE':</i> the word 'cine' has a descriptive meaning in the sense of 'cinema (film)'. Therefore, this component has only limited relevance in the perception of the signs (para. 36).</p>		
Earlier sign	Contested sign	Case No
	NATURAL BEAUTY FROM WITHIN	19/11/2010, R 991/2010-2


Earlier sign	Contested sign	Case No
<p>G&S: Classes 3 and 5</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment of the element 'NATURAL BEAUTY':</i> the element 'NATURAL BEAUTY' is a plain and essential indication of the kind and quality of the goods. The German public understands the meaning of these two basic words as well as the combination thereof (paras 31-35).</p>		
Earlier sign	Contested sign	Case No
FORCE-X	FSA K-FORCE	04/02/2015, T-558/13, EU:T:2015:135
<p>G&S: Classes 9 and 12</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the word 'force', synonymous with strength and power, can describe one of the characteristics of the goods concerned. Furthermore, for some goods in Class 12, it must be held that that word can also designate one of their purposes. Furthermore, as is apparent from the evidence adduced by the applicant, the word 'force' is commonly used, on the European market, in trade marks in the domain of cycling, thus rendering it banal (paras 38-39).</p>		

3.2.2.6 Examples of laudatory components

Earlier sign	Contested sign	Case No
	MAGIC SEAT	09/09/2008, EU:T:2008:319 T-363/06,
<p>G&S: Class 12</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment of the element 'MAGIC':</i> the word 'magic' will be perceived by the relevant public as a simple qualifier for the word 'seat' on account of its resemblance to the Spanish word 'mágico', which is purely laudatory (para. 39).</p>		
Earlier sign	Contested sign	Case No

STAR SNACKS		11/05/2010, EU:T:2010:186	T-492/08,
<p>G&S: Classes 29, 30 and 32</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of the element 'STAR':</i> the word element 'STAR' is laudatory, as it merely constitutes (together with the remaining elements of the signs) a reference to high-quality food products (para. 52).</p>			


3.2.2.7 Examples of allusive components

Earlier sign	Contested sign	Case No	
	WORLDLINK	27/02/2008, EU:T:2008:51	T-325/04,
<p>G&S: Class 36</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of the element 'LINK':</i> the element 'LiNK' of the earlier mark is not immediately descriptive of inter alia 'banking services for the dispensing of cash; funds transfer and payment services; financial information services' (Class 36) covered by the earlier mark, but merely allusive in relation to them (para. 68 et seq.).</p>			

3.2.3 Specific cases


3.2.3.1 Commonplace and banal elements


There are instances where signs are composed of one (or various) distinctive verbal element(s) and one (or various) figurative element(s) that are perceived by the relevant public as being commonplace or banal. These figurative elements frequently consist of a simple geometrical shape (e.g. frames, labels) or of colours frequently used in the market sector (e.g. red for fire extinguishers, yellow or red or orange for the postal sector depending on the Member State concerned). For this reason, these commonplace and banal elements are considered non-distinctive.

Earlier sign	Contested sign	Case No
ARCO		05/10/2011, R 1929/2010-2
<p>G&S: Class 9</p> <p>Territory: EU</p> <p><i>Assessment of figurative elements:</i> the verbal elements of the two signs coincide. Even if it is not negligible in terms of its size, the figurative element of the contested EUTM is likely to be perceived by consumers essentially as a mere decorative element, and not as an element indicating the commercial origin of the goods (para. 43).</p> <p>The marks are visually highly similar and phonetically and conceptually identical (paras 45-48).</p>		

3.2.3.2 Identical verbal elements accompanied by non-distinctive figurative elements

When comparing a word mark with a figurative mark containing an identical word element as its only word element, it is not necessary to assess the distinctiveness of the word if the figurative elements are not distinctive (mere colour, background or common typeface) and not dominant. In such cases, it is irrelevant that the word has only limited distinctiveness in relation to some goods and services in some languages, since this applies equally to both marks, while the figurative elements are clearly not sufficient to distinguish the marks.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
<p>G&S: services related to travel, accommodation and congresses in Classes 35, 39, 41, 42, 43.</p> <p>Territory: EU</p> <p><i>Assessment:</i> The Court did not go into the assessment of the inherent distinctiveness of the elements of the signs and agreed with the Board that the signs were visually highly similar and phonetically and conceptually identical (paras 83-92). The Board, therefore, correctly found the signs to be 'almost identical' (para. 93). The differentiating elements (the orange background and the particular way of writing) were considered to be insignificant.</p>		
Earlier sign	Contested sign	Case No

LEMON GOLD		21/11/2018, B 2 943 036
<p>G&S: Class 31</p> <p>Territory: Spain</p> <p><i>Assessment:</i> The earlier mark is entirely reproduced in the contested mark, where it is the only verbal component. Whether or not the identical verbal components are understood by the relevant Spanish public is immaterial since, given the present circumstances, they are on an equal footing regarding their distinctiveness. The only differences between the signs reside in the figurative elements of the contested sign, namely a lemon on a black, label-shaped, background. However, neither of these elements is distinctive given that lemons are the relevant goods and the label is a commonplace, banal shape. Consequently, the signs are aurally and conceptually identical, and visually highly similar.</p>		

3.2.3.3 One-letter components, numerals and short components

In its judgment of 09/09/2010, C-265/09 P, α , EU:C:2010:508, the Court held that the distinctiveness of single-letter trade marks must be assessed according to an examination based on the facts, focusing on the goods or services concerned and the **same criteria that apply to other word marks** (paras 33-39). Although that judgment deals with absolute grounds, the Office considers that the principle established by the Court (i.e. that the application of the criterion of distinctiveness must be the same for all marks) also applies in *inter partes* cases when it comes to determining the distinctiveness of single-letter components in trade marks.

The Court, although acknowledging that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, held that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law.

In the context of analysis of distinctiveness of components of signs, the Office considers the ruling to mean that, when establishing the distinctiveness of a single letter, being a component of a sign, it is not correct to rely on assumptions such as a priori statements that consumers are not in the habit of perceiving single letters as trade marks or on generic arguments such as that relating to the availability of signs, given the limited number of letters.

The General Court has since stated in a number of cases that a trade mark containing a **single letter** or a single numeral may indeed be inherently distinctive (08/05/2012, T-101/11, G, EU:T:2012:223, § 50; 06/10/2011, T-176/10, Seven for all mankind, EU:T:2011:577, § 36; 05/11/2013, T-378/12, X, EU:T:2013:574, § 37-51).

In its judgment of 10/05/2011, T-187/10, G, EU:T:2011:202, the General Court dismissed the applicant's argument that single letters are generally per se devoid of

distinctive character and that, therefore, only their graphic representation would be protected (paras 38-49).

The above considerations apply both to single-letter/numeral trade marks depicted in standard characters (i.e. word marks) and to stylised single-letter/numeral trade marks.

Furthermore, in accordance with the *α* judgment, as regards these components, unless the letter combination itself is descriptive or otherwise related to the goods and services (e.g. 'S', 'M', 'XL' for goods in Class 25), these components are not necessarily limited in their distinctiveness. The same rules apply to numerals.

3.2.3.4 Disclaimers

Prior to the entry into force, on 23 March 2016, of Amending Regulation (EU) 2015/2424, it was possible to record in the Register a **disclaimer** for an element of an EUTM that was non-distinctive in a language of the European Union. International registrations having effect in the European Union or in a Member State may also include a disclaimer. Some national trade mark systems also recognise disclaimers, or did so in the past. Consequently, an opposition may be filed on the basis of a trade mark that contains a disclaimer.

When signs are being compared or a global assessment of the likelihood of confusion is being carried out, a disclaimer cannot have the effect of excluding, or attributing limited importance to, a trade mark component; the principle of the **overall impression** conveyed by the signs and the **actual perception** of the relevant public prevails (12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 46-58, 62). Consequently, a disclaimed element cannot be disregarded when signs are compared. In general, if a disclaimed element is indeed non-distinctive, taking it into account will not produce a different outcome (12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 53 and 55). However, where the disclaimed element is non-distinctive in one language but distinctive in another which is also relevant for the comparison (as it may often happen with earlier EUTMs and international registrations designating the EU containing a disclaimer), taking the disclaimed element into account in the comparison can produce a different outcome.

3.2.3.5 Earlier marks, the distinctiveness of which is called into question

If the distinctiveness of the earlier mark is questioned, the Office applies the practice clarified in the *F1-Live* judgment (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314), namely that in proceedings opposing the registration of an EUTM, the validity of earlier trade marks may not be called into question.

Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness.

3.3 Dominant elements of the marks

It is the Office's practice to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean '**visually outstanding**'.

For a finding that there is a dominant element within a sign, the sign should have at least two identifiable components ⁽⁴⁵⁾. The rules explained in paragraph 3.2.1 above apply accordingly.

The decision should establish whether there is a dominant element or codominant elements and identify them.

Even though, according to the established case-law of the Court, aspects other than the visual one (such as a possible semantic meaning of part of a one-word sign) may come into play when defining the notion of the dominant element of a sign, it is the practice of the Office to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean 'visually outstanding' and to leave any other considerations for the overall assessment. As a result, the Office's practice is that the dominant character of a component of a sign **is mainly determined by its position, size, dimensions and/or use of colours**, to the extent that they affect its visual impact. As stated by the Court:

With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.

(23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 35; confirmed 28/04/2004, C-3/03 P, *Matratzen + Matratzenmarkt Concord* (fig.), EU:C:2004:233).

In addition, the Court has held that:

... the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.

(13/06/2006, T-153/03, *Peau de vache*, EU:T:2006:157, § 32).

Consequently, the fact that a component of a mark may or may not be considered non-distinctive (or as having a low degree of distinctiveness) has no bearing on the assessment of dominant character.



As a rule of thumb, the following should be considered.


- The assessment of dominant character applies to both the signs under comparison.
- For a finding that there is a dominant component, the sign should have at least two identifiable components.

⁴⁵ In this text the words 'component' and 'element' are used interchangeably.


- Word marks have no dominant elements because by definition they are written in standard typeface. The length of the words or the number of letters is not an issue of dominance but of overall impression (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment).
- Figurative elements may be dominant in signs where word elements are also present.
- Whether or not an element is visually outstanding may be determined in the visual comparison of the signs; if that is the case, it must be consistent with an evaluation of dominant character.
- Lastly, if it is difficult to decide which of the (at least) two components is dominant, this may be an indication that there is no dominant element or that no element is more dominant than the other (which includes cases of codominance). The establishment of dominant character implies that one component is visually outstanding compared to the other component(s) in the mark. If this applies to two or more components, they are codominant. If that assessment is difficult to make, it is because there is no dominant or codominant element(s).

Examples of cases

Sign	Dominant component and reasoning	Case No
	RPT: 'the dominant element of the earlier marks is the acronym RPT, in which the letter "p" predominates' (para. 33).	04/03/2009, T-168/07, EU:T:2009:51
	Free: 'the word "free" dominates the visual impression created by the mark of which it forms part, because it is considerably larger than the other components and, in addition, is much easier to remember and pronounce than the slogan in question' (para. 39).	27/10/2010, T-365/09, EU:T:2010:455

Sign	Dominant component and reasoning	Case No
	<p>Xtreme: ‘Visually, it must be concluded that in the mark applied for, the term “XTREME” occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements, and the word is highlighted with a white outline ... The other verbal components “RIGHT GUARD” and “SPORT”, are written in a much smaller type and are shifted to the right and towards the edge of the sign’ (para. 55).</p>	<p>13/04/2005, T-286/03, EU:T:2005:126</p>

Sign	Dominant component and reasoning	Case No
 <p>(by missako)</p>	<p>GREEN by missako: ‘It must be noted, as a first point, that the representation of the sun has an important place within the mark applied for, in that it is positioned in the centre and covers almost two thirds of the area. Next, the position of the word element “green” is also important within the mark, as it is portrayed in large-typeface, stylised upper case letters in black and takes up about one third of the area. As observed by the Board of Appeal in para. 28 of the contested decision, those two elements thus occupy the major portion of the mark applied for and are, therefore, striking in the overall impression of the mark. Lastly, as regards the word element “by missako”, the Board of Appeal correctly held, in para. 28 of the contested decision, that those words were almost illegible because of their size and that the handwriting made them difficult to decipher. It follows, first, that the dominant nature of the word “green” and of the representation of the sun are thereby further reinforced and, secondly, that the word element “by missako” is negligible in nature’ (paras 37-39).</p>	<p>11/11/2009, EU:T:2009:432</p> <p>T-162/08,</p>

Sign	Dominant component and reasoning	Case No
	BÜRGER: The dominant element of the mark applied for is undeniably the word element in upper case letters that stands out, simply because of its position and the very large size of its lettering, from all the other elements that make up the label (para. 38).	18/09/2012, T-460/11, EU:T:2012:432

3.4 Comparison of signs

In the following paragraphs the application of the principles explained above will be explained with regard to the visual (see paragraph 3.4.1 below), phonetic (see paragraph 3.4.2 below) and conceptual comparison (see paragraphs 3.4.3 and 3.4.4 below). Thereafter, the impact of distinctiveness and dominant character of the common and differing elements (see paragraph 3.4.5 below) and other principles to be taken into account in the comparison of signs (see paragraph 3.4.6 below) will be presented.

3.4.1 Visual comparison

Within the visual comparison it is important to note first that the public perceives word elements of a mark in a different way from other elements. Word elements can be read or associated with a sequence of letters. Other elements are just assessed as to their graphical or figurative characteristics. In the following, the principles of visual comparison will be presented depending on the type of trade marks involved.

3.4.1.1 Word marks versus word marks

A word mark is a mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof, represented in standard script and layout, without any graphic feature or colour (Article 3(3)(a) EUTMIR).

The protection of a word mark concerns the word as such. Therefore, it is irrelevant, for the purposes of the comparison of word marks, if one of them is written in lower-case letters and the other in upper-case letters.

Earlier sign	Contested sign	Case No (degree of similarity)
BABIDU	babilu	31/01/2013, T-66/11, EU:T:2013:48, § 57, 58 (high)
FRUTISOL	Solfrutta	27/01/2010, T-331/08, EU:T:2010:23, § 16, 17, 24 (low)
metabiarex	METABIOMAX	11/06/2014, T-281/13, EU:T:2014:440, § 41, 52-54 (low)

Nevertheless, where a word mark combines upper- and lower-case letters in a manner that departs from the usual way of writing ('irregular capitalisation'), this must be taken into account. Pursuant to Article 3(2) EUTMR, the representation of the trade mark defines the subject matter of the registration. The perception of the relevant public, who will not fail to notice the use of irregular capitalisation, also cannot be disregarded.

Irregular capitalisation may have an impact on how the public perceives the sign, and consequently, on the assessment of similarity. The impact of irregular capitalisation on the comparison of signs is assessed on a case-by-case basis. For example, it may change the meaning of the word element in the relevant language and therefore influence how the sign is perceived.

Earlier sign	Contested sign	Case No
AIDAmia	Damia	31/03/2016, R 3290/2014-4
<p>G&S: Classes 12, 18, 25, 29, 30, 32, 35</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Due to its specific spelling, the earlier sign will be divided by the consumer into the words 'aida' and 'mia'. The consumer will first and foremost perceive the 'AIDA' component of the earlier mark, which has no aural or visual equivalent in the contested sign (paras 36, 38, 45).</p>		

Hence, the use of irregular capitalisation may justify breaking down a single word into components, which may result in a relevant overlap with the conflicting mark (see paragraphs 3.4.3.2 and 3.4.5.1 below).

For word marks, the visual comparison is based on an analysis of the number and sequence of the letters/characters, the position of the coinciding letters/characters, the number of words and the structure of the signs (e.g. whether word elements are separated or hyphenated).

However, the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details. Therefore, small differences in the (number of) letters are often not sufficient to exclude a finding of visual similarity, particularly when the signs have a common structure.

In the following cases the marks were held to be visually similar.

Earlier sign	Contested sign	Case No (degree of similarity)
MEDINETTE	MESILETTE	13/06/2012, T-342/10, EU:T:2012:290 (average)
FORTIS	FORIS	17/03/2003, R 49/2002-4 (high)
ARTEX	ALREX	17/11/2005, T-154/03, EU:T:2005:401 (very high)
MARILA	MARILAN	27/01/2011, R 799/2010-1 (high)
EPILEX	E-PLEX	24/05/2011, T-161/10, EU:T:2011:244 (average)
CHALOU	CHABOU	16/11/2011, T-323/10, EU:T:2011:678 (high)

The following word marks are visually dissimilar.

Earlier sign	Contested sign	Case No
CAPOL	ARCOL	25/03/2009, T-402/07, EU:T:2009:85; 04/03/2010, C-193/09 P, EU:C:2010:121




The Board held that although those marks shared the letter 'a' and the ending 'ol', they 'clearly differ[ed]' visually. The General Court agreed. It held that **the same number of letters in two marks is not, as such, of any particular significance for the relevant public**, even for a specialised public. Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually similar. In addition, the public is not, in general, aware of the exact number of letters in a word mark and, consequently, will not notice, in the majority of cases, that two conflicting marks have the same number of letters (paras 81-82). The Court held that **what matters in the assessment of the visual similarity of two word marks is the presence, in each of them, of several letters in the same order** (para. 83). The ending 'ol' of the marks at issue constituted a common element of the marks but comes at the end and is preceded by completely different groups of letters ('arc' and 'cap' respectively), so the Board of Appeal correctly concluded that that this commonality does not render the marks visually similar (para. 83). The Court of Justice upheld this assessment from a visual perspective (para. 74).

3.4.1.2 Word marks versus figurative marks with word elements



When figurative marks with word elements and word marks are compared visually, what matters is whether the signs share a significant number of letters in the same position and whether the word element in the figurative sign is highly stylised. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour.

In principle, when the same letters are depicted in the same sequence, any variation in stylisation has to be high in order to find visual dissimilarity.

The following marks were considered visually **similar** because there was no high variation in the stylisation of the word elements in the figurative marks and the word element was easily recognisable and legible.

Earlier sign	Contested sign	Case No (degree of similarity)
VITAFIT		25/10/2012, T-552/10, EU:T:2012:576 (average)
COTO DE IMAZ		04/02/2010, R 409/2009-1 (high)
vendus sales & communication group		15/07/2010, R 994/2009-4 (high)

However, where the word in the figurative mark is highly stylised, the marks should be found visually **dissimilar**, as in the following examples.







Earlier sign	Contested sign	Case No
NEFF		20/09/2010, R 1242/2009-2
	NODUS	27/07/2007, R 1108/2006-4

The protection that results from the registration of a word mark concerns the word mentioned in the application for registration and not any specific graphic or stylistic









elements that the mark might eventually adopt in the future. Therefore, the argument that a word mark may be used with a stylisation similar to that of the conflicting figurative mark, so that the signs would look more similar, cannot prosper (see, in this regard, 20/04/2005, T-211/03, Faber (fig.) / NABER, EU:T:2005:135, § 37, 38; 13/02/2007, T-353/04, Curon, EU:T:2007:47, § 74).

3.4.1.3 Figurative marks with word elements versus figurative marks with word elements

When comparing signs in terms of their **word elements**, the Office considers signs similar insofar as they share a significant number of letters in the same position and are not highly stylised or are stylised in the same or a similar manner. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour (18/06/2009, T-418/07, LIBRO, EU:T:2009:208; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663; 29/11/2012, C-42/12 P, Alpine Pro Sportswear & Equipment, EU:C:2012:765, appeal dismissed). In the following examples, the marks were considered visually **similar** because they shared some words or sequences of letters and the typeface was deemed not to be highly stylised.

Earlier sign	Contested sign	Case No (degree of similarity)
		03/09/2007, R 1454/2005-4; confirmed 18/06/2009, T-418/07, EU:T:2009:208 (average)
		19/04/2016, T-198/14, EU:T:2016:222 (high); confirmed 10/11/2016, C-351/16 P, EU:C:2016:866
		16/01/2014, T-383/12, EU:T:2014:12 (high)

In the following examples, however, the marks were considered visually **dissimilar** in spite of the fact that they shared some words and/or letters and/or figurative devices, because the shared letters were highly stylised and/or placed differently and/or there were additional figurative devices.

Earlier sign	Contested sign	Case No
		11/05/2005, T-390/03, EU:T:2005:170
		23/01/2008, T-106/06, EU:T:2008:14
		05/03/2009, R 1109/2008-1
		02/08/2010, R 111/2010-4

When comparing figurative signs with word elements visually, it is still possible to find visual similarity when the figurative elements are different (i.e. neither match nor have the same or similar contours) and the word elements are different. Similarity will be found when the overall stylisation, structure and colour combination render the signs visually similar overall.

The following example illustrates how similar structure, stylisation and colour combination render signs visually similar.





Earlier sign	Contested sign	Case No (degree of similarity)
		29/09/2008, B 1 220 724 (high)

Earlier sign	Contested sign	Case No (degree of similarity)
		26/03/2018, R 1563/2017-2 (high)



3.4.1.4 Purely figurative marks versus purely figurative marks

When comparing signs in conflict in terms of their **purely figurative elements**, the Office considers the latter as images: if they match in one, separately recognisable, element or have the same or a similar contour, it is likely that some visual similarity will be found.

The following purely figurative signs were found to be visually **similar**.

Earlier sign	Contested sign	Case No (degree of similarity)
		15/03/2012, T-379/08, EU:T:2012:125 (average)
		11/03/2009, B 1 157 769 (medium)






The following purely figurative signs were deemed to be visually **dissimilar**.

Earlier sign	Contested sign	Case No
		11/10/2010, B 1 572 059

3.4.1.5 Figurative marks with word elements versus purely figurative marks

A coincidence in a figurative element that is visually perceived in an identical or similar way may lead to a visual similarity.

The following examples are cases where there are visual similarities because of matching figurative elements.

Earlier sign	Contested sign	Case No (degree of similarity)
		14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397 (significant)
(i)  (ii) 		17/11/2010, R 144/2010-2 (low)

In the following example the figurative elements were different and the signs were considered visually **dissimilar**.

Earlier sign	Contested sign	Case No
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		<p>30/05/2002, B 134 900</p> <p>The marks were considered visually dissimilar</p>
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3.4.1.6 Signs consisting of a single letter

In cases of conflicting signs consisting of the same single letter, the visual comparison is of decisive importance, these signs being phonetically and usually also conceptually identical.





The fact that the conflicting signs comprise the same single letter can lead to a finding of visual similarity between them, depending on the particular way the letters are depicted.

In the following examples, the signs were found to be visually similar **to a high or medium degree**.

Earlier sign	Contested sign	Case No
		<p>13/07/2004, T-115/02, EU:T:2004:234</p>
<p>G&S: Classes 9, 16, 25, 35, 41</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> as regards the visual similarity of the conflicting signs, the Board of Appeal rightly considered that both marks in question include as a dominant element the lower-case white letter 'a', of a commonplace typeface, on a black background. That dominant element makes an immediate impression and is remembered. Conversely, the graphic differences between the trade marks in question — namely the shape of the background (oval for the trade mark applied for and square for the earlier trade mark), the position of the letter on that background (in the centre in the case of the trade mark applied for and in the lower right-hand corner in the case of the earlier trade mark), the thickness of the line used to represent that letter (the trade mark applied for uses a slightly broader line than that used in the earlier trade mark) and the calligraphic details of the letters of the respective marks — are minor and do not constitute elements that will be remembered by the relevant public as effective distinguishing features. Consequently, the conflicting signs are very similar from the visual point of view.</p>		
Earlier sign	Contested sign	Case No

Earlier sign	Contested sign	Case No
A		20/05/2011, R 1508/2010-2
<p>G&S: Classes 9, 18, 24, 25, 28</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the Board found the signs visually similar to a medium degree.</p>		

In the following cases, the signs were found to be visually similar **to a low degree** (that resulted, depending on a particular case, in likelihood of confusion or no likelihood of confusion).

Earlier sign	Contested sign	Case No
(i)  (ii) 	 	10/05/2011, T-187/10, EU:T:2011:202
<p>G&S: Classes 9, 18, 25</p> <p><i>Territory:</i> EU, Italy</p> <p><i>Assessment:</i> The contested sign comprised a stylised letter G and the text 'G Line' in miniscule letters underneath. The signs were found to be similar to a low degree from a visual point of view (likelihood of confusion).</p>		


Earlier sign	Contested sign	Case No
		14/03/2017, T-276/15, EU:T:2017:163

G&S: Class 25

Territory: EU

Assessment: even though the signs can both be perceived as representing the letter 'e', they differ visually in their respective colours, typefaces and the overall impressions they convey (para. 25).


The outcome of this case: likelihood of confusion for identical goods and services (this part of the BoA decision was not challenged before the General Court). No likelihood of confusion for the similar and dissimilar goods and services (inter alia, *electric energy emanating from wind power; plants for the production of renewable energy; leasing of wind power energy generating facilities*) for which the relevant public has a high degree of attention.

Earlier sign	Contested sign	Case No
A		22/09/2011, T-174/10, EU:T:2011:519 dismissed 10/10/2012, C-611/11 P, EU:C:2012:626

G&S: Classes 18, 25

Territory: Germany

Assessment: on the basis of the particular graphic design of the contested trade mark, the Court only found a low degree of visual and conceptual similarity (para. 31). A phonetic comparison was not possible, as it was found that the public would most likely not pronounce the contested trade mark given the particular graphic design (para. 32). Please note that the outcome in this case was that of no likelihood of confusion, although the Court found low visual similarity between the signs.

Earlier sign	Contested sign	Case No
F		12/06/2007, R 1418/2006-2

G&S: Class 25

Territory: EU

Assessment: visually, the earlier mark is an upper case letter 'F' written in a standard typeface, whereas the contested mark is a stylised letter 'F', in which the horizontal line is embellished with a distinctive drawing that amounts to a relevant visual difference. The outcome of this case was that of no likelihood of confusion.

Finally, in the examples below the signs were found to be **visually dissimilar** due to the different stylisations or graphic elements of the single-letter signs. The final outcomes of these cases were those of no likelihood of confusion.

Earlier sign	Contested sign	Case No
		12/12/2007, R 1655/2006-4
<p>G&S: Class 25</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> even though the marks share the presence of the letter 'm', they cannot be considered visually similar since the overall visual impression that each mark makes on the relevant public is clearly distinct. The EUTM applied for is a complex graphic device that includes a black lowercase letter 'm' and in addition, other significant figurative elements, namely a bold curved dark line placed above a background circle in which the letter 'm' is almost included. These additional elements are of particular importance since the heavy bold line echoes the form of the background circle and the dark shade of the letter 'm', which is placed over the background. In the earlier mark, the letter 'm' appears in outline font with a characteristic inclination to the right and an uneven height so that the right-hand size of the letter is lower. Consequently, these dissimilarities between the signs are sufficient for it to be held that they do not give the consumer the same visual impression (para. 18).</p>		
Earlier sign	Contested sign	Case No
		04/10/2010, R 576/2010-2; confirmed 24/01/2012, T-593/10, EU:T:2012:25
<p>G&S: Classes 25, 41, 43</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> due to the different colours, figurative element and stylisation, the marks were found to be visually dissimilar. Visually, the earlier mark can be perceived as a boomerang, accompanied by the letter 'B', which is the first letter of 'boomerang'.</p>		

It should be pointed out that the verbal representation of 'one-letter/one-digit sign' is not to be considered equivalent to the sign (e.g. 'ONE' is not equal to '1' or 'EM' to 'M'). Therefore, the aforementioned arguments are not directly applicable to such cases.

Finally, it must be noted that the above considerations also apply to signs consisting of single numbers.

3.4.1.7 Other types of marks

When comparing other types of marks (shape marks, motion marks, etc.), the same basic principles as for word and figurative marks as described above are to be applied.

3.4.2 Phonetic comparison

When the opposition is based on earlier signs that enjoy protection in different EU Member States, in principle, account must be taken of all the different pronunciations of the signs by the relevant public in all official languages of those Member States. Local accents are not taken into account. Nevertheless, as already mentioned, when the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole** EU. However, where there is a likelihood of confusion for a part of the EU **and** it is justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office's analysis need not extend to the whole EU but may instead focus on only a **part or parts** where there is a likelihood of confusion.

The overall phonetic impression produced by a sign is particularly influenced by the number and sequence of its syllables. The common rhythm and intonation of signs play an important role in how signs are perceived phonetically. The *Collins English Dictionary* defines 'rhythm' as 'the arrangement of words into a more or less regular sequence of stressed and unstressed or long and short syllables'. 'Intonation' is defined as 'the sound pattern of phrases and sentences produced by pitch variation in the voice'.

Therefore, the key elements for determining the overall phonetic impression of a trade mark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.

The following are examples of phonetically **dissimilar** marks.

Earlier sign	Contested sign	Relevant territory	Case No
CLENOSAN	ALEOSAN	ES	28/03/2011, R 1669/2010-2
GULAS	MARGULIÑAS	ES	12/04/2011, R 1462/2010-2

The following are examples of phonetically similar/identical marks.

Earlier sign	Contested sign	Relevant territory	Case No (degree of similarity)
CAMEA	BALEA	EU	14/01/2015, T-195/13, EU:T:2015:6 (low)
		PT: the part of the relevant public that has some knowledge of the English language will read and pronounce the earlier mark in the same way as the mark applied for insofar as the latter uses the English word 'forever' (para. 70). The marks at issue share the same ending 'ever'; the Board of Appeal did not err in finding that those marks were phonetically similar to an average degree for the part of the relevant public with no knowledge of the English language (para. 72).	16/01/2014, T-528/11, EU:T:2014:10 (identity/average)
FEMARA		EU	12/02/2010, R 722/2008-4 (above average)
	FOR US	BX	16/09/2010, R 166/2010-1 (identity)
		DE	09/06/2010, R 1071/2009-1 (low)





3.4.2.1 Signs and elements in signs that must be assessed


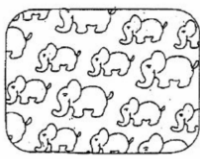
The Office conducts a phonetic comparison when both trade marks can be pronounced or have a sound. Accordingly, a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. In other words, purely figurative marks (i.e. those not containing any word element) are not subject to a phonetic assessment. The ‘meaning’ that the image evokes, or its ‘description’, will be assessed visually and conceptually.

In this respect, the Office follows the case-law established by the judgments of 07/02/2012, T-424/10, *Éléphants dans un rectangle*, EU:T:2012:58, § 46; 08/10/2014, T-342/12, *Star*, EU:T:2014:858, § 48; 30/09/2015, T-364/13, *KAJMAN / Device of a crocodile et al.*, EU:T:2015:738, § 46; 25/11/2015, T-320/14, *Device of two wavy black lines (fig.) / Device of wavy black link (fig.)*, EU:T:2015:882, § 45-46. The contrary position taken by the Court in the judgment of 07/05/2015, T-599/13, *GELENKGOLD / FORM EINES TIGERS et al.*, EU:T:2015:262, § 65 cannot be considered as a prevailing trend until clarification is given by the Court of Justice.

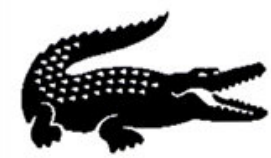

The Office does not undertake an indirect phonetic comparison, based on the description or a meaning attributed to the image by the public, given that in most cases, it is difficult to define which description the public will attribute to a figurative element and that the comparison based on such a description would lead to a subjective and arbitrary outcome. Furthermore, if the phonetic comparison is based on a description of a figurative element or on its meaning, it will only repeat the outcome of the visual or conceptual comparison respectively, where these elements have already been assessed.

The following are examples of where no phonetic comparison could be made because the marks are purely figurative.

Earlier sign	Contested sign	Case No
		25/11/2015, EU:T:2015:882 T-320/14,
		08/10/2014, EU:T:2014:858 T-342/12,

Earlier sign	Contested sign	Case No
		07/02/2012, T-424/10, EU:T:2012:58

Furthermore, when one of the signs has elements that can be read and the other has only figurative elements, the two signs cannot be phonetically compared directly, as in the following examples.

Earlier sign	Contested sign	Case No
		30/09/2015, T-364/13, EU:T:2015:738

Earlier sign	Contested sign	Case No
	 (KUNGFU)	17/11/2010, R 144/2010-2

With regard to the pronunciation of figurative elements reminiscent of a letter, it should be noted that the relevant public will tend to read these figurative elements only when they are linked to or form part of a word known to the relevant public, such as in the following examples.

Earlier sign	Contested sign	Case No
OLI SONE		16/04/2010, B 1 269 549
ROCK		13/10/2009, T-146/08, EU:T:2009:398

In the following case, however, the figurative element will not be recognised and read as 'X' and the contested sign read as 'be light'.

Earlier sign	Contested sign	Case No
BECKs		30/05/2013, EU:T:2013:286 T-172/12,

As a general rule, all word elements (including letters and numbers) are subject to the phonetic comparison. It may be the case, however, that the relevant public refers aurally to a sign by some elements and omits some words/letters.


For example, the relevant public may omit verbal elements that are clearly less prominent than ones that stand out visually, or are otherwise secondary in the overall impression given by the mark.

Furthermore, in its judgment of 03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, the Court found that the public will not pronounce the words 'american blend' due to their **descriptive character**. In its judgment of 03/06/2015, in joined cases T-544/12, PENSA PHARMA, EU:T:2015:355 and T-546/12, pensa, EU:T:2015:355, the Court stated that consumers would not pronounce the word 'pharma', inasmuch as that word was superfluous because of the nature of the goods and services at issue.


Economy of language might be another reason for assuming that some elements will be pronounced while others will be omitted, particularly in case of very long marks (11/01/2013, T-568/11, interdit de me gronder IDMG, EU:T:2013:5, § 44).

Finally, while words, letters and numbers should in principle be assessed phonetically, some symbols and abbreviations give rise to uncertainty.

For example, the logogram '&' (ampersand) will generally be read and pronounced and therefore should be included in the phonetic comparison. However, the pronunciation of a given symbol may differ where different languages are concerned.



Earlier sign	Contested sign	Case No
	DNG	15/09/2010, R 160/2010-2 The ampersand ‘&’ will be pronounced in most European Union languages and is recognised as the corresponding translation of the conjunction ‘and’.


The same goes for the typographic character @, which in principle will be pronounced. Obviously, the pronunciation of a given symbol may differ where different languages are concerned.

Earlier sign	Contested sign	Case No
	VODAFONE AT HOME	30/08/2010, R 138/2010-2 @ will be pronounced as ‘at’ or ‘arobase’ in the Benelux (para. 21).

In the above case, it cannot be denied that a part of the relevant public — in particular English speakers — would read the ‘at’ symbol and thus pronounce the trade mark as ‘at home’. This possibility must, therefore, be taken into consideration, together with other possibilities such as ‘a home’ or simply ‘home’. Naturally, the symbol may be read in a different way in other languages (e.g. ‘arroba’ in Spanish and Portuguese).




However, compare this with the following examples.

Earlier sign	Contested sign	Case No
		03/02/2011, R 719/2010-1; dismissed 19/09/2012, T-220/11, EU:T:2012:444; dismissed 14/11/2013, C-524/12 P, EU:C:2013:874 The @ will be perceived as the letter ‘a’ by (at least) the EN public (para. 25).



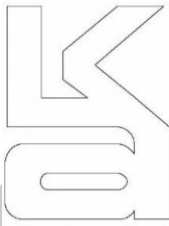


Earlier sign	Contested sign	Case No
		20/07/2016, T-745/14, EU:T:2016:423 The symbol '@' will easily be understood by the consumer as replacing the letter 'a' (para. 26).



The plus (+) and minus/hyphen (-) symbols may or may not be pronounced by the relevant public, depending on the circumstances. The minus symbol may be pronounced when used in combination with a number, for example, '-1', but it will not be pronounced if used as a hyphen (as in 'G-Star').

In the following examples, the symbol '+' in the contested EUTM application would be pronounced as 'plus'.

Earlier sign	Contested sign	Case No
AirPlus International		03/03/2010, T-321/07, EU:T:2010:64; dismissed 25/11/2010, C-216/10 P, EU:C:2010:719
		16/09/2009, T-400/06, EU:T:2009:331

However, sometimes the way in which symbols — or letters — are used makes it unrealistic to assume that they will be read and pronounced in a particular way, for example, when in a figurative mark a symbol is repeated in order to create a pattern or is highly distorted or when the letters/numbers are otherwise not clearly legible/identifiable. This is illustrated by the following examples.

Sign	Explanation
	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' can be read. The mark must, therefore, be assessed phonetically.</p>
	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' is so highly distorted that the Court found that for part of the public it is difficult to clearly identify if it is indeed the letter 'b' or the figure '8'.</p>
	<p>22/06/2011, R 1779/2010-4</p> <p>It is very difficult to determine the pronunciation of the sign. An aural comparison may, therefore, lead to very different results, ranging from identity to dissimilarity.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this figurative mark the letter 'H' can be read and, therefore, must be assessed phonetically.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this sign, the pattern makes it unlikely that consumers will read an 'H' (or rather several 'H's). This mark cannot be assessed phonetically.</p>



Sign	Explanation
	16/10/2013, T-282/12, EU:T:2013:533 The Court held that, although hardly legible at first sight, the words 'FREE' and 'STYLE' in both of the signs are pronounced identically regardless of the language of the public.
	30/11/2017, T-475/16, EU:T:2017:856 The General Court held that it was not likely that the public would detect the letter 'y' in the figurative element of the mark. First, there is a great difference between the letter 'y' and the heart symbol. Second, the heart symbol is not usually used to replace the letter 'y'.

In summary, whether or not a given symbol/letter is pronounceable depends on the type of character in question, how it is depicted, and how it is combined with other elements of the sign.

3.4.2.2 Identical/similar sounds in different order

Where the opposing trade marks are formed of syllables or words that are identical or highly similar but in a different order, so that if just one of the syllables or words were rearranged the signs would be identical or highly similar phonetically, the conclusion should be that the signs are phonetically similar.

Examples

Earlier sign	Contested sign	Case No (degree of similarity)
VITS4KIDS	Kids Vits	09/12/2009, T-484/08, EU:T:2009:486; dismissed 22/10/2010, C-84/10 P, EU:C:2010:628 (significant)
		11/06/2009, T-67/08, EU:T:2009:198 (high)

3.4.2.3 Signs consisting of or including foreign or invented words

When a sign contains foreign words, it should be assumed in principle that the relevant public is unfamiliar with how foreign native speakers pronounce their own language. Accordingly, the public will tend to pronounce a foreign word in accordance with the phonetic rules of their own language.

Earlier sign	Contested sign	Case No
LIDL	LIFEL	19/10/2010, R 410/2010-1 The first two letters and the last one are the same in both marks. Aurally, the similarity is even stronger because LIDL will often be pronounced as if spelt LIDEL. For phonological reasons, 'D' and 'L' are nearly impossible to pronounce in most languages without inserting a vowel between them. Therefore, the marks would be pronounced LIFEL and LIDEL in languages like French, German, Italian and Spanish.
KAN-OPHTAL PAN-OPHTAL	BAÑOFTAL	12/07/2012, T-346/09, EU:T:2012:368 The relevant territory is Germany. The Court found a phonetic similarity. The German consumer will probably pronounce the letters 'N' and 'Ñ' in the same way. Moreover, the letters 'P' and 'B' are pronounced with both lips and their sound can be confused if they are accompanied by the same vowel; the signs PAN-OPHTAL and BAÑOFTAL are aurally very similar.

GLANZ	GLÄNSA	13/07/2011, T-88/10, EU:T:2011:368 The GC concluded that the umlaut would not alter the overall phonetic impression for EN, ES and FR speakers, since the languages in question do not have the letter 'ä' (para. 40).
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However, this will not be the case when the relevant public is familiar with a word, for example in the following scenarios.

- When it is an established fact that a foreign language is known by the relevant public. For example, the Court has already confirmed that there is at least a basic understanding of the English language by the general public in the Scandinavian countries, the Netherlands and Finland (26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23).
- When certain terminology is clearly known by the relevant public for certain classes of goods and/or services. For example, IT professionals and scientists are generally considered to be more familiar with the use of technical and basic English vocabulary than the average consumer, irrespective of territory (27/11/2007, T-434/05, Activy Media Gateway, EU:T:2007:359, § 38, 48 for the IT field (11/12/2008, C-57/08 P, EU:C:2008:718, dismissed); 09/03/2012, T-207/11, Isense, EU:T:2012:121, § 21-22 for German professionals in the medical field).
- When very basic words will be understood in all Member States, such as the English words 'baby', 'love', 'one', 'surf', the Italian word 'pizza', which has also entered the English language, etc.

Earlier sign	Contested sign	Case No
Babylove Baby Love		08/07/2011, R 883/2010-2

- Finally, when any one of the parties provides compelling evidence that a word is known by a significant portion of the relevant public.

Where a significant part of the relevant public pronounces the foreign word correctly, but another significant part applies the rules of their mother tongue, any assessment of phonetic similarity should mention both pronunciations and provide reasoning.



Earlier sign	Contested sign	Case No
WRITE	RIGHT	(example only)
		English: highly similar aurally
		Spanish: dissimilar aurally
	ZIRH	03/03/2004, T-355/02, EU:T:2004:62; dismissed 23/03/2006, C-206/04 P, EU:C:2006:194 Similar in English-speaking countries and Spain.

As regards **invented or fanciful words** (words that do not correspond to any existing word in the EU), the relevant consumer might pronounce them not only as they would sound according to the rules of pronunciation of their mother tongue but also as they are written.

Earlier sign	Contested sign	Case No
BAMIX	KMIX	21/02/2013, T-444/10, EU:T:2013:89 The GC noted that the word element 'kmix' does not correspond to any existing word in the European Union and that it may be pronounced by part of the relevant public as it is written, as a single syllable. However, it also considered it possible that the mark applied for would be pronounced as a two-syllable word, namely 'ka' and 'mix'. In certain languages of the European Union (in particular French and German), the letter 'k' is pronounced as 'ka' and the pronunciation 'km' is not usual (para. 32).

3.4.2.4 Single letter signs

Marks consisting of a single letter can be compared phonetically. The following marks are phonetically identical insofar as they both reproduce the letter 'A'.

Earlier sign	Contested sign	Case No
		13/07/2004, EU:T:2004:234 T-115/02,

3.4.3 Conceptual comparison: the semantic content of marks

Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24). The 'semantic content' of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions 'semantic content' and 'concept' will be used indiscriminately.

If a mark consists of various elements (e.g. a word and a figurative element) the concept of each of the elements must be defined. However, if the mark is a meaningful expression (made up of two or more words), what matters is the meaning of the expression as a whole and not of each of the words in isolation.

Not every concept has to be defined: only those concepts likely to be known by the relevant public, as defined by the relevant territory, matter. For example, if the relevant territory is Spain, the fact that the word has a meaning in Polish is normally irrelevant.

The conceptual comparison may be influenced by the relevant goods and services. For example, if a term has many meanings, one of which is of particular significance to the relevant goods and services, the conceptual comparison may focus on this meaning. In any event, what matters is how the term is perceived by the relevant public. A link between the goods and services and what the sign means, evokes or represents must not be forced or artificially constructed. For example, if the relevant goods relate to *lighting* and the sign is or contains the element 'LED', 'light-emitting diode' is one of the various possible meanings of 'LED'. Therefore, the conceptual comparison may focus on this meaning.

3.4.3.1 The semantic content of words

When the mark consists of or contains a word, the first step for an examiner is to look up the explanation of that word in dictionaries and/or encyclopaedias in the language(s) of the relevant territory. If the word is in the dictionary/encyclopaedia, the described meaning will be its semantic content.

As a starting point, it should be noted that the relevant public in the various EU Member States mainly speak the languages predominant in their respective territories (23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 27). These languages are normally the official languages of the relevant territory.

Earlier sign	Contested sign	Case No
HALLOUMI	HELLIM	13/06/2012, T-534/10, EU:T:2012:292
<p>'Hellim' is the Turkish translation of 'Halloumi' (Greek) (a type of cheese). The relevant territory was Cyprus. The Court held that while Turkish is not an official language of the EU, it is one of the official languages of the Republic of Cyprus. Therefore, Turkish is understood and spoken by part of the population of Cyprus (para. 38).</p> <p>Therefore, the Court found that the average consumer in Cyprus, where both Greek and Turkish are official languages, will understand that the words HALLOUMI or HELLIM both refer to the same specialty cheese from Cyprus. Consequently, there is some conceptual similarity between these words (para. 41).</p>		




However, the Court has made equally clear that this rule only concerns the primary linguistic understanding of the public in those territories. This is not an inflexible rule. The relevant public should not automatically be considered as having as its mother tongue the language that is predominant in the Member State concerned, or to have no particular knowledge of other languages (03/06/2009, C-394/08 P, *Zipcar*, EU:C:2009:334, § 51).

For instance, in the following scenarios, languages other than the predominant one are to be taken into account.

- When the word in another language is very close to the equivalent word in the official language of the relevant territory. For example, the English word 'bicycle' will be understood in Spain because it is very close to the Spanish equivalent word, 'bicicleta'.
- When the word in a foreign language is commonly used in the relevant territory. For example, the Spanish word 'bravo' is commonly used as a term denoting praise, in the sense of 'well done' in Germany.
- When it is known that the relevant public is familiar with a foreign language. For example, the Court has already confirmed that the general public in the Scandinavian countries, the Netherlands and Finland, has at least a basic understanding of the English language (26/11/2008, T-435/07, *New Look*, EU:T:2008:534, § 23).
- When it is known that the relevant public is familiar with a certain language for certain classes of goods and/or services. For example, English IT terms are normally understood by the relevant public for IT goods and services, irrespective of territory.

- Very basic words, which will be understood in all Member States because they have become internationally used, such as ‘baby’, ‘love’, ‘one’, ‘surf’, the Italian word ‘pizza’, which has also entered the English language, etc.
- Finally, when any one of the parties submits evidence that a word is known by a relevant portion of the relevant public.

The following are **examples** of concepts behind words.

Sign	Territory	Concept	Case No
Mirto	ES	[in EN: myrtle] in Spanish describes a shrub of the family <i>Myrtaceae</i> , 2-3 m high.	19/03/2010, T-427/07, Mirtillino, EU:T:2010:104
Storm	EN	Bad weather	08/07/2010, T-30/09, EU:T:2010:298
 --- STAR SNACKS	EU	The terms ‘star snacks’ and ‘star foods’ will be understood as referring to quality food not only by English speakers, but also by most of the relevant public.	11/05/2010, T-492/08 (Star foods I), EU:T:2010:186 10/10/2012, T-333/11 (Star Foods II), EU:T:2012:536
 	EU	There is some degree of conceptual similarity, based on ‘Mc’ and the words ‘baby’ and ‘kids’ that both refer to children (para. 42).	05/07/2012, T-466/09, EU:T:2012:346

As shown in some of the examples above, it is not always necessary to give a complete dictionary definition of what a word means. It is sufficient to use a synonym.

Additionally, when part of the public will perceive the concept while another part either will not or will perceive a different meaning, a distinction should be made accordingly.

When the mark conveys a **meaningful expression**, the meaning of the expression as a whole, as long as it is understood as such by the relevant public, and not that of the individual words, is the one that is relevant for the conceptual comparison (however, note the exception below concerning expressions in foreign languages). Therefore, individual assessment of each element of the mark should be avoided.


Fictional example: ‘KING’S DOMAIN’ v ‘KING SIZE’.

Incorrect assessment: ‘KING’ means ‘a male sovereign’, ‘DOMAIN’ means ‘a territory over which rule or control is exercised’ and ‘SIZE’ means ‘the physical dimensions,

proportions, magnitude, or extent of an object'. The marks are conceptually similar insofar as they share the notion of 'king'.

Correct assessment: 'KING'S DOMAIN' means 'a territory under the control of a king'; 'KING SIZE' means 'larger or longer than the usual or standard size'. The marks are conceptually dissimilar even though they share the word 'KING'.

This is further illustrated by the following example from case-law:

Earlier sign	Contested sign	Case No
BLACK TRACK		06/03/2015, T-257/14, EU:T:2015:141
<p>G&S: Class 28</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The English-speaking public will perceive the expression 'black jack' as a whole designating a card game and will not perceive the word 'black' independently within that expression. The expression constituting the earlier mark, 'black track', will also be perceived with its distinct meaning. Therefore, it cannot be held that the signs are conceptually similar just because they both contain the word 'black'. The signs are conceptually dissimilar (paras 38-42).</p>		

Furthermore, when the mark is composed of a noun and a qualifying adjective, in general it will be perceived as a conceptual unit and will not be broken down into its constituent elements.

Earlier sign	Contested sign	Case No
EAU PRECIEUSE	NUIT PRECIEUSE	12/09/2018, T-905/16, EU:T:2018:527 (02/05/2019, C-739/18 P, EU:C:2019:356, appeal dismissed)
<p>G&S: Class 3</p> <p><i>Territory:</i> France</p> <p><i>Assessment:</i> The relevant public will clearly perceive the meaning of each of the signs at issue as a complete phrase containing a noun, 'nuit' and 'eau' respectively, with an identical qualifying adjective, namely 'précieuse'. While the first sign refers to the concept of water that is precious, the second refers to the idea of a cherished or esteemed night. Those are different concepts and, regard being had to their obvious meaning, the relevant public will not dissect those signs in order to distinguish each element of them (paras 62-64).</p>		

The abovementioned rule on meaningful expression has the following **exception**: when signs are in a foreign language, a significant part of the relevant public may have only a limited command of the relevant foreign language and, therefore, might not be able to

distinguish the difference in meaning between two expressions. In these instances it may be that the meaning of an expression as such is not perceived; only the meanings of the individual elements. This may, therefore, lead to a finding of similarity insofar as the public understands only the common part. In the example above, if it is found that (part of the) public will only understand KING, the finding should be that the signs are conceptually similar.

Earlier sign	Contested sign	Case No
ICEBERG	ICEBREAKER	08/09/2010, T-112/09, EU:T:2010:361
<p>The GC considered that 'icebreaker' would be understood only by that part of the Italian public with a command of the English language. However, 'iceberg' is a common word with an immediately obvious meaning to the relevant public. Therefore, the earlier mark ICEBERG will have a clear meaning for the Italian public, whereas the mark applied for ICEBREAKER would be devoid of any clear meaning for that public.</p> <p>The GC further indicated that the marks at issue have the prefix 'ice' in common. The GC considered that this is a basic English word, understandable for most of the relevant public. It concluded that since the prefix 'ice' had a certain evocative force, it must be regarded as limiting the conceptual difference between the marks at issue, acting as a 'semantic bridge' (paras 41-42).</p>		

Similar considerations apply to expressions that include a combination of technical words understood by only part of the relevant public (e.g. Latin words, words belonging to highly specialised language) and commonly used words. In these cases, it may be that only the meaning of the commonly used words is perceived, and not the meaning of the expression as such.

3.4.3.2 The semantic content of parts of words

In this regard, the Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements which, for them, suggest a specific meaning or which resemble words known to them (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 57).



Consequently, while the rule is that marks are perceived as a whole, the exception to the rule is that, under certain circumstances, consumers could break them down into smaller parts. Since this is an exception, it has to be applied restrictively.

It will be applied in the following cases.

- when a **visual separation** assists in identifying parts with a concept (e.g. through the use of lower- and upper-case letters, the stylisation of letters or the use of a special character separating the elements, such as a symbol, numeral, hyphen or other punctuation mark);

- when, without a visual separation, **all** the parts of the word suggest a concrete meaning known to the relevant public; or
- when, without a visual separation, **one** part of the word has a clear meaning.

i) Examples of signs where a visual separation assists in identifying parts.


Sign	Territory	Concept	Case No
	EU	The use of capital letters allows the sign to be separated immediately into two distinct words, namely 'invest' and 'hedge'.	11/06/2009, T-67/08, EU:T:2009:198, § 35
VITS4KIDS	EU	The mark contains VITS (allusive of 'vitamins') and KIDS.	09/12/2009, T-484/08, EU:T:2009:486
	EU	AGRO: reference to agriculture HUN: reference to Hungary UNI: reference to universal or union.	24/03/2010, T-423/08, EU:T:2010:116

ii) Examples of signs where, despite the absence of a visual separation, the single word can be broken down into parts, **all** of which suggest a concrete meaning known to the relevant public.

Sign	Territory	Concept	Case
Ecoblue	EU	The word element 'eco' is a common prefix or abbreviation in many languages spoken in the European Union, while the word 'blue' is English for the colour blue and part of the basic English vocabulary known to the relevant public.	12/11/2008, T-281/07, EU:T:2008:489; dismissed 22/01/2010, C-23/09 P, EU:C:2010:35

Sign	Territory	Concept	Case
Solfrutta / FRUTISOL	EU	The elements 'sol' and 'frut' are generally recognisable and can be understood as alluding to 'sun' and 'fruit' respectively.	27/01/2010, T-331/08, EU:T:2010:23
RIOJAVINA	EU	The term 'riojavina' in the mark applied for refers directly, so far as the relevant public is concerned, to grapevine products and, more particularly, Rioja wine.	09/06/2010, T-138/09, EU:T:2010:226; Dismissed 24/03/2011, C-388/10 P, EU:C:2011:185

iii) Examples of signs where **one** part of the single word has a clear meaning. These are usually signs that include a common prefix or suffix.

Sign	Territory	Concept	Case No
	DE	'DERMA' may be perceived as referring to goods of a dermatological nature.	03/04/2009, B 1 249 467
RNAiFect	EU	The relevant public, particularly the specialist public, will perceive the first three letters as a reference to the English abbreviation for ribonucleic acid.	28/10/2009, T-80/08, EU:T:2009:416
nfon	EU	The relevant public will isolate the syllable 'fon' in the sign 'nfon', and perceive this term as relating equally to the words 'telephone' or 'phone.' (para. 60).	29/01/2013, T-283/11, EU:T:2013:41; dismissed 16/01/2014, C-193/13 P, EU:C:2014:35

As explained above, all three exceptions have to be construed narrowly; therefore, where it is not obvious that a part or parts suggest(s) a concrete meaning known to the




relevant public, a sign should not be artificially dissected. In the examples below, no concept was found in the signs.

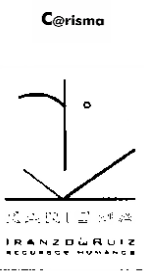
Sign	Territory	Concept	Case No
ATOZ	DE, ES, FR, IT, AT	The TM will not be perceived as 'from A to Z'. The letters 'to' (corresponding to an English preposition) do not stand out in any way from the letters 'a' and 'z'.	26/11/2008, T-100/06, EU:T:2008:527; dismissed 16/09/2010, C-559/08 P, EU:C:2010:529
SpagO	BX	The word 'SpagO' is an invented word that has no meaning in any of the official languages of Benelux countries. It should not be perceived as a combination formed by SPA + GO.	12/11/2009, T-438/07, EU:T:2009:434
CITRACAL --- CICATRAL	ES	The word elements 'cica' and 'citra' do not have any concrete meaning, any more than the endings 'tral' and 'cal'. The signs at issue are, therefore, not likely to be broken down by the public into word elements that have a concrete meaning or resemble words known to it and that, together, would form a coherent whole giving a meaning to each of the signs at issue or to any one of them.	11/11/2009, T-277/08, EU:T:2009:433

3.4.3.3 The semantic content of misspelt words

It is not necessary for a word to be written properly for its semantic content to be perceived by the relevant public. For example, while the written word 'XTRA' is visually not the same as the 'correct' word 'EXTRA', because it is aurally identical to it, the concept of the 'correct' word (extra) will normally be transferred to the misspelt word (xtra).

The following examples illustrate this point.

Sign	Territory	Concept	Case
	EU	Part of the relevant public will regard it as a reference to the English word 'store', meaning 'shop, storage'.	21/01/2010, T-309/08, EU:T:2010:22
CMORE	EN	CMORE will, in view of the common practice of sending text messages, probably be associated by a significant part of the general public in Denmark and Finland with an abbreviation or misspelling of the verb 'to see' in English, with the concept being perceived as 'see more'.	23/09/2011, T-501/08, EU:T:2011:527,
	EN	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.	15/04/2010, T-488/07, EU:T:2010:145
	EU	The term contained in the mark will bring to consumers' minds the idea of 'yogurt', i.e. 'a semi-solid, slightly sour, food prepared from milk fermented by added bacteria'.	14/07/2009, B 1 142 688

Sign	Territory	Concept	Case
	ES	The words 'KARISMA' and 'C@RISMA' refer to 'charisma' or 'charism', i.e. a special personal quality or power of an individual, making him or her capable of influencing or inspiring large numbers of people.	28/10/2008, B 1 012 857

Examiners should take care when attaching meaning to a misspelt word: the meaning is not likely to be transferable when the words are not (aurally) identical and/or when the misspelt element cannot be perceived independently.

Sign	Territory	Concept	Case No
Bebimil	EU	The mark applied for does not contain the word 'baby' but a fanciful word, which is further removed and without any clear and specific meaning, i.e. 'bebi'.	16/09/2006, T-221/06, EU:T:2009:330

3.4.3.4 The semantic content of names and surnames

The General Court has accepted that names have a concept. Therefore, a conceptual comparison must be made when conflicting signs are composed of names (see examples below).

Nevertheless, there are few situations where the fact that a trade mark contains a family name has conceptual significance. In particular, conceptual similarity cannot result from the mere fact that both trade marks contain a name, even the same kind of name (Celtic family name, Dutch name, etc.).

Sign	Territory	Concept	Case No
MCKENZIE / McKINLEY	EU	The relevant public recognises the prefix 'Mc', signifying 'son of', as a prefix to many Scottish or Irish family names. That public will, therefore, regard the word elements of the marks at issue as Celtic family names of no conceptual significance, unless the name is particularly well known as that of a famous person.	18/05/2011, T-502/07, EU:T:2011:223
VANGRACK / VAN GRAF	DE	The fact that both marks may be perceived as lower German or Dutch surnames is on its own neutral for comparison purposes.	12/09/2011, R 1429/2010-4

The mere fact that two names can be grouped under a common generic term of 'names' does not constitute conceptual similarity. For example, if FRANK and MIKE are compared: the fact that both are names would not lead to a finding of conceptual similarity; this is because the public is not likely to make the conceptual link between the two words. By contrast, the fact that FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity.


Sign	Territory	Concept	Case No
SILVIAN HEACH (fig.) / H. EICH	Italy and other territories	Whereas 'HEACH' would be perceived as a surname of Anglo-Saxon origin, the element 'EICH' would be perceived as a surname of German origin (para. 66). In view of this, the consumers would realise that these surnames distinguish different persons. The signs are conceptually different (para. 69).	19/06/2012, T-557/10, EU:T:2012:309

The fact that a trade mark contains a name may have an impact on conceptual comparison in the following situations.

(a) When it is the name/surname of a well-known person (CERVANTES, MARCO POLO, PICASSO)

Sign	Territory	Concept	Case No
PICASSO	EU	The word sign PICASSO has a clear and specific semantic content for the relevant public. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles would, in the perception of the average consumer, override the name of the painter.	22/06/2004, T-185/02, EU:T:2004:189; dismissed 12/01/2006, C-361/04 P, EU:C:2006:25

(b) Where the two marks represent the same name but in different versions (FRANK, with FRANKIE as a diminutive) or languages

Sign	Territory	Concept	Case No
 ELISE	EU	The relevant public is certain to regard these as highly similar female names derived from the same root. In certain Member States, notably Austria, Germany, Ireland and the United Kingdom, and they will certainly be perceived by the relevant public as diminutives of the full forename Elizabeth.	24/03/2010, T-130/09, EU:T:2010:120
PEPEQUILLO / PEPE	ES	The Spanish public will understand 'Pepequillo' as a diminutive of 'Pepe', leading to conceptual identity.	19/05/2011, T-580/08, EU:T:2011:227
JAMES JONES / JACK & JONES	EU	Both trade marks may be understood as referring to the same person.	23/02/2010, T-11/09, EU:T:2010:47

(c) When both trade marks can be understood as referring to the same person, especially when the earlier trade mark is composed solely of a family name

This could be the case when one name is more important than the other.

Sign	Territory	Concept	Case No
EUTM application: Julián Murúa Entrena Earlier mark: MURUA	ES	The EUTM application contains a Spanish name (a forename and two surnames). The first surname, which for the Spanish public is the more important one, coincides with the earlier trade mark.	13/07/2005, T-40/03, EU:T:2005:285



EUTM application: MANO DE VELASCO Earlier mark: VELASCO	ES	'Velasco' is a Spanish surname. The EUTM application can be understood as being composed of two surnames.	16/12/2008, T-259/06, EU:T:2008:575
EUTM application: Antonio Basile Earlier mark: BASILE	IT	The signs are conceptually similar in that they share the same surname (para. 60).	28/06/2012, T-133/09, EU:T:2012:327 & T-134/09, EU:T:2012:328


(d) If the name contained in the trade marks is meaningful in some languages, the coincidence in this meaning may lead to conceptual similarity

Sign	Territory	Concept	Case No
peerstorm / PETER STORM	EU	English-speaking consumers will associate the surname 'Storm' with bad weather (paras 67-68).	08/07/2010, T-30/09, EU:T:2010:298



3.4.3.5 The semantic content of figurative, shape and colour marks


The concepts of marks consisting of or containing figurative elements and marks consisting of shapes (three-dimensional marks) will be what those figurative elements or shapes represent, such as in the following examples.

Sign	Territory	Concept	Case No
	BX, DE, ES, FR, IT, AT, PT	The representation of a red mug on a bed of coffee beans.	25/03/2010, T-5/08 & T-7/08, EU:T:2010:123
	DE	Part of the relevant public may recognise a peacock.	21/04/2010, T-361/08, EU:T:2010:152

Sign	Territory	Concept	Case No
	BX	The contested trade mark will be described as a businessman playing football.	02/12/2009, R 403/2009-2

Consequently, when a mark has both words and images, all concepts have to be assessed.


Sign	Territory	Concepts	Case No
	EN	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public. A bulldog with a citrus fruit in front of it.	15/04/2010, T-488/07, EU:T:2010:145
	EU	The term 'Rioja' in the earlier mark, which is itself conceptually strengthened by the representation of a bunch of grapes and a vine leaf, refers directly to grapevine products and, more particularly, to Rioja wine.	09/06/2010, T-138/09, EU:T:2010:226; dismissed 24/03/2011, C-388/10 P, EU:C:2011:185

Sign	Territory	Concepts	Case No
	BL, BX, CY, DE, ES, FR, HU, RO, SK, IT	<p>The mark depicts a type of fish (a shark).</p> <p>The majority of the relevant language speakers will understand the term SPAIN in the contested mark as referring to that country.</p> <p>The word 'Tiburón' means 'shark' in Spanish but will not be understood by the rest of the relevant public.</p> <p>The remaining term, SHARK, will probably be understood by English-speaking consumers in the relevant territories.</p>	29/09/2008, B 1 220 724

Finally, the semantic content (concept) of colour marks per se is that of the colour they reproduce.

3.4.3.6 The semantic content of numbers and letters





The concept of a word representing a number is the figure it identifies, such as in the examples below.

Sign	Territory	Meaning	Case No
	DE	The word zero evokes the cardinal number 0.	16/09/2009, T-400/06, EU:T:2009:331

Sign	Territory	Meaning	Case No
TV2000 (fig.)/TV1000	LT	The signs are conceptually similar to the extent that they both share the idea of 'television' combined with a round four-digit number, that furthermore correlate in the order of thousands (para. 47).	19/10/2012, R 2407/2011-2
7 (fig.)/7 (fig.)	EU	The BoA found that '7' had a meaning (para. 25).	14/02/2012, R 782/2011-2

The concept of a figure is the number it identifies, unless it suggests another concept such as a specific year.


The Office follows the approach that single letters can have an independent conceptual meaning. The Court has confirmed this approach (08/05/2012, T-101/11, G, EU:T:2012:223, § 56; 21/03/2013, C-341/12 P, G, EU:C:2013:206, appeal dismissed), finding conceptual identity where both trade marks can be seen as the same letter.

Sign	Territory	Meaning	Case No
 / 	DE	For the part of the relevant public that interprets the signs as the letter 'e' and the part of the relevant public that interprets them as the letter 'c', the signs are conceptually identical (para. 99).	10/11/2011, T-22/10, EU:T:2011:651
 /  et al.	EU	The signs were considered conceptually identical (paras 60-61).	10/05/2011, T-187/10, EU:T:2011:202

3.4.3.7 The semantic content of geographical names

The names of cities, villages, regions and other geographic areas evoke a concept that may be relevant for conceptual comparison if it is likely that the relevant public will recognise them as such. Usually, the general public in the European Union is familiar with the names of capitals and bigger cities as well as holiday or travel destinations. If the perception of the public in a particular Member State is relevant, knowledge of the names of small cities and towns in that country can also be assumed.

A lack of evidence or indication that the relevant public recognises the geographical name does not influence the conceptual comparison, as in the following example.

Sign	Territory	Concept	Case No
v 	DE	The result of conceptual comparison is neutral. It is not possible to infer from the appellant's argument that the name 'Chtoura' designates an agricultural area in Lebanon renowned for its agricultural products that this meaning will also be familiar to trade circles in Germany.	08/05/2010, R 1213/2008-4

3.4.3.8 The semantic content of onomatopoeias

The analysis of the semantic content of onomatopoeias follows the general rules for conceptual comparison: their concept will be that depicted by the onomatopoeia in question, provided it can be established that it will be recognised as such by the relevant public. For instance, 'WOOF WOOF' represents the bark of a dog for English speakers; 'MUUU' represents the mooing of a cow for Spanish speakers.

Sign	Territory	Concept	Case No
CLICK	DE	Conceptually, the contested mark 'CLICK' is an English onomatopoeia that expresses a short, sharp sound. This word will be readily understood in Germany given its close equivalent in German, 'Klick' (para. 45).	28/01/2008, R 1394/2006-2

In some cases, the context in which the onomatopoeia will be used can be decisive for establishing whether the relevant public will recognise its meaning. For instance, in the following case, the Board considered that the relevant public would not interpret the sign 'PSS' as onomatopoeia in the context of information technology services.

Sign	Territory	Concept	Case No
PSS	ES	The applicant's argument that the earlier mark could also be pronounced as an onomatopoeia [prompting another to be quiet] is far-fetched in view of the relevant information technology services at issue and the relevant public, who is accustomed, as noted by the applicant itself, to acronyms in this field (para. 42).	15/09/2008, R 1433/2007-2

3.4.4 How to make a conceptual comparison

In essence, when making a conceptual comparison, first it has to be determined if the signs have a concept in accordance with the principles described in the previous paragraph.

- If both signs have a concept, the conceptual comparison can lead to three possible outcomes.
 - If the signs, each as a whole, refer to the same concept, they are conceptually identical.
 - If the signs refer to similar concepts, they are conceptually **similar**.
 - If both signs have a meaning and each refers to different concepts, they are conceptually **dissimilar/not similar**.
- If only one of the signs evokes a concept, the signs are **conceptually dissimilar/not similar**.

On this point, the Office follows the judgment of 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25. Although there is some case-law, such as the judgment of 22/10/2015, T-309/13, ELMA / ELMEX, EU:T:2015:792, which came to the conclusion that ‘it was not possible to make a conceptual comparison’, even though only one of the signs evoked a concept, these cases cannot be considered as a prevailing trend.

- If neither sign has any concept, a conceptual **comparison is not possible** (13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 68-69). The conceptual aspect does not influence the assessment of the similarity of the signs.

As also explained in paragraph 3.4.5.2 below, the fact that **the signs have a descriptive or otherwise non-distinctive element in common** does not suffice to deny all conceptual similarity between them. This fact does not alter the conceptual content of the signs (16/12/2015, T-491/13, TRIDENT PURE / PURE et al., EU:T:2015:979, § 93 and case-law cited; 15/10/2018, T-164/17, WILD PINK / PINK LADY et al., EU:T:2018:678, § 88-89). Nevertheless, depending on the circumstances of the particular case, for example where the only non-distinctive element in common is accompanied by a meaningful distinctive element, the marks may, exceptionally, be found conceptually dissimilar.

The signs cannot be considered conceptually similar on the sole ground that a generic term covering both of them exists and/or they fall under the same general category of signs. If the semantic meanings are too different, the signs may share a general concept, but one so broad that the conceptual relationship is not relevant, as in the following cases.

- The mere fact that two words or symbols can be **grouped under a common generic term** by no means makes them conceptually similar. For example, the General Court held that, although an apple and a pear had features in common, both being fruits that are closely related in a biological sense and are of similar size, colour and texture, such common features had a very limited influence on the overall impression. The Court found that the relevant public would notice such common features only after a detailed analysis. Furthermore, apples and pears are not the only fruit that can be red, yellow or green, and the same applies to the comparable size and texture. Consequently, the Court found these elements insufficient to counterbalance the clear conceptual differences between the marks, which thus


rendered them conceptually dissimilar (31/01/2019, T-215/17, PEAR (fig.) / APPLE BITE (fig.) et al., EU:T:2019:45, § 77-79).

- The same happens when two signs belong to the **same general category or type of mark**: the fact that 'TDL' and 'LNF' are both three-letter abbreviations is conceptually irrelevant and therefore, a conceptual comparison is not possible.
- Another example of signs 'belonging to the same category' concerns **names** and surnames that have a similar semantic content (see paragraph 3.4.3.4 above). If FRANK and MIKE are compared, the fact that they are both names is conceptually irrelevant (since they are on completely different levels); by contrast, the fact that FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity in that case.

In particular, the marks will be conceptually identical or similar in the following situations.

3.4.4.1 Both marks share a word and/or expression

When the two marks share the same word or expression, the marks will be conceptually similar, as in the following examples.

Earlier sign	Contested sign	Opposition No
 Sol Hoteles		17/06/2009, B 1 209 618 (ES)
Similar: the marks share the concept of SOL (= sun: 'the star that is the source of light and heat for the planets in the solar system').		
Earlier sign	Contested sign	Case No
BLUE	ECOBUE	12/11/2008, T-281/07, EU:T:2008:489; dismissed 22/01/2010, C-23/09 P, EU:C:2010:35 (EU)
The marks at issue are conceptually similar because they both refer to the colour blue.		
Earlier sign	Contested sign	Opposition No
T-MUSIC		B 1 081 167 (EU)
The marks above are conceptually similar because both refer to the concept of MUSIC (= 'the art of arranging sounds in time so as to produce a continuous, unified, and evocative composition, as through melody, harmony, rhythm, and timbre').		

Earlier sign	Contested sign	Opposition No
Earlier sign	Contested sign	Opposition No
		29/09/2008, B 1 220 724 (BL, BX, CY, CZ, DE, ES, FR, HU, RO, SK and IT)

The marks above are conceptually similar because both signs have an image of the same fish (a shark) and a reference to the word SHARK (= 'any of numerous chiefly marine carnivorous fishes of the class *Chondrichthyes* (subclass *Elasmobranchii*) ...').



Earlier sign	Contested sign	Case No
EL CASTILLO	CASTILLO	04/11/2003, T-85/02, EU:T:2003:288 (ES)





The Court found that the signs were almost identical conceptually.

Earlier sign	Contested sign	Case No
Servus et al.	SERVO SUO	29/02/2012, T-525/10, EU:T:2012:96 (EU, IT in particular)

The signs are conceptually similar from the point of view of the average Italian consumer insofar as both signs share a reference to 'servant'. The Court confirmed the BoA finding that the Italian public was likely to perceive the meaning of the Latin word 'SERVUS', given its proximity to the Italian word 'SERVO'.

As already mentioned, misspellings may also have a semantic content and in such cases can be compared, as in the following examples.

Earlier sign	Contested sign	Case No
		14/09/2011, T-485/07, EU:T:2011:467 (ES)
For the relevant Spanish public, both signs invoke the concept of an olive. There is no evidence that the relevant Spanish consumer will understand the English word 'live'.		
Earlier sign	Contested sign	Opposition No

Earlier sign	Contested sign	Case No
		14/07/2009 B 1 142 688 (EU)
Both marks refer to the word yogurt and consequently share the concept of 'a dairy product produced by bacterial fermentation of milk'.		
Earlier sign	Contested sign	Opposition No
		28/10/2008, B 1 012 857 (ES)
The above marks are conceptually similar because they both refer to the concept of 'charisma' (= 'the ability to develop or inspire in others an ideological commitment to a particular point of view').		


3.4.4.2 Two words or terms have the same meaning but in different languages

It is possible for the relevant public to assign a conceptual similarity or even identity in cases of marks with elements in different languages, as long as the meanings of the words in those languages are known to that public.

In the following example, it was found that the marks were conceptually identical because a substantial part of the Portuguese public would understand the words constituting the marks at issue given (i) the close proximity of the English word 'vitamin' to the Portuguese equivalent term 'vitamina', (ii) 'water' is a basic English word likely to be understood by that part of the Portuguese public that has sufficient knowledge of the English language, (iii) that 'aqua' is a widespread Latin expression and resembles the Portuguese equivalent term 'água' (paras 56-60).

Earlier sign	Contested sign	Case No
VITAMINWATER (relevant territory Portugal)		28/11/2013, EU:T:2013:615 T-410/12,

As it is the actual understanding of the relevant public that matters, the mere fact that one term is objectively the foreign-language equivalent of the other may not be relevant at all in the conceptual comparison.

Earlier sign	Contested sign	Case No
	LE LANCIER	26/09/2012, T-265/09, EU:T:2012:472
The relevant territory is Spain. 'El lancero' (in Spanish) means 'le lancier' in French. Conceptually, the GC concluded that the average Spaniard only had a limited knowledge of French and that the expression 'le lancier' did not belong to the basic vocabulary of that language. Conceptually, the signs are not similar.		

3.4.4.3 Two words refer to the same semantic term or variations thereof


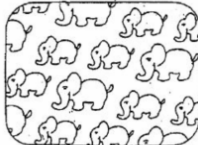




There is conceptual identity where synonyms are involved, that is to say where two words exist for the same semantic meaning (invented examples where English is the reference language: baggage/luggage; bicycle/bike; male horse/stallion).

Conceptual similarity was found in the following cases.

Earlier sign	Contested sign	Case No
SECRET PLEASURES	PRIVATE PLEASURES	15/06/2000, R 616/1999-1
	ORPHAN INTERNATIONAL	14/06/2010, R 1142/2009-2

3.4.4.4 Two purely figurative marks represent the same or a similar concept

When two purely figurative marks represent the same or a similar concept, the signs will be conceptually identical or similar.

Earlier sign	Contested sign	Case No
		07/02/2012, T-424/10, EU:T:2012:58, § 52 (similarity)
		12/04/2012, R 703/2011-2 (identity)
		17/06/2011, R 1107/2010-2 (identity)



3.4.4.5 When there is a word versus a figurative, shape or colour mark representing the concept behind the word

Conceptual identity also exists between a word and an image showing what the word represents (fictional examples: word mark 'TIGER' compared with a figurative mark depicting a tiger; or word mark 'orange' and a mark for the colour orange per se).

3.4.4.6 When both marks have figurative elements with the same or an analogous concept, one or both accompanied by verbal elements



If each of the signs has a non-negligible figurative element with an independently identifiable concept, and these concepts are the same (identical) or analogous (similar), the signs as a whole are conceptually similar. The degree of similarity depends on various factors, such as whether the concepts are identical or similar, whether the verbal elements reinforce the concept of the figurative elements or rather introduce different concepts, whether the verbal elements appear in both signs or in only one, and the distinctiveness of the common concept.

Earlier sign	Contested sign	Case No
		16/10/2018, T-548/17, EU:T:2018:686

Earlier sign	Contested sign	Case No
<p>G&S: Classes 14, 18, 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Notwithstanding the verbal elements that have no meaning, both marks represent a monkey that results in conceptual similarity for the signs taken as a whole (paras 46-49).</p>		
Earlier sign	Contested sign	Case No
		27/02/2002, R 68/2001-4 & R 285/2001-4
<p>G&S: Classes 18, 24, 25, 28</p> <p><i>Territory:</i> Benelux, Germany, Spain, France, Italy, Austria</p> <p><i>Assessment:</i> the wording 'La Maison de la Fausse Fourrure' is not sufficient to reduce the impression of similarity between the conflicting marks. In addition to its possibly descriptive nature, the wording, compared with the footprint device, occupies a secondary position (it is placed under the device), is of a relatively limited size (four times smaller) and is in a conventional writing style (para. 22).</p>		

Signs with figurative elements corresponding to the meaning of the verbal elements

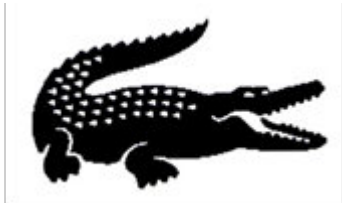

The concept inherent in the figurative element may be reinforced by the verbal part in defining a particular **concept** and may even help with the understanding of words that, in principle, might not be widely known to consumers. This strengthens the conceptual similarity.

Earlier sign	Contested sign	Case No
		17/04/2008, T-389/03, EU:T:2008:114

G&S: Classes 1, 2, 17

Territory: EU

Assessment: As regards the earlier trade marks, it must be held that the word element 'Pelikan' will be understood by consumers as a direct reference to the figurative element. Each of those two elements, appearing side by side, reinforces the other, so that consumers more easily understand one because of the other. Taken together, the two elements clearly call to mind the idea of a pelican. The signs are conceptually identical (paras 90-91).

Earlier sign	Contested sign	Case No
		30/09/2015, T-364/13, EU:T:2015:738

G&S: Classes 18, 25

Territory: EU



Assessment: The verbal element in the contested mark will be understood as a direct reference to the figurative element at least in Member States where the word 'kajman' or its close linguistic variation exists. Since the marks at issue are perceived as representing a reptile of the crocodilian order, they have analogous semantic content and are thus conceptually similar to at least an average degree (paras 47, 48, 53).

Earlier sign	Contested sign	Case No
		20/10/2011, T-238/10, EU:T:2011:613

G&S: Class 18

Territory: Portugal

Assessment: Even assuming that some consumers might wonder for a moment whether the figurative element depicts a horse in the contested mark, any possible confusion is removed by the word element 'horse', which will be understood as such by the majority of the Portuguese public. The word and figurative elements reinforce each other, with the result that consumers will more easily understand one because of the other. As both marks will evoke the same concept of a horse, they are conceptually identical (paras 30, 39).

Earlier sign	Contested sign	Case No
		14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397

G&S: Classes 32, 33

Territory: Spain

Assessment: The Spanish public will perceive the term 'venado' (meaning 'deer') not independently, but as a direct reference to the figurative element in the contested marks. The marks are conceptually similar (para. 100).

3.4.4.7 When the signs have a meaningful word in common that is distinctive, and one of them contains an additional word or figurative element without any meaning

Where the signs have a meaningful word in common that is distinctive, and one or both of them contains an additional word element without any meaning (a fanciful word or one that will not be understood in the relevant language area), the signs are considered conceptually highly similar, and not identical. In such a case, even if not understood, the relevant public will note the presence of the additional term that prevents the signs from being perceived as conceptually totally identical.

Earlier sign	Contested sign	Case No
VIKING	VIKING PRUX	Invented example
VIKING DREMBL	VIKING PRUX	Invented example

Earlier sign	Contested sign	Case No
The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The words 'PRUX' and 'DREMBL' have no meaning. The signs are conceptually highly similar.		

However, where the word that the signs have in common is accompanied by additional figurative elements that lack any particular concept (such as a background, colours or a particular typeface), the signs are considered conceptually identical. In such a case, the additional figurative elements have no impact on the conceptual perception of the signs.

Earlier sign	Contested sign	Case No
		Invented example
The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The additional figurative elements do not introduce any concept capable of altering the conceptual perception of the signs. The signs are conceptually identical.		

3.4.5 Impact of the distinctive and dominant character of the components on the similarity of signs



When assessing similarity between signs, account must be taken of (i) whether the element they have in common is recognisable or rather remains unnoticed in the overall impression of both marks (paragraph 3.4.5.1 below), (ii) the distinctiveness and dominant character of the common elements (paragraph 3.4.5.2 below), and the (iii) impact of the remaining elements in the overall impression conveyed by each of the marks (paragraph 3.4.5.3 below).


3.4.5.1 Identifiable common element

Two marks are similar when, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects (23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 30). Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements that, for them, suggest a specific meaning or that resemble words known to them (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 57). The element in common can be clearly identified when it appears **independently** in each sign.

Earlier sign	Contested sign	Reason	Case No
BEYOND VINTAGE	BEYOND RETRO	Coinciding first word.	30/04/2014, T-170/12, EU:T:2014:238
SCHUHPARK	JELLO SCHUHPARK	The earlier trade mark is identical to the second word of the EUTM application.	08/03/2005, T-32/03, EU:T:2005:82

The element in common may also be identified as a **part of** a single word where a **visual** separation allows it to be perceived independently (e.g. through the use of lower- and upper-case letters, the stylisation of letters or the use of a special character, such as a symbol, numeral, hyphen or other punctuation mark).

Earlier sign	Contested sign	Reason	Case No
ip_law@mbp	MBP	The earlier mark is composed of the elements 'ip-law' and 'mbp' separated by the '@' symbol, so that the marks have the element 'mbp' in common (para. 53).	16/09/2013, T-338/09, EU:T:2013:447
MAXX	NaraMaxx	The use of upper-case and lower-case letters and different colour shades immediately allows separate identification of the elements 'Nara' and 'Maxx', notwithstanding that neither of them has any meaning for the relevant Bulgarian public.	22/09/2017, T-586/15, EU:T:2017:643, § 37, 46
		The letters 'FLT' have an independent role in the EUTM application due to the colour red (para. 48).	14/05/2013, T-19/12, EU:T:2013:242

Earlier sign	Contested sign	Reason	Case No
TRONIC		The common element 'TRONIC' is separated visually in the contested mark by its white lettering (para. 38).	12/05/2016, T-775/14, EU:T:2016:293

Furthermore, the element in common may also be identified as a **part of** a single word where a clear **conceptual meaning** allows it to be perceived independently (see also paragraph 3.4.3.2 above).

Earlier sign	Contested sign	Reason	Case No
MARINE BLEU	BLUMARINE	The part 'marine' in the EUTM application will be understood as a reference to the sea and 'blu' as a misspelling of 'blue'.	14/05/2014, T-160/12, EU:T:2014:252
CADENACOR	COR	The Spanish-speaking public will be able to identify the element 'cor' separately within the earlier mark because the initial element 'cadena' suggests a concrete meaning (chain) to it (para. 47) — likelihood of confusion.	20/10/2011, T-214/09, EU:T:2011:612
BLUE	ECOBUE	The relevant public will split the EUTM application into the commonly used prefix 'eco' and the word 'blue' (para. 30) — likelihood of confusion.	12/11/2008, T-281/07, EU:T:2008:489; confirmed 22/01/2010, C-23/09 P, EU:C:2010:35

On the contrary, if it remains unnoticed, the mere coincidence in a string of letters is not enough for a finding of similarity. The rule remains that the public compares the marks as a whole and will not artificially dissect them. In the following cases **the similarity of the marks was denied** despite an overlap in some letters (see also paragraph 4 below, especially paragraph 4.2.4).

Earlier sign	Contested sign	Reason	Case No
CS	CScreen	The contested sign will probably be broken down into the elements 'C' and 'Screen', which has a meaning highly relevant for computers and their peripherals. It will not be perceived as containing the separate entity 'CS' corresponding to the earlier mark.	18/08/2010, R 545/2009-4

3.4.5.2 Distinctiveness and dominant character of the common elements

For the conclusion of similarity, the **degree of distinctiveness of the common element** (or elements) must be taken into account. The more distinctive the common element is, the higher the degree of similarity. A finding that the common element has limited distinctiveness will lower the degree of similarity, with the consequence that if the only common element of both marks is non-distinctive, the degree of similarity will be low or the marks will even be dissimilar depending on the impact of the elements that differentiate the marks (see paragraph 4.2.5 below).

In the following examples, the common element was considered descriptive or otherwise non-distinctive, with the consequence that the degree of similarity was considered low.



Earlier sign	Contested sign	Case No
FSA K-FORCE	FORCE-X	04/03/2015, T-558/13, EU:T:2015:135
The element 'force' has a weak distinctive character for the goods concerned. Low visual, phonetic and conceptual similarity — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
PINK LADY	WILD PINK	15/10/2018, T-164/17, EU:T:2018:678

Earlier sign	Contested sign	Case No
The element 'pink' in both signs will be understood by the relevant public in the EU as denoting the colour pink. The element has a low degree of distinctive character as it indicates the colour of the relevant goods (fruits). The signs are considered to share at least a low degree of visual and aural similarity. They are deemed to have a low degree of conceptual similarity owing to the shared concept of the colour pink (§ 79, 81, 88-89).		

Earlier sign	Contested sign	Case No
ACTU+	News+	12/12/2014, T-591/13, EU:T:2014:1074
The presence of the '+' sign in both signs cannot generate a visual similarity as this is a mathematical symbol that implies a concept of increase, so it only enjoys a weak distinctive character (para. 29). The signs share a weak similarity on the phonetic side because of the presence of the '+' sign (paras 35-36) — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
VISCOPLEX	VISCOTECH	19/11/2014, T-138/13, EU:T:2014:973
As regards the common initial part of the marks 'visco', it is descriptive for the German public with relation to one of the main characteristics of the relevant goods (oils, greases and fuels), namely its viscosity (para. 57). The marks are only vaguely similar visually and phonetically — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
		22/05/2012, T-60/11, EU:T:2012:252
The word premium is laudatory (para. 44). The coincidence leads only to a low visual and phonetic and an average conceptual similarity — no likelihood of confusion.		

The fact that the coinciding element is a non-distinctive element, does not however, suffice to deny any similarity between the marks, unless there are further factors differentiating them (see paragraph 4.2.5 below). If the public will notice the overlap, it

must be taken into account in the comparison. The fact that an element is descriptive or otherwise non-distinctive is not on its own sufficient to conclude that that word is negligible in the overall impression produced by that mark (08/02/2011, T-194/09, *Líneas aéreas del Mediterráneo*, EU:T:2011:34, § 30).

(For the impact of common weak or non-distinctive components on likelihood of confusion see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment).

The conclusion on similarity also has to take into account **whether the common element is dominant** (visually outstanding) or **at least codominant** in the overall impression of the marks. As explained previously (see paragraph 3.3 above), within the assessment of the dominant character of one or more components, the intrinsic qualities (size, striking graphical representation, etc.) of each of those components have to be compared with the intrinsic qualities of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite mark (08/06/2017, T-341/13 *RENV, So'bio etic (fig.) / SO...? et al.*, EU:T:2017:381, § 40 and 44-56; confirmed by 28/02/2019, C-505/17 P, *So'bio etic (fig.) / SO...? et al.*, § 39-53).

The distinctiveness and dominant character of the common element(s) are separate but related terms. According to the Court:

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.



(31/01/2013, T-54/12, *Sport*, EU:T:2013:50, § 24 and the case-law cited).

3.4.5.3 Importance of additional (not common) elements



Within the comparison of trade marks as a whole, the impact of the non-common elements in their overall impression also has to be taken into account in order to reach a conclusion on similarity. The more differences the remaining elements of the marks present, the lower would be the similarity resulting from the common element.

It cannot be generally assumed that the elements of difference between the marks would tend to become less marked in the consumer's memory in favour of the elements of similarity. In accordance with settled case-law, the extent of the similarity or difference between the signs at issue may depend, in particular, on the inherent qualities of the signs (13/05/2015, T-169/14, *Koragel / CHORAGON*, EU:T:2015:280, § 84).

The distinctiveness and dominant character of the differentiating elements has to be, therefore, taken into account. If these elements are the distinctive ones and dominate the overall impression of the marks, the degree of similarity will decrease.

Earlier sign	Contested sign	Case No
		18/06/2013, T-338/12, EU:T:2013:327
As regards the visual comparison, the figurative element representing a dog in the earlier mark constitutes the dominant one. Given that the respective graphic elements are different, the coincidence in the word element 'K9' leads to a visual similarity only to a low degree. The marks are phonetically similar to a high degree. As to the conceptual comparison, the contested mark does not contain any figurative element conveying the concept of a dog, the marks are not conceptually similar (paras 27-34).		

On the contrary, if the element in which the marks differ is of less inherent distinctiveness than the common element, this will increase the degree of similarity.

Earlier sign	Contested sign	Case No
	 (NEGRA MODELO)	06/03/2002, R 536/2001-3; confirmed 15/02/2005, T-169/02, EU:T:2005:46
The earlier trade mark was a Portuguese registration. 'Negra' is descriptive for the relevant goods in Class 33, since it may be used in Portuguese to designate brown beer, i.e. the type of beer sold under the trade mark NEGRA MODELO. The attention of the average Portuguese consumer will be focused on the coinciding word 'modelo'. Low visual, average phonetic and strong conceptual similarity — likelihood of confusion.		

3.4.6 Other principles to be taken into account in the comparison of signs

3.4.6.1 The impact of the verbal element in the case of composite marks

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and

will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, BEST TONE (fig.) / BETSTONE, § 24; 13/12/2011, R 53/2011-5, JUMBO (fig.) / DEVICE OF AN ELEPHANT (fig.), § 59).

However, the verbal element of a sign does not automatically have a stronger impact (31/01/2013, T-54/12, Sport, EU:T:2013:50, § 40) and in certain cases, the figurative element of a composite mark may, owing to, inter alia, its shape, size, colour or position within the sign, rank equally with the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37). Below are some examples of such a scenario:

Earlier sign	Contested sign	Case No
GIOVANNI	 GIOVANNI GALLI	03/06/2015, T-559/13, EU:T:2015:353
<p>G&S: Class 3</p> <p>Territory: EU</p> <p>Assessment: The figurative element of the mark applied for is as important as the word elements and has a significant impact on the overall visual impression given by that mark. It is positioned above the word elements and occupies more space than both of those elements combined. Furthermore, it is distinctive for the goods at hand, as a duck has no connection with cosmetic or cleaning preparations. In addition, the drawing of the duck is quite elaborate. Even if the element 'GIOVANNI' is placed before the element 'GALLI', there is only a low degree of visual similarity between the marks at issue, in view of the significant impact of the figurative element of the mark applied for on the overall impression given by that mark (paras 62-64, 72, 74).</p>		
		12/11/2015, T-449/13, EU:T:2015:839

Earlier sign	Contested sign	Case No
<p>G&S: Classes 32 and 33</p> <p><i>Territory:</i> Poland</p> <p><i>Assessment:</i> the figurative element of the mark applied for, consisting of the stylised representation of a bovine animal viewed in profile looking to the left and which may be perceived as a European bison, is of a similar size to that of the verbal element 'wisent' and occupies a comparable space in that mark. As a result of its shape, its size, its colour and its position, that representation of a bison [...] helps clearly to establish the image of the contested mark which the relevant public will retain in their mind, with the result that it cannot be discounted in the perception of that mark [...].</p> <p>As regards the earlier mark, a naturalistic representation of a bison standing on four legs in a circle against a background of trees, coloured green, brown and black, is clearly perceptible in that mark. That representation of a bison occupies a central position and is of a slightly larger size than the only perceptible verbal element, the term 'żubrówka', represented in yellow and black and placed above that representation. Therefore, the figurative element consisting of a naturalistic representation of a bison cannot be discounted in the overall impression created by the earlier mark [...]. Despite the presence of different verbal elements, as a whole the marks are visually similar to a low degree given the fact that they both contain a bison, the image of which will easily be retained by consumers in their memory as a result of their position within the marks at issue and their size (paras 76-77, 82, 85-86, 111, 113).</p>		

3.4.6.2 Beginning of the signs in the visual and phonetic comparison

In word signs or in signs containing a verbal element, the first part is generally the one that primarily catches the consumer's attention and, therefore, will be remembered more clearly than the rest of the sign. This means that in general the beginning of a sign has a significant influence on the general impression made by the mark (15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 40; 25/03/2009, T-109/07, Spa Therapy, EU:T:2009:81, § 30).

Nevertheless, the concept 'beginning of the sign' is undetermined, as there is no particular indication of what forms the beginning, what is the end or even if there is or is not a middle part of the sign. Again, this perception mostly depends on the circumstances of the case (length of sign, syllabic distribution, use of typeface, etc.) and not on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much larger middle or central part. Consequently, depending on the circumstances, the rule of the relevance of the beginning of the sign could have less weight to the benefit of a more relevant central part.

As it is usually the beginning of a sign that catches consumers' attention, where signs only differ in their endings, this difference is often insufficient to exclude similarity. However, this is not a fixed rule and the outcome depends on the circumstances of the case. Moreover, this rule only applies when the sign contains a verbal element (which

would explain reading from left to right) and when this verbal element is not very short (otherwise the sign will be perceived immediately in its entirety). The Office considers signs consisting of three or fewer letters/numbers as very short signs (see in more detail paragraph 3.4.6.3 below).

In principle, coincidences at the beginning of signs increase their similarity more than in the middle or at the end.

Earlier sign	Contested sign	Case No
ALENTIS	ALENSYS	10/02/2011, R 1243/2010-1
<p>G&S: Class 42</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> while both marks do not have any meaning and, thus, no conceptual comparison can be made, the trade marks are visually and phonetically highly similar, in particular because they coincide in their first four letters 'ALEN'. It is generally accepted that people pay more attention to the first part of a trade mark, at least when they perceive the mark visually (para. 33).</p>		
Earlier sign	Contested sign	Case No
AZURIL	AZULIB	01/06/2011, R 1543/2010-1
<p>G&S: Class 5</p> <p><i>Territory:</i> Greece</p> <p><i>Assessment:</i> the signs share five of their six letters and the first two syllables are identical. There is a certain degree of visual similarity. Aurally the signs are highly similar as the initial part, which is normally the most important, is identical. Neither sign has a meaning in Greek (paras 35-36).</p>		

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning.

Earlier sign	Contested sign	Case No
CALSURA	CALSORIN	15/12/2010, R 484/2010-2

G&S: Class 5

Territory: EU

Assessment: visually, the marks share some similarity due to the coinciding letters 'C', 'A', 'L', 'S' and 'R' placed in the same order. Aurally, there is a low degree of similarity. Conceptually, the marks are similar insofar as they both contain the component 'CAL'. However, since this element clearly alludes to the kind of goods (containing 'calcium'), not much weight can be given to this conceptual similarity (paras 21-23) — no likelihood of confusion.

Earlier sign	Contested sign	Case No
NOBLESSE	NOBLISSIMA	22/07/2011, R 1257/2010-4

G&S: Class 30

Territory: Denmark, Finland, Sweden

Assessment: the signs differ in the fifth letter and in their ending. They are visually similar to an average degree. In view of the length of the EUTM application, the signs differ in rhythm and intonation and are thus aurally similar to a low degree. The earlier signs 'NOBLESSE' do have a clear connotation in both Finland and Sweden. In these territories, the word 'NOBLISSIMA' lacks any meaning. They are, therefore, conceptually dissimilar. The earlier marks are laudatory in nature and to a certain extent descriptive of the characteristics of the goods 'chocolate', namely describing their superior character. The distinctive character is below average.

Earlier sign	Contested sign	Case No
ALBUMAN	ALBUNORM	01/02/2011, R 489/2010-2

G&S: Class 5

Territory: EU

Assessment: visually, phonetically and conceptually the signs are similar insofar as they have the prefix 'ALBU' (abbreviation of 'albumin' or 'albumen') in common. But this similarity is of little significance because the prefix is generic and so devoid of distinctiveness. The second element of the earlier mark, 'MAN', is visually, phonetically and conceptually completely different from the second element, 'NORM', of the contested mark.

3.4.6.3 Short signs

The comparison of signs must be based on the **overall impression** given by the marks.

The length of signs may influence the effect of the differences between them. In principle, the shorter a sign, the more easily the public is able to perceive all its single

elements. In contrast, the public is usually less aware of differences between longer signs. **However, each case must be judged on its own merits, having regard to all the relevant factors.**

The Courts have not defined exactly what a short sign is. However, signs with three or less than three letters/numbers are considered by the Office as short signs. The paragraphs below thus analyse the impact on the overall impression, and thus, on the similarity of the respective signs for one-, two- and three-letter/number signs.

The comparison between signs consisting of a single letter or a combination of three or less than three letters not recognisable as a word, **follows the same rules** as that for word signs comprising a word, a name or an invented term (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).




Single-letter/Single-number signs


It follows from the case-law of the Court that in the assessment of likelihood of confusion between signs comprising the same single letter, the **visual comparison** (see paragraph 3.4.1.6 above) is, in principle, decisive. The aural and conceptual identity may be overridden, in the assessment of likelihood of confusion, by sufficient visual differences between the signs (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 7.1).

Two-letter/number signs




The over-mentioned rule on the importance of visual comparison applies to two-letter/number marks accordingly. The comparison of these signs depends on their stylisation and, especially, on whether the letters are recognisable as such in the sign. Consequently, the visual overall impression of the signs may be different when two conflicting signs, albeit containing or consisting of the same combination of two-letters, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element.

In the following examples, the **marks were found visually similar** due to the graphic representations/visual similarities of the same two-letter combinations.

Earlier sign	Contested sign	Case No
(i)  (ii) 		31/03/2000, B 61 046

Earlier sign	Contested sign	Case No
<p>G&S: Class 36</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> the overall visual impression of the conflicting marks is that they consist of two letters in an arbitrary figurative design that conveys the same impression. The trade marks are considered similar.</p>		
Earlier sign	Contested sign	Case No
GE		28/02/2014, T-520/11, EU:T:2014:100
<p>G&S: Classes 6, 7, 9, 11, 17</p> <p><i>Territory:</i> UK</p> <p><i>Assessment:</i> it cannot be excluded that part of the relevant public will interpret the contested mark as the letter combination 'GE' (paras 33-35). The marks are phonetically identical and visually similar to a medium degree.</p>		

In the following example, **the signs were found visually and phonetically dissimilar** due to the different graphic representation and the fact that they may not be read as the same letters.



Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p> 		<p>18/11/2011, R 82/2011-4</p>

G&S: Class 33

Territory: EU


Assessment: from a visual point of view, the graphic stylisation of the earlier marks is very different compared with the contested mark. The mere fact that one or both letters of the marks are identical is not enough to render the marks visually similar. There is no aural similarity if the contested mark will be pronounced as 'B' or 'PB' as in short signs differences have a higher impact on the overall impression than in longer marks. Conceptually, the contested mark and the earlier marks with no additional elements to the letter combination 'AB' do not have a meaning in any of the relevant languages: the conceptual comparison remains thus neutral (paras 17-19).

As to the difference in one of the letters see the following examples.





Earlier sign	Contested sign	Case No
(i) CX (ii) 	KX	21/01/2011, R 864/2010-2
<p>G&S: Class 7</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> visually, the initial letters 'K' and 'C' show a clearly different shape and can be considered only visually similar to a low degree. The same degree of similarity — low — applies for the phonetic comparison. Aurally, the signs will be pronounced 'K-X' and 'C-X' respectively, and not as words. Neither of the marks has a conceptual meaning (paras 25-27).</p>		
Earlier sign	Contested sign	Case No
KA		22/03/2011, T-486/07, EU:T:2011:104
<p>G&S: Classes 9, 11, 12</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> it must be concluded that, for each of the possible perceptions by the relevant public of the mark applied for, that public will perceive significant visual differences for each of the earlier marks (para. 65). Some degree of phonetic similarity between the marks at issue must be recognised, but it is not very high. Without making an error, the Board of Appeal, therefore, could find that the phonetic similarity between the marks at issue was not 'notable' (para. 71). As both marks have no meaning, no conceptual comparison can be made (para. 72).</p>		


Three-letter/number signs

When the signs in conflict are three-letter/number signs, a difference of one letter does not exclude similarity, especially if this letter is phonetically similar.

Earlier sign	Contested sign	Case No
	ELS	23/10/2002, EU:T:2002:260 T-388/00,
<p>G&S: Classes 16, 35, 41</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> two of the three letters are identical and in the same sequence; the difference in a single letter does not constitute a significant visual and aural difference. The letters 'E' and 'I' in Germany are pronounced similarly (paras 66-71).</p>		
Earlier sign	Contested sign	Case No
Ran	R.U.N.	17/12/2009, T-490/07, EU:T:2009:522
<p>G&S: Classes 35, 38, 42</p> <p><i>Territory:</i> EU, Germany</p> <p><i>Assessment:</i> the Court held that the signs in the mind of the relevant consumer, having a good command of the English language, are visually, aurally and conceptually similar (para. 55).</p>		

In contrast, when trade marks are composed of only three letters, with no meaning, the difference of one letter may be sufficient to render them not similar.


Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p>  <p>(iii)</p> 		07/02/2001, R 393/1999-2

Earlier sign	Contested sign	Case No
<p>G&S: Class 25</p> <p><i>Territory:</i> Benelux, Germany, Spain, France, Italy, Portugal, Austria</p> <p><i>Assessment:</i> in this case the pronunciation of the first letters of the marks in dispute, i.e. 'J' and 'T', is different in all relevant languages. These letters are also visually dissimilar. Furthermore, the figurative elements of the compared marks do not resemble each other (paras 17-18).</p>		
Earlier sign	Contested sign	Case No
	COR	23/05/2007, T-342/05, EU:T:2007:152
<p>G&S: Class 3</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the GC considered that the signs were only aurally similar to a low degree (paras 47, 50). The relevant public in Germany will certainly notice the differences in the beginning of the signs.</p>		

3.4.6.4 The impact of conceptual difference

Where at least one of the signs at issue has a clear and specific meaning that can be grasped immediately, the resulting conceptual difference may offset the visual and aural similarity between the signs (12/01/2006, C-361/04, *Picaro*, EU:C:2006:25, § 20). This is the so-called principle of 'neutralisation'. That impact of conceptual difference is taken into consideration when making the overall assessment of similarity between the signs (05/10/2017, C-437/16 P, *CHEMPIOIL / CHAMPION et al.*, EU:C:2017:737, § 44; 04/03/2020, C-328/18 P, *BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al.*, EU:C:2020:156, § 75).

Not just any conceptual dissimilarity can lead to neutralisation. Neutralisation can only be applied exceptionally, if at least one of the signs **as a whole** has a **clear and specific meaning that can be grasped immediately** by the relevant public.

Earlier sign	Contested sign	Case No
	CHEMPIOIL	05/10/2017, C-437/16 P, EU:C:2017:737

Earlier sign	Contested sign	Case No
<p>G&S: Classes 1, 3 and 4</p> <p><i>Territory:</i> European Union</p> <p><i>Assessment:</i> The word 'champion' has a clear and specific meaning that will be understood by the relevant public, as it is used extensively in various fields of daily life, such as the arts, literature, cinema, music or sport. Whilst the term 'chempioil' alludes to oil or chemicals, it does not convey any clear meaning for the sign as a whole. Despite the visual and phonetic similarities between the signs, the consumer would make a distinction between them due to the clear concept conveyed by the earlier sign. Consequently, the visual and aural similarities of the signs at issue are offset by the conceptual difference conveyed by the meaning of the term 'champion' (§ 31, 46-47 and 55).</p>		

Where neither of the signs as a whole has a clear and specific meaning, any conceptual difference between the signs that may result from a vague concept that the sign may evoke is insufficient to offset the visual and aural similarities.

Earlier sign	Contested sign	Case No
MUNDICOLOR	MUNDICOR	17/03/2004, T-183/02 & T-184/02, EU:T:2004:79
<p>G&S: Class 2</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> Whilst 'MUNDICOLOR' is to a certain extent evocative of 'colours of the world' or 'the world in colours' for the Spanish public, it cannot be regarded as having any clear and specific meaning. In the mark applied for, the same prefix, 'mundi', is accompanied by the suffix 'cor', a term that has no meaning in Spanish. Therefore, notwithstanding the evocative nature of the prefix 'mundi' (world), the latter sign is ultimately devoid of any concept for the Spanish public. As neither of the signs has a clear and specific meaning likely to be grasped immediately by the public, any conceptual difference between them is not such as to counteract their visual and aural similarities (§ 90-99) — likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
		04/03/2020, C-328/18 P, EU:C:2020:156
<p>G&S: Class 3</p> <p><i>Territory:</i> Czech Republic, Hungary, Poland and Slovenia</p> <p><i>Assessment:</i> Conceptually, the relevant public is not familiar with the meaning of the English word 'label', so the earlier mark will be perceived as consisting of a fanciful word devoid of meaning. However, they will understand the adjective 'black', which is a basic word in English, as a description of a colour, and will also be able to understand the words 'by equivalenza' as indicating that the goods in question come from Equivalenza Manufactory. Furthermore, the signs are visually and aurally similar to an average degree. However, as neither of the signs (as a whole) has a clear and specific meaning that can be grasped immediately by the relevant public, the conceptual differences between the signs cannot offset the similarities in the other aspects, and a global assessment has to be carried out (§ 76-77, 97 and 99) — likelihood of confusion.</p>		

Furthermore, for neutralisation to apply, the meaning of the sign must be clear and specific for **the entire public** for whom the signs are visually and phonetically similar. If neither of the signs has a clear and specific meaning that could be grasped immediately by a significant part of the public, neutralisation is not appropriate, notwithstanding the fact that for another part of the public at least one of the signs had such a meaning.

Earlier sign	Contested sign	Case No
TAIGA	tigha	13/09/2018, T-94/17, EU:T:2018:539 (confirmed 16/07/2020, C-714/18 P, EU:C:2020:573, § 75-77)

Earlier sign	Contested sign	Case No
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> European Union</p> <p><i>Assessment:</i> The contested mark 'tigha' has no meaning for the relevant public. As for the earlier mark, it is likely that the relevant public in the northern and eastern parts of the European Union will immediately perceive the word 'taiga' as referring to a boreal forest. However, this could not be established for the relevant public elsewhere in the European Union. The alleged 'evident conceptual differences' have not been established throughout the European Union. Taking account of the visual and phonetic similarity of the signs at issue, their lack of clear and specific meaning for a significant part of the relevant public, and the similarity or identity of the goods concerned, there was a likelihood of confusion (§ 67-71, 77, 80) — likelihood of confusion.</p>		

However, even if at least one of the signs does have a clear and specific meaning that could be grasped immediately by the entire relevant public, the visual or aural similarity may be so high that the resulting conceptual differences could still not be offset.

Earlier sign	Contested sign	Case No
INTESA	INTEA	13/04/2005, T-353/02, EU:T:2005:124
<p>G&S: Classes 3, 21</p> <p><i>Territory:</i> Italy (among other EU member states)</p> <p><i>Assessment:</i> Although the word 'intesa' means agreement or contract in Italian, it refers to an abstract concept that, in the context of the goods at issue, is unlikely to create a strong association capable of facilitating memorisation of the sign on the basis of that meaning. In addition, it is possible that, owing to the strong visual and aural similarities between the signs, this conceptual difference will escape the attention of the relevant Italian public. In the present case, the inherent concept of the earlier mark is incapable of offsetting the similarities between the signs (§ 34) — likelihood of confusion.</p>		

3.5 Conclusion on similarity

An assessment of similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another. The comparison must be made by examining each of the marks in question as a whole. However, this does not mean that the overall impression conveyed by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. In

general, the more features the marks have in common, the higher the degree of similarity.

The conclusion reached on the similarity between the signs is the result of an evaluation of all of the relevant factors discussed in detail above.

It must also be borne in mind that since the assessment of similarity is based on the overall impression of the signs, once signs have been found to be similar, it would not be consistent to find later, in the global assessment of the likelihood of confusion, that ‘the overall impression of the signs is different’ in order to support an outcome of no likelihood of confusion.

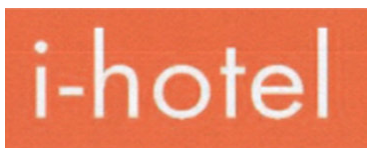

In general, the following should be considered when assessing similarity and degrees of similarity.


Impact of the distinctiveness of the elements

The greater or lesser degree of distinctiveness of the common elements of the signs is one of the relevant factors in assessing the similarity between signs.

For example, if the coincidences between the signs on any of the three aspects of comparison derive from an element with limited distinctiveness, the established degree of visual, aural and/or conceptual similarity, respectively, will be lower than where the elements in common have a normal distinctiveness.

In the following examples the signs involved weak/descriptive elements but with different outcomes.

Earlier sign	Contested sign	Case No
		13/06/2012, T-277/11, EU:T:2012:295 (likelihood of confusion)
<p>G&S: Classes 35, 39, 41, 42 and 43</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the Court found the signs visually highly similar, and identical phonetically and conceptually (paras 86, 88, 91 and 93).</p>		
Earlier sign	Contested sign	Case No

Earlier sign	Contested sign	Case No
	TRIDENT PURE	16/12/2015, T-491/13, EU:T:2015:979 (No likelihood of confusion)
<p>G&S: Class 30</p> <p><i>Territory:</i> inter alia EU</p> <p><i>Assessment:</i> The Court established a low degree of visual similarity given that the coinciding element 'PURE', despite being descriptive for part of the public, was not on its own sufficient to conclude that the word is negligible in the overall impression produced by the mark (paras 69-71). Aurally, the marks were deemed similar to a low degree for those who understood the non-distinctive meaning of 'PURE' but to an average degree for the remaining part of the public (para. 87). Conceptually, they are similar for those who understand 'PURE' as a descriptive term referring to the purity of the goods at issue and to the purity of breath. The fact that the word 'pure' is descriptive of the characteristics of the goods in question does not alter the conceptual content of the marks (para. 93).</p>		

Impact of the dominant elements



The conclusion on similarity also has to take into account whether the common element is dominant (visually outstanding) or at least codominant in the overall impression of the marks.

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.

It should be emphasised that the abovementioned factors may not be applicable to all cases and the assessment of similarity is always undertaken on a case-by-case basis and a consideration of further factors may be necessary. Furthermore, it should be noted that the above factors and principles do not call into question the principle that the examination of the similarity of trade marks must take into account the overall impression produced by them on the relevant public.

Impact of word versus figurative elements

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component.

Earlier sign	Contested sign	Case No
		16/01/2014, T-149/12, EU:T:2014:11 (likelihood of confusion)
<p>G&S: Class 9</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> the signs were found visually highly similar and phonetically identical, notwithstanding the descriptive character of the element 'MICRO' (paras 54-55, 60) and taking into account that the differences were limited to banal graphical elements.</p>		

In general, the identity or similarity of the figurative component of the signs is insufficient to establish a considerable degree of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign.

However, although the word elements of a mark may have a greater impact, this is not necessarily the case where the figurative element visually dominates the overall impression made by the mark (see paragraph 3.4.6.1 above).

Beginning of signs

In principle, coincidences at the beginning of signs increase their similarity more than coincidences in the middle or at the end of signs.

Therefore, consumers attach less importance to the end of the mark and coincidences located at the end of signs would lead to a finding of a lower degree of visual similarity than common elements at the beginning of signs (see first example below). Likewise, the position of the coinciding/similar phonemes or syllables at the beginning of the conflicting signs would increase the degree of aural similarity.

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning (see second example below).

Earlier sign	Contested sign	Case No
OXYGESIC	Maxigesic	16/10/2013, T-328/12, EU:T:2013:537

Earlier sign	Contested sign	Case No
<p>G&S: Class 5</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the signs were found visually similar to a low degree due to the descriptive character of the suffix 'GESIC', given that it refers to painkillers (paras 35, 47), as well as the different beginnings (para. 49). Phonetically, they were found similar to an average degree (para. 51) and conceptually dissimilar, the latter again due to the descriptive content of 'GESIC' and the differing associations that could be made with the respective prefixes of the signs ('OXY' refers to oxygen/oxycodon and 'MAXI' to maximum (para. 53)), with the result that a likelihood of confusion was excluded.</p>		

Earlier sign	Contested sign	Case No
		05/02/2015, EU:T:2015:77 T-33/13,
<p>G&S: Class 35, 36 and 42.</p> <p><i>Territory:</i> Austria, Benelux, Bulgaria, the Czech Republic, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.</p> <p><i>Assessment:</i> visually, the signs were deemed to have at least a certain degree of visual similarity, even if the coincidence in 'bonus' related to an element of a weak distinctive character (paras 32, 41). Phonetically, the signs were found similar to an average degree due to the identical pronunciation of the first two syllables (para. 34). Conceptually, there is at least a certain degree of similarity for a significant part of the public for whom the common element 'bonus' conveys an identical meaning (para. 42).</p>		

Short signs

The length of the signs may influence their overall impression and thus the effect of the differences between them. In principle, the shorter a sign is, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs.

The application of the abovementioned principles and factors should not be automatic. The decision has to explain their relevance for the particular case and weigh them up.

However, the rules explained in this chapter have a general character and the particularities of a specific case may justify different findings. However, in such cases it is of even greater importance to provide a clear and thorough reasoning in the decision.

4 Dissimilarity of Signs

4.1 Introduction

The similarity of signs is a necessary condition for a finding of a likelihood of confusion under Article 8(1)(b) EUTMR. An assessment of the similarity between two marks must be based on the **overall impression** created by them, in particular, by their distinctive and dominant components (23/10/2002, T-6/01, Matratzen + Matratzenmarkt Concord (fig.), EU:T:2002:261, § 32 and the case-law cited). Where the overall impression is that the signs are dissimilar, this excludes the likelihood of confusion.

The finding as to whether signs are similar or dissimilar overall is the result of a combined assessment of (i) the visual, phonetic, conceptual overlaps and differences and (ii) the significance of the overlaps and differences in the perception of the relevant public.

The finding that the signs are dissimilar has the following consequences.

- The goods and services are not compared.
- Any claim of enhanced distinctiveness is not examined. If the signs are dissimilar, the opposition under Article 8(1)(b) EUTMR must be rejected regardless of any enhanced distinctiveness of the earlier mark. Where the marks in question are not similar, there is no need to take account of the reputation of the earlier mark, since it does not fall within the scope of the test of similarity and cannot serve to increase the similarity between those marks (14/03/2011, C-370/10 P, EDUCA Memory game, EU:C:2011:149, § 50-51 and the case-law cited).
- There is no global assessment of factors. The decision concludes that in the absence of one of the conditions, the opposition under Article 8(1)(b) EUTMR must be rejected.
- The signs will be considered dissimilar also for the purposes of other grounds of opposition. In particular, any claim under Article 8(5) EUTMR will be rejected (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.2).

4.2 Scenarios for dissimilarity

4.2.1 No element in common

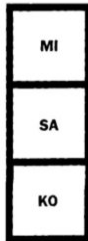



The signs are obviously dissimilar if they have nothing in common in any of the three aspects of comparison. This is more a hypothetical scenario as the signs at issue in an opposition under Article 8(1)(b) EUTMR normally have something in common. What is rather debated by the parties is the significance of the overlap in an element.

4.2.2 Overlap in a negligible element

The signs are dissimilar if the only element they have in common is **negligible** in one or both of the marks in the sense that, due to its size and/or position, it will be likely to go **unnoticed** or **disregarded** by the relevant public. Negligible elements, after **having duly reasoned** why they are considered negligible, will not be compared (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). The notion of negligible elements should be strictly interpreted and, in the event of any doubt, the assessment should cover all the elements of the sign (see paragraph 1.2 above).

Concerning the assessment as to whether an element is negligible, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, decipher the element concerned. The question is rather whether, in the overall impression of the sign, the element is noticeable by the average consumer who normally perceives a sign as a whole and does not proceed to analyse its various details.

Examples


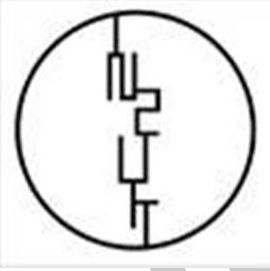
Earlier sign	Contested sign	Case No
		<p>11/11/2009, T-162/08, EU:T:2009:432</p> <p>The words 'by missako' are almost illegible: the size and script make them difficult to decipher</p>
 <p>(RL RÓTULOS LUNA S.A.)</p>		<p>12/12/2011, R 2347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible</p>

4.2.3 Overlap in a verbal element not noticeable due to high stylisation

The signs are dissimilar if the verbal element, which would give rise to similarity, is not discernible due to its high stylisation. Sometimes the way in which letters or symbols are used makes it unrealistic to assume that they will be read and pronounced, for example, when in a figurative mark a symbol or letter is repeated in order to create a pattern, is highly distorted or otherwise not clearly legible. If the verbal element is not recognisable in the overall impression of the sign, thus, not legible and not pronounceable, it will not be taken into account in the comparison.

Again, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, identify the verbal element concerned. It is irrelevant if the verbal element is recognised only with the help of the other mark, as the consumer normally does not have the opportunity to compare signs side by side. Furthermore, it is irrelevant that the party refers to its mark by a particular verbal element in its submissions or if the particulars of the mark indicate a verbal element, because the consumer will not be assisted by that information on encountering the sign as registered or applied for.

Examples

Earlier sign	Contested sign	Case No
KA		22/06/2011, R 1779/2010-4
intuit		17/09/2015, R 164/2015-2


The question whether the verbal element is indeed 'lost' in the stylisation must be carefully assessed. The consumer intuitively looks for pronounceable elements in figurative signs by which the sign can be referred to. The high stylisation of one or more letters of a word may not prevent the consumer from identifying the verbal element as a whole, particularly, if it suggests a concrete meaning. It should also be emphasised that if the complex stylisation of the verbal element of a sign does not make it totally illegible, but merely lends itself to various interpretations, the comparison must take into account the different realistic interpretations. Thus, it is only in the — rather rare — case where the legibility of the sign is truly unrealistic, without being assisted by a mark description or the other mark, that the verbal element will be disregarded in the comparison.



4.2.4 Overlap in other irrelevant aspects

The fact that there is some coincidence between the signs does not necessarily lead to a finding of similarity. This is in particular the case when the overlapping part is not perceived independently within the overall impression of the marks. The Court considered the following signs dissimilar despite the overlap in a sequence of letters.





Examples

Earlier sign	Contested sign	Case No
StoCretec	CRETEO	28/01/2016, EU:T:2016:38 T-640/13,
<p>The conflicting signs are dissimilar (para. 87). In the visual impression created by the marks, the beginnings 'sto' and 'cre' and the endings 'tec' and 'o' play a more important role than the syllables 'cre' and 'te', which are placed in the middle of the signs and are less perceived by the relevant public. Therefore, it is concluded that there is no visual similarity between the signs (para. 71). The marks are not phonetically similar, in particular on account of their different beginnings and endings (para. 72). The conceptual comparison remains neutral, as 'StoCretec' and 'CRETEO' are coined terms without any meaning in German (para. 73).</p>		

Earlier sign	Contested sign	Case No
ALDI		26/11/2014, EU:T:2014:994 T-240/13,
<p>The figurative elements and the additional word 'foods' must not be disregarded when comparing the signs (paras 54-55). The overall visual impression of the conflicting signs is clearly dissimilar (paras 59-61). The signs are not phonetically similar bearing in mind, in particular, the additional element 'foods' of the contested mark (paras 65-66). Finally, the marks are also conceptually not similar (para. 73).</p>		

Earlier sign	Contested sign	Case No
		12/11/2014, EU:T:2014:944 T-524/11,
<p>The figurative elements of the earlier figurative marks further distinguish those marks from the mark applied for (para. 36). The signs at issue have a different rhythm of pronunciation (paras 43-44). The words have no meaning; it is not possible to carry out a conceptual comparison (para. 54).</p>		

The same applies to similarities in the figurative elements that are of minor impact.

Earlier sign	Contested sign	Case No
		16/07/2014, EU:T:2014:673 T-36/13,
The figurative elements of the signs have the same outline, but will be perceived as different by the relevant public (paras 45-47). The word elements are visually different since they have only two letters in common, which are also placed in distinct positions.		
Earlier sign	Contested sign	Case No
		22/03/2012, B 1 837 106
The marks coincide only in that the verbal elements are written in white on a contrasting grey background and the white frame that separates the verbal and the landscape elements in equal parts. These are commonplace figurative elements, omnipresent in marks in virtually all fields of trade. The consumer's attention is not caught by any of these details, but rather by the fanciful term 'tukaş' in the earlier mark and by the word 'Ekonomik' in the contested mark. As the signs visually overlap only in irrelevant aspects and have nothing in common aurally and conceptually, they are dissimilar overall.		

The decision must contain a thorough reasoning, in the comparison of signs, as to why the overlap in particular aspects is considered irrelevant.

4.2.5 Overlap in a non-distinctive element

If the signs overlap exclusively in an element that is **descriptive** or **non-distinctive** for the relevant goods and services in all parts of the relevant territory, and both **contain other distinctive element(s) capable of differentiating** between the signs, they can be considered dissimilar.

It follows that two conditions have to be fulfilled in order to find dissimilarity in this context:

- the coinciding element must be non-distinctive (if the coinciding element has some, even very low distinctiveness, the signs cannot be found dissimilar);
- both signs must contain other elements that are distinctive and capable of differentiating the marks.

Therefore, two signs may be dissimilar for some of the goods and services but not for others. In such a case, strategy may justify comparing some of the goods and services


to find them dissimilar, and then continuing with the assessment of the similarity of the signs for the remaining goods and services only.

Furthermore, if in part of the relevant territory the overlapping element is not perceived as descriptive or non-distinctive (e.g. due to non-understanding of the term), the signs cannot be considered dissimilar.

The following invented examples illustrate cases where the coincidence in one element cannot lead to any similarity because that element is non-distinctive and the other elements, which are clearly different, allow the public to differentiate sufficiently between the marks.



Earlier sign	Contested sign
HOTEL FRANCISCO	HOTEL ZENITH
G&S: provision of accommodation Territory: EU	
CASA ENRIQUE	CASA RACHEL
G&S: provision of restaurant services Territory: Spain (where 'casa' has also the meaning 'bar', 'restaurant')	
MARKET.COM	FITNESS.COM
G&S: telecommunications services Territory: EU	

Examples from case-law



Earlier sign	Contested sign	Case No
	CARBON CAPITAL MARKETS	22/06/2010, T-563/08, EU:T:2010:251 (paras 39-61)
G&S: Class 36 Territory: EU (relevant public considered to be familiar with basic English financial terminology) Assessment: the common element 'capital markets' directly describes the services.		

According to the rules established above, despite a lack of distinctive character of the elements in common, it would **not** be appropriate to conclude on dissimilarity, where:

- the particular combination of the elements confer some distinctiveness on the signs (i.e. the combination would be protected)

Earlier sign	Contested sign	Case No
		22/05/2012, EU:T:2012:252 T-60/11,
<p>G&S: Classes 30, 31, 42</p> <p>Territory: EU</p> <p><i>Assessment:</i> there is some similarity between the marks. The earlier mark consists of two elements that are non-distinctive for the goods in question — the image of a corn (descriptive for bakery products) and the laudatory word element 'PREMIUM'. The combination of these elements is arbitrary (unlike the word combination 'Capital markets' in the example above, which is an established expression). The coincidences between the marks are therefore not limited to non-distinctive elements but extend to their particular combination.</p>		

- the other element that is supposed to distinguish between the signs is perceived as an insignificant figurative detail, or is otherwise non-distinctive (see paragraph 3.2.3.1 above)

Earlier sign	Contested sign	Case No
		13/06/2012, EU:T:2012:295 T-277/11,
<p>G&S: services related to travel, accommodation and congresses in Classes 35, 39, 41, 42, 43</p> <p>Territory: EU</p> <p><i>Assessment:</i> the visual differences between the marks (the orange background and the particular way of writing) do not distract from the common element. The marks are visually highly similar and aurally and conceptually identical (paras 83-92).</p>		

Earlier sign	Contested sign	Case No
waterPerfect	AquaPerfect	28/01/2015, EU:T:2015:52 T-123/14,

Earlier sign	Contested sign	Case No
<p>G&S: Class 7</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> while the element 'Perfect' has weak distinctive character, the fact remains that none of the other elements can be considered to have greater distinctive character. The elements 'aqua' and 'water' also have weak distinctive character as they will be perceived by the relevant public as meaning 'water' and the goods covered all involve water in one way or another (para. 42).</p> <p>The signs were found visually, phonetically and conceptually similar to an average degree.</p>		

- the non-distinctive elements constituting (forming exclusively) the sign are entirely incorporated in the other sign

Earlier sign	Contested sign	Case No
POST	TPG POST	13/05/2015, T-102/14, EU:T:2015:279
<p>G&S: Class 39 and others related to postal services</p> <p><i>Territory:</i> Germany, EU</p> <p><i>Assessment:</i> although the element 'post' as such is non-distinctive for postal services, it corresponds to the earlier mark, which should be attributed with a minimum degree of distinctiveness (para. 43).</p>		

In summary, the finding of 'dissimilar overall' on account of an overlap exclusively in non-distinctive elements should be limited to evident cases where the other element serves to safely distinguish between the signs.

In less evident cases low similarity should be attributed to the marks. The examination will then proceed and the cases will be solved at the stage of the global assessment (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 6.2).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 5

Distinctiveness of the earlier mark

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1 General Remarks

The Court of Justice of the European Union (the Court) held in its judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18, 24:

... marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

... the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

The assessment of the distinctiveness of an earlier mark is **especially** important in cases when there is only a low degree of similarity between the signs, as it must be assessed whether this low degree can be compensated by the high degree of similarity between the products (11/06/2014, T-281/13, Metabiomax, EU:T:2014:440, § 57; 13/05/2015, T-102/14, TPG POST / DP et al., EU:T:2015:279, § 67) and vice versa.

According to case-law, it is necessary to distinguish between the **notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark**, and the **notion of the distinctive character which an element of a composite mark possesses, which determines its ability to dominate the overall impression created by the mark** (27/04/2006, C-235/05 P, Flexi Air, EU:C:2006:271, § 43). While it is true that it is necessary to examine the **distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs (...)**, the **degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion**. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs (23/01/2014, C-558/12 P, WESTERN GOLD / WeserGold et al., EU:C:2014:22, § 42-45; 25/03/2010, T-5/08 & T-7/08, Golden Eagle / Golden Eagle Deluxe, EU:T:2010:123, § 65; 19/05/2010, T-243/08, EDUCA Memory game, EU:T:2010:210, § 27).

The Office therefore distinguishes between: (i) the analysis of the distinctive character of the earlier mark as a whole, which determines the scope of protection afforded to that mark and is one of the factors in the global assessment of the likelihood of confusion, and (ii) the analysis of the distinctive character of a component of the marks within their comparison.⁽⁴⁶⁾

Whereas distinctive character must be assessed for the components of both the earlier mark and the contested mark, distinctiveness of the mark as a whole is assessed only in respect of the earlier mark.⁽⁴⁷⁾ The distinctiveness of the contested mark as a whole

⁴⁶ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

⁴⁷ See also Objective 1 of the Common Practice on the impact of non-distinctive/weak components on likelihood of confusion agreed within the framework of the European Trade Mark and Design Network (ETMDN).

is not relevant, as such, to the assessment of the likelihood of confusion, as explained in more detail in paragraph 2.1.2 below. Therefore, any reference below to the distinctiveness of the mark **as a whole** refers exclusively to the earlier mark.

2 Assessment of Distinctiveness of the Earlier Mark

The *Canon* judgment makes clear that (i) the more distinctive the earlier mark, the greater will be the likelihood of confusion, and (ii) earlier marks with a highly distinctive character because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. Consequently, the distinctive character of the earlier mark as a whole determines the strength and breadth of its protection and must be taken into consideration for the purposes of assessing the likelihood of confusion.

2.1 General issues

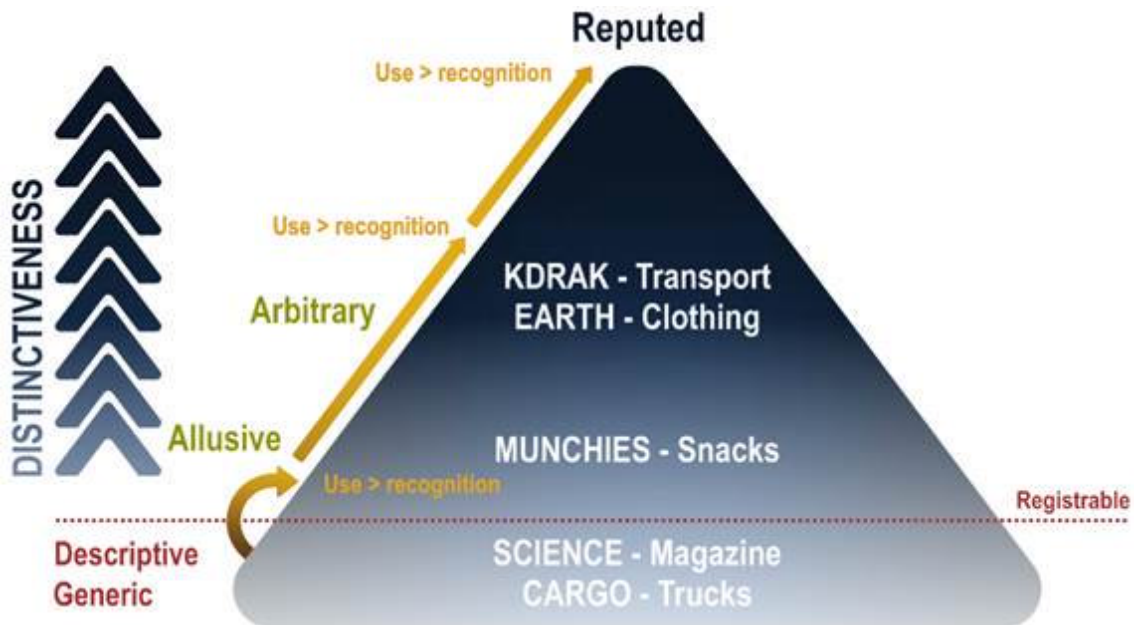
2.1.1 Distinctiveness

The Court has defined distinctiveness in the following manner:

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings** (emphasis added).

(22/06/1999, C-342/97, *Lloyd Schuhfabrik*, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies, whereby a sign can lack distinctiveness entirely, be highly distinctive or be at any point in between.



A sign is **not distinctive** if it is descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.), laudatory and/or if its use in trade is common for those goods and services. Similarly, a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness. The rules for the assessment of distinctive character follow those established by examination on absolute grounds.

A sign may be **distinctive to a low degree** if it alludes to (but is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods and/or services might not materially affect distinctiveness. For example:

- ‘Billionaire’ for *gaming services* is allusive in a manner that would affect distinctiveness because it implies, for instance, that you may become a billionaire.
- ‘Billy O’Naire’, which sounds identical to ‘billionaire’ in English, would be allusive for *gaming services* as a clever wordplay on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a ‘normal’ degree of distinctiveness.

A sign is deemed to possess a **‘normal’ degree of inherent** distinctiveness if there is no indication for a limitation thereof (e.g. due to a descriptive character, laudatory meaning, etc.). This means that the sign in question is fully distinctive, in the sense that its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired.

Any **higher degree of distinctiveness** acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, has to be proven by its proprietor by submitting appropriate evidence (see paragraph 2.3 below). A mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H/Eich, EU:C:2013:317, § 71).

However, an EUTM applicant may argue that the earlier sign is distinctive to a low degree. One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all the trade marks have been effectively used (13/04/2011, T-358/09, Toro de Piedra, EU:T:2011:174, § 35; 08/03/2013, T-498/10, David Mayer, EU:T:2013:117, § 77-79).

It follows that the evidence filed must demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that this element has a low degree of distinctive character.

When dealing with the distinctiveness of the **earlier mark as a whole**, the latter should always be considered **to have at least a minimum degree of inherent distinctiveness**. Earlier marks, whether EUTMs or national marks, enjoy a 'presumption of validity'. The Court made it clear, in its judgment of 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 40-41, that 'in proceedings opposing the registration of a European Union trade mark, the validity of national trade marks may not be called into question'. The Court added that 'it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character'.⁽⁴⁸⁾

2.1.2 Inherent and enhanced distinctiveness

The Office must consider, as a first step, the overall **inherent distinctiveness** of the earlier mark (see paragraph 2.2 below) and, as a second step, if claimed and relevant to the outcome, whether the earlier mark has **acquired enhanced distinctiveness** as a consequence of the use the opponent has made of it (see paragraph 2.3 below).

The degree of distinctiveness of the earlier sign is one of the factors to be taken into account in the overall assessment (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23). It is a matter of law which must be examined by the Office even if the parties do not comment on it. In contrast, the degree of enhanced distinctiveness acquired through use of the earlier sign is a matter of law **and** fact, which the Office cannot examine unless the opponent claims and substantiates it in due time (see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2, Substantiation).

The inherent distinctiveness of the **contested** trade mark **as a whole** is not examined within the framework of the opposition proceedings, as it is the scope of protection of the earlier mark that is relevant for the purposes of likelihood of confusion. Likewise, the enhanced distinctiveness of the contested sign is also irrelevant because likelihood

⁴⁸ See also Objective 1 of the Common Practice on the impact of non-distinctive/weak components on likelihood of confusion agreed within the framework of the ETMDN.

of confusion requires a consideration of the scope of protection of the earlier mark rather than that of the mark applied for. If an earlier mark is recognised as having a broader scope of protection by reason of its enhanced distinctiveness, the reputation acquired by the **mark applied for** is, as a matter of principle, irrelevant for the purpose of assessing the likelihood of confusion (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 84).

2.1.3 Relevant point in time

The inherent distinctiveness of the earlier mark(s) should be assessed at the time of the decision. The enhanced distinctiveness of the earlier trade mark(s) (if claimed) should exist (i) at the time of filing of the contested EUTM application (or any priority date), **and** (ii) at the time of the decision.

2.1.4 Relevant goods and services

The assessment of the **inherent distinctiveness** of the earlier mark is carried out only for the goods or services that have been found to be identical or similar to the contested goods and services.

Assessment of the **enhanced distinctiveness** of the earlier mark is carried out only in respect of the goods or services protected by the sign for which enhanced distinctiveness is claimed and that have been found to be identical or similar to the contested goods and services.

Furthermore, it is the perception of the relevant public for these goods and services that is of relevance (e.g. whether a specialist public is involved or not).

2.2 Examination of inherent distinctiveness of the earlier mark

2.2.1 General principles

The first step in examining the distinctiveness of the earlier mark is to examine its inherent distinctiveness. The same rules and principles apply as those for the examination of distinctiveness of components, in terms of the relevant public and its linguistic and cultural background, relevant territory, relevant goods and services, etc. (see the Guidelines, Part C, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.2).

At the stage of determining the distinctiveness of the earlier mark as a whole, distinctiveness of its various components (or its only component) has already been established in the section on comparison of signs. In principle, if an earlier mark contains a normally distinctive component, then the inherent distinctiveness of such an earlier mark as a whole is also normal, regardless of the possible presence of other non-distinctive or weak components. If the most distinctive component of the earlier

mark is distinctive only to a low degree, then in principle the overall inherent distinctiveness of that mark will be no more than low.

As mentioned above, earlier registered trade marks are presumed to have **at least a minimum degree** of inherent distinctiveness (24/05/2012, C-196/11, F1-Live, EU:C:2012:314), even where persuasive evidence is submitted to challenge this presumption. If the EUTM applicant proves that it has started a cancellation action against the earlier registered mark, then it might be necessary to suspend the opposition proceedings pending the outcome of the said action.

The outcome of the examination of inherent distinctiveness of the earlier mark as a whole will be one of the following.

- The earlier mark has **less than normal distinctiveness** because, as a whole, it is allusive (in a way that materially affects distinctiveness) or laudatory of the characteristics of identical or similar goods or services (or because it is otherwise weak). As set out above, the Office will not conclude that an earlier mark as a whole is descriptive and/or non-distinctive.
- The earlier mark has **normal distinctiveness** because, as a whole, it is not descriptive, allusive (in a way that materially affects distinctiveness) or laudatory (or is not otherwise weak) in relation to identical or similar goods or services.

It is Office practice, when an earlier mark is not descriptive (or is not otherwise non-distinctive), to consider it as having no more than a normal degree of inherent distinctiveness. As indicated above, this degree of distinctiveness can be further enhanced if appropriate evidence is submitted showing that a higher degree of distinctiveness of the earlier mark has been acquired through use or because it is highly original, unusual or unique (26/03/2015, T-581/13, Royal County of Berkshire POLO CLUB (fig.) / BEVERLEY HILLS POLO CLUB et al., EU:T:2015:192, § 49, last alternative). It should, however, be recalled that a mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H/Eich, EU:C:2013:317, § 71).

2.2.2 Impact of the low distinctiveness of the earlier mark

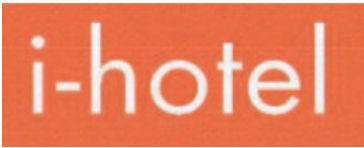
As explained in paragraph 2.1.1 above, the Office, following the case-law of the Court of Justice, attributes at least a minimum degree of distinctiveness to the earlier mark.


A finding that a trade mark has a low or even very low (minimal) degree of distinctiveness may have a different impact on the likelihood of confusion. In general, this finding is an argument against a likelihood of confusion. It must however be balanced with the other factors, like the degree of similarity of the signs and the goods or services, as well as the degree of attention and sophistication of the relevant public.

The Court has emphasised on several occasions that a finding of a low distinctive character for the earlier trade mark does not prevent a finding of a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak

distinctive character, there may be a likelihood of confusion on account, in particular, of a high degree of similarity between the signs and between the goods or services covered (13/12/2007, T-134/06, Pagesjaunes.com, EU:T:2007:387, § 70).

The **likelihood of confusion was affirmed** for similar and identical goods, when the trade marks differed only in stylisation or non-distinctive figurative elements and showed therefore a high degree of similarity.

Earlier mark	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
<p>G&S : Class 43 and others related to travel and hotel services</p> <p><i>Territory</i> : EU</p> <p><i>Assessment</i> : the trade marks are visually highly similar; there is phonetic and conceptual identity.</p>		

Earlier mark	Contested sign	Case No
SHE		15/10/2015, T-642/13, EU:T:2015:781
<p>G&S : Class 25</p> <p><i>Territory</i> : Germany</p> <p><i>Assessment</i> : the trade marks are visually and conceptually similar; there is phonetic identity.</p> <p>The finding of the likelihood of confusion is not called into question by the argument that the earlier word mark is purely descriptive and thus has a low distinctive character.</p> <p>The fact that the mark at issue consists of the same word sign as the earlier word mark and differs from it solely by a figurative element without particular meaning could be perceived as a particular configuration of the earlier word mark (paras 73, 77).</p>		

However, **the likelihood of confusion was excluded** even for identical goods in cases where the degree of similarity between the marks was low due to differences resulting from an additional fully distinctive element:

Earlier mark	Contested sign	Case No
--------------	----------------	---------

POST	TPG POST	13/05/2015, T-102/14, EU:T:2015:279
<p>G&S: Class 39 and others related to postal services</p> <p><i>Territory</i> : Germany, EU</p> <p><i>Assessment</i> : the earlier mark has limited distinctiveness. The differences between the marks due to the addition of the distinctive element 'TPG' will be perceived visually, phonetically and conceptually (paras 61, 68.</p>		

Earlier mark	Contested sign	Case No
F1	F1H2O	21/05/2005, T-55/13, EU:T:2015:309
<p>G&S : Class 9, 25, 38, 41</p> <p><i>Territory</i> : IT, UK and others</p> <p><i>Assessment</i> : the visual and phonetic similarity is low, the signs are conceptually dissimilar. The element 'F1' is indeed likely to create a link in the mind of the relevant public between those goods and services and the field of motor racing. The distinctiveness of the earlier word marks does not help confer on those marks, or on the element of the mark applied for composed of the alphanumeric combination 'F1', a dominant character or independent distinctive character, inasmuch as the mark applied for is not broken down by the relevant public, but would be perceived by that public in its entirety (paras 45, 50).</p>		

2.2.3 Specific themes

2.2.3.1 One-letter signs, numerals and short signs

The Court, in its judgment of 09/09/2010, C-265/09 P, α , EU:C:2010:508, held that the distinctiveness of single-letter trade marks must be assessed according to an examination based on the facts, focusing on the goods or services concerned and the **same criteria that apply to other word marks** (paras 33-39). Although that judgment deals with absolute grounds, the Office considers that the principle established by the Court (i.e. that the application of the criterion of distinctiveness must be the same for all marks) also applies in *inter partes* cases when it comes to determining the distinctiveness of single-letter trade marks.

The Court, while acknowledging that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, held

that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law.

The Office considers the ruling to mean that, when establishing the distinctiveness of an earlier mark, it is not correct to rely on assumptions such as a priori statements that consumers are not in the habit of perceiving single letters as trade marks or on generic arguments such as that relating to the availability of signs, given the limited number of letters.

The General Court has since stated in a number of cases that a trade mark containing a **single letter** or a single numeral may indeed be inherently distinctive (08/05/2012, T-101/11, G, EU:T:2012:223, § 50; 06/10/2011, T-176/10, Seven for all mankind, EU:T:2011:577, § 36; 05/11/2013, T-378/12, X, EU:T:2013:574, § 37-51).

In its judgment of 10/05/2011, T-187/10, G, EU:T:2011:202, the General Court dismissed the applicant's argument that single letters are generally per se devoid of distinctive character and that therefore only their graphic representation would be protected (paras 38, 49).

Consequently, whilst registered **earlier trade marks consisting of a single letter (or numeral)** represented in **standard characters** enjoy a presumption of validity, ultimately their degree of inherent distinctiveness will have to be assessed with reference to the goods/services concerned.

If the corresponding claim is made, account should be taken of evidence submitted by the opponent that demonstrates that its registered trade mark consisting of a single letter has acquired **enhanced distinctiveness**. This circumstance could lend the earlier trade mark a broader scope of protection.

The above considerations apply both to single-letter/numeral trade marks represented in standard characters (i.e. word marks) and to stylised single-letter/numeral trade marks.

Where the opponent has successfully proven that its single-letter trade mark has acquired enhanced distinctiveness through intensive use, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of the earlier single-letter trade mark cannot justify a finding of likelihood of confusion if the overall visual impression conveyed by the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single-letter trade mark that is stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

Furthermore, in accordance with the α judgment, as regards **short signs**, unless a letter combination, as such, is intrinsically non-distinctive for the goods and services (e.g. 'S' or 'XL' for goods in Class 25), these signs are not necessarily distinctive only to a low degree. The same rules apply to numerals.

2.2.3.2 Collective marks

Where the mark on which the opposition is based is a collective mark, its inherent distinctiveness is to be assessed in the usual way. The mark may have a low or even very low degree of inherent distinctiveness when it refers to the nature or other characteristics of the goods concerned. The fact that the mark is a collective mark does not imply that its scope of protection is broader (13/06/2012, T-534/10, Hellim, EU:T:2012:292, § 49-52; 05/12/2012, T-143/11, F.F.R., EU:T:2012:645, § 61).

Even where the earlier mark is a collective mark that contains a geographically descriptive element and is registered pursuant to Article 74(2) EUTMR, its distinctiveness is to be assessed in the usual way. The geographically descriptive elements in such collective marks will be considered to be devoid of distinctive character. This is because the distinctiveness of such marks must stem from the addition of other elements enabling the consumer to distinguish the goods or services of the members of the proprietor association from those of other undertakings (05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 72-73). If the earlier mark consists only of a geographically descriptive element, its distinctiveness should be considered low (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 44).

2.3 Examination of enhanced distinctiveness

After the obligatory **examination of inherent distinctiveness**, the second step is to check — provided the opponent has made the corresponding claim ⁽⁴⁹⁾ — whether the earlier mark has acquired enhanced distinctiveness at the time of filing (or priority date) of the contested EUTM application as a consequence of the use that the opponent has made of it.

The distinctiveness of the earlier mark always has to be taken into account when deciding on the likelihood of confusion. The more distinctive the earlier trade mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24). Therefore, marks with a highly distinctive character, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).


In practice, this means that the fact that an earlier trade mark enjoys enhanced distinctive character or reputation is an argument in favour of finding a likelihood of confusion.

Enhanced distinctiveness of an individual mark means that the relevant public recognises the mark as having an enhanced ability or a high capacity to identify the goods or services for which it is registered as coming from a particular undertaking. Mere knowledge or recognition of the mark by the relevant public as, for instance, a certification mark, is not sufficient. The enhanced recognition of a mark must be related

⁴⁹ See the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2.

to its essential function, which is, in the case of individual marks, that of indicating commercial origin. Enhanced distinctiveness of the mark is the result of its use in accordance with its essential function (07/06/2018, T-807/16, N & NF TRADING / NF ENVIRONNEMENT (fig.) et al., EU:T:2018:337).

Use in accordance with the mark's essential function may enhance the distinctiveness of marks with little or no inherent distinctiveness or of those that are inherently distinctive.

Earlier mark	Contested sign	Case No
CRISTAL		17/11/2003, R 37/2000-2
<p>G&S: Class 33</p> <p>Territory: France</p> <p><i>Assessment:</i> (earlier mark 'CRISTAL') 'As regards the claim that "Cristal" is a descriptive word for the goods at issue (sparkling wines with crystalline character), the Board cannot accept it. On the one hand, it is an evocative indication which suggests the crystalline character of wines, but which in no way describes the product. On the other hand, [the Board] considers that a highly distinctive character of the mark CRISTAL on the French market had been shown.' (para. 31)</p>		

The Court has given some guidance in respect of the evaluation of distinctiveness acquired through use of the earlier mark and provided a non-exhaustive list of factors.

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.


(22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 23)

The evidence of enhanced distinctiveness acquired through use must refer to both (i) the relevant geographical area and (ii) the relevant goods and services. The opponent may claim enhanced distinctive character of the earlier mark for only part of the registered goods and services. According to the evidence submitted, the Office must establish precisely for which goods and services distinctiveness has been acquired. The nature, factors, evidence and assessment of enhanced distinctiveness are the same as for reputation. For further details on the evidence required and its

assessment see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

However, a finding of reputation requires that a certain threshold of recognition be met whilst, as set out above, the threshold for a finding of enhanced distinctiveness may be lower.

Enhanced distinctiveness is anything above inherent distinctiveness.

Earlier mark	Contested sign	Case No
EL COTO		12/03/2008, T-332/04, EU:T:2008:69
<p>G&S: Classes 33, 35, 39</p> <p>Territory: EU</p> <p><i>Assessment:</i> enhanced distinctiveness of the trade mark 'EL COTO': 'The Board of Appeal took into account the market knowledge of the earlier mark 'EL COTO' and made a proper assessment of the relevant case-law principles to conclude that the earlier mark 'EL COTO' has a highly distinctive character; it based its finding on the following facts: the certificate issued by the Secretary General of the Consejo Regulador de la Denominación de Origen Calificada 'Rioja', which certifies that the owner markets its wines, among others, under the brand names 'El Coto' and 'Coto de Imaz' since 1977 and that these marks 'enjoy a significant well-known character' in Spain, various decisions of the Spanish Patent and Trade Mark Office acknowledging that the mark 'EL COTO' is well known in Spain, a document on sales evolution, indicating that they had sold under the mark 'El Coto' 339 852, 379 847, 435 857 and 464 080 boxes of twelve bottles of wine in 1995, 1996, 1997 and 1998, respectively' (para. 50).</p>		

Importantly, acquisition of enhanced distinctive character by a mark may be a result of its use as part of another registered trade mark (07/07/2005, C-353/03, Have a break, EU:C:2005:432, § 30-32; 07/09/2006, T-168/04, Aire limpio, EU:T:2006:245, § 74).

The outcome of the examination of enhanced distinctiveness will be one of the following.

- Where there is no evidence of enhanced distinctiveness as regards the relevant goods and services or the territory, or the evidence is insufficient, the degree of distinctiveness of the earlier mark will be its inherent distinctiveness (less than normal or normal).
- Where there is evidence of enhanced distinctiveness as regards all or some of the relevant goods and services and the territory, and the evidence is sufficient:
 - if the earlier mark has less than normal inherent distinctiveness, the mark/component may have acquired a normal or even a high degree of distinctiveness, depending on the evidence submitted⁵⁰; or

- if the earlier trade mark has normal inherent distinctiveness, it may have acquired high distinctiveness.

It must be recalled that although a mark as a whole may have acquired enhanced distinctiveness, there may be descriptive elements that will have less than normal or no distinctiveness. For example, the enhanced distinctiveness of the mark 'Coca Cola' as a whole does not alter the fact that the element 'Cola' remains entirely descriptive for certain products.

⁵⁰ For further details on the evidence required and its assessment see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 6

Other factors

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1 Introduction

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion under separate headings before the chapter on global assessment. These factors have been treated in the preceding chapters of these Guidelines.

However, the global assessment also takes into account **other factors, based on arguments and evidence submitted by the parties**, which are relevant for deciding on likelihood of confusion. This chapter deals with the frequent arguments/claims raised by the parties.

2 Family of Marks/Series of Marks

When an opposition to an EUTM application is based on several earlier marks and those marks display characteristics that give grounds for regarding them as forming part of a single 'series' or 'family', a likelihood of confusion may be created by the possibility of association between the contested trade mark and the earlier marks forming part of the series. The Courts have given clear indications on the two cumulative conditions that have to be satisfied (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 123-127, confirmed 13/09/2007, C-234/06 P, Bainbridge, EU:C:2007:514, § 63).

- Firstly, the proprietor of a series of earlier marks must submit **proof of use** of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a 'series' (i.e. at least three).
- Secondly, the trade mark applied for must **not only be similar** to the marks belonging to the series, but must also display characteristics capable of **associating** it with the series. Association must lead the public to believe that the contested trade mark is also part of the series, that is to say, that the goods and services could originate from the same or connected undertakings. This may not be the case where, for example, the element common to the earlier series of marks is used in the contested trade mark, either in a different position from that in which it usually appears in the marks belonging to the series, or with a different semantic content.

The argument that there is a 'family of marks' must be claimed before the expiry of the **time limit set for substantiating the opposition**. The opponent must prove within the same time limit that it has used the marks forming the alleged family in the marketplace to such an extent that the relevant public has become familiar with this family of marks as designating the goods and/or services of a particular undertaking.

A positive finding that the opponent has a family of marks entails **the use of at least three marks**, the minimum threshold for such an argument to be taken into due consideration. Proof of use relating to only two trade marks cannot substantiate the existence of a series of marks.

Normally, the trade marks constituting a ‘family’ and used as such are all registered marks. However, it cannot be precluded that the ‘family of marks’ doctrine may also include **non-registered trade marks**.

When the opponent has proven the existence of a family of marks, it would be wrong to compare the contested application individually with each of the earlier marks making up the family. Rather, the assessment of similarity **should be conducted to make a comparison between the contested mark and the family taken as a whole**, in order to establish if the contested sign displays those characteristics that are likely to trigger the association with the opponent’s family of marks in consumers’ minds. In fact, an individual comparison between the conflicting signs might even lead to a finding that the signs are not sufficiently similar to lead to a likelihood of confusion, whereas the association of the contested sign with the earlier family of marks might be the decisive factor that tips the balance to a finding of likelihood of confusion.

An assumption of a family of marks on the part of the public requires that the **common denominator of the contested application and the earlier family of marks must have a distinctive character**, either per se or acquired through use, to allow a direct association between all of these signs. Likewise, there will be no assumption of a family of marks where the further components of the earlier signs have a greater impact in the overall impression of those signs.

Earlier signs	Contested sign	Case No
Ophtal, Crom-Ophtal, Visc-Ophtal, Pan-Ophtal	ALERGOFTAL	06/06/2002, R 838/2001-1
<p>G&S: Class 5</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the Board held that the differences between the signs were such as to exclude the likelihood that the contested mark would be perceived as belonging to the opponent’s family of marks (assuming the existence of this had been established). In particular, the Board considered that, whereas the claimed ‘series’ depended upon the presence in every case of the suffix ‘-ophtal’ (and not ‘oftal’) preceded by a hyphen, the contested sign did not contain exactly the same suffix nor reflect exactly the same principles of construction. When ‘ophtal’ is combined with ‘Pan-’, ‘Crom-’ and ‘Visc-’, these partly disjointed prefixes become of greater distinctive value, affecting quite significantly the overall impression made by each of the marks as a whole, and in each case providing initial elements quite clearly different from the first half — ‘Alerg’ — of the mark applied for. The German consumer, upon seeing ‘Alergoftal’ would not think of dividing it into two elements, as opposed to being invited to do so when encountering marks made up of two elements separated by a hyphen (paras 14, 18).</p>		
Earlier signs	Contested sign	Case No
TIM OPHTAL, SIC OPHTAL, LAC OPHTAL etc.	OFTAL CUSI	14/07/2011, T-160/09

G&S: Class 5

Territory: EU

Assessment: the element 'Ophtal', which denotes ophthalmologic preparations, is a weak element in the family of marks. The elements TIM, SIC and LAC are the distinctive elements (paras 92-93).

The finding that a particular mark forms part of a family of marks requires that the **common component of the signs is identical or very similar**. The signs must contain the same distinctive element, and this element must play an independent role in the sign as a whole. Minor graphical differences in the common component may not exclude an assumption of a series of marks, when these differences may be understood by the public to be a modern presentation of the same product line. In contrast, letters that are different from or additional to the common component generally do not allow an assumption of a family of marks.

Normally, the **common element that characterises the family appears in the same position within the marks**. Therefore, the same (or very similar) element appearing in the same position in the contested sign will be a strong indicator that the later mark could be associated with the opponent's family of marks. However, the common element appearing in a different position in the contested sign weighs heavily against such an association being established in the consumers' minds. For example, the contested sign ISENBECK is not likely to be associated with a family of BECK- marks where the element BECK is at the beginning of the signs making up the family.

Earlier signs	Contested sign	Case No
UNIZINS, UNIFONDS and UNIRAK	UNIWEB	16/06/2011, C-317/10 P
<p>G&S: Class 36 (<i>financial services</i>)</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> in this judgment the Court annulled a decision of the GC since it had not duly assessed the structure of the marks to be compared, nor the influence of the position of their common element on the perception of the relevant public (para. 57).</p>		

Examples where the Boards considered that a family of marks had been established

Earlier signs	Contested sign	Case No
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UniSECTOR UniSTARTUP UniSTRATEGIE	uni-gateway	05/03/2009, R 31/2007-1
<p>G&S: Class 36 (<i>financial services</i>)</p> <p>Territory: Germany</p> <p>Assessment: the Board considered that the opponent had in fact submitted sufficient evidence, by submitting, in particular, references from the relevant specialist press, such as FINANZtest, and by referring to its considerable 17.6 % market share of 'Uni' investment funds amongst German fund management companies, to show that it uses the prefix 'UNI' for a number of well-known investment funds. There is a likelihood of confusion from the point of view of the family of trade marks since the relevant trade circles would include in the series the trade mark applied for, since it is constructed in accordance with a comparable principle (paras 43-44).</p>		
Earlier signs	Contested sign	Case No
UNIFIX, BRICOFIX, MULTIFIX, CONSTRUFIX, TRABAFIX, etc.	ZENTRIFIX	11/09/2008, R 1514/2007-1
<p>G&S: Classes 1, 17 and 19 (<i>adhesives</i>)</p> <p>Territory: Spain</p> <p>Assessment: the Board considered that the opponent had proven the existence of a family of marks. Firstly, the Board discarded that the common element 'FIX' would be non-distinctive, given that it is not a Spanish word and even its Spanish meaning 'fijar' is not one that spontaneously comes to mind to average Spanish consumers in the context of glues and adhesives, since verbs like 'pegar', 'encolar' or 'adherir' are used more regularly in this context. Secondly, the opponent duly proved that all the marks forming the family are being used. Invoices and promotional literature duly show that goods bearing these marks are available to consumers on the market. Consumers, therefore, are aware that there is a family of marks. Thirdly, ZENTRIFIX has characteristics that replicate those of the trade marks in the family. The FIX element is placed at the end; the element that precedes it alludes to something that has some relevance to glues; the two elements are juxtaposed without any punctuation signs, dashes or physical separation; the typeface used for the two elements is the same (paras 43-44).</p>		
Earlier signs	Contested sign	Case No
CITIBANK, CITIGOLD, CITICORP, CITIBOND, CITICARD, CITIEQUITY, etc.	CITIGATE	30/04/2009, R 821/2005-1 (confirmed 26/09/2012, T-301/09, EU:T:2012:473)

G&S: Classes 9, 16 (potentially finance-related goods)

Territory: EU

Assessment: the Board considered that the evidence — consisting in particular of extracts from the opponents' websites, annual reports, press advertisements and so forth — is littered with references to the trade marks CITICORP, CITIGROUP, CITICARD, CITIGOLD, CITIEQUITY. The evidence demonstrates that CITIBANK is in the nature of a 'house mark' or basic brand and that the opponents have developed a whole series of sub-brands based on the CITI concept. The contested mark CITIGATE is the sort of mark that the opponents might add to their portfolio of CITI marks, in particular if they wished to offer a new service to customers and place the emphasis on the idea of access (paras 23-24).

3 Coexistence of Conflicting Marks on the Market in the Same Territory

The EUTM applicant may claim that the conflicting trade marks coexist in the relevant territory. Usually the coexistence argument comes up when the applicant owns a national trade mark corresponding to the EUTM application in the territory where the opposing trade mark is protected. The applicant may also refer to coexistence with a trade mark owned by a third party.

Therefore, two different situations, both referred to as 'coexistence' by the parties, should be distinguished:

- coexistence between the two marks involved in the opposition can be persuasive of the absence of a likelihood of confusion in the relevant public's perception (see below);
- where many similar marks (other than the two marks involved in the opposition) are used by competitors, the coexistence may affect the scope of protection of the earlier right. See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

3.1 Coexistence between the marks involved in the opposition

In opposition proceedings, it is most commonly argued by the EUTM applicant that the conflicting marks coexist on a national level and that the coexistence is tolerated by the opponent. Occasionally, it is argued that coexistence is accepted by the parties in a coexistence agreement.

The possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 82). In certain cases, the coexistence of earlier marks in the market could reduce the likelihood of confusion that the Office finds

between two conflicting marks (11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 86).

However, the indicative value of coexistence should be treated with **caution**. There might be different reasons why the two signs coexist on a national level, for example, a different legal or factual situation in the past or prior rights agreements between the parties involved.

Therefore, whilst the impact of coexistence on the finding of likelihood of confusion is accepted in theory, the conditions for this coexistence to be persuasive of the absence of a risk of confusion are, in practice, very difficult to establish and seldom prevail.

For the EUTM applicant to prove that the coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public, certain conditions must be met.

- **Comparable situation.** The earlier ('coexisting') marks and the marks at issue are **identical** to those involved in the opposition before the Office (11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 86; 18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 60-61) and cover the same goods or services as those in conflict (30/03/2010, R 1021/2009-1, ECLIPSE / ECLIPSE (fig.), § 14).
- The coexistence concerns the relevant **countries** in the case (e.g. alleged **coexistence in Denmark is irrelevant when the opposition is based on a Spanish** trade mark; 13/07/2005, T-40/03, Julián Murúa Entrena, EU:T:2005:285, § 85). If the earlier trade mark is an EUTM, the EUTM applicant must show coexistence in the entire EU.
- Only coexistence in the **marketplace** can be taken into account. The mere fact that both trade marks exist in the national register (formal coexistence) is insufficient. The EUTM applicant has to prove that the trade marks were **actually used** (13/04/2010, R 1094/2009-2, BUSINESS ROYALS (fig.) / ROYALS (fig.), § 34). Coexistence should be understood as 'co-use' of concurrent and supposedly conflicting marks (08/01/2002, R 360/2000-4, NO LIMITS / LIMMIT, § 13; 05/09/2002, R 1/2002-3, CHEE.TOS / Chitos, § 22).
- The **period of coexistence** must be taken into consideration: in the judgment of 01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, the alleged coexistence of only 4 months was considered obviously too short. Moreover, the coexistence of the trade marks has to relate to a period close to the filing date of the EUTM application (12/05/2010, R 607/2009-1, ELSA ZANELLA (fig.) / ZANELLA et al., § 39).
- The absence of a likelihood of confusion may be only inferred from the '**peaceful**' nature of the coexistence of the marks at issue on the market concerned (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 82; 08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 74; 24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 64). This is not the case when the conflict has been an issue before the national courts or administrative bodies (infringement cases, oppositions or applications for annulment of a trade mark).
- Moreover, the peaceful coexistence of the trade marks in the relevant national market does not outweigh the likelihood of confusion if it is based on prior rights agreements between the parties, including agreements settling disputes before

national courts, since these agreements, even if based on the assessment of the legal situation made by the parties, may have purely economic or strategic reasons.

However, exceptional situations are possible. In its preliminary ruling of 22/09/2011, C-482/09, Budweiser, EU:C:2011:605, the Court of Justice ruled that two identical trade marks designating identical goods can coexist on the market to the extent that there has been a long period of **honest concurrent use** of those trade marks and that use neither has nor is liable to have an adverse effect on the essential function of the trade mark, which is to guarantee consumers the origin of the goods and services.

As regards **coexistence agreements** between the parties, when assessing likelihood of confusion, the Office's policy is that these agreements may be taken into account like any other relevant factor, but they are **in no way binding on the Office**. This is particularly true when the application of the relevant provisions of the EUTMR and the established case-law lead to a conclusion that is not in accordance with the content of the agreement.

If an agreement is disputed before national instances or there are pending court proceedings and the Office estimates that the outcome could be relevant for the case at issue, it may decide to suspend the proceedings.

In addition, as a general rule, nothing precludes the opponent from filing an opposition against an EUTM application, whether or not it previously opposed other (national) marks of the applicant. This cannot be considered as 'contradictory behaviour' and interpreted to the opponent's disadvantage, especially since in opposition proceedings, unlike invalidity proceedings, the defence of 'acquiescence' is not available (the rules for opposition proceedings do not contain an equivalent to Article 61 EUTMR, according to which an EUTM proprietor may invoke as a defence the fact that the applicant for invalidity has acquiesced to the use of the EUTM for more than 5 years).

4 Incidences of Actual Confusion

Likelihood of confusion means a **probability** of confusion on the part of the relevant consumer and does not require **actual** confusion. As expressly confirmed by the Court: '... it is not necessary to establish the existence of actual confusion, but the existence of a likelihood of confusion' (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 69).

In the global assessment of likelihood of confusion, all relevant factors have to be taken into consideration. Evidence of actual confusion is a factor that may weigh in favour of likelihood of confusion; its indicative value should not, however, be overestimated for the following reasons:

- in everyday life there are always people who confuse and misconstrue everything, and others who are extremely observant and very familiar with every trade mark. Therefore, there is no legal value in highlighting the existence of these people since it could lead to subjective results;

- insofar as the targeted consumer's perception is concerned, the assessment is normative. The average consumer is assumed to be 'reasonably well informed and reasonably observant and circumspect', even though in purely factual terms some consumers are extremely observant and well informed, whilst others are careless and credulous (10/07/2007, R 40/2006-4, SDZ DIRECT WORLD / SAZ, § 32).

Therefore, incidences of actual confusion can influence the finding of likelihood of confusion only if it is proven that these incidences usually accompany the existence of the conflicting trade marks in the market in the typical situation in trade involving the goods and/or services concerned.

To properly weigh evidence on the number of occasions when actual confusion has arisen, the assessment must be made in the light of the number of opportunities for confusion. If the business transactions are voluminous but the instances of confusion are sparse, this evidence will have little weight in the assessment of likelihood of confusion.

Lack of actual confusion has been treated in the context of coexistence, in paragraph 3 above.

5 Prior Decisions by EU or National Authorities Involving Conflicts Between the Same (or Similar) Trade Marks

5.1 Prior Office decisions

As regards previous decisions of the Office in conflicts between identical or similar trade marks, the General Court has stated that:

... it is settled case-law ... that the legality of the decisions of the [Office] is to be assessed purely by reference to [the EUTMR] and not the Office's practice in earlier decisions.

(30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198, § 35.)

Accordingly, the Office is **not bound by its previous decisions**, since each case has to be dealt with separately and with regard to its particularities.

Notwithstanding the fact that previous decisions of the Office are not binding, their reasoning and outcome should still be **duly considered** when deciding upon the case in question. This was reinforced in the judgment of 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73-75:

The Office is under a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration.

In the light of those two principles, the Office must, when examining an application for registration of a European Union trade mark, take into account the decisions already

taken in respect of similar applications and consider with special care whether it should decide in the same way or not ...

That said, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality.


The indicative value of the previous decisions will in principle be limited to cases that bear a sufficiently close resemblance to the case in question. However, according to Article 95(1) EUTMR, in opposition proceedings the Office is restricted in the examination of the case to the facts, evidence and arguments submitted by the parties. For this reason, even in cases based on comparable facts and involving similar legal problems, the outcome may still vary due to the different submissions made by the parties and the evidence they present.

5.2 Prior national decisions and judgments

Decisions of national courts and of national offices in cases regarding conflicts between identical or similar trade marks on the national level **do not have a binding effect** on the Office. According to case-law, the European Union trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it and applies independently of any national system. Accordingly, the registrability of a sign as a European Union trade mark is to be assessed on the basis of the relevant legislation alone (13/09/2010, T-292/08, *Often*, EU:T:2010:399, § 84; 25/10/2006, T-13/05, *Oda*, EU:T:2006:335, § 59).

Therefore, the decisions adopted in a Member State or in a state that is not a member of the European Union are not binding for the Office (24/03/2010, T-363/08, *Nollie*, EU:T:2010:114, § 52).

Still, their reasoning and outcome should be **duly considered**, particularly when the decision has been taken in the Member State that is relevant to the proceedings. National courts have a thorough knowledge of the specific characteristics of their Member State, in particular as regards the marketplace reality in which goods and services are marketed and the customer perception of signs. This may, in particular cases, be relevant for the assessment made by the Office.

Earlier sign	Contested sign	Case No
MURUA		T-40/03

G&S: Class 33

Territory: Spain

Assessment: the Court took into consideration the reasoning of a judgment of the national court as far as it explained the perception of family names on the part of the public in the relevant country: regarding the question whether the relevant public in Spain will generally pay greater attention to the surname 'Murúa' than to the surname 'Entrena' in the trade mark applied for, the Court considers that, while it is **not binding** on EU bodies, Spanish case-law can provide **a helpful source of guidance** (para. 69).

Earlier sign	Contested sign	Case No
	OFTEN	T-292/08

G&S: Class 14

Territory: Spain

Assessment: the Court did not see the relevance of Spanish case-law, according to which an average member of the Spanish public has some knowledge of English for the assessment of the particular case:

In the present case, the applicant has not put forward any factual or legal consideration, deriving from the national case-law relied upon, which is capable of providing helpful guidance for determination of the case The mere finding that certain English words are known to the Spanish consumer, namely the words 'master', 'easy' and 'food', even if that is clear from the national case-law in question, cannot lead to the same conclusion as regards the word 'often' (para. 85).

Whilst it is, in principle, permissible to take into account decisions of national courts and authorities, these decisions should be examined **with all the required care and in a diligent manner** (15/07/2011, T-108/08, Good Life, EU:T:2011:391, § 23). Usually the understanding of such a decision will require the submission of sufficient information, in particular about the facts on which the decision was based. Their indicative value will therefore be limited to the rare cases when the factual and legal background of the case was presented completely in the opposition proceedings and is conclusive, clear and not disputed by the parties.

The above guidelines are without prejudice to the effects of the judgments of EUTM courts dealing with counterclaims for revocation or for a declaration of invalidity of EUTMs.

6 Irrelevant Arguments for Assessing Likelihood of Confusion

6.1 Specific marketing strategies

The examination of the likelihood of confusion carried out by the Office is a prospective examination. In contrast to trade mark infringement situations — where the courts deal with specific circumstances in which the particular facts and the specific nature of use of the trade mark are crucial — the deliberations of the Office on likelihood of confusion are carried out in a more abstract manner.

For this reason, specific marketing strategies are not relevant. The Office must take the usual circumstances in which the goods covered by the marks are marketed as its benchmark, that is, those circumstances that are expected for the category of goods covered by the marks. The particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks (15/03/2007, C-171/06 P, *Quantum*, EU:C:2007:171, § 59; 22/03/2012, C-354/11 P, G, EU:C:2012:167, § 73; 21/06/2012, T-276/09, *Yakut*, EU:T:2012:313, § 58).

For example, the fact that one party offers its everyday consumer goods (wines) for sale at a higher price than competitors is a purely subjective marketing factor that is, as such, irrelevant when assessing the likelihood of confusion (14/11/2007, T-101/06, *Castell del Remei Oda*, EU:T:2007:340, § 52).

6.2 Reputation of EUTM application

Applicants sometimes argue that there will be no likelihood of confusion with the earlier mark because the EUTM application has a reputation. This argument cannot prosper because the right to an EUTM begins on the date when the EUTM application is filed and not before, and it is from that date onwards that the EUTM has to be examined with regard to opposition proceedings. Therefore, when considering whether or not the EUTM falls under any of the relative grounds for refusal, events or facts that happened before the filing date of the EUTM are irrelevant because the opponent's rights, insofar as they predate the EUTM, are earlier than the applicant's EUTM.

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

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

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 7

Global assessment

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1 Introduction

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. If a significant part of the relevant public of the goods or services at issue may be confused as to the origin of the goods or services, this is sufficient. Therefore, there is no need to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

The Court has stated that likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion and establishes their degrees:

1. similarity of the goods and services;
2. the relevant public and its degree of attention and sophistication;
3. similarity of the signs taking into account their distinctive and dominant elements;
4. the distinctiveness of the earlier mark.

In the last section of a decision containing the global assessment, those factors are weighed up. However, the global assessment can weigh up many other factors that are relevant to deciding on likelihood of confusion (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 6, Other Factors).

2 Interdependence Principle

The Court has set out the essential principle that evaluating likelihood of confusion implies some **interdependence between the relevant factors** and, in particular, between the previously established findings on the degree of similarity between the marks and that between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). This principle of interdependence is crucial to the analysis of likelihood of confusion.

The interdependence of those factors is expressly referred to in recital 11 in the Preamble to the EUTMR, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association that can be made with the used or registered sign, the degree of

similarity between the mark and the sign and that between the goods or services identified (10/09/2008, T-325/06, Capio, EU:T:2008:338, § 72 and case-law cited).

The requirement for a global assessment and the principle of interdependence means that, where there is at least some degree of similarity between the signs and the relevant goods/services, there will be an assessment of likelihood of confusion involving an iterative process that weighs up all the relevant factors. This process takes place in the global assessment section.

In practice, this means that the **Office will weigh up**, inter alia, the degree of similarity between the goods and services and the degree of attention paid by the relevant public to those goods and services, the degree of similarity between the signs, and whether the impression produced in any aspect of the comparison (visual/aural/conceptual) is more important, and the distinctiveness of the earlier mark.

The outcome depends on the particularities of each case, but as a rule of thumb it can be said that, when there is an average degree of similarity between the signs and between the goods or services, the degree of attention of the relevant public is average and the earlier trade mark has a normal distinctiveness, there will be a likelihood of confusion. However, the lower the degree of one factor, the higher the degree of other factors must be in order to find a likelihood of confusion (bearing in mind that the likelihood of confusion is inversely affected by an increased degree of attention of the relevant public). Therefore, on the basis of an average degree of distinctiveness of the earlier mark and an average degree of attentiveness of the public, the finding of a likelihood of confusion may be justified when the signs are identical or highly similar, despite a low degree of similarity between the goods/services. However, such a finding is more difficult on the basis of a limited distinctiveness of the earlier mark and/or when the degree of attention of the public is higher than average. Furthermore, it is true that, by virtue of the principle of interdependence, a lesser degree of similarity between the goods or services covered may be offset by a greater degree of similarity between the marks, and vice versa. However, there is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where identical goods are involved and there is a certain degree of similarity between the marks at issue (26/03/2020, T-343/19, Sonance / Conlance, EU:T:2020:124, § 63).

Moreover, the factors to be taken into account and their importance in the global assessment **will vary** according to the particular circumstances. For example, in clear-cut cases where the goods/services and the signs are highly similar or identical, the Office may find a likelihood of confusion without assessing all factors — such as enhanced distinctiveness, family of marks, etc.

Importantly, it is not possible to set out in the abstract whether one factor carries more weight than another, because these factors will have varying degrees of relative importance depending on the circumstances. For instance, the degree of visual similarity may weigh more heavily in connection with goods that are usually examined visually, whilst the degree of aural similarity may be more relevant to goods normally ordered orally (see paragraph 4 below).

3 Imperfect Recollection

Although the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers with a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).

4 Impact of the Method of Purchase of Goods and Services

The Court has stated that, when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed (22/09/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 27). Those factors must be taken into account at the stage of the global assessment of the likelihood of confusion and not at the stage of assessing the similarity of the signs (04/03/2020, C-328/18 P, Black Label by Equivalenza (fig.) / Labell (fig.) et al., EU:C:2020:156, § 70).





The category of goods and services involved may increase the importance of one of the different aspects of similarity between signs (visual, phonetic and conceptual) because of how goods and services are ordered and/or purchased. An aural or conceptual comparison between signs may be less important in the case of goods and services that are usually examined visually or may be tried on before being bought. In such cases, the visual impression of signs counts more in the assessment of likelihood of confusion.

However, it is important to emphasise that, as with all of the factors that are relevant to likelihood of confusion, the factors are interlinked and each set of circumstances must be examined on a case-by-case basis. This means that no general rule should be applied to broad categories of goods or services.




4.1 Visual similarity

A good example of where visual similarity can play a greater — but not exclusive — role in the global assessment of the likelihood of confusion is *clothing*. Generally, in clothes shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made


visually. Therefore, visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (14/10/2003, T-292/01, Bass, EU:T:2003:264, § 55; 06/10/2004, T-117/03-T-119/03 & T-171/03, NL, EU:T:2004:293, § 50; 18/05/2011, T-502/07, McKenzie, EU:T:2011:223, § 50; 24/01/2012, T-593/10, B, EU:T:2012:25, § 47). These considerations played a role in finding no likelihood of confusion between the marks below for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign	Case No
		T-502/07
		T-593/10

The same considerations were central to a finding of likelihood of confusion in the following cases also for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign	Case No
		09/06/2009, R 1050/2008-4
PETER STORM	PEERSTORM	08/07/2010, T-30/09, EU:T:2010:298
		18/05/2011, T-376/09, EU:T:2011:225

However, granting preferential consideration to the visual perception does not mean that identical verbal elements can be overlooked due to the presence of striking figurative elements, as can be seen in the case below, where likelihood of confusion was found for goods in Class 25.

Earlier sign	Contested sign	Case No
	FISHBONE	29/09/2011 T-415/09, EU:T:2011:550 (appeal 18/07/2013, C-621/11 P, EU:C:2013:484, dismissed)

In a similar way, the visual impression for marks covering *video games* has also been held to be particularly relevant because these goods are normally purchased after a comprehensive examination of their respective specifications and technical characteristics, firstly upon the basis of information that appears in specialist catalogues or on the internet, and then at the point of sale. For these reasons, the visual differences were key to the finding of no likelihood of confusion below (08/09/2011, T-525/09, Metronia, EU:T:2011:437, § 38-47).

Earlier sign	Contested sign	Case No
		T-525/09

The visual similarity between signs may also have an increased importance where the goods are **ordinary consumer products** (e.g. goods in Classes 29 and 30) that are most commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the mark they are looking for. Consequently, for such goods, the visual differences were central to a finding of no likelihood of confusion in the United Kingdom between the marks below.

Earlier sign	Contested sign	Case No
	EGLÉFRUIT	15/04/2010, T-488/07, EU:T:2010:145

However, the broad principle above does not mean that, for goods that are normally purchased visually, the phonetic impression can be overlooked. This latter point was highlighted in a case involving the marks below where the General Court, confirming

the finding of a likelihood of confusion, held that, although *computers and computer accessories* are sold to consumers ‘as seen’ on shelves in self-service areas, the phonetic identity between the marks at issue was, in this case, at least as important as their visual similarity because an oral discussion of the characteristics of the goods and their mark is also likely to take place at the time of purchase. Furthermore, those goods could be advertised orally, on the radio or by other consumers.

Earlier sign	Contested sign	Case No
CMORE		23/09/2011, T-501/08, EU:T:2011:527

4.2 Aural similarity

In contrast to the cases above, where visual similarity played a stronger role, the aural similarity may have more weight than the visual when the goods or services at issue are, in a significant amount of cases, also ordered orally.

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time. Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as **bars or nightclubs**. In such cases, attaching particular importance to the aural similarity between the signs at issue may be appropriate. These considerations came into play in the finding of likelihood of confusion between the marks below for certain goods in Class 33 (15/01/2003, T-99/01, *Mystery*, EU:T:2003:7, § 48).

Earlier sign	Contested sign	Case No
MIXERY		T-99/01

Nevertheless, the broad principle above does not mean that the visual impression can be overlooked for goods normally purchased orally. Indeed, the General Court has held that although preponderant importance had sometimes been accorded to the phonetic perception of marks for beverages, the phonetic dissimilarities of the marks did not merit particular importance where the specific beverages were widely distributed and sold not only in specialist shops, where they would be ordered orally, but also in large shopping centres, where they would be purchased visually (03/09/2010, T-472/08, 61 *a nossa alegria*, EU:T:2010:347, § 106).



4.3 Conclusion

The circumstances set out above demonstrate that in certain situations the Office should grant preferential consideration to the visual or aural perception of marks depending on how the goods and services at issue are ordered or purchased. However, identical or highly similar visual or aural elements cannot be entirely overlooked even in these situations because all the relevant factors are interlinked and interdependent, and each set of circumstances must be examined on a case-by-case basis.


5 Impact of Conceptual Identity or Similarity on the Likelihood of Confusion

A conceptual **similarity** between signs with **analogous** semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24, where the signs shared the broader concept of a 'bounding feline', but did not evoke the same animal: a puma in the earlier mark and a cheetah in the contested mark).

However, exceptionally, where the signs have the **same** distinctive concept in common accompanied by visual similarities between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark, as illustrated by the following example.

Earlier sign	Contested sign	Case No
		14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397
<p>G&S: Classes 32, 33</p> <p><i>Territory:</i> Spain (where 'venado' means 'deer')</p> <p><i>Assessment:</i> The Court found that the signs had the same concept and that there was significant visual similarity. In the absence of a clear semantic link between a deer or a deer's head and alcoholic or non-alcoholic beverages, the Court found it impossible to deny that the concept of a deer's head portrayed facing forward inside a circle had at least average distinctive character for designating beverages (para. 110). Enhanced distinctiveness was not considered — likelihood of confusion (for the Spanish public).</p>		

A conceptual similarity between the signs may not be sufficient to outweigh the visual and phonetic differences where the concept in common is non-distinctive.

Earlier sign	Contested sign	Case No
K2 SPORTS		31/01/2013, T-54/12, EU:T:2013:50
<p>G&S: Classes 18, 25, 28</p> <p><i>Territory:</i> Germany and the United Kingdom</p> <p><i>Assessment:</i> Contrary to the Board's finding that there is no conceptual similarity, the term 'sport', notwithstanding its descriptive character, refers to the same concept and leads to the conclusion that there is a degree of conceptual similarity. The Court concluded that this similarity was weak in the context of the overall impression of the signs and in particular of the very weak distinctive character of this term. However, the weak conceptual similarity did not offset the significant visual and phonetic differences between the signs (para. 49) — no likelihood of confusion.</p>		

6 Impact on Likelihood of Confusion of Components that are Non-Distinctive or Distinctive Only to a Low Degree

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise weak is carried out in order to calculate the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. It may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non-distinctive elements ⁽⁵¹⁾.

The Office and a number of trade mark offices of the European Union have agreed on a **Common Practice** under the European Trade Mark and Designs Network with regard to the impact on likelihood of confusion of components that are non-distinctive or distinctive only to a low degree.

6.1 Common components with a low degree of distinctiveness

According to the Common Practice ⁽⁵²⁾, when the marks share an element with a **low degree of distinctiveness**, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks, as previously assessed in the comparison of signs. That assessment takes into account the similarities/differences and distinctiveness of the non-coinciding components.

⁵¹ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

⁵² For the purposes of the Common Practice, all the other factors that may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. It is also considered that the goods and services are identical.

A coincidence in an element with a low degree of distinctiveness **will not normally on its own lead to likelihood of confusion**. However, there may be likelihood of confusion if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

No likelihood of confusion was found in the following examples.

Earlier sign	Contested sign	Case No
	TORO XL	24/05/2012, T-169/10, EU:T:2012:261
<p><i>G&S: Class 33 Alcoholic beverages</i></p> <p><i>Territory: EU</i></p> <p><i>Assessment:</i> The coinciding letters 'XL' have a low degree of distinctiveness for the goods in question. 'XL' is an abbreviation of extra-large size used within the whole EU. For the goods in question, namely <i>alcoholic beverages</i>, the public is likely to associate it with an extra quantity of a drink (paras 34, 35). The word element TORO is distinctive (para. 42).</p> <p>The marks are visually, and phonetically dissimilar (paras 46, 48) and there is only a weak conceptual similarity (para. 52). The likelihood of confusion is excluded (para. 57)</p>		



Earlier sign	Contested sign	Case No
ZITRO SPIN BINGO,		29/01/2015, T-665/13, EU:T:2015:55

G&S: Classes 9, 41, 42 in relation to *games*

Territory: EU

Assessment: The word 'bingo' is descriptive of the corresponding game of chance, the English word 'spin' alludes to a rotating object or to the action of spinning something (para. 36).

The Court confirmed the Board's finding that there was a low degree of visual, aural and conceptual similarity between the signs at issue, despite the fact that they contain the expression 'spin bingo'. Visually, the degree of similarity is low because, regarding the earlier sign, the public would pay attention to the more distinctive element 'zitro', which is devoid of any meaning in the relevant languages and is at the beginning of the sign. Concerning the contested sign, consumers will pay as much attention to the different colour elements of the device which are the circles and the reel on which there is a representation of a smiling face. Aurally, the similarity was weak as well in the light of the descriptive meaning of the expression 'spin bingo', and the fact that the public will pay attention to the more distinctive element 'zitro'. Conceptually, the word 'zitro' was dominant and was not similar to the contested sign (paras 11, 44). There is no likelihood of confusion.

Earlier sign	Contested sign	Case No
		28/07/2011, R-1946/2010-1, confirmed 20/03/2013, T-571/11, appealed, 06/02/2014, C-301/13 P

G&S: Classes 16, 21, 29, 30, 32, 33

Territory: Spain

Assessment: The conflicting signs only share the two words 'CLUB' and 'GOURMET'. However, they differ in all their other characteristics. First, the dominant and distinctive element of the earlier sign is not reproduced in the contested sign. Second, the verbal element 'CLUB GOURMET' differs from the verbal element 'CLUB DEL GOURMET': the earlier sign has fourteen letters (whilst the contested sign has eleven) and it is separated by the word 'DEL' and followed by a comma. Finally, they differ with respect to the following aspects: the number of words (seven for the earlier sign, two for the contested sign), the use of punctuation marks (',' and '...' in the earlier sign), the triangle (which is absent in the contested sign and contains no figurative element at all) and the font (which is partly stylised in the earlier sign). The common elements 'CLUB' and 'GOURMET' only have a weak distinctive character in relation to the goods and services at issue. Indeed, there exists, for the relevant consumer, a strong conceptual link between the verbal element 'CLUB DEL GOURMET' and the goods provided for by the opponent's services, which mainly consist of food and beverages. In the consumer's mind, 'GOURMET' refers to the idea of a connoisseur or lover of good food or a person with a discerning palate, that is to say, someone who appreciates good food and drink. Although it sounds and is of French origin, the meaning will be immediately grasped by the Spanish consumer (paras 39, 40).

In the following example there was a likelihood of confusion because other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar.

Earlier sign	Contested sign	Case No
		11/02/2015, T-395/12, EU:T:2015:92

Territory: United Kingdom

G&S: Class 19.

Assessment: The word element 'solid floor' of the earlier mark is only of weak distinctive character (para. 32), but the differentiating element in the contested sign, 'The professional's choice', will be perceived by the relevant public as a clearly laudatory and banal slogan with no trade mark connotations that would allow them to perceive it as a badge of origin (para. 34) and the figurative elements of the signs at issue are limited (para. 35).

There is a [average] visual similarity and a high degree of phonetic and conceptual similarity (paras 36, 38, 40).

There is a likelihood of confusion for identical and similar goods, namely *building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate; subfloors; transportable floors, not of metal.*

There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

Earlier sign	Contested sign	Case No
waterPerfect	AquaPerfect	28/01/2015, T-123/14, EU:T:2015:52
<p>G&S: Class 7</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> while the element 'Perfect' has a laudatory character, the fact remains that none of the other elements in the signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that they will be perceived by the relevant public as meaning 'water' and the goods covered all involve, in one way or another, <i>water</i> (para. 42). Visually and phonetically, the similarity of the signs at issue is not limited to the presence of the term 'perfect' within each of those two signs, since those signs also have the same length and the same number of syllables, that are identically stressed, and an almost identical sequence of vowels; based on an overall impression, the similar elements between the signs referred to prevail globally over the dissimilar elements (paras 28, 32). The signs were found visually, phonetically and conceptually similar to an average degree (paras 32-33, 40).</p>		

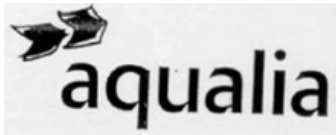
Further (invented) examples, agreed upon in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to **CP 5. Relative Grounds — Likelihood of Confusion** ⁽⁵³⁾.

6.2 Common components with no distinctiveness

According to the Common Practice, when marks share an element with **no distinctiveness**, the assessment will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.



A coincidence only in non-distinctive components **does not lead to a likelihood of confusion**. However, when marks also contain other figurative and/or word elements that are similar, there will be likelihood of confusion if the overall impression of the marks is highly similar or identical.

No likelihood of confusion was found in the following example, as the signs coincide solely in a non-distinctive element.

Earlier sign	Contested sign	Case No
		25/02/2016, T-402/14, EU:T:2016:100
<p>G&S: Classes 35, 37, 39, 40, 42</p> <p>Territory: EU</p> <p><i>Assessment:</i> The Court confirmed that the lack of distinctive character of the term 'AQUA' has to be taken into account and that the specialised relevant public will not pay much attention to the descriptive element 'AQUA', the only common element of the conflicting signs (paras 84-85). The figurative elements of the signs are totally different. They are basic but not insignificant, so they must be taken into account in the overall impression of the signs (paras 54-55). There is a low degree of visual similarity. There is a low degree of phonetic and conceptual similarity, even though the different suffixes allow the specialised public to gather a different conceptual content (paras 71-73).</p> <p>The differences between the signs are sufficient to exclude the likelihood of confusion, even for identical services and taking into account that the earlier trade mark, as a whole, has an enhanced distinctiveness (para. 86).</p>		

Likelihood of confusion was found in the following examples because the marks also contain other figurative and/or word elements that are similar, and the overall impression of the marks is highly similar or identical.

⁵³ Principles of the common practice CP 5. Relative Grounds — Likelihood of Confusion (Impact of non-distinctive/weak components) <https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>, p. 9.

Earlier sign	Contested sign	Case No
		20/07/2016, T-745/14, EU:T:2016:423
<p>G&S: Classes 36, 38</p> <p>Territory: Bulgaria</p> <p><i>Assessment:</i> The Court confirmed that the signs at issue are visually and phonetically highly similar, and conceptually identical, given that they coincide in their word elements, and despite the figurative nature of the signs at issue, the fonts used for the word elements do not make it possible to detect any particular difference between them (para. 28 <i>in fine</i>).</p>		

Earlier sign	Contested sign	Case No
BIOCERT	BIOCEF	10/12/2014 T-605/11, EU:T:2014:1050
<p>G&S: Class 5</p> <p>Territory: Austria</p> <p><i>Assessment:</i> The Court found that although the element 'BIO' is descriptive for the goods in question, the trade marks coincide not only in these three letters, but also in their fourth and fifth letters, 'c' and 'e' (para. 38).</p> <p>The difference in the last letters, 'rt' versus 'f', does not counteract the important similarity arising from the fact that the first five letters at the centre of the two signs, which are of very similar length, are identical (para. 39).</p> <p>There is an average degree of visual and phonetic similarity (paras 40, 46), whereas the conceptual comparison is neutral (para. 48)</p>		

Further (invented) examples agreed in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to CP 5. Relative Grounds — Likelihood of Confusion ⁽⁵⁴⁾.

⁵⁴ Principles of the common practice CP 5. Relative Grounds — Likelihood of Confusion (Impact of non-distinctive/weak components) <https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>, p. 10.

6.3 Distinctiveness of the earlier mark versus distinctiveness of the common component

The abovementioned examples concern the coincidence in a weakly distinctive or non-distinctive element of the marks. The distinctiveness of an element of the mark is a separate question from the assessment of the distinctiveness of the earlier mark as a whole (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2). The enhanced distinctiveness of the earlier mark does not automatically lead to an enhanced distinctiveness of the common element (e.g. 25/02/2016, T-402/14, AQUALOGY (fig.) / AQUALIA et al., EU:T:2016:100, in paragraph 6.2 above).

However, when the earlier trade mark is entirely contained in the contested EUTM application and recognisable as such, its degree of distinctiveness naturally equals that of the coinciding element, with the following consequences.

The analysis of the cases where the earlier mark is entirely contained in the contested EUTM application cannot follow the principles established in paragraph 6.2 above (Common components with no distinctiveness) but rather those established in paragraph 6.1 (Common components with a low degree of distinctiveness). This is because the Office applies the practice clarified in the judgment of 24/05/2012, C-196/11 P, F1-LIVE, EU:C:2012:314, namely that in proceedings opposing the registration of an EUTM application, the validity of earlier trade marks may not be called into question. Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.2.3.5 (Earlier marks, the distinctiveness of which is called into question)).

If the earlier mark contained in the contested EUTM application enjoys enhanced distinctiveness through use despite low inherent distinctiveness, the common element corresponding to that mark cannot be considered distinctive to a low degree and the principles of the Common Practice mentioned in paragraphs 6.1 and 6.2 above do not apply.

Earlier sign	Contested sign	Case No
MINI		23/01/2015, R 596/2014-4, confirmed 10/03/2016, T-160/15, EU:T:2016:137

G&S: Class 12

Territory: United Kingdom

Assessment: The earlier trade mark is reputed for *cars*, and accordingly, it has enhanced distinctive character in the UK. Thus, for the relevant public in the UK, the contested composite sign will be perceived as the widely-known trade mark ‘MINI’ in combination with the descriptive word ‘CARGO’. This is as a direct consequence of the earlier trade mark’s repute in the field of motor vehicles (paras 19, 25-26).

7 Specific Cases

7.1 Short signs

As indicated before, the Courts have not exactly defined what a short sign is. However, signs with three or fewer letters/numbers are considered by the Office as short signs.

The General Court held that the global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) **follows the same rules** as that in respect of word signs comprising a word, a name or an invented term (06/10/2004, T-117/03 – T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).

In the assessment of the likelihood of confusion it is important to establish the degree of **inherent distinctiveness** of the earlier trade mark, and therefore its scope of protection. See in this respect the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2.2.3.1.

As to the overall assessment of likelihood of confusion, the Court made it clear that the fact that two trade marks consisting of the same letter (or of the same sequence of letters) are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trade mark causes a **sufficiently different visual impression** that a likelihood of confusion can be safely ruled out (T-187/10, G, EU:T:2011:202, § 60).

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same single letter or a combination of letters not recognisable as a word, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element. See examples in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.4.1.6.

Where the opponent has successfully proven that its earlier mark has acquired enhanced distinctiveness through intensive use or reputation, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of an earlier mark containing or consisting of a single letter or a combination of letters cannot justify a finding of a likelihood of confusion if the overall visual impression of the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single letter or combination of letters stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

7.2 Name/Surnames

7.2.1 Names




In principle, there are no specific criteria to be taken into account when likelihood of confusion between names is assessed. However, because of the very nature of names and surnames, there are certain aspects that come into play (as will be seen below) that have to be carefully considered and balanced, such as whether a given name and/or surname is common or not in the relevant territory.

7.2.2 Business names in combination with other components

The assessment of the likelihood of confusion may be influenced by the fact that one of the signs contains several verbal elements, where one such element could be seen as a business name, that is to say, indicating a specific trade origin (typically, a company name preceded by the preposition 'by').

In such a situation, either element (i.e. the business name or the element typically indicating the mark designating the line of product) may become more relevant in the overall impression of the sign, even if it has a lower degree of distinctiveness or is visually less prominent. This is because in such a situation, both elements of the sign (i.e. the business name and the mark designating the product line) will in principle play an independent distinctive role even where the distinctiveness *per se* of one of them is lower. On account of this particular configuration of the sign the consumer will perceive the elements independently, as each indicating an aspect of the commercial origin of the goods or services designated by it (e.g. a business name and a mark designating the product line).

Consequently, if the earlier mark is identical (or highly similar) to either element (the business name or the mark designating the product line), even if it is the one that otherwise would be less relevant (e.g. due to its size or due to its lower distinctiveness), there will, in principle, be a likelihood of confusion.

Earlier sign	Contested sign	Case No
		09/04/2014, EU:T:2014:198 T-386/12,
<p>G&S: Classes 32, 38, 39</p> <p><i>Territory:</i> United Kingdom</p> <p><i>Assessment:</i> In the present case, the particular structure of the mark applied for must also be taken into account. As the Opposition Division has pointed out, the presence within the mark applied for of the preposition 'by' will lead the consumer, insofar as they understand the meaning, to think that the mark applied for consists of two brands, the sub-brand 'elite' and the main brand 'Mondariz'. As a consequence, the word 'elite' will not be perceived as a mere denomination of one of the characteristics of the goods and services it designates, but rather as an independent and distinct part of the mark in question. That element is likely to reinforce the similarity between the signs at issue, regardless of the higher or lesser intrinsic distinctiveness of the word 'elite' (para. 107) — likelihood of confusion.</p>		
RICCI		15/09/2016, EU:T:2016:490 T-358/15,
<p>G&S: Classes 3, 25, 35</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> It is also necessary to reject the applicant's argument that the dominant element of the mark applied for is 'roméo has a gun', owing to its initial position and greater size in relation to the word element 'by romano ricci'. The relevant public would not pay attention only to the first word element of the mark applied for, but would seek to supplement it, inasmuch as it gave the impression of the title of, or citation from, an artistic work. The word element 'by romano ricci' thus has the effect, as the Board of Appeal stated in paragraph 31 of the contested decision, of giving further meaning to the first word element of the earlier mark RICCI, which confers on it an independent distinctive position. Furthermore, the Office is correct in submitting that it is usual in the field of fashion as regards personal care items and high fashion clothing to refer to the designer or source of a product, using the same format as that used by the mark applied for. In that field, the designer or source of a product, in particular, is likely to play a more important role for the relevant public than for other categories of goods. Therefore, the word element 'romano ricci' is of such a nature as to be perceived as the mark of the house, while the element 'roméo has a gun' will be perceived as the sign identifying a particular line of goods or services among a wider range of goods and services offered by the applicant (para. 46) — likelihood of confusion.</p>		

7.2.3 First and family names


The perception of signs made up of personal names may vary from country to country within the European Union. Family names have, in principle, a higher intrinsic value as indicators of the origin of goods or services than first names. This is because common experience shows that the same first names may belong to a great number of people who have nothing in common, whereas the presence of the same surname (provided it is not common in the relevant territory) could imply the existence of some link between them (identity of the persons or a family link). In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding on the Office or the EU courts, may provide useful guidelines (01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, § 52).

There are instances where the applicants invoke, as a defence, their right to use their name. However, such arguments are not valid in opposition proceedings, since it does not influence the issue of whether there will be likelihood of confusion on the part of the public. Furthermore, the registration of trade marks does not hinder the use of names of natural persons, due to the special protection provided by Article 14(1)(a) EUTMR and the relevant national trade mark laws according to Article 14(1)(a) of the Trade Mark Directive.

- First name against the same first name or slight variations thereof

The rule of thumb is that when two conflicting signs consist exclusively of the same first name, consumers are likely to perceive the similar/identical goods/services marketed under those marks as coming from the same source. It is clear that in the absence of any differentiating element, **likelihood of confusion** is the necessary conclusion.

Earlier sign	Contested sign	Case No
GIORDANO	GIORDANO	16/12/2009, T-483/08, EU:T:2009:515
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> Portugal</p> <p><i>Assessment:</i> The two word marks at issue are identical, which increases the likelihood that consumers might perceive the goods marketed under those marks as coming from the same source. Moreover, the applicant has not shown that the Italian first name 'Giordano' which makes up both trade marks is common in Portugal (para. 32) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No

ELISE		24/03/2010, T-130/09, EU:T:2010:120
<p>G&S: Classes 9, 42</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The Court considers that even if it is not certain that the relevant public throughout the European Union will necessarily perceive the signs at issue as being specifically diminutives of the name 'Elizabeth', the relevant public will certainly regard them as highly similar female names derived from the same root. In certain Member States, notably the United Kingdom, Ireland, Germany and Austria, they will certainly be perceived by the relevant public as being diminutives of the full forename Elizabeth (para. 36) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
GISELA	GISELE	08/03/2011, R 1515/2010-4
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The marks compared are both variations of the female first name 'Giselle' of old German and French origin and are overall very similar, so that a likelihood of confusion exists (paras 14, 15, 20) — likelihood of confusion.</p>		

- First name against identical first name plus surname

Whenever two signs share the same first name and one of the two also contains a surname, and when the **first name** is likely to be perceived as a **common** (let alone very common) name in the relevant territory, the rule of thumb is that there will be **no likelihood of confusion**, since consumers will be aware that there are many people with that name.

Earlier sign	Contested sign	Case No
LAURA	LAURA MERCIER	25/01/2002, R 95/2000-2

G&S: Class 3

Territory: Spain

Assessment: In the Board's view, the average Spanish consumer who is familiar with the trade mark 'LAURA' for perfumes will not be confused. Conceptually, 'LAURA' will be seen as a common first name in Spain. It is highly unlikely that the average Spanish consumer would consider linking the more specific name 'LAURA MERCIER' with 'LAURA' (para. 16) — no likelihood of confusion.

An **exception** applies when a given first name is likely to be perceived as **uncommon** in the relevant territory. In such cases, the presence of this uncommon element is likely to focus the consumers' attention and they could be misled into attributing a common origin to the goods/services concerned.

Earlier sign	Contested sign	Case No
AMANDA	AMANDA SMITH	17/03/2009, R 1892/2007-2
<p>G&S: Classes 29, 30</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The term 'SMITH' in the trade mark application will be perceived by the Spanish consumers as a common Anglo-Saxon surname and will have less weight than the first name 'AMANDA' (which is less common in Spain) (para. 31) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
ROSALIA	ROSALIA DE CASTRO	05/10/2011, T-421/10, EU:T:2011:565, (appeal 03/10/2012, C-649/11 P, EU:C:2012:603, dismissed)
<p>G&S: Classes 32, 33, 35</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The signs are visually and conceptually similar, and aurally very similar. The products are identical. The services are similar. Neither the name ROSALIA nor the surname DE CASTRO is common in Spain. None of these elements has a higher distinctive character than the other (paras 50-51) — likelihood of confusion.</p>		



- First name plus surname against identical first name plus different surname

When two conflicting signs contain the same first name but are followed by clearly different surnames, the rule of thumb is that there is **no likelihood of confusion**.

Consumers will realise that they distinguish goods/services of different, unconnected undertakings.

Invented example: 'Michael Schumacher' / 'Michael Ballack' (no likelihood of confusion).

However, when the overall impression created by the signs is one of clear similarity, that is to say, the differences between the signs are lost in the overall impression created by the signs, then, applying the normal criteria, the outcome will be that there is **likelihood of confusion**.

Earlier sign	Contested sign	Case No
 (Emidio Tucci fig.)		13/12/2004, T-8/03, EU:T:2004:358, 03/10/2002, R 700/2000-4 & R 746/2000-4, confirmed 28/09/2006, C-104/05 P, EU:C:2006:611
<p>G&S: Classes 3, 18, 24, 25</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> Both marks consist of the combination of a first name and a surname and give a similar overall impression — likelihood of confusion.</p>		

- First name plus surname against different first name plus identical surname

When the conflicting signs contain the same surname preceded by different first names, the outcome will very much depend on the perception of the surname in the relevant territory. The less common a surname is, the more likely it is that it will attract the consumers' attention (regardless of whether the first names are common or not).

Earlier sign	Contested sign	Case No
ANTONIO FUSCO	ENZO FUSCO	01/03/2005, T-185/03, EU:T:2005:73
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> Italy</p> <p><i>Assessment:</i> Since it was contested that 'Fusco' was not one of the most common surnames in Italy, the Court considered that, since the Italian consumer generally attributes greater distinctiveness to the surname than the forename, it will keep in mind the (neither rare nor common) surname 'Fusco' rather than the (common) forenames 'Antonio' or 'Enzo'. Therefore, a consumer faced with goods bearing the trade mark applied for, ENZO FUSCO, might confuse it with the earlier trade mark, ANTONIO FUSCO, so that there is a likelihood of confusion (paras 53, 67) — likelihood of confusion.</p>		

In contrast, when two marks have the same surname and this is likely to be perceived as common (let alone very common) in the relevant territory, consumers will not normally be misled into attributing a common origin to the goods/services concerned (01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 82-83; 24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 36). Consumers are used to trade marks that contain common surnames and will not blindly assume that every time a common surname occurs in two conflicting signs the goods/services in question all emanate from the same source.

Earlier sign	Contested sign	Case No
VITTORIO ROSSI	CHRISTIAN ROSSI	15/09/2010, R 547/2010-2
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Not only are consumers throughout the EU aware of the fact that people share the same surname without being necessarily related, but they will also be able to distinguish the Italian surname 'ROSSI' bearing two different first names in the fashion field (paras 33-35) — no likelihood of confusion.</p>		

- First name plus surname against different first name plus identical surname conjoined in a single word

In cases where one of the conflicting signs consists of a name and surname and the other of a single word that will, however, be broken down into separate components by at least part of the relevant public, due to the recognisable presence of a name and surname combined to form the one word making up that sign, the result will be one of likelihood of confusion whenever the overall impression created by the marks is one of similarity.

Earlier sign	Contested sign	Case No
PETER STORM	Peerstorm	08/07/2010, T-30/09, EU:T:2010:298
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Both of the marks at issue are made up of a first name and a surname. It is common ground that the element 'storm' in the two marks at issue can be a surname. The elements 'peer' and 'peter' in the mark applied for and the earlier mark respectively are first names. In particular in the Nordic countries and in Germany, Peer is a first name. The fact that the mark applied for is written as one word cannot cast doubt on the finding that the two marks at issue are made up of a first name and a surname (para. 66) — likelihood of confusion.</p>		

- Surname against first name plus identical surname

When two signs contain the same surname but only one of them also contains a given first name, the rule of thumb is that normally there will be a **likelihood of confusion**. Consumers might be misled and attribute a common origin to the goods/services concerned. The presence of a first name in one of the conflicting signs will not suffice to safely distinguish the signs in the minds of the consumers. The surname alone will be perceived as the short version of the full name, thus identifying the same origin.

Earlier sign	Contested sign	Case No	
MURÚA		13/07/2005, T-40/03, EU:T:2005:285	
<p>G&S: Class 33</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is quite likely that the relevant public will regard the addition, in the trade mark applied for, of the first name 'Julián' and the surname 'Entrena' merely as a way of distinguishing a range of wines produced by the undertaking that owns the earlier trade mark or, at least, an undertaking economically linked to the intervener (paras 42, 78) — likelihood of confusion.</p>			
Earlier signs	Contested sign	Case No	
BRADLEY	VERA BRADLEY	01/09/2011, R 1918/2010-1	

G&S: Class 11

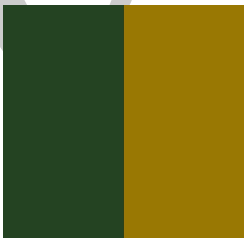

Territory: EU

Assessment: The sign for which the EUTM applied for seeks protection consists of the term 'Vera Bradley', which will most probably be seen as the name (forename and family name) of a person, fictitious or real. It is composed of the first name 'VERA', which is a common name for women in many EU countries such as, e.g. the Czech Republic, Germany, Ireland, the Netherlands, Austria, Slovenia and the United Kingdom, and the surname 'BRADLEY', which is an English family name. The latter surname is not a common family name, neither in English-speaking countries nor in any other countries within the European Union. Even if consumers might be able to distinguish between the signs due to the element 'Vera', which has no counterpart in the earlier trade mark, they will see a specific line of products or an extended form of the mark. Consequently, consumers might believe that the trade marks belong to the same undertakings or economically linked undertakings (paras 36-37, 52) —likelihood of confusion.

7.3 Colour marks per se

When the likelihood of confusion of two colour marks per se is assessed, a phonetic or conceptual comparison of the signs cannot be made and the visual similarities will depend on the colour of the signs.

In the overall assessment, the Office takes into account the fact that there is a 'public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought' (24/06/2004, C-49/02 Blau/Gelb, EU:C:2004:384, § 41; 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 52-56). The inherent distinctiveness of colour marks per se is limited. The scope of protection should be limited to identical or almost identical colour combinations.

Earlier sign	Contested sign	Case No
		20/10/2010, R 755/2009-4

G&S: Class 8

Territory: EU

Assessment: In the case at hand, the colour combinations, identified by different colour codes, are not sufficiently close to lead to a likelihood of confusion, taking into account that the inherent distinctiveness is limited (para. 18). The BoA referred to CJEU judgments and public interest in ensuring that colours remain available to competitors (para. 19). The opponent did not prove enhanced distinctive character (para. 25) — no likelihood of confusion.

7.4 Earlier collective and certification marks

As set out in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 1, General Principles the ‘essential function’ of **individual** trade marks is to indicate commercial origin and the concept of ‘likelihood of confusion’ relates to detriment to this essential function (18/06/2009, C-487/07, L’Oréal, EU:C:2009:378, § 58-59). The vast majority of cases where a likelihood of confusion is alleged relate to confusion regarding the commercial origin of goods or services covered by conflicting individual marks, that is, the particular undertaking they come from.

This is not so when the **earlier mark** is a **collective** or a **certification** mark.

The assessment of the likelihood of confusion in the latter cases must be made bearing in mind the different essential functions specific to those marks and will consist in assessing whether the contested mark (individual, collective or certification) causes detriment to that essential function, that is:

- for earlier collective marks, the risk that the public might believe that the goods or services covered by the earlier trade mark and those covered by the trade mark applied for all originate from members of the association that is the proprietor of the earlier trade mark or, where appropriate, from undertakings economically linked to those members or to that association (05/03/2020, C-766/18 P, BBQLOUMI (fig.) / HALLOUMI, EU:C:2020:170, § 71).
- for earlier certification marks, the risk that the public might believe that the goods and services covered by the contested mark are certified by the proprietor of the earlier certification mark in respect of a characteristic denoted by that mark.

However, when the **contested** mark is a **collective** or **certification** mark, and the opposition is based on an individual mark, the usual assessment of the likelihood of confusion must be carried out (i.e. whether the public will think that the goods or services covered by the contested mark and by the earlier mark have the same commercial origin or that of economically linked undertakings).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 3

Unauthorised filing by agents of the TM proprietor (Article 8(3) EUTMR)

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1 Preliminary Remarks

According to Article 8(3) EUTMR, upon opposition by the proprietor of an earlier trade mark, a trade mark will not be registered:

where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

1.1 Origin of Article 8(3) EUTMR

Article 8(3) EUTMR has its origin in Article 6*septies* of the Paris Convention (PC), which was introduced into the convention by the Revision Conference of Lisbon in 1958. The protection it affords to trade mark proprietors consists of the right to prevent, cancel, or claim as their own unauthorised registrations of their marks by their agents or representatives, and to prohibit use thereof, where the agent or representative cannot justify its acts. Article 6*septies* PC reads as follows:

(1) If the agent or representative of the person who is the proprietor of the mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for, or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

Article 8(3) EUTMR implements this provision only to the extent it gives the rightful proprietor the right to oppose applications filed without its authorisation. The other elements of Article 6*septies* PC are implemented by Articles 13, 21 and Article 60(1)(b) EUTMR. Article 60(1)(b) EUTMR gives the proprietor the right to cancel unauthorised registrations, whereas Articles 13 and 21 EUTMR enable the proprietor to prohibit the use thereof and/or to request the transfer of the registration to its own name.

Since Article 46 EUTMR provides that an opposition may only be based on the grounds provided for in Article 8 EUTMR, the additional rights conferred on the proprietor by the above provisions may not be invoked in opposition proceedings. Hence, any request by the opponent, either for the prohibition of use of the agent's mark, or for an assignment of the application to itself, will be dismissed as inadmissible.

In view of the specific subject matter for protection under Article 8(3) EUTMR, while the use or lack of use made of the earlier rights may have a bearing on arguments regarding the justification for applying for the EUTM, the opponent cannot be obliged to

provide proof of use under Article 47(3) EUTMR for any earlier rights thereby relied upon (see the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 1.2.1.2). This practice of the Office is also justified by the fact that Article 47(2) and (3) EUTMR refer to the 'earlier mark' in the meaning of Article 8(2) EUTMR, which does not apply to Article 8(3) EUTMR.

1.2 Purpose of Article 8(3) EUTMR

The unauthorised filing of the proprietor's trade mark by its agent or representative is contrary to the general obligation of trust underlying commercial cooperation agreements of this type. Such a misappropriation of the proprietor's mark is particularly harmful to its commercial interests, as the applicant may exploit the knowledge and experience acquired during its business relationship with the proprietor and, thus, improperly benefit from the proprietor's effort and investment (06/09/2006, T-6/05, First Defense Aerosol Pepper Projector, EU:T:2006:241, § 38; 19/05/2011, R 85/2010-4, LINGHAMS'S (fig.) / LINGHAMS'S (fig.), § 14; 03/08/2010, R 1231/2009-2, BERIK (fig.) / BERIK et al., § 24; 30/09/2009, R 1547/2006-4, POWERBALL / POWERBALL, § 17).

Therefore, the purpose of Article 8(3) EUTMR is to safeguard the legitimate interests of trade mark proprietors against the arbitrary appropriation of their trade marks, by granting them the right to prohibit registrations by agents or representatives that are applied for without their consent.

Article 8(3) EUTMR is a manifestation of the principle that commercial transactions must be conducted in good faith. Article 59(1)(b) EUTMR, which allows for the declaration of invalidity of an EUTM on the ground that the applicant was acting in bad faith, is the general expression of this principle.

However, the protection granted by Article 8(3) EUTMR is narrower than that afforded by Article 59(1)(b) EUTMR, because the applicability of Article 8(3) EUTMR is subject to the fulfilment of a number of additional conditions laid down in this provision.

2 Entitlement of the Opponent

According to Article 46(1)(b) EUTMR, the right to file an opposition on the grounds of Article 8(3) EUTMR is reserved only for the proprietors of earlier trade marks. This is in contrast both to Article 46(1)(a) EUTMR, which stipulates that oppositions based on Articles 8(1) or (5) EUTMR may also be filed by authorised licensees, and to Article 46(1)(c) EUTMR, which stipulates that for oppositions based on Article 8(4) EUTMR, the right to file an opposition is also extended to persons authorised by national law to exercise the relevant rights.

It follows that since the right to oppose an EUTM application on the grounds of Article 8(3) EUTMR belongs exclusively to the proprietors of earlier trade marks, oppositions filed in the name of third persons, be they licensees or otherwise

authorised by the relevant national laws, will be dismissed as inadmissible due to lack of entitlement.

Case No	Comment
30/09/2009, R 1547/2006-4, POWERBALL / POWERBALL (confirmed 16/11/2011, T-484/09, Powerball)	The Board confirmed the OD decision rejecting the opposition based on Article 8(3) EUTMR to the extent that the opponent was not the proprietor of the earlier right but merely claimed to be the licensee of the company Nanosecond Technology Co. Ltd.
Case No	Comment
14/06/2010, R 1795/2008-4, ZAPPER-CLICK (on appeal, 03/10/2012, T-360/10, ZAPPER-CLICK, EU:T:2012:517)	The respondent failed to meet the requirement regarding ownership of the trade mark, namely of the ownership of the registered mark ZAPPER-CLICK. On appeal, the Court did not address this point.

Likewise, if the opponent fails to prove that it was the rightful proprietor of the mark when the opposition was filed, the opposition will be dismissed without any examination of its merits due to lack of substantiation. The evidence required in each case will depend on the kind of right relied upon. The current proprietor may also invoke the rights of its predecessor in title if the agency/representation agreement was concluded between the previous proprietor and the applicant, but this needs to be duly substantiated by evidence.

3 Scope of Application

3.1 Kinds of mark covered

Article 8(3) EUTMR applies to earlier 'trade marks' that have been applied for as EUTMs without their proprietor's consent. However, Article 8(2) EUTMR does not apply to oppositions based on this ground, as it only enumerates the kinds of earlier rights on which an opposition may be entered under paragraphs (1) and (5) of the same article. Therefore, the kinds of rights on which an opposition based on Article 8(3) EUTMR may be entered needs to be determined in more detail, both as regards their nature and their geographical origin.

In the absence of any restriction in Article 8(3) EUTMR and in view of the need to provide the legitimate interests of the real proprietor with effective protection, the term 'trade marks' should be interpreted broadly and must be understood as including

pending applications, since there is nothing in this provision restricting its scope exclusively to registered trade marks.

For the same reasons, **unregistered marks or well-known marks** within the meaning of Article 6*bis* PC also fall within the term ‘trade marks’ within the sense of Article 8(3) EUTMR. Consequently, both registered and unregistered trade marks are covered by this provision, to the extent that the law of the country of origin recognises rights of the latter kind.

In contrast, the express reference to ‘trade marks’ means that Article 8(3) EUTMR **does not apply to mere signs used in the course of trade**, other than unregistered trade marks. Likewise, **other kinds of intellectual property rights** that could be used as a basis for an invalidity action cannot be invoked in the context of Article 8(3) EUTMR either.

Case No	Comment
08/06/2010 B 1 461 948, Quick Effect Plaster Gu Tong Tie Gao (fig.)	As Article 8(3) EUTMR refers only to earlier trade marks, the evidence filed by the opponent with regard to rights in respect of copyright law in the territory of China was not relevant. This is another kind of intellectual property right that is excluded as a result of the express reference in the article to ‘trade marks’.

It is clear from the wording of Article 8(3) EUTMR that the trade mark on which the opposition is based must be **earlier** than the EUTM application. Hence, the **relevant point in time** that should be taken into account is the **filing or priority date** of the contested application. The rules according to which the priority should be determined depend on the kind of trade mark relied upon. If the earlier mark has been acquired by registration, it is its filing or priority date that should be taken into account for assessing whether it precedes the contested EUTM application, whereas if it is a use-based right, the relevant conditions for protection through use must have been fulfilled before the filing date (or if appropriate, the priority date) of the contested EUTM application. In the case of earlier well-known marks, the mark must have become well known before the filing or priority date of the contested EUTM application.

Case No	Comment
21/12/2009, R 1621/2006-4, D-Raintank	The Board noted that the trade mark applications filed by the cancellation applicant in 2003 were all later than the filing date of the contested EUTM and even later than its date of registration, and could not serve to establish that the cancellation applicant owned a 'mark' in the sense of a registered mark, be it anywhere in the world, for the sign at issue when the EUTM was filed. It went on to affirm that, 'Obviously, nobody can base a claim on relative grounds for refusal or declaration of invalidity on rights which are younger than the contested EUTM' (para. 53).
19/06/1999, B 3 436, NORAXON	The period to be taken into account in order to determine the applicability of Article 8(3) EUTMR starts on the date on which the EUTM application in question came into force, i.e. 26/10/1995. This was the priority date in Germany, claimed by the applicant, granted by the Office and subsequently published, and not the filing date of the EUTM application at the Office.

3.2 Origin of the earlier mark

As Article 8(2) EUTMR does not apply to oppositions based on Article 8(3) EUTMR, it cannot serve to define the territorial extent of protection granted by Article 8(3) EUTMR. In the absence of any other reference in Article 8(3) EUTMR to a 'relevant territory', it is **immaterial whether the earlier trade mark rights reside in the European Union or not**.

The practical importance of this provision lies precisely in the legal capacity it confers on holders of trade mark rights **outside the European Union** to defend these rights against fraudulent filings, since proprietors of trade mark rights within the European Union may rely on the other grounds provided for in Article 8 EUTMR to defend their earlier rights from such acts. Of course, EUTMs or national marks, which provide a basis for opposition pursuant to Article 8 EUTMR, also qualify as earlier marks that can be invoked as a basis for an Article 8(3) EUTMR opposition.

Case No	Comment
19/12/2006, B 715 146, Squirt	‘For the purpose of Article 8(3) EUTMR, it is immaterial where in the world the rights of proprietorship reside. Indeed, if in the Paris Convention the proprietorship in a Paris Union member country is required, in the absence of any reference in the EUTMR to any territory in which such proprietorship shall exist, one must conclude that it is sufficient that the opponent complies with the requirements of Article 5 EUTMR concerning “Persons who can be proprietors of European Union trade marks”. In the present case, the opponent complied with such a requirement, as it was a company based in the United States of America.’
10/01/2011, 3 253 C, MUSASHI (fig.)	The fact that the earlier registrations were from non-EU countries has no bearing on the invalidity ground at issue, since Article 8(2) EUTMR, imposing this territorial condition, does not apply to proceedings based on Article 8(3) EUTMR and cannot serve to define the territorial extent of protection granted by that article. ‘In the absence of any reference to a “relevant territory” in Article 8(3) EUTMR, the Cancellation Division must presume that earlier trade marks registered in countries outside the EU may constitute the basis for an invalidity request based on Article 8(3) EUTMR (para. 33).’
26/01/2012, R 1956/2010-1, HEATSTRIP / HEATSTRIP (confirmed 09/07/2014, T-184/12)	The opposition was based on an unregistered mark protected, inter alia, in Australia. The Board considered that the evidence submitted by the opponent supports that it has been using the mark in Australia to a substantial extent (paras 3 and 34 respectively).
19/05/2011, R 85/2010-4, LINGHAMS’S (fig.) / LINGHAMS’S (fig.)	The opposition was based on a registered mark protected in Malaysia. By filing the Malaysian registration certificate, it was proven that the opponent is the owner of the Malaysian trade mark.

4 Conditions of Application

Article 8(3) EUTMR entitles trade mark proprietors to oppose the registration of their marks as EUTMs, provided the following substantive cumulative requirements are met (13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 61).

1. The applicant is or was an agent or representative of the proprietor of the mark.
2. The application is in the name of the agent or representative.
3. The application was filed without the proprietor's consent.
4. The agent or representative fails to justify its acts.
5. The signs and the goods and services are identical or closely related.

4.1 Agent or representative relationship

4.1.1 Nature of the relationship

In view of the purpose of this provision, which is to safeguard the legal interests of trade mark proprietors against the misappropriation of their trade marks by their commercial associates, the terms 'agent' and 'representative' should be **interpreted broadly** to cover all kinds of relationships based on any business arrangement (governed by a written or oral contract) where one party is representing the interests of another, regardless of the *nomen juris* of the contractual relationship between the principal-proprietor and the EUTM applicant (confirmed 13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 64).

Therefore, it is sufficient for the purposes of Article 8(3) EUTMR that there is some agreement of commercial cooperation between the parties of a kind that gives rise to a **fiduciary relationship** by imposing on the applicant, whether expressly or implicitly, a general duty of **trust and loyalty** as regards the interests of the trade mark proprietor. It follows that Article 8(3) EUTMR may also extend, for example, to licensees of the proprietor, or to authorised distributors of the goods for which the mark in question is used.

Case No	Comment
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09/07/2014, T-184/12, Heatstrip	The Court concluded that, although there was no written cooperation agreement between the parties, their relationship on the date of the application for the EUTM was, in view of the business correspondence between them, more than that of merely buyer and seller. There was, rather, a tacit cooperation agreement that led to a fiduciary obligation on the part of the EUTM applicant (para. 67).
21/11/2014, R 1958/2013-1, СЛОБОДА (fig.)	The Board found that the contents of the exchanged information lead to the conclusion that 'the CTM proprietor was, in effect, acting as an agent or distributor of the invalidity applicant. Even if the relationship was not explicitly defined as such, the parties appeared to be business partners, which would require a certain level of trust. The CTM proprietor was regularly reporting and consulting the marketing strategy with the invalidity applicant, which on its part, allowed a certain level of control, to the CTM proprietor (para. 46).'
29/02/2012, B 1 818 791, HoverCam (fig.)	The Opposition Division found that the evidence submitted by the opponent showed that the relationship and its ultimate purpose constituted an example of commercial cooperation, through which a general duty of trust and loyalty was imposed on the applicant and was the type of relationship envisioned under Article 8(3) EUTMR (para. 5).

Given the variety of forms that commercial relationships may acquire in practice, a **case-by-case approach** is applied, focusing on whether the contractual link between the proprietor-opponent and the applicant is only limited to a series of occasional transactions, or if, conversely, it is of such a duration and content to justify the application of Article 8(3) EUTMR (as regards the points in time that are crucial for the relationship, see, paragraph 4.1.4 below). The material question should be whether it was the cooperation with the proprietor that gave the applicant the possibility to get to know and appreciate the value of the mark and incited the applicant to subsequently try to register the mark in its own name.

Nevertheless, some kind of cooperation agreement has to exist between the parties. If the applicant acts completely **independently**, without having entered into any kind of fiduciary relationship with the proprietor, it cannot be considered an agent within the meaning of Article 8(3) EUTMR (confirmed 13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 64).

Case No	Comment
16/06/2011, 4 103 C, RETROFIT	The Cancellation Division found that rather than an agent or representative relationship, at the time of filing the EUTM, the parties held parallel and independent rights to the marks in the USA and Japan. For these reasons, Article 8(3) EUTMR was not applicable.

Case No	Comment
17/03/2000, B 26 759, EAST SIDE MARIO'S	A mere desire to establish a commercial relationship with the opponent cannot be considered as a concluded agreement between the parties regarding the use of the contested trade mark.

Therefore, **a mere customer or a client** of the proprietor cannot amount to an 'agent or representative' for the purposes of Article 8(3) EUTMR, since such persons are under no special obligation of trust to the trade mark proprietor.

Case No	Comment
13/04/2011, T-262/09, First Defense Aerosol Pepper Projector	The opponent did not submit any evidence showing the existence of an agent-principal relationship with the applicant. The opponent provided invoices and order forms addressed to itself, on the basis of which the existence of a business agreement between the parties could, in other circumstances, be assumed. However, in the present case, the General Court concluded that the evidence does not show that the applicant acted on behalf of the opponent, but merely that there was a seller-customer relationship that could have been established without a prior agreement between them. Such a relationship is not sufficient for Article 8(3) EUTMR to be applicable (para. 67).

Case No	Comment
26/06/2009, B 955 528, Iber Fusion (fig.)	The Office considered that the evidence on the kind of commercial link between the opponent and the applicant was inconclusive, that is, it could not be established whether the applicant was really an agent or representative or a mere purchaser of the opponent's goods. Accordingly, the Office was unable to hold that Article 8(3) EUTMR applied.

It is irrelevant for the purposes of Article 8(3) EUTMR whether an **exclusive** agreement exists between the parties, or just a simple, non-exclusive commercial relationship. Indeed, a commercial cooperation agreement entailing an obligation of loyalty can exist even in the absence of an exclusivity clause (09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 69).

Article 8(3) EUTMR also applies to **analogous** forms of business relationships that give rise to an obligation of trust and confidentiality between the trade mark proprietor and the professional, as is the case with legal practitioners and attorneys, consultants, trade mark agents, etc. However, the legal representative or manager of the opponent's company cannot be considered as an agent or representative within the meaning of Article 8(3) EUTMR, given that such persons are not business associates of the opponent. The purpose of this provision is not to protect the proprietor from infringing acts coming from within its company. It may well be that such acts can be sanctioned under the general bad faith provision in Article 59(1)(b) EUTMR.

Case No	Comment
20/03/2000, B 126 633, Harpoon (fig.)	In this case, the applicant was a legal representative of the opponent's company. The opposition was rejected.

The **burden of proof** regarding the existence of a cooperation relationship lies with the opponent (13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 64, 67).

4.1.2 Form of the agreement

It is not necessary for the agreement between the parties to assume the form of a written contract. Of course, the existence of a formal agreement between the parties will be of great value in determining exactly what kind of relationship exists between them. As mentioned above, the title of such an agreement and the terminology chosen by the parties should not be taken as conclusive. What counts is the kind of commercial cooperation established in substance and not its formal description.

Even in cases where a written contract does not exist, it may still be possible to infer the existence of a commercial agreement of the kind required by Article 8(3) EUTMR by reference to indirect indications and evidence, such as the commercial correspondence between the parties, invoices and purchase orders for goods sold to the agent, or credit notes and other banking instruments (always bearing in mind that a mere customer relationship is insufficient for Article 8(3) EUTMR). Even dispute resolution agreements may be relevant to the extent that they give sufficient information about the past relationship between the parties.

Case No	Comment
07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	The Opposition Division was correct to conclude that there was an agency relationship between the applicant and the opponents, on the basis of correspondence indicating that the two parties had a long and close commercial relationship. The applicant company acted as a distributor of the opponents' goods (para. 18).

Furthermore, circumstances such as sales targets imposed on the applicant, or payment of royalties, or production of the goods covered by the mark under licence or help in the setting up of a local distribution network, will be strong indications of a commercial relationship of the type covered by Article 8(3) EUTMR.

The Court also decided that active cooperation between an EUTM applicant and an opponent in the advertising of the product, in order to optimise the marketing thereof, could give rise to the fiduciary relationship required under Article 8(3) EUTMR.

Case No	Comment
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<p>26/01/2012, R 1956/2010-1, HEATSTRIP / HEATSTRIP (confirmed 09/07/2014, T-184/12)</p>	<p>The Court confirmed the findings of the Board, who considered that a binding contractual relationship could be established by means of business letters exchanged by the parties, including by email. The Board examined the email correspondence between the parties to determine what each party asked from the other (para. 50). The Board concluded that the emails showed that both parties were actively cooperating in the promotion of the product, by advertising it in brochures and exhibiting it at a fair, in order to create the best conditions for its successful marketing: the opponent supplied the material for these purposes and the applicant adapted it to the German market (para. 54). The Board thus concluded that the email correspondence denoted an agreement of commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship (para. 56). The Court dismissed the applicant's arguments that there was no cooperation between the parties (because the applicant was not integrated in the opponent's sales structure, was not subject to a no-competition clause and had to bear the costs of sale and promotion) and confirmed the Board's decision (para. 67 et seq.).</p>
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However, the mere desire of the applicant to enter into a commercial relationship with the opponent cannot be considered as a concluded agreement between the parties. Prospective agents or representatives are not covered by Article 8(3) EUTMR (see B 26 759 cited above).

4.1.3 Territorial scope of the agreement

Even though the wording of Article 8(3) EUTMR does not refer to the territorial scope of the agreement between the trade mark proprietor and its agent or representative, **an inherent limitation to relationships covering the EU or a part thereof must be read in this provision.**

This is more in line with the economic considerations underlying Article 8(3) EUTMR, which are to prevent agents or representatives from unduly exploiting a commercial relationship covering a given territory, by filing an unauthorised application for the principal's mark precisely in that territory, that is, in the territory where the applicant will be more able to benefit from the infrastructure and know-how it possesses as a result of its prior relationship with the proprietor. Therefore, as the filing prohibited by

Article 8(3) EUTMR is an application for the acquisition of trade mark rights in the EU, the agreement must also concern the same territory.

Hence, a purposive interpretation must be followed in this regard, according to which Article 8(3) EUTMR only applies to agreements that cover the territory of the EU, whether in whole or in part. In practice, this means that worldwide or pan-European agreements are covered by this provision, as are agreements extending to one or more Member States, or only covering part of their territory, irrespective of whether they also include third territories. Conversely, agreements exclusively applying to third territories are not covered.

4.1.4 Relevant points in time

The agent-representative relationship must have been established **prior to the filing date** of the EUTM application. Therefore, it is immaterial whether after that time the applicant entered negotiations with the opponent, or made unilateral proposals with the purpose of becoming a representative or agent of the latter.

Case No	Comment
19/05/2011, R 85/2010-4, LINGHAMS'S (fig.) / LINGHAMS'S (fig.)	The opponent granted the applicant a special power of attorney (PoA), consenting to the applicant's filing of trade mark applications. Subsequent to this PoA, the applicant filed an EUTM. After the filing, the opponent revoked the PoA and filed the opposition. The Board considered that the relevant point in time is the filing date. At that moment, the owner's consent was present. The revocation had effects <i>ex nunc</i> (and does not affect the validity of actions performed under the PoA) and not <i>ex tunc</i> (as if the PoA had never existed) (para. 24).
06/09/2006, T-6/05, First Defense Aerosol Pepper Projector	The Board of Appeal ought to have examined whether, on the day of the application for registration of the mark, the intervener was still bound by the consent (para. 50).

However, even if the agreement between the parties was formally concluded **after the filing date** of the application, it may still be possible to deduce from the evidence that the parties were already in some form of commercial cooperation before the signature of the relevant contract and that the applicant was already acting as the opponent's agent, representative, distributor or licensee.

However, the agreement between the parties **does not have to be still in force technically** when the application is filed. The reference to a filing made by an 'agent or

representative' should not be understood as a formal requirement that must be present at the time the EUTM application is filed. Article 8(3) EUTMR also applies to **agreements that expired before the filing date of the EUTM application**, provided that the time that has lapsed is of such duration that it can be reasonably assumed that the obligation of trust and confidentiality was still present when the EUTM application was filed (confirmed 13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 65).

Article 8(3) EUTMR and Article 6*septies* PC do not protect a trade mark proprietor that is careless and makes no efforts to secure trade mark protection on its own. Post-contractual fiduciary obligations mean that none of the parties may use the termination of an agreement as a pretext for getting rid of its obligations, for example, by terminating an agreement and immediately afterwards filing a trade mark. The rationale of Article 8(3) EUTMR and Article 6*septies* PC is to prevent a situation where a representative in country A of a principal who owns trade marks in country B, and who is meant to market the trade-marked goods and observe the interests of the latter in country A, uses the filing of a trade mark application in country A as a weapon against the principal, for example to force the principal to continue with the representative and to prevent the principal from entering the market in country A. This rationale likewise applies if an agreement exists but the representative terminates it to take advantage and file a trade mark for the same reasons. However, this does not create absolute rights for the principal to obtain trade mark protection in other countries. The mere fact that the principal holds a trade mark in country B does not give the principal an absolute right to obtain trade marks in all other countries; the trade marks registered in different countries are in principle independent from each other and may have different proprietors, in accordance with Article 6(3) PC. Article 6*septies* PC is an exception to this principle and only to the extent that the contractual or de facto obligations of the parties involved justify this. Only to that extent is it justified that the ensuing EUTM would 'belong' to the principal under Article 21 EUTMR (19/11/2007, R 73/2006-4, PORTER (fig.) / PORTER (fig.) et al., § 26).

This should be assessed on a case-by-case basis, and the decisive factor should be whether it is still possible for the applicant to take commercial advantage of its expired relationship with the trade mark proprietor by exploiting the know-how and contacts it acquired because of its position.

Case No	Comment
19/11/2007, R 73/2006-4	The contested application was not filed during the validity of the agreements between Gallant (owner of shares in Porter, the applicant) and Yoshida (opponent) which allowed Gallant to file an EUTM, but nearly 1 year after the termination of the last agreement (para. 25). The Board noted that post-termination fiduciary obligations are not meant to last forever but for a certain transitional period after the termination of the agreement in which the parties may redefine their commercial strategies and concluded, inter alia, that any post-contractual relationship between Yoshida and Gallant was phased out at the time of the filing of the EUTM (para. 27).
21/02/2002, B 167 926, AZONIC	In this case, it was considered that less than 3 months after the expiry of a contract relationship such as a licence agreement, the fiduciary relationship between the parties still exists imposing on the applicant a duty of loyalty and confidence.

4.2 Application in the agent's name

According to Article 8(3) EUTMR, the trade mark applied for will not be registered where the agent or representative applies for registration thereof in its own name. It will usually be easy to assess whether this requirement has been fulfilled, by comparing the name of the applicant with that of the person appearing in the evidence as the agent or representative of the proprietor.

However, there may be cases where the agent or representative will try to **circumvent** this provision by arranging for the application to be filed by a third person, whom it either controls, or with whom it has entered into some form of understanding to that effect. In such cases adopting a more flexible approach is justified. Therefore, if it is clear that because of the nature of the relationship between the person filing the application and the agent, the situation is effectively the same as if the application had been filed by the agent personally, it is still possible to apply Article 8(3) EUTMR, notwithstanding the apparent discrepancy between the applicant's name and the name of the proprietor's agent.

Such a case could arise if the application is filed not in the name of the agent's company, but in the name of a natural person that **shares the same economic**

interests as the agent, as for example its president, vice-president or legal representative. Given that in this case the agent or representative could still benefit from such a filing, it should be considered that the natural person is bound by the same limitations as the company.

Case No	Comment
21/02/2002, B 167 926, AZONIC	The Opposition Division considered that, even though the EUTM application was applied for in the name of the natural person Mr Costahau de instead of directly in the name of the legal person STYLE'N USA, INC., the situation was effectively the same as if it had been filed in the name of the legal person.
28/05/2003, B 413 890, CELLFOOD	If it is clear that because of the nature of the relationship between the person filing the application and the agent, the situation is effectively the same as if the application had been filed by the agent personally, it is still possible to apply Article 8(3) EUTMR, notwithstanding the apparent discrepancy between the applicant's name and the name of the owner's agent.

Moreover, if the person filing the contested application had also **signed the agency agreement** on behalf of the company, this would have to be considered a strong argument in favour of the application of Article 8(3) EUTMR, since in such a case the applicant cannot possibly deny direct knowledge of the relevant prohibitions. Similarly, if an agency agreement contained a **clause** holding the management of the company personally responsible for the observance of the contractual obligations undertaken by the agent, this would also have to be considered a further indication that the filing of the application is covered by the prohibition of Article 8(3) EUTMR.

Case No	Comment
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<p>21/02/2002, B 167 926, AZONIC</p>	<p>Bearing in mind the position of the authorised representative of the licensee company, the Office considered that despite the fact that the EUTM application was made in the name of this natural person, the situation was effectively the same as if it had been filed by the legal person, that is, the licensee company. The EUTM application in the name of the former could have a direct effect on the latter due to their professional relationship, and, furthermore, the president or vice-president of a company should be considered obliged by the same limitations as their company, or at least temporarily obliged in the case of the expiry of their professional relationship.</p> <p>This position is strengthened by the fact that in the present case there is a clause in the renewed agreement that establishes the licensor's immediate termination right in the case that '... control of STYLE'N (the licensee) is transferred and the management thereby changed', which shows that the management of the licensee company was also bound by the terms of the agreement.</p>
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A similar case arises where the agent or the representative and the applicant are distinct legal entities, but the evidence shows that they are **controlled, managed or run** by the same natural person. For the reasons given above it is appropriate to 'lift the corporate veil' and apply Article 8(3) EUTMR also to these cases.

4.3 Application without the proprietor's consent

Even though the absence of the proprietor's consent is a **necessary condition** for the application of Article 8(3) EUTMR, the **opponent does not have to submit evidence that shows that the agent was not permitted** to file the EUTM application. A mere **statement** that the filing was made without its consent is generally **sufficient**. This is because the opponent cannot be expected to prove a 'negative' fact, such as the **absence** of consent. In these cases the **burden of proof is reversed** and it is up to the applicant to prove that the filing was authorised, or to give some other justification for its acts.

In view of the need to provide effective protection to the legitimate proprietor from unauthorised acts of its agents, the application of Article 8(3) EUTMR should be denied only where the proprietor's consent is sufficiently **clear, specific** and **unconditional** (06/09/2006, T-6/05, First Defense Aerosol Pepper Projector, EU:T:2006:241, § 40).

Therefore, even if the proprietor has expressly authorised the filing of the EUTM application, its consent cannot be considered sufficiently clear if it has not also explicitly specified that the application may be in the name of the agent.

Case No	Comment
07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	'In view of its serious effect in extinguishing the exclusive rights of the proprietors of the trade marks in issue in the main proceedings (rights which enable them to control the initial marketing in the EEA), consent must be so expressed that an intention to renounce those rights is unequivocally demonstrated' (para. 18).

Likewise, even if the proprietor has expressly authorised the filing of an EUTM application, its consent cannot be considered sufficiently specific for the purposes of Article 8(3) EUTMR if there is no indication of the specific signs for which the applicant has permission to file as an EUTM.

It will be generally easier to assess whether the filing was authorised by the proprietor where the conditions under which an agent or representative may apply for an EUTM application are adequately regulated by **contract**, or are given by other kinds of **direct evidence** (letters, written representations, etc.). In most cases, such evidence will be sufficient to demonstrate whether the proprietor has given its express consent, or if the applicant has exceeded the limits of its authorisation.

In other cases, a contract will either not exist or it will be inadequate on the subject. Although the wording of Article 8(3) EUTMR is in principle broad enough to include cases of **tacit or implied consent**, such consent should only be inferred if the evidence is sufficiently clear as to the intentions of the proprietor. If the **evidence is completely silent** as to the existence of an express or implied authorisation, **lack of consent should be generally presumed**.

Notwithstanding **indirect indications** and evidence pointing to implied consent, any **ambiguity or doubt** should be **interpreted in favour of the opponent**, as it will usually be quite difficult to assess whether such consent is sufficiently clear and unequivocal.

For example, the mere fact that the proprietor tolerated unauthorised applications in the name of the agent in third jurisdictions cannot alone create legitimate expectations on the part of the applicant that the proprietor will not object to the filing of an EUTM application either.

Case No	Comment
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31/01/2001, B 140 006, GORDON SMITH (fig.); confirmed 07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	The mere fact that the opponents failed to immediately oppose the applicant's action to register the trade mark after they received notice of the fact did not constitute consent.
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The fact that the proprietor tolerates conduct outside the boundaries of a contract (such as use of the sign) cannot lead to the conclusion that filing the EUTM did not breach the established fiduciary duty if consent is not clear, specific and unconditional.

Case No	Comment
T-537/10 & T-538/10, Fagumit, EU:T:2012:2952,	<p>The applicant (the EUTM owner in cancellation proceedings) focused her line of argument on the consent allegedly granted by the proprietor of the mark. The Court held (like the Board of Appeal) that the consent for the purposes of the registration of the mark in the name of the representative or agent must be clear, specific and unconditional (paras 20-23).</p> <p>The document relied upon by the EUTM owner does not show consent within the meaning of Article 8(3) EUTMR (para. 28). The EUTM owner was not mentioned in the document and it did not refer to the possibility of registration of the sign as a trade mark. The EUTM owner cannot rely on the fact that the cancellation applicant did not object to the use of the sign by companies other than those referred to in the document. Use of the marks occurred during the course of marketing the goods produced by the cancellation applicant. However, such use is the logical consequence of the cooperation between the cancellation applicant and the distributors of its goods and does not show any abandonment of the sign, which would enable anyone to make an application for the registration of that sign — or its dominant element — as an EUTM (para. 27)</p>

Even where consent of the proprietor has been deemed to be clear, specific and unconditional, it will be a question of fact to determine if such consent survives a **change of proprietor** by way of an asset sale.

Case No	Comment
06/09/2006, T-6/05, First Defense Aerosol Pepper Projector	<p>The General Court remitted a case of this nature back to the Boards of Appeal in order to determine whether the consent obtained by the EUTM applicant had survived the purchase of the assets of the former trade mark holder and whether, on the day of the application for registration of the mark, the new holder of the trade mark in the USA (the opponent) was still bound by that consent.</p> <p>If the opponent was no longer bound by the consent, the General Court indicated that the Board ought then to determine whether the applicant had a valid justification which could offset the lack of such consent.</p>

4.4 Absence of justification on the part of the applicant

As mentioned above, since it is not possible for the opponent to prove the absence of consent, the burden of proof is reversed and it is up to the applicant to show that the filing of the application was authorised by the proprietor. Although Article 8(3) EUTMR treats the lack of the proprietor's consent and the absence of a valid justification on the part of the applicant as two separate conditions, these requirements largely overlap to the extent that if the applicant establishes that the filing of the application was based on some agreement or understanding to this effect, then it will also have provided a valid justification for its acts.

In addition, the applicant may invoke any other kind of circumstance showing that it had a justification for filing the EUTM application in its own name. However, in the absence of evidence of direct consent, only exceptional reasons are accepted as valid justifications, in view of the need to avoid a violation of the proprietor's legitimate interests without sufficient indications that its intention was to allow the agent to file the application in its own name.

For example, it could be possible to infer that the proprietor has tacitly consented to the filing of the application if it does not react within a reasonable period of time after having been informed by the applicant that it intends to apply for an EUTM in its own name. However, even in such a case it will not be possible to assume that the application has been authorised by the proprietor if the agent had not made it sufficiently clear to the proprietor in advance in whose name it would file the application.

Another case of valid justification could be if the proprietor causes its agent to believe that it has abandoned the mark, or that it is not interested in obtaining or maintaining

any rights in the territory concerned, for example, by suspending the use of the mark over a relatively long period of time.

The fact that the proprietor does not want to spend money on registering its trade mark does not give the agent a right to act on its own initiative, as the proprietor might still have an interest in using its trade mark in the territory although it is not registered. Such a business decision cannot be taken in itself as a sign that the proprietor has given up the rights in its mark.

Justifications exclusively linked to an applicant's economic interests, such as the need to protect its investment in setting up a local distribution network and promoting the mark in the relevant territory, cannot be considered valid for the purposes of Article 8(3) EUTMR.

Nor can the applicant successfully argue in its defence that it is entitled to some financial remuneration for its efforts and expenditure in building up goodwill for the mark. Even if such remuneration were well deserved or is expressly stipulated in the agency agreement, the applicant cannot use the registration of the mark in its own name as a means of extracting money from the opponent or in lieu of financial compensation, but should try to settle its dispute with the proprietor either by way of agreement or by suing for damages.

Finally, if the applicant does not provide any justification for its actions, it is not for the Office to make any speculations in that regard (09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 73-74).

Case No	Comment
04/10/2011, 4 443 C, CELLO	As to the justificatory argument that the EUTM application was filed in order to protect the goodwill of the mark in the EU, which had been established solely as a result of its trading activities, the Cancellation Division considered that the fact that a distributor, exclusive or otherwise, develops the goodwill of the trade mark of the owner in its allocated territory forms part of the usual duties of a distributor and cannot constitute, in itself and in the absence of other circumstances, a valid justification for the appropriation of the owner's mark by the distributor.

Case No	Comment
10/01/2011, 3 253 C, MUSASHI (fig.)	As regards justification concerning economic claims of the party filing the EUTM and its arguments that it is entitled to some financial remuneration for permitting the sign to enjoy protection at EU level, and that it could be transferred to the cancellation applicant, it was held that this could not be valid justification within the meaning of Article 8(3) EUTMR. 'Even if remuneration were well deserved, the EUTM proprietor cannot use the registration of a mark in its own name as a means of receiving payment' (from the cancellation applicant) (para. 47).
07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	An act which compromises the interests of the trade mark proprietor, such as the filing of a trade mark application in the agent's or a representative's name without the proprietor's consent, and is driven solely by an intention to safeguard the agent's or a representative's own interests, is not considered justifiable for the purposes of Article 8(3) EUTMR. The same applies to the applicant's second argument, that is, that it was justified in doing so because it bore the registration costs. The interests of the trade mark proprietor cannot be subordinate to an agent's or a representative's financial expenses. The fact that an opponent might be unwilling to incur any financial expenses to register a trade mark does not automatically grant a right to the agent or representative to proceed with the registration of the trade mark in its own name. This would constitute a violation of the agent's or representative's duty of trust and loyalty towards the trade mark proprietor (para. 24).

4.5 Applicability beyond identical signs — goods and services

Article 8(3) EUTMR provides that an EUTM application will not be registered where 'an agent or representative of the proprietor of the mark applies for **registration thereof** in his own name'. Such an explicit reference to the principal's trade mark gives the prima facie impression that the EUTM applied for must be the same as the earlier mark.

Hence, a literal interpretation of Article 8(3) EUTMR would lead to the conclusion that its application is only possible where the agent or representative intends to register a mark identical to that of the proprietor.

Moreover, the text of Article 8(3) EUTMR does not refer to the goods and services for which the application has been filed and for which the earlier mark is protected and, thus, gives no guidance as to what the exact relationship between the respective goods and services should be for the Article to apply.











However, applying Article 8(3) EUTMR exclusively to identical signs for identical goods or services would render this provision largely ineffective, as it would allow the applicant to escape its consequences by merely making slight modifications either to the earlier mark or to the specification of goods and services. In such a case, the proprietor's interests would be seriously prejudiced, especially if the earlier mark were already in use and the variations made by the applicant were not significant enough to rule out confusion. What is more, if the application were allowed to proceed to registration despite its similarity to the earlier mark, the applicant would be in a position to prevent any subsequent registration and/or use of the earlier mark by the original proprietor within the EU, by relying on Article 8(1) or 9(2) EUTMR, or the equivalent provisions of national law.

To sum up, in view of the need to effectively protect the legitimate proprietor against unfair practices by its representatives, a restrictive interpretation of Article 8(3) EUTMR must be avoided.

Therefore, Article 8(3) EUTMR must be applied where the respective marks are identical or where there is a relation between them comparable to the examples in the below table; and

- when the goods and services in conflict are closely related or equivalent in commercial terms. The requirement 'equivalent in commercial terms' must be interpreted in a narrow sense and does not have the same meaning as 'similar' pursuant to Article 8(1)(b) EUTMR (15/09/2015, R 2406/2014-5, STUDIOLINE / STUDIOLINE et al., § 17). In other words, what finally counts is that the goods or services of the applicant may be perceived by the public as 'authorised' products, the quality of which is still somehow 'guaranteed' by the opponent, and which it would have been reasonable for the opponent to market in view of the goods and services protected under the earlier mark. If the goods or services, however, are not identical or similar or equivalent, Article 8(3) EUTMR does not apply (17/02/2014, R 407/2013-4, WOUXUN / WOUXUN).

The following are examples of conflicting **signs** where the Office considered that Article 8(3) EUTMR is applicable.

Earlier sign	EUTM application	Case No
<p>FIRST DEFENSE</p>  <p>(2 US earlier rights)</p>		<p>04/05/2009, R 493/2002-4, FIRST DEFENSE AEROSOL PEPPER PROJECTOR (fig.)</p> <p>13/04/2011, T-262/09, First Defense Aerosol Pepper Projector</p>
		<p>03/05/2012, R 1642/2011-2, MARITIME ACOPAFI (fig.) / MARITIME MONTERING AS (fig.) et al.</p>
 <p>BERIK (word mark)</p> <p>(2 earlier rights)</p>		<p>03/08/2010, R 1367/2009-2, BERIK- DESIGN (fig.) / BERIK et al.</p>
 <p>BERIK (word mark)</p> <p>(2 earlier rights)</p>		<p>03/08/2010, R 1231/2009-2, BERIK (fig.) / BERIK et al.</p>
	<p>NORAXON</p>	<p>19/06/1999, B 3 436, NORAXON</p>
	<p>APEX</p>	<p>26/09/2001, B 150 955 and B 170 789, APEX</p>

The following are examples of **goods and services** in conflict where the Office considered that Article 8(3) EUTMR is applicable.

Case No	Comment
<p>04/05/2009, R 493/2002-4, FIRST DEFENSE AEROSOL PEPPER PROJECTOR (fig.)</p>	<p>The Board held that the contested <i>disabling sprays</i> in Class 13 were covered by the proprietor's <i>non-explosive defense weapons in the nature of an organic irritant packaged in an aerosol (or pressurized spray) canister</i>.</p> <p>However, it considered that protection did not extend to the contested <i>side arms, ammunition, projectiles</i>. These are goods for which commercial activity from the proprietor cannot be reasonably expected. Side arms and ammunition are far too different from pepper sprays to be covered by Article 8(3) EUTMR given that the opponent markets a very specific product (paras 19-24).</p> <p>In its judgment of 13/04/2011, T-262/09, the General Court did not examine the arguments of the parties regarding the similarity of the goods.</p>
<p>03/05/2012, R 1642/2011-2, MARITIME ACOPAFI (fig.) / MARITIME MONTERING AS (fig.) et al.</p>	<p>The Board held that the wording suggests only if the mark applied for is essentially identical to the earlier right, in terms of both signs and goods/services, can it be prohibited. On the other hand, a too-literal reading of that provision would fatally weaken its utility by allowing fraudulent agents to register their principals' marks by merely making minor modifications or unimportant additions to them. Despite these considerations, however, the provision must apply only where the signs and the goods/services are essentially the same, or largely equivalent (para. 18).</p> <p>In view of this, the Board upheld OD's findings that the earlier mark's use for <i>installation of marine accommodation</i> was fundamentally different from the applicant's services in Class 42 (<i>scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software</i>).</p>

Case No	Comment
<p>03/08/2010, R 1367/2009-2, BERIK- DESIGN (fig.) / BERIK et al.</p>	<p>The Board agreed with the Cancellation Division that the cancellation applicant's goods in Class 25 could not be considered closely related or equivalent in commercial terms to the applicant's goods in Class 18, <i>leather or imitation leather</i>. The latter are raw materials for producers of goods made of leather or imitation of leather and, thus, target a different public and have different distribution channels from the goods covered by the cancellation applicant's marks (paras 30-31).</p> <p>It further agreed with the Cancellation Division that the cancellation applicant's goods in Class 25 could not be considered closely related or equivalent in commercial terms to the applicant's goods in Class 16 even if, for example, some of the contested goods could be used as merchandising items for a line of clothing (paras 28-30).</p>
<p>27/02/2012, B 1 302 530, NEOWEB / GEOWEB et al.</p>	<p>'In view of the necessity to effectively protect the legitimate proprietor against unfair practices by its representatives, a restrictive interpretation of Article 8(3) EUTMR must be avoided. Therefore, this provision must be applied not only where the respective marks are identical, but also where the mark applied for by the representative or agent essentially reproduces the earlier mark with slight modifications, additions or deletions, which do not substantially affect its distinctiveness.</p> <p>In line with the aforementioned reasoning, Article 8(3) EUTMR does not only cover cases where the respective lists of goods and services are strictly identical, but it also applies where the goods and services in conflict are closely related or equivalent in commercial terms. In other words, what finally counts is that the goods or services of the applicant may be perceived by the public as "authorised" products, the quality of which is still somehow "guaranteed" by the opponent (para. 20).'</p>

In the following example, the **goods and services** in conflict were not considered equivalent in commercial terms.

Case No	Comment
15/09/2015, R 2406/2014-5 STUDIOLINE / STUDIOLINE et al.	The Board held that the connection between <i>photographer services</i> , including in the sense of 'organisation of photo-shoot parties', and <i>sporting and cultural activities</i> is too imprecise and vague to be regarded as 'equivalent in commercial terms'. It can be concluded from this that the decision concerned correctly ruled that the opposition was to be refused in relation to <i>sporting and cultural activities</i> (para 18).

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

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

Part C

Opposition

Section 4

Rights under Article 8(4) and 8(6) EUTMR

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1 Introduction

The relationship between the European Union trade mark system and national law is characterised by the **principle of coexistence**. This means that both the European Union trade mark system and the national laws exist and operate side by side. The same sign can be protected by the same proprietor as an EUTM and as a national trade mark in one (or all) of the Member States. The principle of coexistence further implies that the EUTM system actively acknowledges the relevance of national rights and their scope of protection. Where conflicts arise between EUTMs and national trade marks or other national rights, there is no hierarchy determining that one system prevails over the other; instead, these conflicts apply the principle of priority. If the respective requirements are met, earlier national trade marks or other earlier national rights can prevent registration of, or invalidate a later EUTM.

Although Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks and the directives that preceded it have harmonised the laws relating to **registered trade marks**, no such harmonisation has taken place on an EU scale with regard to **non-registered trade marks** nor for most **other earlier rights** of a similar nature. These unharmonised rights remain completely governed by national laws. Furthermore, there are rights other than trade marks whose acquisition and/or scope of protection is governed by EU law.

Article 8(4) EUTMR is the ground for opposition against an EUTM application based on an earlier non-registered trade mark or other sign used in the course of trade protected under EU law or the laws of the Member States, subject to the conditions of that provision.

2 Structure of Article 8(4) EUTMR

Article 8(4) EUTMR reads:

Upon opposition by the **proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance**, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign:

1. rights to that sign were **acquired prior** to the date of application for registration of the EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark;
2. that sign confers on its proprietor the **right to prohibit the use of a subsequent trade mark**.

Article 8(4) EUTMR means that in addition to the earlier trade marks specified in Article 8(2) EUTMR, non-registered trade marks and other signs protected at EU or Member State level used in the course of trade of more than mere local significance

can be invoked in an opposition provided that such rights confer on their proprietors the right to prohibit the use of a subsequent trade mark.

Article 8(4) EUTMR does not expressly or exhaustively enumerate the particular rights that can be invoked under this provision, but rather outlines a broad spectrum of rights that might serve as a basis for an opposition against an EUTM application. Therefore, Article 8(4) EUTMR can be regarded as a general ‘catch-all provision’ for oppositions based on non-registered trade marks and other signs used in the course of trade.

Nevertheless, the broad scope of earlier rights to be relied upon in opposition proceedings under Article 8(4) EUTMR is subject to a number of restrictive conditions: these rights must confer an entitlement to the proprietor to exercise them, they must be of more than local significance, they must be protected by the applicable law governing them against the use of a subsequent trade mark and the rights must have been acquired prior to the EUTM application under the applicable law governing that sign.

The ‘more than mere local significance’ requirement aims to restrict the number of potential opposing non-registered rights, thus avoiding the risk of a collapse or paralysis of the EUTM system by being flooded with opposing, relatively insignificant rights.

The ‘national protection’ requirement is deemed necessary as the non-registered national rights are not easily identifiable and their protection is not harmonised on an EU level. Consequently, only national law governing the earlier signs may define the scope of their protection.

While the requirements of ‘use in the course of trade’ and ‘use of more than mere local significance’ are to be interpreted in the context of EU law (European standard), national law applies when determining whether a particular right is recognised and protected under the national law, whether its holder is entitled to prohibit the use of a subsequent trade mark, and what conditions need to be met under national law for the right to be successfully exercised.

As a consequence of this dualism, the Office must apply both the relevant provisions of the EUTMR and the national law governing the earlier opposing right. In view of the two-tier examination to be applied under Article 8(4) EUTMR, this provision, as the link between EU and national law, displays a somewhat ‘hybrid’ nature.

3 Conditions of Article 8(4) EUTMR

The conditions for successfully invoking Article 8(4) EUTMR are:

1. the opponent must be the proprietor of a non-registered trade mark or of another sign used in the course of trade or a person authorised under the applicable law to exercise such a right (see paragraphs 3.1 and 3.2 below);
2. use in the course of trade of more than mere local significance (see paragraph 3.3 below);
3. acquisition prior to the EUTM application under the applicable law governing that sign (see paragraph 3.4 below);

4. right to prohibit the use of a subsequent trade mark under the applicable law governing that sign (see paragraph 3.5 below).

3.1 Entitlement: direct right conferred on the opponent

The legal systems of the EU Member States provide various means of preventing the use of later marks on the basis of earlier signs used in the course of trade. However, in order to come within the meaning of Article 8(4) EUTMR, the earlier right must be vested in a particular owner or a precise class of user that has **a quasi-propietorial interest** over it, in the sense that it can exclude or prevent others from unlawfully using the sign. This is because Article 8(4) EUTMR is a 'relative' ground for opposition and Article 46(1)(c) EUTMR provides that oppositions may be filed only by the proprietors of earlier marks or signs referred to in Article 8(4) EUTMR and by persons authorised under the relevant national law to exercise these rights. In other words, only persons having an interest directly recognised by law in initiating proceedings are entitled to file an opposition within the meaning of Article 8(4) EUTMR.

For example, in some Member States, the use of a sign may be prohibited if it results in unfair or misleading business practices. In such cases, if the earlier right lacks any 'proprietary quality', it will not fall within Article 8(4) EUTMR. It does not matter whether these signs are protected against misleading or unfair use under trade mark law, the law relating to unfair competition, or any other set of provisions. An example in this respect is the German regulation governing the use of the geographical indication 'Solingen' for specific goods (cutlery, scissors, knives, etc.). This law would not be a proper basis for an opposition under Article 8(4) EUTMR because the sign in question lacks any proprietary quality and, as such, is more public in nature.

Earlier right	Case No
A.O. CUBA	23/10/2008, R 51/2007-4, CUBAO / CUBA
Where the national law does not confer on a legal entity (whether public or private) a subjective right allowing it to prohibit the use of a subsequent trade mark, the 'proprietary requirement' is not met. The Board found that the Spanish law giving effect to the bilateral agreement between Spain and Cuba for the protection of the appellation of origin 'Cuba' was not sufficient to grant such a subjective right (paras 23-27).	

In assessing the proprietorship of a sign used in the course of trade, the Office must analyse specifically whether the opponent has acquired rights over the sign 'in accordance with the national law' (18/01/2012, T-304/09, BASmALI, EU:T:2012:13).

3.2 Types of rights falling under Article 8(4) EUTMR

3.2.1 Introduction

When assessing which kind of intellectual property rights can be invoked under Article 8(4) EUTMR and which cannot, a European standard applies. The distinction follows from the scheme of the EUTMR and, in particular, from the differentiation made between the kinds of earlier signs upon which an opposition may be based under Article 8(4) EUTMR and the types of further rights that may be the basis for invalidity under Article 60(2) EUTMR. While Article 8(4) EUTMR refers to **signs** ('non-registered trade mark or ... another sign'), Article 60(2) EUTMR refers to a broader set of rights: (a) a right to a name; (b) a right of personal portrayal; (c) a copyright; and (d) an industrial property right.

Therefore, although the signs covered by Article 8(4) EUTMR fall within the broad category of 'industrial property rights', not all industrial property rights are 'signs' for the purposes of Article 8(4) EUTMR. Since this distinction is contained in the EUTMR, the classification of a right under the respective national law is not decisive, and it is immaterial whether the national law governing the respective sign or industrial property right treats both types of rights in one and the same law.

The types of rights falling under Article 8(4) EUTMR are:

- 'non-registered trade marks'; and
- 'other signs used in the course of trade' such as:
 - trade names
 - company names
 - titles of publications or similar works
 - domain names.

The category of 'other signs used in the course of trade' within the meaning of Article 8(4) EUTMR mainly covers non-registered signs. However, the fact that a sign is also registered in accordance with the requirements of the respective national law does not bar it from being invoked under Article 8(4) EUTMR.

3.2.2 Non-registered trade marks

Non-registered use-based trade marks exist in a number of the Member States ⁽⁵⁵⁾ and are signs that indicate the commercial origin of a product or service. Therefore, they are signs that function as a trade mark. The rules and conditions governing acquisition of rights under the relevant national law vary from simple use to use having acquired a reputation. Neither is their scope of protection uniform, although it is generally quite similar to the scope of protection under the provisions in the EUTMR concerning registered trade marks.

⁵⁵ Benelux, Croatia, Estonia, France, Hungary, Lithuania, Poland, Romania, Slovenia and Spain do not protect unregistered trade marks (unless, for some jurisdictions, they are considered well known within the meaning of Article 6*bis* of the Paris Convention).

Article 8(4) EUTMR reflects the existence of such rights in Member States and grants the proprietors of non-registered marks the possibility of preventing the registration of an EUTM application where they would succeed in preventing use of that EUTM application under the relevant national law, by showing that the conditions set by the national law for prohibiting use of the later EUTM are satisfied and the other conditions of Article 8(4) EUTMR are met. As non-registered trade marks are not protected at European Union level, a 'European Union non-registered trade mark' is not an eligible basis for opposition.

Example: 17/03/2011, R 1529/2010-1, GLADIATOR / GLADIATOR, where a non-registered trade mark in the Czech Republic was invoked and 05/11/2007, R 1446/2006-4, RM2000T / RM2000T, where a non-registered trade mark in Belgium was invoked and the opposition rejected as unfounded because non-registered trade marks are not protected in Belgium.



3.2.3 Other signs used in the course of trade

'Other signs used in the course of trade' is a broad category that is not enumerated in Article 8(4) EUTMR. In order for such signs to come within the ambit of Article 8(4) EUTMR, they must have an identifying function as to commercial origin, that is to say, they must serve to identify an economic activity engaged in by their proprietor (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 149). Article 8(4) EUTMR does not cover other types of intellectual property rights that are not 'commercial signs' — such as patents, copyrights or design rights that do not have a primarily identifying function but protect technical or artistic achievements or the 'appearance' of something.

Some examples of cases dealing with whether a right is a 'sign' for the purposes of Article 8(4) EUTMR are set out below.

Earlier right	Case No
JOSE PADILLA (copyright)	22/06/2010, T-255/08, EU:T:2010:249
The Court found that copyright cannot constitute a 'sign used in the course of trade' within the meaning of Article 8(4) EUTMR. It is apparent from the scheme of Article 52 of Regulation No 40/94 [now Article 60 EUTMR] that copyright is not such a sign. Article 52(1)(c) of Regulation No 40/94 [now Article 60(1)(c) EUTMR] provides that an European Union trade mark is to be declared invalid where there is an earlier right as referred to in Article 8(4) EUTMR and the conditions set out in that paragraph are fulfilled. Article 52(2)(c) of Regulation No 40/94 [now Article 60(2)(c) EUTMR] provides that an European Union trade mark is also to be declared invalid where the use of such a trade mark may be prohibited pursuant to any 'other' earlier right and in particular a copyright. It follows that copyright is not one of the earlier rights referred to in Article 8(4) EUTMR.	

Earlier right	Case No
Dr. No (copyright)	30/06/2009, T-435/05, EU:T:2009:226
[...] the protection provided for by copyright cannot be relied on in opposition proceedings , but only in proceedings for a declaration of invalidity of the European Union trade mark in question (para. 41).	

Earlier rights	Case No
 and  (Community designs)	07/09/2010, B 1 530 875
Designs are a form of intellectual property dealing with the ornamental or aesthetic aspects of an article's appearance. Designs are deemed to be the result of a creative work that needs to be protected against unauthorised copying or imitation by third parties in order to ensure a fair return on investment. They are protected as intellectual property, but they are not business identifiers or trade signs. Therefore, designs do not qualify as signs used in the course of trade for the purpose of Article 8(4) EUTMR.	

3.2.3.1 Trade names

Trade names are the names used to identify businesses, as distinguished from trade marks that identify goods or services as produced or marketed by a particular undertaking.

A trade name is not necessarily identical with the corporate name or commercial name entered in a commercial or similar register as trade names can cover other non-registered names such as a sign that identifies and distinguishes a certain establishment. Trade names are protected as exclusive rights in all Member States.

Pursuant to Article 8 of the Paris Convention, trade names enjoy protection without any registration requirement. If national legislation requires registration for national trade names, the respective provision is not applicable by virtue of Article 8 of the Paris Convention with respect to trade names held by a national of another contracting party to the Paris Convention. This applies as well in respect of nationals of a member of the WTO Agreement.

As regards the application of Article 8(4) EUTMR to trade names, where the trade name is invoked on the basis of the law of one of the Member States where a registration is a condition for the enforcement of rights in a trade name, the Office will apply this requirement where the Member State and the nationality of the opponent are the same, but will not apply this requirement in all other cases, since this would violate the provisions of Article 8 of the Paris Convention.

Examples: 16/08/2011, R 1714/2010-4, where the Spanish trade name 'JAMON DE HUELVA' was invoked.

3.2.3.2 Company names

A company name is the official designation of an undertaking, in most cases registered in the respective national commercial register.

Article 8(4) EUTMR requires that actual use be shown, even if national law vests in the holder of such a name the right to prohibit the use of a subsequent trade mark on the basis of registration alone. However, if under national law registration is a prerequisite for protection, registration must be demonstrated as well. Otherwise, there would be no national right that the opponent could invoke.

Examples: 14/09/2011, T-485/07, O-live, EU:T:2011:467, where the Spanish commercial name 'OLIVE LINE' was invoked and 08/09/2011, R 21/2011-1, where the French company name 'MARIONNAUD PARFUMERIES' was invoked.

3.2.3.3 Domain names

A domain name is a combination of typographical characters corresponding to one or several numeric IP addresses that are used to identify a particular web page or set of web pages on the internet. As such, a domain name functions as an 'address' used to refer to a specific location on the internet (euipo.europa.eu) or an email address (@euipo.europa.eu).

Domain names are registered with organisations or commercial entities called 'domain name registrars'. Although a domain name is unique and may be a valuable commercial asset, a domain name registration per se is not an intellectual property right. Such registrations do not create any form of exclusive right. Instead, 'registration' in this context refers to a contractual agreement between a domain name registrant and the domain name registrar.

However, the **use** of a domain name may give rise to rights that can be the basis for an opposition under Article 8(4) EUTMR. This can occur if through the use of the domain name it acquires protection as a non-registered trade mark or a trade sign identifying commercial origin under the applicable national law.

Examples: 07/12/2011, R 275/2011-1, where rights based on the use of the German domain name 'lucky-pet.de' were invoked; B 1 719 379, where rights based on the use of the French domain name 'Helloresto.fr' were invoked; 14/05/2013, T-321/11 & T-322/11, Partito della libertà, EU:T:2013:240, where rights based on the use of the

Italian domain name 'partidodellaliberta.it' were invoked and the Court considered that references to this site in the Italian press did not in themselves substantiate its use in the context of a commercial activity.

3.2.3.4 Titles

Titles of magazines and other publications, or titles of similar categories of works such as films, television series, etc. fall under Article 8(4) EUTMR only if, under the applicable national law, they are protected as a trade sign identifying commercial origin.

The fact that the copyright in a title of a work can be invoked under the respective national law against a subsequent trade mark is not material for the purposes of Article 8(4) EUTMR. As set out above, whilst a right in copyright may be used to invalidate an EUTM under Article 60(2) EUTMR, it is only where a title has an 'identifying' function and acts as a trade sign identifying commercial origin that it comes within the scope of Article 8(4) EUTMR. Therefore, for such signs to be relied on under Article 8(4) EUTMR in the context of opposition proceedings, the national law must envisage a protection that is independent from that recognised by copyright law (30/06/2009, T-435/05, Dr. No, EU:T:2009:226, § 41-43.)

As with all rights under Article 8(4) EUTMR, the title must have been used in the course of trade. This will normally require that the work to which the title relates must have been placed on the market. Where the title relates to a service (such as a television programme), the service must have been made available. However, there will be circumstances where pre-use advertising may be sufficient to create rights, and where such advertising will constitute 'use' within the meaning of Article 8(4) EUTMR. In all cases, the title must have been used as an indicator of the commercial origin of the goods and services in question. Where a title is used only to indicate the artistic origin of a work, such use falls outside the scope of Article 8(4) EUTMR (30/06/2009, T-435/05, Dr. No, EU:T:2009:226, § 25-31).

Example: 12/01/2012, R 181/2011-1, where the magazine title 'ART' was invoked.

3.3 Use requirements

In order to successfully invoke Article 8(4) EUTMR in opposition proceedings, the earlier rights must be used. There are two different use requirement standards which must be taken into account:

- national standard
- European standard.

The two use requirement standards, however, clearly overlap. They must not be viewed in isolation but have to be assessed together. This applies, in particular, to the 'intensity of use' under the national standard and 'use in trade of more than mere local significance' under the European standard.

3.3.1 National standard

The national standard is relevant as it defines the scope of protection of the earlier rights, which are often not easily identifiable, all the more so since their protection is not harmonised on an EU level (see paragraph 3.5.2 below on the scope of protection). This standard determines the existence of the national right and the conditions of protection. For non-registered trade marks and other trade signs identifying commercial origin that do not require registration, use constitutes the only factual premise justifying the existence of the right, including ascertainment of the beginning of its existence. The national standard also prescribes the intensity of use under the relevant national law, which may vary from mere first use in trade to use requiring recognition or reputation.

For example, right to an unregistered trade mark in Denmark is acquired by **mere commencement of use of the mark** in Danish territory.

In Germany, however, the right to an unregistered trade mark is acquired through **use that has led to recognition by the relevant public of it as a trade mark** (*Verkehrsgeltung*). According to case-law, distinctive signs require 20 to 25 % recognition whereas non-distinctive signs must demonstrate recognition by 50 % of the relevant public.

3.3.2 European standard — use in the course of trade of more than mere local significance

Under Article 8(4) EUTMR, the existence of an earlier non-registered trade mark or of another sign gives good grounds for opposition if the sign satisfies, inter alia, the following conditions: it must be **used in the course of trade** and the use must be of **more than mere local significance**.

The above two conditions are apparent from the very wording of Article 8(4) EUTMR (reiterated in Article 7(2)(d) EUTMDR), and must, therefore, be interpreted in the light of EU law. The common purpose of the two conditions laid down in Article 8(4) EUTMR is to limit conflicts between signs by preventing an earlier right that is not sufficiently definite — that is to say, important and significant in the course of trade — from preventing registration of a new European Union trade mark. A right of opposition of that kind must be reserved to signs which actually have a **real presence** on their relevant market (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 157).

3.3.2.1 Use in the course of trade

The first requirement under Article 8(4) EUTMR is that the sign must be used in the course of trade.

The notion of '**use in the course of trade**' in accordance with Article 8(4) EUTMR is not the same as '**genuine use**' in accordance with Article 47(2) and (3) EUTMR (30/09/2010, T-534/08, Granuflex, EU:T:2010:417, § 24-27). The aims and conditions connected with proof of genuine use of registered European Union or national trade marks are different from those relating to proof of use in the course of trade of the signs

referred to in Article 8(4) EUTMR (09/07/2010, T-430/08, Grain Millers, EU:T:2010:304, § 26; 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 143). Therefore, use must be interpreted according to the particular type of right at issue.

The Court of Justice ruled that the ‘use of the sign in the course of trade’ within the meaning of Article 8(4) EUTMR refers to the use of the sign ‘in the course of a commercial activity with a view to economic advantage and not as a private matter’ (12/11/2002, C-206/01, Arsenal, EU:C:2002:651, § 40; 25/01/2007, C-48/05, Opel, EU:C:2007:55, § 18; 11/09/2007, C-17/06, Céline, EU:C:2007:497, § 17).

However, the Court of Justice also ruled that deliveries made without charge may be taken into account in order to ascertain whether the requirement for use of the earlier right in the course of trade has been met, since those deliveries could have been made in the context of a commercial activity with a view to economic advantage, namely to acquire new outlets (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 152).

As far as the **time of use** of the sign is concerned, an opponent must prove that use took place before the filing of the EUTM application or the priority date if relevant (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 166-168).

Earlier sign	Case No
BUD	29/03/2011, C-96/09 P, EU:C:2011:189
<p>The Court discussed whether use that takes place exclusively or to a large extent between the filing of an application for registration and its publication was sufficient to meet the use requirement. One of the parties had argued that only the acquisition of the right had to take place before filing of the EUTM application but not its use. The Court applied the same temporal condition as to the acquisition of the right and concluded that use had to take place before the filing of the application. The Court of Justice considered that in view of the considerable period of time which may elapse between the filing of an application for registration and its publication, the obligation of use in the course of trade of the sign before the filing of the application guarantees that the use claimed for the sign concerned is real and not an exercise whose sole aim has been to prevent registration of a new trade mark (paras 166-168).</p>	

Moreover, it must be clear from the evidence that the use continues on the date of the filing of the opposition. In this context, Article 7(2)(d) EUTMDR expressly states that if an opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, the opponent must provide evidence of its acquisition, **continued existence** (emphasis added) and scope of protection of that right.

The following is an example of an *inter partes* case relating to invalidity proceedings. The reasoning and the findings also apply to oppositions, given that Article 8(4) EUTMR is a ground that can be invoked both in opposition and in invalidity.

Earlier sign	Case No

BAMBOLINA (non-registered mark in a number of MS)	30/07/2010, 3 728 C (confirmed 03/08/2011, R 1822/2010-2; 23/10/2013, T-581/11, EU:T:2013:553)
<p>The evidence showed use in the course of trade of the non-registered trade mark for 3 years, not covering the last 2 years before the date of filing of the invalidity request. The Cancellation Division held that an earlier non-registered sign relied on in an invalidity action must be in use at the time of filing the request. Since for these signs use constitutes the factual premise justifying the existence of the right, the same factual premise must still exist, and be proven, on the date of filing of the invalidity request (30/07/2010, 3 728 C, paras 25-28). The Board confirmed the finding of the Cancellation Division, adding that Rules 19(1) and (2)(d) of Regulation No 2868/95 [now Article 7(1) and (2)(d) EUTMDR] state that where an opposition is based on Article 8(4) EUTMR, evidence of, inter alia, its 'continued existence' must be adduced within the period given by the Office for presenting or completing facts, evidence or arguments in support of the opposition. Failure to prove the existence, validity and scope of protection of the earlier mark or right within that period will lead to the opposition being rejected as unfounded. In the Board's opinion, these provisions applied <i>mutatis mutandis</i> to cancellation proceedings (03/08/2011, R 1822/2010-2, para. 15).</p>	

The requirement that the sign be used in the course of trade must, as stated above, be interpreted in the light of EU law. It must be distinguished from the requirements provided for under the applicable national laws that might set specific requirements as far as the **intensity of the use** is concerned.

The European Union use requirement as prescribed by Article 8(4) EUTMR applies independently of whether national law allows prohibition of a subsequent trade mark on the basis of the registration of a sign alone, that is, without any requirement relating to use. The following is an example where the opponent relied on the registration, at national level, of a trade name, but failed to prove that the sign was used in trade.

Earlier sign	Case No
NACIONAL (Portuguese name of establishment)	07/02/2010, R 693/2011-2
<p>Under Article 8(4) EUTMR, the fact that the opponent may, in accordance with the law of Portugal, have acquired exclusive rights plainly enforceable against subsequent trade marks on the basis of the registration of a 'name of establishment', does not exempt it from the burden of proving that the sign in question has been used in the course of trade of more than local significance. The mere fact that the sign is registered in accordance with the requirements of the respective Portuguese law is not in itself sufficient for the application of Article 8(4) EUTMR (paras 20-26).</p>	

Depending on the applicable national law, an opponent might have to prove not only that the sign relied on is used in the course of trade (this being, as stated, a requirement under EU law), but also that it has been **registered with the competent**

national authorities. It would not be sufficient that the European Union requirement of 'use in trade' is met if the registration requirement is not fulfilled. However, under certain national laws, rights in a company name may be invoked, as long as the company name has been used, prior to the registration of the entity in the companies register. The following is an example where the opponent invoked prior rights in a company name used in the course of trade in Germany that was not registered at the time of filing the contested EUTM application.

Earlier sign	Case No
Grain Millers GmbH & Co. KG (German company name)	09/07/2010, T-430/08, EU:T:2010:304
The opponent invoked under Article 8(4) EUTMR the company name 'Grain Millers GmbH & Co. KG' used in the course of trade in Germany for 'flour, in particular wheat flour and rye flour'. Therefore, the opponent claimed the name of a GmbH (Gesellschaft mit beschränkter Haftung, 'limited liability company' in English). The applicant argued that, according to Article 11(1) German Limited Companies Act (GmbH Gesetz), a GmbH does not exist before its registration and that the opponent was therefore not entitled, in support of its opposition, to rely on its business name, because the company was registered only after the filing of the contested EUTM application. The Court took a different view and held that, according to the case-law of the German courts, the right to a business name exists pursuant to paragraph 5(2) of the Markengesetz from the first use in the course of trade, without the obligation to register (para. 36).	

A sign is used in the course of trade where that use occurs in the context of **commercial activity with a view to economic advantage** and not as a private matter.

Therefore, the Office will reject an opposition in the absence of actual use of the invoked sign. The following are examples where the opponent failed to meet this basic requirement.

Earlier sign	Case No
Octopussy (film title, claimed to have been used in the course of trade in, inter alia, Germany)	20/04/2010, R 526/2008-4

The opponent merely submitted general information explaining the content of the film, its characters, gross figures, video offers on the internet and advertisements without any details as regards the relevant market. The information as regards turnover is also insufficient since it is too broad a general reference to the activities carried out by the opponent and does not specify either the type of activity or the territories concerned. For the same reason, the figures from a periodical, relating to the box office receipts generated by the film, have no bearing on the use of the sign in Germany. The remaining press articles furnished by the opponent concern subjects which cannot corroborate the use of the sign in the Member States indicated. The licence agreements for merchandising do not constitute any evidence with regard to the use of the sign as a film title. Lastly, the mere fact that the film was a worldwide success cannot substitute the obligation of the opponent to file concrete evidence with regard to the Member States in which it claims protection under Article 8(4) EUTMR (para. 26).

Earlier sign	Case No
'lucky-pet.de' (German domain name)	07/12/2011, R 275/2011-1
<p>The opponent invoked under Article 8(4) EUTMR the domain name 'lucky-pet.de' used in the course of trade in Germany for 'mats for animals; retail services with respect to pet supplies'. It has not been proven that the domain has been used with more than local significance for the claimed goods and services. The invoices provided and the catalogue only show the internet address www.lucky-pet.de. However, they do not prove that the website www.lucky-pet.de has been visited and, if so, to what extent. It has neither been stated nor proven by any document how many people visited the website and ordered products via email (para. 31).</p>	

3.3.2.2 Use of more than mere local significance

Rights falling under Article 8(4) EUTMR may only be invoked if their use is of more than mere local significance. This requirement applies for all the rights within the scope of Article 8(4) EUTMR, that is, both to unregistered trade marks and to other trade signs identifying commercial origin. The proprietors of rights the use of which is of mere local significance retain their exclusive rights under the applicable national law pursuant to Article 138 EUTMR.

The question whether the use of a non-registered sign is of more than mere local significance will be answered by applying a uniform European standard (18/04/2013, T-506/11 & T-507/11, Peek & Cloppenburg, EU:T:2013:197, § 19, 47-48).

The General Court held that the significance of a sign used to identify specific business activities must be established in relation to the identifying function of that sign. That consideration means that account must be taken, firstly, of the **geographical dimension** of the sign's significance, that is to say, of the territory in which it is used to identify its proprietor's economic activity, as is apparent from a textual interpretation of

Article 8(4) EUTMR. Account must be taken, secondly, of the **economic dimension** of the sign's significance, which is assessed in view of the length of time for which it has fulfilled its function in the course of trade and the degree to which it has been used, of the group of addressees among which the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet (24/03/2009, T-318/06 – T-321/06, General Optica, EU:T:2009:77, § 36-37; 30/09/2010, T-534/08, Granuflex, EU:T:2010:417, § 19).

The Court of Justice clarified that the significance of a sign cannot be a function of the mere geographical extent of its protection, since, if that were the case, a sign whose protection is not merely local could, by virtue of that fact alone, prevent registration of a European Union trade mark, even though the sign might be used only to a very limited extent in the course of trade. The sign must be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a **substantial part of that territory** (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 158-159).

However, it is not possible to establish a priori, in an abstract manner, which part of a territory must be used to prove that the use of a sign is of more than mere local significance. Therefore, the assessment of the sign's significance must be made *in concreto*, according to the circumstances of each case.

Therefore, the criterion of '**more than mere local significance**' is more than just a **geographical examination**. The **economic impact** of the use of the sign must also be evaluated. Consideration must be given, and the evidence must relate, to these elements:

1. the intensity of use (sales made under the sign);
2. the length of use;
3. the spread of the goods (location of the customers);
4. the advertising under the sign and the media used for that advertising, including the distribution of the advertising.

In the following example, both the geographic and the economic dimension of use of the sign were found to meet the standards.

Earlier sign	Case No
GLADIATOR (non-registered trade mark in the Czech Republic)	17/03/2011, R 1529/2010-1

The around 230 invoices are sufficient to conclude that the sign 'GLADIATOR' has been used in the course of trade for 'all terrain vehicles'. They are issued to the opponent's clients in Czech cities such as 'Praha', 'Kraslice', 'Dolní Lánov', 'Pelhrimov', 'Opava', 'Bozkov', 'Plzeň' and many other Czech cities which cover many different areas of the Czech Republic. Furthermore, the catalogues and the magazines '4X4 Style' from 2007 are written in Czech and it is very likely that they are distributed in different venues within the Czech Republic. The documents such as the list of distributors, catalogues and magazines support the findings that the sign has been used in the course of trade (paras 22-33).

As far as the use of the sign is concerned, in general, neither the territory of a city alone, even a large one, nor a regional district or province, is of more than mere local significance. It will depend on the circumstances of the case (see examples below). The leading judgment in this respect is the one rendered by the General Court in the *General Óptica* case, where use of the sign was confined to a specific locality and was, therefore, insufficient to meet the prescribed requirements.

Earlier sign	Case No
Generalóptica (Portuguese establishment name)	24/03/2009, T-318/06 – T-321/06, EU:T:2009:77
It is not apparent from the evidence provided by the opponent that the significance of the sign relied on in the present case is more than merely local within the meaning of Article 8(4) EUTMR. As the Board of Appeal stated in paragraph 33 of the contested decisions, it is apparent from the documents submitted by the opponent that at the time when registration of the first two European Union trade marks was applied for, the sign in question had been used for almost 10 years merely to designate a business establishment open to the public in the Portuguese town of Vila Nova de Famalicão, which has 120 000 inhabitants. In spite of its explanations at the hearing, the applicant did not provide any evidence of recognition of the sign by consumers or of its business relationships outside the abovementioned town. Likewise, the applicant has not shown that it had developed any advertising activity in order to ensure that its business establishment was promoted outside that town. It must therefore be held that the business establishment name Generalóptica is of mere local significance within the meaning of Article 8(4) EUTMR (para. 44).	

Earlier sign	Case No
FORTRESS FORTRESS INVESTMENTS FORTRESS INVESTMENT GROUP (non-registered trade marks in the UK)	 01/04/2011, R 354/2009-2 08/03/2011, R 355/2009-2

The fact that the invalidity applicant was involved in the acquisition, lease-back and management of nationwide property portfolios of major UK institutions and companies proves that the use was of more than mere local significance. The fact that use is limited to London is relevant in the sense that London is the seat of nearly all governmental institutions and bodies and home to the City of London, one of the leading financial centres of the world. The economic dimension of the sign's significance was important since by mid 2000, the invalidity applicant had already an equity capital under management in excess of USD 1 billion. Furthermore, the group of addressees among which the sign was known is significant since it included major players in the financial field and UK public institutions. The exposure given to the sign was also significant, cf. the national and specialised press coverage. Therefore, use in the course of trade was of more than mere local significance (paras 49-51).


The notion that the use in trade of the sign relied on must be proven in the territory of the Member State/s where protection is sought is not incompatible with use of the sign in connection with **cross-border commercial transactions**.

Earlier sign	Case No
GRAIN MILLERS (German business name)	09/07/2010, T-430/08, EU:T:2010:304
The use of a business name in the context of the importation of goods from another State (in this case, documents of the transaction concluded by opponent concerning the import of wheat from Romania to Germany) is indeed use in the context of a commercial activity with a view to economic advantage, since import-export constitutes a normal, everyday activity of an undertaking, necessarily involving at least two States (para. 41).	

The following are examples where the opponent failed to prove that the **economic dimension** of the use of the signs concerned was sufficient to meet the prescribed legal requirements.

Earlier sign	Case No
BRIGHTON (non-registered marks in the United Kingdom, Ireland, Germany and Italy)	30/06/2010, R 408/2009-4 (confirmed 27/09/2011, T-403/10, EU:T:2011:538, § 38-40; dismissed 27/09/2012, C-624/11 P, EU:C:2012:598, § 40-50)

The sales chart provided by the opponent shows that the sale activities in the Member States concerned were not consistent over time to the extent that for certain years no sales at all appear to have taken place and that for others the sales revenue was very low indeed. Therefore, the sales figures show that the opponent was not able to maintain an intensity of use of the signs over three consecutive years. It is unlikely in those cases that the public was able to memorise the mark as an indication of origin. The opponent did not submit any evidence relating to the advertising and promotion of the marks invested in the concerned Member States, or other material showing that the signs in question had established themselves in the marketplace to such an extent as to justify the acquisition of exclusive rights in non-registered trade marks (paras 12-21).

Earlier sign	Case No
 (Greek non-registered mark)	01/06/2011, R 242/2010-1
Although the documents confirm the geographical extent of the trade mark to Greece, the evidence regarding the extent of time of the alleged use is clearly insufficient. The last dated document is from 1997, i.e. seven years before the contested application was submitted. Moreover, the most recent documents in which the trade mark 'ESKIMO' can be seen are the invoices dating from 1991 to 1994. They only reflect the sales of a little less than 100 units throughout these four years, which cannot be deemed sufficient to prove the use of the mark as a business identifier by the opponent (paras 27-28).	

Earlier sign	Case No
Up Way Systems – Representações Unipessoal LDA (Portuguese company name)	25/01/2013, R 274/2012-5
Three invoices, addressed to companies in the Porto region of Portugal, for a total sales amount of EUR 16 314, are not sufficient to show that the sign was used in the course of trade, considering the price level of building materials and building services in general (paras 20-23).	

3.3.2.3 Nature of the use

Use of a sign relied on under Article 8(4) EUTMR must be made in accordance with the essential **function** of such a sign. This means that if an opponent relies on a non-registered trade mark, proof of use of the sign as a company name would not be sufficient to substantiate the earlier right.

The following is an example where the evidence shows use of a sign whose function does not correspond to that of the sign relied on.

Earlier sign	Case No
JAMON DE HUELVA (Spanish trade name)	16/08/2011, R 1714/2010-4
<p>The proof furnished in order to substantiate the use of 'Jamón de Huelva' almost exclusively relates to the designation of origin 'Jamón de Huelva'. Designations of origin are very different legal concepts from trade names, as, instead of identifying a particular commercial origin, they are geographical indications relating to an agricultural or food product of which the quality or characteristics are fundamentally or exclusively due to the geographical environment in which they are produced, processed or prepared. The opposition based on the use in Spain of the trade name 'Jamón de Huelva' must be dismissed in view of the fact that the proof furnished does not relate to this legal concept and does not identify a specific commercial activity, but instead the activities relating to a designation of origin and the Supervisory Council thereof (paras 34-37).</p>	

The requirement that the sign must be used in trade for its own particular economic function does not exclude that the same sign might be used for several purposes.

It is common market practice to also use company or trade names as trade marks, either alone, or together with other product identifiers. This is the case when use of a 'house mark' is concerned, that is, an indication which usually coincides with the manufacturer's company or trade name and which not only identifies the product or service as such, but also provides a direct link between one or more product/service lines and a specific undertaking.

Therefore, depending on the specific circumstances of the case, in a case where an opponent relies on a non-registered trade mark, the use of the same sign as a company name or trade name may well also accomplish the function of indicating the origin of the goods/services concerned (thus, a trade mark function), as long as the sign is used in such a way that a link is established between the sign that constitutes the company or trade name and the goods marketed or the services provided (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 22-23).

As Article 8(4) EUTMR continues to apply to oppositions based on geographical indications filed before the entry into force on 23/03/2016 of Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark, the opponent is still required to **prove that the geographical indication is used in the course of trade of more than mere local significance**. Use must be made in accordance with the essential function of such a sign, namely **to guarantee to consumers in the course of trade the geographical origin of the goods and the special qualities inherent in them** (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147, 149). Therefore, documents mentioning a geographical indication exclusively in a non-trade context are not sufficient for the purposes of Article 8(4) EUTMR.

3.4 Earlier right

The right invoked under Article 8(4) EUTMR must be earlier than the EUTM application. In order to determine which of the conflicting rights is earlier, the relevant dates on which the rights were obtained must be compared.

- For the **EUTM application**, this is the filing date or any priority date validly claimed (EUTM date). Seniority claims, even if they relate to the Member State where the other earlier right is claimed to exist, are not relevant.
- As regards the **right falling under Article 8(4) EUTMR**, the relevant date of acquisition of exclusive rights under the national law is decisive (07/05/2013, T-579/10, makro, EU:T:2013:232, where the Court confirmed the Board's rejection of evidence submitted by the invalidity applicant, which related to periods subsequent to the owner's application for the EUTM (§ 70).

Where mere use is sufficient under the national law, this must have begun before the EUTM date. Where recognition in the trade or reputation is required, this must have been acquired before the EUTM date. Where these conditions are fulfilled only after the EUTM date, the opposition will have to be rejected.

3.5 Right to prohibit the use of a subsequent trade mark under the applicable law

Earlier rights falling under Article 8(4) EUTMR are protected if they confer on their proprietors under the applicable law the right to prohibit use of a later trade mark.

This requires, firstly, a finding that under the applicable law, rights of the type involved, in the abstract, are exclusive rights enforceable by means of an injunction vis-à-vis later marks and, secondly, a finding that in the actual case under consideration the conditions for obtaining such injunctive relief, if the mark that is the subject of the opposed EUTM application were used in the territory in question, are present (scope of protection) (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 190). Both questions have to be answered in accordance with the applicable law.

3.5.1 The right of prohibiting use

Article 8(4) EUTMR requires a right that confers on its proprietor the right to prohibit **use** of a subsequent mark. Therefore, the opponent should invoke and submit those provisions of law that could be relied on in an action for infringement to prevent unauthorised use.

However, provisions of law prohibiting or invalidating the **registration** of a later sign may also be accepted. The right to oppose the registration of a later sign, implicitly, encompasses the right to oppose use of that sign. By opposing the registration of a later mark, the proprietor of the earlier right seeks effective protection against any future use of that mark. The concept of 'the right to prohibit the use of a subsequent

trade mark’ encompasses the case in which the owner of a sign has, under the applicable law, the power to prevent that use through an invalidity action against a subsequent trade mark (21/10/2014, T-453/11, Laguiole, EU:T:2014:901, § 37; 24/10/2018, T-435/12, 42 BELOW (FIG. MARK) / VODKA 42 (FIG. MARK), EU:T:2018:715, § 98-102; 19/04/2018, C-75/17P, PALLADIUM PALACE IBIZA RESORT & SPA (fig.), EU:C:2018:269, § 60).

3.5.2 Scope of protection

For many, if not most of the rights falling under Article 8(4) EUTMR, the prerequisites of national regulations are quite similar to those applied in conflicts between trade marks that Office examiners are familiar with, namely, likelihood of confusion, or damage to reputation or distinctiveness.

For example, unregistered marks are generally protected against subsequent marks in the event of a likelihood of confusion and, thus, in accordance with the same criteria that are applicable to conflicts between registered marks, namely, identity or similarity of the signs, identity or similarity of the goods or services, etc. In these cases, the criteria developed by the courts and by the Office for applying Article 8(1) EUTMR may easily be transported into Article 8(4) EUTMR, unless the party claims that the relevant case-law of the national courts follows a different approach.

Where the applicable national law provides protection for unregistered trade marks that is different from that found in Article 8(1) EUTMR, the scope of protection of the earlier right invoked follows from national law. If, for example, the applicable national law also grants protection to unregistered marks for dissimilar goods and services under certain conditions, the same protection will be granted under Article 8(4) EUTMR.

4 Proof of the Applicable Law Governing the Sign

4.1 The burden of proof

According to Article 95(1) EUTMR, in all *inter partes* cases, the burden is on the party making a particular claim or allegation to provide the Office with the necessary facts and arguments in order to substantiate the claim. Unlike other grounds in Article 8 EUTMR, Article 8(4) EUTMR does not specify the conditions governing the acquisition and scope of protection of the earlier right invoked. It is a framework provision where the particulars of the applicable law must be provided by the opponent.

Article 7(2)(d) EUTMDR provides that if an opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, the opponent must provide, *inter alia*, evidence of its acquisition, continued existence and scope of protection, including where the earlier right is invoked pursuant to the law of a Member State, a clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence.

It follows from the law and it has been interpreted by the Court that the opponent must provide the content of the relevant national law and show that it would succeed under that national law in preventing the use of a subsequent trade mark.

In that regard, it should be observed that Article 8(4)(b) of Regulation No 40/94 [now Article 8(4)(b) EUTMR] lays down the condition that, pursuant to the law of the Member State governing the sign relied on under Article 8(4), that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Furthermore, in accordance with Article 74(1) of Regulation No 40/94 [now Article 95(1) EUTMR], the burden of proving that that condition is met lies with the opponent before the Office.

In that context and in relation to the earlier rights relied on ... regard must be had, in particular, to the national rules advanced in support of the opposition and to the judicial decisions delivered in the Member State concerned and that, on that basis, the opponent must establish that the sign concerned falls within the scope of the law of the Member State relied on and that it allows use of a subsequent mark to be prohibited.

(29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 188-190.)

The Court held that in applications for a declaration of invalidity brought under Article 52(2) of Regulation No 40/94 [now Article 60(2) EUTMR], it is for the party who seeks to rely on an earlier right protected under national law

to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of an EU trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law.

(05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452, § 50; 27/03/2014, C-530/12 P, Mano, EU:C:2014:186, § 34.)

Although these judgments referred to invalidity proceedings under Article 52(2) of Regulation No 40/94 [now Article 60(2) EUTMR], since Article 8(4) EUTMR also concerns the application of earlier rights protected under European Union legislation or under the law of the Member State governing the sign at issue, the cited case-law also applies to oppositions brought under Article 8(4) EUTMR.

The information on the applicable law must allow the Office to understand and apply the content of that law, the conditions for obtaining protection and the scope of this protection, and allow the applicant to exercise the right of defence. It may also be particularly useful to submit evidence of relevant case-law and/or jurisprudence interpreting the law invoked.

The Office must effectively assess the applicability of the ground for refusal invoked. In order to ensure the correct application of the law invoked, the Office has the power to verify, by whatever means it deems appropriate, the content, the conditions governing the application and the scope of the provisions of the applicable law relied upon by the opponent (27/03/2014, C-530/12 P, Mano, EU:C:2014:186, § 44-46), while respecting the parties' right to be heard. If, after verifying the evidence submitted, the Office is of the opinion that the parties' proposed interpretation or application of the law invoked

was inaccurate, it can introduce new and/or additional elements. In order to respect the parties' rights to be heard, the Office will invite the parties to comment on these elements, where appropriate.

This power of verification is limited to ensuring the **accurate application of the law relied upon by the opponent**. It does not therefore discharge the opponent from the burden of proof and it cannot serve to substitute the opponent in adducing the appropriate law for the purposes of its case (02/06/2014, R 1587/2013-4, GROUP, § 26; 30/06/2014, R 2256/2013-2, (+) ENERGY / ENERGETIX, § 26).

4.2 Means of evidence and standard of proof

Pursuant to Article 8(4) EUTMR, the applicable law may be the law of a Member State or European Union law.

4.2.1 National law

As regards national law, the opponent must provide:

1. the provisions of the applicable law:
 - on the **conditions governing acquisition of rights** (whether there is a requirement of use and, if so, the standard of use required; whether there is a registration requirement, etc.); and
 - on the **scope of protection of the right** (whether it confers the right of prohibition of use; the injury against which protection is provided, e.g. likelihood of confusion, misrepresentation, unfair advantage, evocation).
2. particulars proving fulfilment of the conditions:
 - of **acquisition** (entitlement; earlier acquisition; whether it is in force; evidence of use if use-based; evidence of registration if registration-based, etc.); and
 - of **the scope of protection** (facts, evidence and/or arguments that the requirements laid down by the applicable law for a prohibition of use are met, e.g. the nature of the goods, services or business activity protected by the earlier right and their relation with the contested goods or services; a cogent argument showing that there is a risk of injury).

First, as regards the provisions of the applicable law (see paragraph 4.2.1 a) above), the opponent must provide a clear identification of the contents of the national law relied upon by adducing publications of the relevant provisions or jurisprudence (Article 7(2)(d) EUTMDR). The opponent must provide the **reference** to the relevant legal provision (article number and the number and title of the law) and the **content** (text) of the legal provision by adducing publications of the relevant provisions or jurisprudence (e.g. excerpts from an official journal, a legal commentary, legal encyclopaedias or court decisions). If the relevant provision refers to a further provision of law, this must also be provided to enable the applicant and the Office to understand the full meaning of the provision invoked and to determine the possible relevance of this further provision. Where the evidence concerning the content of the relevant national law is accessible online from a source recognised by the Office, the opponent

may provide such evidence by making a reference to that source (Article 7(3) EUTMDR) (see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2.4.3).

As the opponent is required to **prove** the content of the applicable law, **it must provide the applicable law in the original language**. If that language is not the language of the proceedings, the opponent must also provide a **complete translation** of the legal provisions invoked in accordance with the standard rules of substantiation (Article 7(4) EUTMDR, first sentence). However, a mere translation of the applicable law does not itself constitute proof and cannot substitute the original; therefore, the translation alone is not considered sufficient to prove the law invoked. Article 7(4) EUTMDR requires any provisions of the applicable national law governing the acquisition of the rights and their scope of protection, including evidence accessible online to be submitted in the language of the proceedings or accompanied by a translation into that language, which must be submitted within the time limit specified **for submitting the original document**. The same rules apply where the opponent provides the content of the relevant national law by making reference to a relevant online source recognised by the Office.

Where the opponent seeks to rely on national case-law or jurisprudence interpreting the law invoked, it must provide the relevant information in sufficient detail (e.g. a copy of the decision invoked or excerpts from the legal literature). The translation rules apply equally to that evidence, including cases when the opponent provides such evidence by making reference to a relevant online source recognised by the Office.

Second, as regards the particulars proving fulfilment of the conditions of the applicable law (see paragraph 4.2.1 b) above), apart from providing appropriate evidence of acquisition of the right invoked, the opponent must submit evidence that the conditions of protection vis-à-vis the contested mark are actually met and, in particular, put forward a cogent line of argument as to why it would succeed in preventing the use of the contested mark under the applicable law. Merely providing the applicable law itself is not considered sufficient, as it is not up to the Office to make the relevant argument on behalf of the opponent.

Furthermore, in an opposition under Article 8(4) EUTMR, what matters is whether the relevant provisions of the law conferring on the opponent the right to prohibit the use of a subsequent trade mark would apply to the contested mark in the abstract, and not whether the use of the contested mark could actually be prevented. Therefore, the applicant's argument in defence that the opponent had not hitherto invoked or had not hitherto been able to prevent the actual use of the contested mark in the relevant territory cannot succeed (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191, 193).

Based on the above, the Office will reject the opposition if:

- the opponent invokes a right but does not include a **reference** to any specific national law and/or legal provision protecting that right (e.g. the opponent only indicates that the opposition is based on a commercial designation in Germany or that the opposition based on a commercial designation in Germany is protected under DE-TMA); or

- the opponent provides a reference to the applicable national law and legal provision(s) but the reference is not complete: the legal provision only indicates the conditions governing the **acquisition** of the right but not the **scope of protection** of the right (or vice versa) (e.g. the opponent indicates that the opposition is based on a commercial designation in Germany protected under Article 5 DE-TMA, which establishes the conditions for acquisition of the right, but the reference to the conditions governing the scope of protection, Article 15 DE-TMA, is missing); or
- the opponent provides the reference to the relevant legal provision but does not provide the **content** (text) of the legal provision (e.g. the opponent's submission refers to the DE-TMA but does not include the content of the law); or
- the opponent provides the content of the legal provision only in the language of the proceedings but not in the **original language** (e.g. the language of the proceedings is English but the text of the DE-TMA is submitted only in English, not in German); or
- the opponent does not provide any or sufficient evidence of the acquisition of the right invoked or does not provide arguments as to why it fulfils the conditions governing the scope of protection (e.g. the opponent refers to the relevant legal provisions and provides their content both in the original language and translated into the language of the proceedings, but does not provide any or sufficient evidence of the acquisition of protection or does not state whether it fulfils the conditions of the scope of protection).

4.2.2 European Union law

The above requirements also apply to European Union law, except that the opponent is not obliged to provide the content (text) of the law invoked. However, the opponent has to provide particulars proving the fulfilment of the conditions under the relevant provisions of European Union law (paragraph 4.2.1. b) above).

5 Article 8(6) EUTMR — the Protection of Geographical Indications

The essential function of the protection of a geographical indication is to guarantee to the consumer the geographical origin of the goods and the special qualities connected therewith (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147).

EU legislation distinguishes between 'protected designations of origin' (PDOs), where the quality or characteristics of the product are **essentially or exclusively due to** a particular geographical environment, and 'protected geographical indications' (PGIs), where a **given** quality, reputation or other characteristic of the product is **essentially attributable to** its geographical origin, without the stages of production, processing or preparation all necessarily taking place in the same area. In essence, PDOs have a closer link with the geographical area of production. The distinction, however, does not affect their scope of protection, which is the same for PDOs and PGIs. For the

purposes of this chapter, the term ‘geographical indication’ (GI) is used to refer to both PDOs and PGIs in general.

For a general overview of geographical indications see the Guidelines, Part B: Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR).

5.1 Relationship between Article 8(4) and 8(6) EUTMR

Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark (Amending Regulation) introduced Article 8(4a) of Regulation No 207/2009 [now Article 8(6) EUTMR] as a specific ground of opposition for GIs. Prior to that, GIs could form the basis of an opposition pursuant to Article 8(4) EUTMR as ‘another sign used in the course of trade’. However, the introduction of this specific ground means that as of the entry into force of Article 8(4a) of Regulation No 207/2009 (⁵⁶) [now Article 8(6) EUTMR], GIs can only be invoked under the new ground. GIs can no longer form the basis of an opposition under Article 8(4) EUTMR, even though the wording of that provision has not changed.

However, if an opponent files an opposition based on a GI after entry into force of the Amending Regulation, in which it indicates incorrectly Article 8(4) EUTMR as a ground for opposition, the Office will examine the opposition, to the extent that it is clearly based on a GI, as if the ground invoked were Article 8(6) EUTMR. In such a case, the notice of opposition leaves no doubt as to the opponent’s intention to invoke the ground for opposition protecting earlier GIs.

Oppositions based on GIs filed before the date of entry into force of Article 8(4a) of Regulation No 207/2009 [now Article 8(6) EUTMR] will continue to be assessed under the conditions of Article 8(4) EUTMR. In the absence of transitory provisions, Article 8(4a) of Regulation No 207/2009 (now Article 8(6) EUTMR) applies in oppositions filed on or after its entry into force, regardless of whether the contested EUTM application was filed, or had a date of priority before or after such entry into force.

Article 8(6) EUTMR reads:

Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

1. an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;

⁵⁶ 23 March 2016.

2. that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

This ground of opposition for GIs specifies this particular type of earlier right, its beneficiary and its date of priority. However, apart from those evident specificities, the only substantial difference between Article 8(4) and 8(6) EUTMR is that the latter **does not require the opponent to prove use in the course of trade of more than mere local significance**.

The other conditions, namely, entitlement and proof of the applicable law, apply as explained in the Chapter dedicated to Rights under Article 8(4) EUTMR, with the specificities indicated below in paragraph 5.2.1.1.

The rest of this chapter addresses the particularities of GIs as a basis for opposition.

5.2 Types of GIs falling under Article 8(6) EUTMR

GIs are protected on various levels, under EU law, national law or international agreements, and cover various product areas such as foodstuffs, wines, aromatised wines, spirits or handicrafts.

5.2.1 GIs protected under EU law

As regards **EU legislation** protecting GIs, the following EU regulations are currently in place:

- Regulation (EU) No 1308/2013 ⁽⁵⁷⁾ in respect of *wines*;
- Regulation (EU) No 251/2014 ⁽⁵⁸⁾ in respect of *aromatised wines*;
- Regulation (EU) 2019/787 ⁽⁵⁹⁾ in respect of *spirit drinks*;
- Regulation (EU) No 1151/2012 ⁽⁶⁰⁾ in respect of *agricultural products and foodstuffs*.

For more information see also the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 2, Definition of Geographical Indications under EU Regulations.

⁵⁷ Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007.

⁵⁸ Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91.

⁵⁹ Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, and repealing Regulation (EC) No 110/2008.

⁶⁰ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs. It replaced and repealed Regulation (EC) No 510/2006.

5.2.1.1 Specifics of substantiation

GIs protected under the above Regulations may be a valid basis for an opposition under Article 8(6) EUTMR, to the extent that they allow the person authorised under the applicable law to exercise those rights **to prevent the use** of a subsequent mark. Their ability to prevent use is governed by the relevant provisions of the Regulations cited above (Article 13(1) of Regulation (EU) No 1151/2012, Article 103(2) of Regulation (EU) No 1308/2013, Article 21 of Regulation (EU) 2019/787 and Article 20(2) of Regulation (EU) No 251/2014). In this context, it is important to distinguish the latter provisions **preventing use** from those that **prevent registration** ⁽⁶¹⁾ of a trade mark, which are not a basis for opposition under Article 8(6) EUTMR (the provisions preventing registration are used as a basis for absolute grounds according to Article 7(1)(j) EUTMR).

Article 7(2) EUTMDR is applicable to oppositions based on Article 8(6) EUTMR. Therefore, the opponent must file evidence of the existence, validity and scope of protection of its earlier GI, as well as evidence of its entitlement to file the opposition.

In particular, according to Article 7(2)(e) EUTMDR, in order to substantiate its right, the opponent must provide the Office with the necessary facts and evidence regarding the validity and the scope of protection of its right. Depending on the GI, documents such as publication and registration in the Official Journal (for Regulation (EU) 2019/787, Regulation (EU) No 1151/2012 and Regulation (EU) No 251/2014) or an extract from the official register (for Regulation (EU) No 1308/2013) will be deemed sufficient if **they contain sufficient data to determine all the relevant particulars of the earlier right** (e.g. protected name, application or registration date, goods protected by the GI).

In addition, where these particular documents lack information about the opponent's entitlement, further documents must be submitted proving entitlement to file the opposition as an **authorised person under the relevant law to exercise the rights arising from a GI** (Article 46(1)(d) EUTMR and Article 7(2)(e) EUTMDR) (17/10/2013, R 1825/2012-4, *Dresdner Striezel-Glühwein / Dresdner Stollen*, § 37). Opponents seeking to rely on the relevant GI must provide some means of proof to substantiate their entitlement, and other relevant particulars of the GI, including national laws or administrative decisions granting GI protection in force at the time of the automatic extension of EU protection. For instance, where the opponent is a producer group that has applied for protection of a GI (typically represented via a Consejo Regulador, a Consorzio or, generally, a producer association), it may prove its entitlement by filing the statutes of the association or legislative acts conferring on the opponent the right to defend the GI. The documents submitted for proving the entitlement to file the opposition must be in the language of the proceedings (Article 7(4) EUTMDR).

⁶¹ Article 14(1) of Regulation (EU) No 1151/2012, Article 102(1) of Regulation (EU) No 1308/2013, Article 36(1) of Regulation (EU) 2019/787 and Article 19(1) of Regulation (EU) No 251/2014.

5.2.1.2 The exhaustive nature of the EU system of protection

The Court of Justice has stated (08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521) that the EU system of protection for GIs for *agricultural products and foodstuffs* laid down in Regulation (EC) No 510/2006 [then in effect] is '**exhaustive in nature**'. The Court further confirmed that the same must be true for the EU system of protection for GIs for *wines* as laid down in Regulation (EC) No 1234/2007, as these 'two systems were, essentially, the same in nature, since their objectives and characteristics were similar' (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 76).

The Office applies an analogous approach for GIs for *aromatised wines* and *spirit drinks* for the following reasons. The former protection at national level of geographical indications for *aromatised wines* and *spirit drinks* that now qualify for a GI under Regulation (EU) No 251/2014 and Regulation (EU) 2019/787, respectively, was **discontinued** once those geographical indications were registered at EU level (see Article 107 of Regulation (EU) No 1308/2013, Article 26 of Regulation (EU) No 251/2014, Articles 15(2) and 20(1) of Regulation (EC) No 110/2008, which was subsequently repealed by Regulation (EU) 2019/787, and Article 9 of Regulation (EU) No 1151/2012 read in conjunction with recital 24 of that Regulation).

5.2.2 GIs protected under the laws of Member States

GIs protected under the laws of Member States may be a basis for opposition under Article 8(6) EUTMR **only to the extent that no uniform EU protection is in place for the given category of goods**. This is the case, for example, for handicraft products (e.g. 'HEREND' for porcelain goods originating from Herend, Hungary).

For the reasons set out above, in the areas of *foodstuffs*, *wines*, *spirit drinks* and *aromatised wines*, protection at EU level is exhaustive in nature, which means that opposition under Article 8(6) EUTMR cannot be based on national rights in these areas. This is because the EU system of protection comprising the above regulations **overrides and replaces** national protection of GIs for *foodstuffs*, *wines*, *spirit drinks* and *aromatised wines*.

For the latter products, the opponent must invoke the relevant EU legislation in the notice of opposition as the reference to national law provisions will not be considered as relevant.

Article 8(6)(i) EUTMR requires proof of registration of the GI invoked. Accordingly, the opponent must submit the relevant registration certificate or equivalent documents emanating from the competent national registration authority. By way of analogy, this provision applies also to national GIs granted not in a registration procedure, but through other administrative means (such as a law or administrative decision granting protection). Such evidence may be provided by making reference to an online source recognised by the Office (Article 7(3) EUTMDR). The evidence must prove all the particulars of the GI, including its name, that it is protected as a GI, the goods covered, that it was acquired prior to the date of priority of the contested mark, proof of

entitlement and proof that protection pursuant to national law confers on the beneficiary of the GI a direct right of action against unauthorised use. Further, pursuant to Article 7(2)(e) EUTMDR, where the earlier GI is invoked pursuant to the law of a Member State, the opponent must provide a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or case-law. It may provide such evidence by making a reference to a relevant online source recognised by the Office. The opponent must prove the conditions of the scope of protection and particulars proving that those conditions are fulfilled in the given case.

An opposition may also be based on an application for a GI. In such cases, the Office may suspend the proceedings until the GI is registered, if the suspension is appropriate under the circumstances of the case.

5.2.3 GIs protected under international agreements

Notwithstanding that Article 8(6) EUTMR does not explicitly mention GIs protected under international agreements, the reference to ‘Union legislation’ and ‘national law’ naturally includes international agreements as they form part of the legal order of the European Union or the Member State that is a party to the international agreement.

In order for an opposition under Article 8(6) EUTMR to be successful on the basis of a right deriving from any international agreement, the provisions under the international agreement must be directly applicable and they must allow the beneficiary of the relevant GI to take direct legal action to prohibit the use of a subsequent trade mark.

In the latter respect, international agreements are **not always self-executing**. This depends on the characteristics of the agreement itself and on how they have been interpreted in the relevant jurisdiction. For example, the Office considers that the provisions of the Lisbon Agreement (in particular Articles 3 and 8) are not self-executing. As expressly indicated by Article 8 of the Lisbon Agreement, it is the relevant national legislation that must determine which type of legal actions may be taken, their scope and whether these legal actions include allowing the proprietor of an appellation of origin to prohibit the use of a subsequent trade mark. Therefore, in such cases, the requisite national legislation must be adduced as this is a necessary component in order for the opponent to prove that the GI in question can prevent use of the subsequent mark and that the opponent is entitled by the law governing the right to exercise this right.

5.2.3.1 International agreements entered into by the EU

GIs deriving from agreements between the EU and third countries can be invoked under Article 8(6) EUTMR if the provisions of these agreements vest the GI **in a particular beneficiary or a precise class of users** that have a direct right of action.

Article 8(6)(i) EUTMR requires that a GI already be applied for and be subsequently registered. However, this provision can also be applied by way of analogy to third-country GIs protected under international agreements. In the case of international agreements to which the EU is a party, the date of entry into force of the international

agreement is deemed to be the date of priority of such a GI (and in the case of a third-country GI added subsequently to the list, the date of entry into force of the relevant amendment), unless the international agreement stipulates an earlier date of priority.

The EU is a Contracting Party to the Geneva Act of the Lisbon Agreement, which entered into force on 26 February 2020. GIs originating in non-EU countries protected under the Geneva Act of the Lisbon Agreement can be relied on in oppositions under Article 8(6) EUTMR provided that they were granted protection in the EU by the Commission through Regulation (EU) 2019/1753 of the European Parliament and of the Council of 23/10/2019 on the action of the Union following its accession to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (the 'Regulation (EU) 2019/1753') and provided that the contested trade mark was applied for after the notification of WIPO to the Commission of the international registration of the GI.

If the contested mark was applied for before the notification to the Commission of the international registration but after the filing of the international registration with the International Bureau, the GI only constitutes an *earlier* right if the opponent proves that the trade mark was applied for in bad faith.

The substantive law on which the opposition must rely when invoking GIs protected under the Geneva Act is Article 11(1) and (3) of the Geneva Act in conjunction with Regulation (EU) 2019/1753. For further details, see paragraph 5.3.2 below and the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 6.2.3, GI is Protected under the Lisbon System (Geneva Act).

5.2.3.2 International agreements entered into by Member States including the Lisbon Agreement ⁽⁶²⁾

For the reasons set out in paragraph 5.2.1.2 above, a GI protected under an international agreement concluded by Member States (either among Member States or with third countries) cannot be invoked as an earlier right under Article 8(6) EUTMR if it encroaches upon the exhaustive nature of EU law in the relevant areas (currently certain foodstuffs and other agricultural products, wines, spirit drinks and aromatised wines).

In the 'Budějovický Budvar' case (08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521), the Court discussed the exhaustive nature of EU law as regards GIs originating from Member States. In the Office's interpretation, this also applies a fortiori to third-country GIs in the relevant product fields that enjoy protection in the territory of a Member State through an international agreement concluded between that Member State and a non-EU country ⁽⁶³⁾.

⁶² Some Member States (Bulgaria, Czech Republic, France, Italy, Hungary, Portugal and Slovakia) are party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 (as revised at Stockholm on 14/07/1967, and as amended on 28/09/1979). The European Union is **not** a signatory to the Lisbon Agreement.

⁶³ To which the EU is not a contracting party.

This equally applies to the Lisbon Agreement. In principle, appellations of origin protected in an EU Member State by virtue of the Lisbon Agreement cannot be a basis for opposition under Article 8(6) EUTMR. The only exceptions in this regard are the following.

- International agreements that cover GIs that do not relate to foodstuffs, wines, spirit drinks or aromatised wines.
- International agreements concluded with third countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to the EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307 of the Treaty establishing the European Community, now Article 351 (TFEU), as interpreted by the Court in its judgment of 18/11/2003, C-216/01, Budějovický Budvar, EU:C:2003:618, § 168-172).
- International agreements concluded with a third country by a Member State after its accession to the EU, but before the entry into force of the uniform EU system of protection in the given product area.

As Member States are under an obligation to eliminate incompatibilities with EU law, the Office will apply the last two exceptions (which exclusively concern third country GIs in the fields of foodstuffs, wines, spirit drinks or aromatised wine products) **only when the opponent expressly refers to the exception and supports it by a coherent line of argument and relevant evidence** (in particular, concerning the date of entry into force of the cited international agreement in the EU Member State where protection is claimed and its continued validity). General allegations by the opponent (such as merely citing the relevant international agreement) will not be sufficient in themselves for the Office to consider that one of the latter two exceptions applies.

5.3 Scope of protection of GIs

5.3.1 Situations Covered by the EU Regulations

The **scope of protection of GIs protected under EU Regulations** is governed by Article 13(1) of Regulation (EU) No 1151/2012, Article 103(2) of Regulation (EU) No 1308/2013, Article 21 of Regulation (EU) 2019/787 and Article 20(2) of Regulation (EU) No 251/2014. The provisions preventing registration, Article 14(1) of Regulation (EU) No 1151/2012, Article 102(1) of Regulation (EU) No 1308/2013, Article 36(1) of Regulation (EU) 2019/787 and Article 19(1) of Regulation (EU) No 251/2014, are not a basis for opposition under Article 8(6) EUTMR (12/06/2007, T-60/04 - T-64/04, Bud, EU:T:2007:169, § 78); such an opposition cannot depend on whether the opponent fulfilled the conditions required to prohibit registration under the said provisions (18/09/2015, T-387/13, COLOMBIANO HOUSE / CAFE DE COLOMBIA, EU:T:2015:647, § 40 et seq.). Therefore, under Article 8(6) EUTMR, a GI can prevail if the conditions set out in the provisions preventing use are met.

The EU regulations refer, *mutatis mutandis*, to different situations of ‘use’ against which GIs are protected:

1. any use of a GI (direct or indirect):
 - a. in respect of comparable products; or
 - b. insofar as such use exploits the reputation of a GI;
2. any misuse, imitation or evocation;
3. Any other false or misleading indications or practices.

It must be emphasised that what applies are the specific conditions of the scope of protection as laid down in the applicable provisions and not, for example, the ‘similarity of signs’, ‘similarity of goods and services’ or ‘likelihood of confusion’.

Detailed information on the scope of protection of GIs protected under the relevant EU regulations is included in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR) (e.g. definitions of direct and indirect use, imitation, evocation, misuse, misleading indication and practices, objectionable products).

There is a distinction between absolute and relative grounds of assessment. This distinction is based either on the goods that are being opposed, on the fact that the Office will need evidence to be able to assess any possible exploitation of reputation or intention, or on the fact that something indeed should be considered a misleading indication or practice. As the absolute grounds assessment is limited either by the EU GI regulations, namely Article 14(1) of Regulation (EU) No 1151/2012, Article 102(1) of Regulation (EU) No 1308/2013, Article 19(1) of Regulation (EU) No 251/2014 and Article 36(1) of Regulation (EU) 2019/787 with respect to the objectionable goods and related services, or by the fact that submission of evidence is required, these are the possible conflicts that are left to the relative grounds assessment.

Should the opponent claim in its submission that, for example, the EUTM ‘uses’ a GI and the goods applied for are of the same type as those covered by that GI, the Office will, if this is indeed the case, reopen the examination on the absolute grounds. The same would apply in the event of claimed ‘evocation’ when the goods and, possibly, related services are those protected by the GI relied on.

5.3.1.1 Exploitation of the reputation of the GI

The provisions of the EU regulations preventing use contemplate situations where a GI can be invoked against goods or services that do not necessarily fall within the scope of objectionable goods and services under the *ex officio* examination of absolute grounds, subject to the conditions of the relevant provisions of the corresponding EU regulations. The scope of protection of GIs in an *ex officio* examination must be read in line with the mandate contained in the provisions preventing registration: Article 14(1) of Regulation (EU) No 1151/2012, Article 102(1) of Regulation (EU) No 1308/2013, Article 19(1) of Regulation (EU) No 251/2014 and Article 36(1) Regulation (EU) 2019/787. The Office interprets those provisions as limiting the refusal of trade mark registration to specific products. See also the Guidelines, Part B, Examination,

Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 4.5.

Under Article 13(1)(a) of Regulation (EU) No 1151/2012, Article 103(2)(a)(ii) of Regulation (EU) No 1308/2013, Article 21(2)(a) of Regulation (EU) 2019/787 and Article 20(2)(a)(ii) of Regulation (EU) No 251/2014, a GI can be invoked against goods and services that would not be objectionable *ex officio* under absolute grounds, subject to use of the GI in the contested EUTM and proof that such use in relation to the contested goods and services **would exploit the reputation of the GI**. On 'use of a GI' see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 4.1. Therefore, the exploitation of reputation argument can only be put forward when there is 'use' of a GI, and the opponent shows the possible exploitation of reputation of the GI for goods not covered by the GI and services unrelated to the GI (as goods and services related to the GI would already be objectionable under Absolute Grounds assessment).

The reputation of GIs depends on their image in the minds of consumers, and that image, in turn, depends essentially on particular characteristics and more generally on the quality of the product. It is on the quality of the product that its reputation is based (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 81-82). Therefore, contrary to situation with trade marks, where reputation is quantitatively assessed, the reputation of a GI is linked only to the quality of the product that it designates. All registered GIs offer a guarantee of quality due to their geographical provenance. Therefore, the Office considers that GIs **are intrinsically reputed** within the meaning of Article 13(1)(a) of Regulation (EU) No 1151/2012, Article 103(2)(a)(ii) of Regulation (EU) No 1308/2013, Article 21(2)(a) of Regulation (EU) 2019/787 and Article 20(2)(a)(ii) of Regulation (EU) No 251/2014 by the mere fact that they are registered. This is irrespective of whether a GI has been registered on the basis of a claim in the application to its reputation being essentially attributable to its geographical origin (Article 5(2)(b) of Regulation (EU) No 1151/2012, Article 93(1)(b)(i) of Regulation (EU) No 1308/2013, Article 3(4) of Regulation (EU) 2019/787 and Article 2(3) of Regulation (EU) No 251/2014).

Consequently, opponents **do not have to submit evidence of the reputation** of the GI. Nevertheless, opponents must submit **convincing arguments and/or evidence regarding the exploitation of the reputation of the GI**. The Court held that '[t]he incorporation in a trade mark of a name which is protected ... cannot be held to be capable of exploiting the reputation of that [name] ... if that incorporation does not lead the relevant public to associate that mark or the goods in respect of which it is registered with the [name] concerned or the ... product in respect of which it is protected' (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 115).

As a rule, general allegations (such as merely citing the relevant wording of the EU regulations) of exploitation of the reputation **will not be sufficient in themselves** for proving such exploitation: the opponent must adduce evidence and/or develop a cogent line of argument, taking into account both rights, the goods and services in

question and all the relevant circumstances, to demonstrate specifically how the alleged injury might occur.

5.3.1.2 Misuse and misleading indications and practices

For ‘misuse’ and ‘misleading indications and practices’ see Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 4.

5.3.1.3 Limits to the scope of protection of GIs on relative grounds

The scope of protection of GIs under EU regulations cannot exceed what is required in order to safeguard the function of the GI, which is to designate goods as being from a particular **geographic origin** and as having the **special qualities connected therewith**. Unlike other signs, GIs are not used to indicate the commercial origin of goods and afford no protection in this regard.

Therefore, where the specification of an EUTM application **is limited, in relation to goods identical to the product covered by the GI, to goods in conformity with the specification of the relevant GI**, the function of the GI in question is safeguarded in relation to those products because the EUTM application only covers products from the particular **geographic origin and the special qualities connected therewith**. Consequently, an opposition against an EUTM application that has been appropriately limited will not succeed. See in this regard Article 12(1) of Regulation (EU) No 1151/2012 or Article 103(1) of Regulation (EU) No 1308/2013. For general information on limits to the scope of protection of GIs, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 4.6.

5.3.2 Scope of protection of GIs protected under national law or international agreements

The scope of protection of GIs protected under national law or international agreements, including agreements concluded by the EU with third countries, is **governed by the relevant provisions** (e.g. for the abovementioned Hungarian GI ‘HEREND’, by Article 109 of Act XI of 1997 on the protection of trade marks and geographical indications; for the GI ‘Mezcal’, by the relevant provisions of the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designations for spirit drinks (OJ L 152, 11.06.1997, page 16). The substantive provisions of the agreement concerned may for instance include specific requirements or authorisation for the use of the protected term. See also the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 6.2.

As regards the scope of protection of GIs protected under the Geneva Act to which the European Union is a contracting party, and in particular its Article 11, please see the

Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 6.2.3, GI is Protected under the Lisbon System (Geneva Act).

The Office considers that in spite of the different wording of Article 11(1) of the Geneva Act, the scope of protection corresponds to that of the GIs protected under the EU Regulations (i.e. against direct and indirect use of the GI for the same and comparable products, exploitation of reputation of the GI, misuse, imitation or evocation or other misleading indications and practices). In this respect, the Office considers that the notion of 'goods that are not of the same kind' is analogous to the notion of 'non-comparable goods' under the EU Regulations providing for the protection of GIs.

Finally, unlike in the *ex officio* examination of absolute grounds of refusal, an opposition based on Article 8(6) EUTMR can be successful against goods and services that are not comparable to those for which the GI is protected, provided that the opponent submits evidence and arguments to prove that either Article 11(1)(a)(ii) or Article 11(1)(b) of the Geneva Act apply to such non-comparable goods or services.

***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’⁶⁴) 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:

⁶⁴ () 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⁽⁶⁵⁾ 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.

⁶⁵ () 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 newspapers and on many television channels 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 market share of BOTOX in the United Kingdom, 74.3 % in 2003 , 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 to assess the market share 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 newspapers and on many television channels that can be read/viewed throughout Europe. The opponent also submitted evidence of substantial investments in advertising . 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 advertisements in newspapers and magazines, showing its promotional activity, 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>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, the goods at issue concern related market sectors. 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. 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 (paras 65 to 79).</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>Visually the signs give a different overall impression, 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 close aural similarity 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 conceptually different 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 the visual and conceptual differences between the marks prevented any assumption of a possible link between them (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 differ visually 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. There is a low degree of phonetic similarity between the signs taken as a whole. Conceptually, the word 'corona', meaning 'crown' in Spanish, does not have any meaning in Estonian, Latvian or Lithuanian. Accordingly, no conceptual comparison is possible between the signs at issue 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, 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 (paras 30 to 34 and 49).</p>		

3.4 The risk of injury ⁶⁶

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

⁶⁶ 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>	

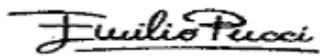

Earlier reputed sign	EUTM application	Case No
Nasdaq		10/05/2007, T-47/06, EU:T:2007:131
<p>'Taking account of the fact that the financial and stock market listing services supplied by the intervener under its trade mark Nasdaq and, therefore, the trade mark Nasdaq itself, undeniably present a certain 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	TDK-EPC	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


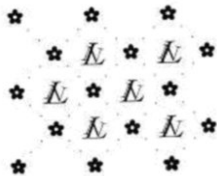
an earlier reputed mark, this would in any case normally take unfair advantage of the distinctive character or repute of the earlier trade mark or be detrimental to its distinctiveness.

Cases on dilution by tarnishing

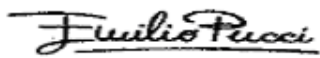
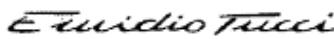
Tarnishment established

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 in Class 16, Travel agency in Class 39</i>	
<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
15/06/2009, R 1142/2005-2, MARIE CLAIRE (fig.) / MARIE CLAIRE et al.	<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 the interveners have acquiesced to the use of Citigate in relation to the goods and services covered by the application for registration, the Court stated that the 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.</p> <p>In the present case, coexistence was not proven.</p>

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

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

Part C

Opposition

Section 6

Proof of use

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Obsolete

1 General Considerations

1.1 Function of proof of use

European Union legislation on trade marks establishes an obligation for the owner of a registered trade mark to use that mark in a genuine manner. The owner must put the mark to genuine use within a period of 5 years following its registration (Article 18(1) EUTMR). However, the owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use of the mark in order to rely upon it — including in opposition proceedings before the Office. During the grace period, the mere formal registration gives the mark full protection. Once this period lapses, the owner may be required to prove genuine use of the earlier mark.

The reason behind the requirement that earlier marks must be put to genuine use is to restrict the number of trade marks registered and protected and, consequently, the number of conflicts between them (12/03/2003, T-174/01, Silk Cocoon, EU:T:2003:68, § 38).

When it comes to the requirement to prove use in opposition proceedings before the Office, it is important to bear in mind that the purpose of Article 47(2) and (3) EUTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to only large-scale commercial use of the marks (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 32; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38).

The Office does not inquire *ex officio* whether the earlier mark has been used. Such examination takes place only when the EUTM applicant makes an explicit request for proof of use. Such a request, if the legal requirements are met, triggers the procedural and substantive consequences laid down in the EUTMR, EUTMDR and EUTMIR.

1.2 Legislative framework

The legislative framework consists of provisions of the EUTMR, the EUTMDR, the EUTMIR and Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks ⁽⁶⁷⁾ (the Directive), as implemented in the national law of the Member States.

⁶⁷ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

1.2.1 EUTMR, EUTMDR and EUTMIR

1.2.1.1 Article 18 EUTMR — obligation to use registered marks

Article 18 EUTMR stipulates the basic substantive requirement for the obligation to use registered marks. It reads as follows:

If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

Article 18(1)(a) EUTMR states that use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered constitutes use. This applies regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor. Article 18(1)(b) EUTMR states that affixing the EU trade mark to goods or to the packaging of goods in the Union also constitutes use, even when solely for export purposes.

According to Article 18(2) EUTMR, use of the EUTM with the consent of the proprietor will be deemed to constitute use by the proprietor.

1.2.1.2 Article 47 EUTMR — consequences of lack of use

The consequences of a lack of use in opposition proceedings are dealt with in Article 47(2) and (3) EUTMR. According to Article 47(2) EUTMR:

If the applicant so requests, the proprietor of an earlier EU trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of filing or the date of priority of the EU trade mark application, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier EU trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier EU trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

This wording is the result of Amending Regulation (EU) 2015/2424 ⁽⁶⁸⁾, which entered into force on 23/03/2016. Previously, the 5-year period was computed backwards from the date of publication of the contested EUTM application. For oppositions filed before the date of entry into force of Amending Regulation (EU) 2015/2424, the relevant

⁶⁸ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2839/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

period will continue to be counted from the date of publication of the contested EUTM application.

In accordance with Article 47(3) EUTMR:

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Union.

There is no express provision in the EUTMR that such forms of use as mentioned in Article 18(1) and (2) EUTMR may also be regarded as use of earlier national trade marks. However, the concept of the obligation to use the registered mark is harmonised as a consequence of Article 10(2) and (3) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version). Hence, it is appropriate to apply the same substantive provision as Article 18(1) and (2) EUTMR to the use of earlier national trade marks, with the only difference being that such use must be made in the Member State in which the national mark is registered.

Moreover, it follows from the wording of Article 47(2) and (3) EUTMR that proof of use can only be requested if the earlier right is an **EUTM** or other **trade mark** having effect in the EU or an EU Member State, as defined in Article 8(2)(a) EUTMR. Since oppositions brought under **Article 8(4) EUTMR** cannot be based on either EUTMs or other trade marks referred to in Article 8(2)(a) EUTMR, the EUTM applicant is not entitled to request proof of use for earlier rights relied upon in oppositions brought under this provision. Nevertheless, Article 8(4) EUTMR requires the opponent to prove use in the course of trade of more than mere local significance for the earlier rights in question.

As for **Article 8(3) EUTMR**, the Office's practice is that requests for proof of use of the earlier right cannot be made. The reason is that such earlier rights include both trade marks having effect in the EU/EU Member States (EUTMs, national trade marks, IRs) **and** national non-EUTMs, requests for proof of use of the latter not being possible under the EUTMR. It would be discriminatory to request proof of use for some countries' trade marks but not for others. Accordingly, and in view of the specific subject matter for protection under Article 8(3) EUTMR, while the use or lack of use made of the earlier rights may have a bearing on arguments regarding the justification for applying for the EUTM, the opponent cannot be obliged to provide proof of use under Article 47(3) EUTMR for any earlier rights thereby relied upon.

1.2.1.3 Article 10 EUTMDR — procedural rules, evidence and language

In accordance with Article 10(2) EUTMDR, where, pursuant to Article 47(2) or (3) EUTMR, the opponent has to submit proof of use or show that there are proper reasons for non-use, the Office will invite the opponent to provide the proof required within a period specified by the Office. If the opponent does not provide such proof before the time limit expires, the Office will reject the opposition.

In accordance with Article 10(3) EUTMDR, the indications and evidence required to prove use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

In accordance with Article 10(4) EUTMDR, the evidence must consist of written documents and in principle be confined to supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR.

In accordance with Article 10(5) EUTMDR, a request for proof of use may be submitted at the same time as observations on the grounds on which the opposition is based. Such observations may also be filed together with the observations in reply to the proof of use.

In accordance with Article 10(6) EUTMDR, where the evidence submitted pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of the evidence in that language, within a period specified by the Office.

The detailed rules of procedure relating to the proof of use request are described in the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5.

1.2.2 The Directive and national law implementing it

Article 16 of the Directive contains provisions identical to Article 18 EUTMR, except with 'use in the Union' being replaced by 'use in the Member State'.

2 Substantive Law

2.1 Genuine use: the principles of the Court of Justice

The EUTMR, the EUTMDR and the EUTMIR do not define what is to be regarded as 'genuine use'. However, the Court of Justice (the 'Court') has laid down several important principles as regards the interpretation of this term.

In *Minimax* (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145), the Court established the following principles:

- genuine use means **actual** use of the mark (paragraph 35);
- genuine use must, therefore, be understood to denote use that is **not merely token**, serving solely to preserve the rights conferred by the mark (paragraph 36);
- genuine use must be consistent with the **essential function** of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others that have another origin (paragraph 36);

(⁶⁹)

- genuine use entails use of the mark **on the market** for the goods or services protected by that mark and not just internal use by the undertaking concerned (paragraph 37);
- genuine use must relate to **goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (paragraph 37);
- when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is **real**, in particular whether such use is viewed as warranted in the economic sector concerned to **maintain or create a share in the market** for the goods or services protected by the mark (paragraph 38);
- the circumstances of the case may, therefore, include giving consideration, inter alia, to the **nature** of the goods or services at issue, the **characteristics of the market** concerned and the scale and **frequency** of use of the mark (paragraph 39);
- use need **not**, therefore, always be **quantitatively significant** for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (paragraph 39).

In its order of 27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, the Court further elaborated the *Minimax* criteria as follows:

- the question whether use is sufficient to preserve or create market share for the goods or services concerned depends on several factors and on a case-by-case assessment. The **characteristics** of the goods and services, the **frequency or regularity** of the use of the mark, whether the mark is used for the purpose of marketing **all** the identical goods or services of the proprietor or merely some of them, or evidence that the proprietor is able to provide, are among the factors that may be taken into account (paragraph 22);
- use of the mark by a single client that **imports** the goods for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (paragraph 24);
- a **de minimis** rule cannot be laid down (paragraph 25).

2.2 Genuine use: standard of proof applied by the Office

Article 47 EUTMR requires **proof** of genuine use of the earlier mark. Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 22).

⁶⁹ The criterion of 'identity of origin' applies only to individual marks. As regards the essential function of collective and certification marks and the consequences for assessing genuine use, see paragraph 2.3.1.2 below.

Moreover, the Office cannot determine *ex officio* the genuine use of earlier marks. Even proprietors of purportedly well-known marks must submit evidence to prove genuine use of the earlier mark(s).

The Office does not necessarily require a high threshold of proof of genuine use. The Court has indicated that it is not possible to prescribe, in the abstract, **what quantitative threshold should be chosen** in order to determine whether use was genuine or not, and accordingly there can be no objective *de minimis* rule to establish a priori the level of use needed in order for it to be 'genuine'. So, whilst a minimum extent of use must be shown, what exactly constitutes this minimum extent depends on the circumstances of each case. The general rule is that, when it serves a real commercial purpose, **even minimal use of the trade mark could be sufficient to establish genuine use**, depending on the goods and services, and the **relevant market** (23/09/2009, T-409/07, *acopat*, EU:T:2009:354, § 35 and case-law cited therein; 02/02/2012, T-387/10, *Arantax*, EU:T:2012:51, § 42).

In other words, it is sufficient if the evidence of use proves that the trade mark owner has seriously tried to acquire or maintain a commercial position in the relevant market. However, not just any proven commercial exploitation can automatically be qualified as genuine use of the mark in question (17/07/2014, C-141/13 P, *Walzer Traum*, EU:C:2014:2089, § 32). Use may still be insufficient even where commercial exploitation has been proven to a certain extent.

According to Article 10(3) EUTMDR, the indications and evidence required in order to provide proof of use must concern the **place, time, extent and nature of use** of the opponent's trade mark for the relevant goods and services.

These requirements for proof of use are **cumulative** (05/10/2010, T-92/09, *STRATEGI / Stratégies*, EU:T:2010:424, § 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the **entirety** of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, *Friboi*, EU:T:2011:47, § 31).

Thus, the Office evaluates the evidence submitted in **an overall assessment**. All the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed **in conjunction with each other**. Therefore, although pieces of evidence may be insufficient by themselves to prove the use of an earlier trade mark, they may contribute to proving use in combination with other documentation and information.

Evidence of use may be **of an indirect/circumstantial nature**, such as evidence about the share in the relevant market, the importing of the relevant goods, the supply of the necessary raw materials or packaging to the owner of the mark, or the expiry date of the relevant goods. Such indirect evidence can play a decisive role in the overall assessment of the evidence submitted. Its probative value has to be carefully assessed. For instance, the judgment of 08/07/2010, T-30/09, *Peerstorm*,

EU:T:2010:298, § 42 et seq. found that catalogues in themselves could — under certain circumstances — be conclusive evidence of sufficient extent of use.

It is necessary to take into account **the specific kind of the goods and services involved** when assessing the probative value of the evidence submitted. For example, it may be common in a particular market sector for the samples of the goods and services themselves not to bear indications of the place, time, extent and nature of use. In these cases it is obviously inappropriate to disregard such evidence of use if indications in this respect can be found in the other evidence submitted.

Each of the documents submitted has to be carefully evaluated as to whether it really reflects use in the 5 years preceding the date of filing or the date of priority of the EUTM application (see paragraph 2.5 below) and use in the relevant territory (see paragraph 2.4 below). ⁽⁷⁰⁾ In particular, the dates and place of use shown on orders, invoices and catalogues are carefully examined.

Material submitted **without any indication of date of use** may, in the context of an overall assessment, still be relevant and taken into consideration **in conjunction with other pieces** of evidence that are dated (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 33). This is the case in particular if it is common in a particular market sector for the samples of the goods and services themselves not to bear indications of time (05/09/2001, R 608/2000-4, PALAZZO / HELADERIA PALAZZO, § 16, noting that ice-cream menus are rarely dated).

For implementation of the abovementioned general principles in practice, see the examples in paragraph 3.7.5 below.

2.3 Nature of use

The term 'nature of use' refers to:

- use of a mark in accordance with its essential function (paragraph 2.3.1 below);
- use of the mark as registered or of a variation thereof in accordance with Article 18(1)(a) EUTMR (paragraph 2.7 below); and
- use in connection with the goods and services for which it is registered (paragraph 2.8 below).

2.3.1 Use of a mark in accordance with its function

2.3.1.1 Use of individual marks

Article 18 and Article 47(2) EUTMR require proof of genuine use in connection with the goods or services for which the trade mark is registered and which the opponent cites as justification for its opposition. Hence, the opponent has to show that the mark has been used as a trade mark on the market.

⁷⁰ Publication date of the contested EUTM application in the event of oppositions filed before 23/03/2016, see paragraph 2.5.2 below.

As a trade mark has, inter alia, the function of operating as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a **clear link between the use of the mark and the relevant goods and services**. As clearly indicated in Article 10(4) EUTMDR, it is not necessary for the mark to be affixed to the goods themselves (12/12/2014, T-105/13 TrinkFix, EU:T:2014:1070, § 28-38). A representation of the mark on packaging, catalogues, advertising material or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use (see also paragraph 2.3.3.2 below).

Genuine use requires that use is made as a **trade mark**:

- not for purely illustrative purposes or on purely promotional goods or services,
- in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43).

Therefore, by way of example, the following are **not suitable** for supporting genuine use of a **trade mark**.

1. Use as a **certification mark**. Certification marks can be obtained in some jurisdictions for compliance with defined standards. The holder of a certification mark is not the authorised user, producer or provider of the certified goods or services, but rather the certifier, which exercises legitimate control over use of the certification mark. Certification marks may be used together with the individual trade mark of the producer of the certified goods or of the provider of the certified services. The essential function of a certification mark is different from the essential function of an individual trade mark: while the latter primarily serves to identify the origin of goods and services, the former serves to certify that the goods or services meet certain established standards and possess particular characteristics. Therefore, use as a certification mark does not serve as use as an individual trade mark, because it does not guarantee to consumers that the goods or services come from a single undertaking under the control of which the goods or services are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services (08/06/2017, C-689/15, Cotton Flower, EU:C:2017:434, § 45).
2. Use as a **Geographical Indication (GI)**. The essential function of GIs is to designate the origin of goods as being from a particular region or locality. This is in contrast with the main function of an individual trade mark, namely to serve as an indicator of commercial origin. When a GI is contained within an individual mark that guarantees to consumers that the goods which it designates come from a single undertaking under the control of which those goods are manufactured and which is responsible for the quality of those goods, the opponent must submit proof of use as an individual mark (07/06/2018, T-72/17, Steirisches Kürbiskernöl (fig.), EU:T:2018:335, § 52; 17/10/2019, C-514/18 P, Steirisches Kürbiskernöl (fig.), EU:C:2019:878, § 37-43). Evidence of use as a GI (e.g. general statements of Regulatory Councils) cannot serve for proving use as an individual mark. For more information on geographical indications see the Guidelines, Part B, Examination,

Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR.

Depending on the circumstances, the following situations may be suitable for supporting genuine use of the registered trade mark. That is because use of the sign can serve more than one purpose at the same time. Consequently, the following uses can also be use of the sign as a trade mark. However, the purpose for which a sign is used needs to be assessed individually.

1. **Use of a sign as a business, company or trade name** can be regarded as trade mark use provided that the relevant goods or services themselves are identified and offered on the market under this sign (13/04/2011, T-209/09, Alder Capital, EU:T:2011:169, § 55-56). In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services), or appears on the back of a catalogue or as an incidental indication on a label (18/01/2011, T-382/08, Vogue, EU:T:2011:9, § 47).

In principle, use of the sign as a **company name or trade name**, is not, of itself, intended to distinguish goods or services. The purpose of a **company name** is to identify a company, whereas the purpose of a **trade name or a shop name** is to designate a business that is being run. Accordingly, where use of a company name, trade name or shop name is limited to identifying a company or designating a business that is being run, such use cannot be considered as being 'in relation to goods or services' (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21; 13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156, § 31-32).

Use of a business, company or trade name can be regarded as **use 'in relation to goods'** where:

- a party **affixes the sign** constituting its company name, trade name or shop name to the goods or;
- even though the sign is not affixed, the party uses the sign in such a way that a **link is established** between the company, trade or shop name and the goods or services (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21-23).

Provided that either of these two conditions is met, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 38).

For example, the presentation of the business name at the top of **order forms or invoices** may, depending on how the sign appears on them, be suitable to support genuine use of the registered trade mark (06/11/2014, T-463/12, MB, EU:T:2014:935, § 44-45). Simultaneous use of the company name and the trade mark on invoices may, when the two indications can be clearly distinguished, prove use of the sign as an indicator of the commercial origin of the services provided, irrespective of the fact that the invoices may also show other sub-brands (03/10/2019, T-666/18, ad pepper (fig.), EU:T:2019:720, § 82-84).

However, mere use of a business name at the top of invoices without a clear reference to specific products/services is not sufficient.

2. Use of a **sign as a domain name or as part of a domain name** primarily identifies the website as such. However, depending on the circumstances, such use may also be use of a registered mark (this presupposes that it connects to a site on which the goods and services appear).

The mere fact that the opponent has registered a domain name containing the earlier trade mark is not sufficient in itself to prove genuine use of the trade mark. It is necessary for the party to prove that the relevant goods or services are offered under the trade mark contained in the domain name.

2.3.1.2 Use of collective and certification marks

National and EU collective marks and certification marks can also constitute 'earlier trade marks' within the meaning of Article 8(2) EUTMR on which an opposition can be based and, as such, be subject to the requirement of use pursuant to Article 47(2) and (3) EUTMR.

The requirements of the EUTMR relating to the conditions of use apply. However, the different function of these marks must be taken into account. The opponent must demonstrate that the authorised persons (see paragraph 2.9.3 below) used the collective or certification mark in accordance with its essential function.

The essential function of a **collective mark** is to distinguish the goods or services of the members of the **association** that is the proprietor of the mark from those of other undertakings (20/09/2017, C-673/15 P & C-674/15 P & C-675/15 P & C-676/15 P, DARJEELING (fig.) / DARJEELING et al., EU:C:2017:702, § 63). The specific characteristic of collective marks is to indicate the **collective** commercial origin of the goods or services, that is to say to indicate that certain products or services come from a member of a certain 'collective', which is the proprietor of the collective mark, and not an **individual** commercial origin as is the case with individual marks. Therefore, unlike an individual mark, a collective mark does not have the function of indicating to consumers 'the identity of origin' of the goods or services in respect of which it is registered. Manufacturers, producers, suppliers or traders who are affiliated with the association that is the proprietor of a collective mark do not have to form part of the same group of companies that manufacture or supply the goods or services under unitary control. In fact, they can be competitors, each of which uses, on the one hand, the collective mark indicating their affiliation with that association and, on the other, an individual mark indicating the identity of origin of their goods or services. However, like an individual mark, a collective mark must be used by the members of the association to create or preserve an outlet for the registered goods or services (12/12/2019, C-143/19 P, EIN KREIS MIT ZWEI PFEILEN (fig.), EU:C:2019:1076).

The essential function of a **certification mark** is not to indicate **commercial** origin, as for individual and collective marks, but to differentiate the goods and services that are certified by the proprietor of the mark as meeting established standards and possessing particular characteristics from those that are not thus certified. For the use

of a certification mark to be considered genuine, it must be used in accordance with this essential function.

2.3.2 Public use in the course of trade

2.3.2.1 Public use versus internal use

The use must be public, that is to say it must be external and apparent to actual or potential customers of the goods or services. Use in the private sphere or purely internal use within a company or a group of companies does not amount to genuine use (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 22; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 09/09/2015, T-584/14, ZARA, EU:T:2015:604, § 33).

The mark must be used **publicly and outwardly** in the context of commercial activity with a view to economic advantage for the purpose of ensuring an outlet for the goods and services that it represents (12/03/2003, T-174/01, Silk Cocoon, EU:T:2003:68, § 39; 30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135, § 38). Outward use does not necessarily imply use aimed at end consumers. For instance, the relevant evidence can validly stem from an **intermediary**, whose activity consists of identifying professional purchasers, such as distribution companies, to which the intermediary sells products it has had manufactured by original producers (21/11/2013, T-524/12, RECARO, EU:T:2013:604, § 25-26).

Relevant evidence can also validly come from a **distribution company** that forms part of a group. Distribution is a method of business organisation that is common in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of companies, since the mark is also used outwardly and publicly (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32).

Use of the mark must **relate to goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Mere preparation to use the mark — such as the printing of labels, producing of containers, etc. — is internal use and, therefore, not use in the course of trade for the present purposes (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37).

2.3.2.2 Commercial activity versus promotional activity

Where the mark is protected for goods or services of **not-for-profit enterprises**, and the mark has been used, the fact that there is no profit motive behind the use is irrelevant: 'The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services' (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 17).

Goods and services offered **free of charge** may constitute genuine use when they are offered commercially, that is to say with the intention of creating or maintaining an outlet for those goods or services in the EU, as opposed to the goods or services of other undertakings, and therefore of competing with them (09/09/2011, T-289/09, Omnicare Clinical Research, EU:T:2011:452, § 67-68).

Mere use of the mark on **promotional material for other goods** cannot normally be considered as sufficient (indirect) evidence of use within the meaning of trade mark law for the type of promotional items on which the mark is or has been used. For example, giving away articles of clothing such as T-shirts and baseball caps at promotional events with the purpose of marketing a certain other product, such as a drink, cannot be considered as genuine use of the mark at issue for clothing.

The Office practice concerning 'genuine use' with regard to promotional articles has been confirmed by the Court.

Earlier sign	Case No
WELLNESS	15/01/2009, C-495/07, EU:C:2009:10 (preliminary ruling)
<p>The opponent owned the mark 'WELLNESS' in Classes 25 and 32. In the context of selling its 'WELLNESS' clothing, it also used the mark to designate an alcohol-free drink, which was handed out in small bottles as a gift along with the clothing sold. No drinks were sold separately under the 'WELLNESS' mark.</p> <p>The Court held that, where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter, the mark loses its commercial raison d'être for the promotional goods and cannot be considered to have been genuinely used on the market for goods in that class (para. 22).</p>	

2.3.3 Use in relation to goods or services

2.3.3.1 Use in relation to goods

Trade marks have traditionally been used on goods (printed on the goods, on labels, etc.) or their packaging. However, showing use on goods or their packaging is not the only way of proving use in relation to goods. It is sufficient, if there is a proper connection between the mark and the goods, for the mark to be used 'in relation to' the goods or services, such as on brochures, flyers, stickers, signs inside places of sale, etc.

For example, when the opponent sells its goods only through catalogues (mail-order sales) or the internet, the mark may not always appear on the packaging or even on the goods themselves. In such cases, use on the (internet) pages where the goods are presented — provided it is otherwise genuine in terms of time, place, extent and nature (see paragraph 2.3.4.4 below) — will generally be considered sufficient. The owner of the mark will not have to provide proof that the mark actually appeared on the goods themselves.

Earlier sign	Case No
PETER STORM	08/07/2010, T-30/09, Peerstorm, EU:T:2010:298
<p>The evidence produced to show genuine use of the mark at issue may include catalogues. 'It must be pointed out that, in addition to items of clothing designated by different marks, more than 80 different items are offered for sale in that catalogue under the mark PETER STORM. They comprise men's and women's jackets, jumpers, trousers, tee-shirts, footwear, socks, hats and gloves, the respective characteristics of which are briefly described. The earlier mark appears, in stylised characters, next to each item. In that catalogue, the prices of the items in GBP and the reference number for each item are stated' (paras 38-39).</p>	

However, the situation is different when a trade mark is used, for example, in a catalogue or advertisements, or on bags or invoices, to designate the retailer of the goods and not the goods themselves.

Earlier sign	Case No
Schuhpark	13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156
<p>The General Court found that the use of the sign <i>Schuhpark</i> for footwear on advertisements, bags and invoices was not meant to identify the origin of the shoes (which bore their own mark or no mark at all) but rather the company name or trade name of the shoe retailer. This was considered insufficient to establish a link between the sign <i>Schuhpark</i> and the shoes. In other words, <i>Schuhpark</i> may well be a mark for the retail of shoes, but it was not used as a trade mark for goods (paras 31-32).</p>	

2.3.3.2 Use in relation to services

Marks cannot be directly used 'on' services. Therefore, use of marks registered for services will generally be on business paper, in advertising, or in some other way directly or indirectly related to the services. Where the use on such items demonstrates genuine use, such use will be sufficient.

Earlier sign	Case No
M&P	06/11/2014, T-463/12, MB, EU:T:2014:935

The earlier trade mark was registered in Class 42 for, inter alia, the services of a patent attorney. Its use on invoices, business cards and business correspondence was considered sufficient to show genuine use in connection with the services of a patent attorney.

STRATEGIES

05/10/2010, T-92/09, STRATEGI / Stratégies,
EU:T:2010:424

Where an earlier mark was registered for *business management* services and used as the title of business magazines, the General Court did not exclude that such use could be considered genuine for the services in question if it were shown that the magazine provides support for the supply of the *business management* services, i.e. if the services are provided through the medium of a magazine. The fact that there is no 'direct bilateral link' between the publisher and the recipient of the services does not impair such a finding of genuine use. This is because the magazine is not distributed free of charge, which could lend credibility to the claim that payment of the price of the magazine constitutes remuneration for the service provided (paras 31-35).

2.3.3.3 Use in advertising

Trade marks fulfil their function of indicating the commercial origin of goods or services and symbols of the goodwill of their owner not only when they are actually used on or for goods or services, but also when they are used in advertising. In fact, the advertising or market communication function of trade marks is one of their most important functions.

Therefore, use in advertising will generally be considered as amounting to genuine use:

- if the volume of advertising is sufficient to constitute genuine public use of the mark; and
- if a relation can be established between the mark and the goods or services for which the mark is registered.

The Court confirmed this approach in the *Minimax* case, where it held that use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, **particularly in the form of advertising campaigns** (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37).

However, the outcome in a particular case will depend very much on the individual circumstances, as demonstrated by the following examples:

Earlier sign	Case No
BLUME	28/10/2002, R 681/2001-1, Blumen Worldwide (fig.) / BLUME, LEOPOLDO BLUME
<p>Services: services of a publishing company in Class 41.</p> <p>The Board confirmed that the evidence (consisting of catalogues, press notes and advertisements) read in conjunction was enough to prove genuine use of the trade mark.</p> <p>'Although the order record and the receipt of the bank account do not provide any information on how and to what extent the mark was used in Spain, the remaining documents, namely the catalogues, press notes and advertisements, when read in conjunction, demonstrate that during the relevant period, the opponent has published in Spain books and magazines under the trade mark BLUME. Even if the opponent does not provide any invoices, orders or sales figures, there is some reason to assume that it advertised its books and magazines, promoted and sold them under the trade mark BLUME. Although the advertising documents and the press notes were identified and dated by the opponent, the trade mark BLUME is always mentioned in the press notes and on the cover page of the quoted books. In addition, the text is in the Spanish language and the price mentioned in pesetas. When read together with the catalogues, these press notes demonstrate that they refer to some of the books expressly quoted in the catalogues' (para. 23).</p>	

Earlier sign	Case No
BIODANZA	13/04/2010, R 1149/2009-2, BIODANZA (fig.) / BIODANZA; confirmed 08/03/2012, T-298/10, Biodanza, EU:T:2012:113

G&S: Classes 16 and 41.

The Board rejected the Opposition Division's finding that the evidence (only advertisements) proved genuine use.

It follows clearly from the finding of the contested decision that the evidence of use submitted by the opponent consists solely of advertisements that can prove only that the opponent advertised a yearly 'BIODANZA' festival during the whole of the relevant period and workshops on both a regular and irregular basis from 2002.

However, contrary to the finding of the contested decision, such advertisements cannot provide proof of their distribution to a potential German clientele. Nor can they prove the extent of any distribution or the number of sales or contracts made for the services protected by the mark. The mere existence of advertisements could, at most, make it probable or credible that the services advertised under the earlier mark were sold or, at least, offered for sale within the relevant territory, but it cannot prove this, as was unduly supposed by the contested decision.

Where advertising is carried out in parallel with the marketing of goods and services and there is proof of both activities, advertising will support the genuineness of the use.

Advertising in advance of the actual marketing of goods and services — if it is with a view to establishing a market for the goods or services — will generally be considered to constitute genuine use.

Whether mere advertising, without any current or future plans to actually market goods or services, constitutes genuine use appears doubtful. As in most other situations, the outcome will depend on the circumstances of each case. For example, where the goods or services are available abroad, such as holiday accommodation or particular products, advertising alone may be sufficient to amount to genuine use.

2.3.3.4 Use on the internet

The standard applied when assessing evidence in the form of printouts from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trade mark on websites can show inter alia the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, the mere presence of a trade mark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided.

Earlier sign	Case No
SHARP	20/12/2011, R 1809/2010-4, SHARPMaster / SHARP (fig.)

Earlier sign	Case No
The opponent submitted 'extracts from the opponent's websites for different countries'. The Board considered that 'simple print-outs from a company's own Internet page is not able to prove use of a mark for certain goods without complementary information as to the actual use of the Internet site by potential and relevant consumers or complementary advertising and sales figures regarding the different goods, photos of the goods with the corresponding mark etc.' (para. 33).	

Earlier sign	Case No
WALZERTRAUM	17/01/2013, T-355/09, Walzer Traum, EU:T:2013:22; confirmed 17/07/2014, C-141/13 P, Walzer Traum, EU:C:2014:2089
The opponent, a confectioner, which owns the German trade mark 'WALZERTRAUM' for goods in Class 30, sought to prove the extent of use of its mark by submitting evidence relating to an advertising brochure published on the internet, which gives general information about its working methods, the ingredients used for its products and the product range, including its 'WALZERTRAUM' chocolate. However, the goods could not be ordered online via the web page. For this reason the General Court held that a connection between the website and the number of items sold could not be established (para. 47).	

In particular, the value in terms of evidence of internet extracts can be strengthened by submitting evidence that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period. For instance, useful evidence in this regard could be records that are generally kept when operating a business web page, for example records relating to the number of hits attained at various points in time or, in some cases, the countries from which the web page has been accessed.

As to the **relevant period**, information on the internet or in online databases is considered to be of the date on which the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only from such websites. This includes, for example, online catalogues that are not available in printed format.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records that enable members of the public to establish precisely what was published when.

In this context, the date of use on the internet will be considered reliable in particular where:

- the website time-stamps each entry and thus provides information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google™ cache); or
- a screenshot of a web page bears a given date.

The evidence submitted must show that the online transactions were **connected with the goods or services** designated by the mark.

Earlier sign	Case No
ANTAX	02/02/2012, T-387/10, Arantax, EU:T:2012:51
The opponent has submitted, inter alia, internet extracts from the home pages of several tax consultancies using the opposing mark. The General Court considered that the indications on the internet pages allowed the reader to establish a link between the trade mark and the services provided (paras 39-40).	

Whereas the **nature of the mark** and, to a certain extent, the **time** (as seen above) and **place** are less complex elements to prove, the **extent of use** presents more difficulties if only evidence of internet use is provided. It should be taken into account that transactions on the internet tend to eliminate most of the ‘traditional’ evidence of sales such as invoices, turnover, taxation documents, etc. New ‘electronic’ evidence tends to substitute them, or has already substituted them, as certified means of payment, orders and confirmations thereof, registrations of safe transactions, etc.

Earlier sign	Case No
Skunk funk (fig.)	31/03/2011, R 1464/2010-2, SKUNK FU! (fig.) / SKUNK FUNK (fig.)
‘[E]xcerpts from third parties’ websites, despite having been printed out on 10 June 2008, contain consumers’ comments about ‘SKUNKFUNK’ clothes and shops dated within the relevant period. In particular, as regards the relevant territory, the documents show various comments made by consumers in Spain and dated December 2004 and February-March-April-May-July 2007. Moreover, as the Opposition Division pointed out, a blog comment (dated 4 March 2007) on the Internet page www.cybereuskadi.com mentions that the opponent (‘designer of Skunkfunk’) “exports surf clothes worldwide and has a turnover of nearly 7 million euros per year” (para. 21).	

2.4 Place of use

2.4.1 Use on the 'domestic' market

Trade marks must be used in the territory where they are protected (European Union for EUTMs, the territory of the Member State for national marks or Benelux for Benelux marks, and the territories of the relevant countries for international registrations).

As the Court held in para. 30 of *Leno Merken*, its judgment of 19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, 'the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not'. The Court further indicated that use of the mark in non-EU territories cannot be taken into account (para. 38).

In view of the globalisation of trade, an indication of the registered seat of the owner of the mark may not be regarded as sufficient indication that the use has taken place in that particular country. Even though Article 18(1)(b) EUTMR stipulates that the affixing of the trade mark to goods or to the packaging thereof in the European Union solely for export purposes is considered as use of the mark, mere indication of the opponent's seat as such does not constitute evidence of such acts. On the other hand, the fact that clients that have their seats outside the relevant territory are listed in the documents for proving use of the earlier mark is in itself not sufficient to rule out that services (e.g. promotion services) may actually have been rendered in the relevant territory for the benefit of these companies located in other territories (09/06/2010, R 952/2009-1, GLOBAL (fig.) / GLOBAL TABACOS (fig.), § 16).

2.4.2 EUTMs: use in the European Union

If the earlier mark is a European Union mark, it must be used 'in the Union' (Articles 18(1) and 47(2) EUTMR). Following *Leno Merken*, Article 18(1) EUTMR must be interpreted as meaning that the territorial borders of the Member States should be disregarded when assessing whether an EUTM has been put to 'genuine use' in the European Union (§ 44).

In territorial terms and in view of the unitary character of the EUTM, the appropriate approach is not that of political boundaries but of market(s). Moreover, one of the aims pursued by the EUTM system is to be open to businesses of all kinds and sizes. Therefore, the size of an undertaking is not a relevant factor for establishing genuine use.

As the Court indicated in *Leno Merken*, it is impossible to determine a priori and in the abstract what territorial scope should be applied in order to determine whether use of the mark is genuine or not (§ 55). Territorial scope is only one of several factors to be taken into account when assessing whether use of an EUTM is genuine. Furthermore, a *de minimis* rule for establishing whether that factor is satisfied cannot be laid down (07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 80).

An EUTM need not be used in an extensive geographic area for use to be deemed genuine, since this will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 55; 07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782 § 80).

All the relevant facts and circumstances must be taken into account, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 58).

Moreover, for use of an EUTM to be deemed genuine, the mark need not be used in a substantial part of the European Union. The possibility that it may have been used in the territory of only a single Member State must not be ruled out, since the borders of the Member States must be disregarded while the characteristics of the goods or services concerned must be taken into account (07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782, § 80).

The General Court has held on numerous occasions that use of an EUTM in a single Member State (for example, in Germany, in Spain, or in the United Kingdom), or even in a single city in a Member State of the European Union, is sufficient to satisfy the criterion of territorial scope (07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782, § 81 and the case-law cited).

For example, use of an EUTM in the United Kingdom (15/07/2015, T-398/13, TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57) or even in London and its immediate surroundings may be geographically sufficient (30/01/2015, T-278/13, now, EU:T:2015:57). The Board of Appeal decision of 07/03/2013, R 234/2012-2, now (fig.) (confirmed 30/01/2015, T-278/13, now, EU:T:2015:57), considered the use of an EUTM for wireless broadband services in Class 42 **in the geographical area comprising London and the Thames Valley** sufficient to constitute genuine use in the United Kingdom and also in the European Union, taking into account the territorial extent [London being ‘the largest city in the United Kingdom and the largest urban zone in the European Union’, having ‘a metropolitan area ... with an estimated total population of between 12 million and 14 million people’, being ‘the world’s leading financial centre along with New York’, ‘a leading centre of arts, science, tourism and media and information technology’, and having a profile on the European commercial scene ‘disproportionately high in respect to the services in question’ (R 234/2012-2, § 47), and the Thames Valley being ‘200 miles long and 30 miles wide’ and including ‘populous towns and cities of significant economic activity’ (R 234/2012-2, § 45-46)], the scale, frequency and regularity of use and the characteristics of the market concerned (R 234/2012-2, § 52).

In other words, whether an EUTM has been used in one Member State or several is irrelevant. What matters is the impact of use in the internal market and, more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a

commercially relevant presence of the goods and services in that market. Whether that use results in actual commercial success is not relevant (07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782, § 82).

The Office must determine on a case-by-case basis whether the various indications and evidence can be combined for the purpose of assessing the genuine character of use, the geographical dimension of which is only one of the aspects to be considered.

In any event, it must be underlined that the European requirements or standards for genuine use are applicable (i.e. the conditions of Article 18 EUTMR) and not national standards or practices applied to EUTMs.

2.4.3 National marks: use in the relevant Member State

If the earlier mark is a national mark with effect in one of the Member States of the European Union, the mark must have been genuinely used in the country where it is protected (Article 47(3) EUTMR). Use in a part of the Member State, provided it is genuine, may be considered sufficient:

Case No	Earlier trade mark	Comment
11/05/2006, C-416/04 P, Vitafruit	VITAFRUT	Use considered sufficient, even though the earlier Spanish mark was not present in a substantial part of the territory of Spain as the evidence referred to the sale of everyday consumer goods (concentrated fruit juices) to only a single customer in Spain (paras 60, 66 and 76).

If the earlier mark is an international mark or a Benelux mark, the mark must have been genuinely used in the territory of the relevant countries of the international registration or in Benelux, respectively.

2.4.4 Use in the import and export trade

According to Article 18(1)(b) EUTMR, the affixing of the European Union trade mark to goods or to the packaging thereof in the European Union solely for **export** purposes also constitutes use within the meaning of Article 18(1) EUTMR. The mark has to be used (i.e. affixed to goods or their packaging) in the relevant market — that is, the geographical area where it is registered.

Case No	Earlier trade mark	Comment
04/06/2015, T-254/13, EU:T:2015:156	STAYER	Genuine use may result from the export to a single operator located outside Europe, who can be an intermediary, for the purpose of selling to the end consumer in a non-EU country. Proof that the products have been put on the market in the non-EU importing country is not required (paras 57-61).
14/07/2010, R 602/2009-2	RED BARON	The Board indicated that sales in Austria and Great Britain from the Netherlands also constituted genuine use in the Netherlands (para. 42).

Evidence relating only to the **import** of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area (see by analogy 09/07/2010, T-430/08, Grain Millers, EU:T:2010:304, § 33, 40 et seq. regarding proof of use in the course of trade of a sign, on the basis of imports from Romania to Germany).

The Court has held that **transit**, which consists in transporting goods lawfully manufactured in a Member State to a non-member country by passing through one or more Member States, does not involve any marketing of the goods in question and is therefore not liable to infringe the specific subject matter of the trade mark (regarding the transit through France of goods originating in Spain and destined for Poland, see judgments of 23/10/2003, C-115/02, Rioglass and Transremar, EU:C:2003:587, § 27; 09/11/2006, C-281/05, Diesel, EU:C:2006:709, § 19). Therefore, mere transit through a Member State cannot constitute genuine use of the earlier mark in that territory (09/12/2015, T-354/14, ZuMEX (fig.) / JUMEX, EU:T:2015:947, § 62).

2.5 Time of use

2.5.1 Oppositions filed on or after 23/03/2016

If the earlier mark is subject to the use requirement at all (registered for not less than 5 years), the actual period for which use must be shown can simply be computed backwards from the **filing or**, if the contested EUTM application has a priority date, **from the priority date** of the contested EUTM application. For example, if the contested EUTM application was filed on 15/06/2016, or if this date was the priority

date of the contested EUTM application, the opponent would have to prove genuine use of its mark within the period from 15/06/2011 to 14/06/2016.

If the contested mark is an international registration designating the European Union, the actual period for which use must be proven can simply be computed backwards from the date of registration (INID code 151) or the date of priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891). For example, if the contested international registration were registered, or if the European Union were subsequently designated, on 15/06/2016, the opponent would have to prove genuine use of its mark within the period from 15/06/2011 to 14/06/2016.

Evidence referring to use made outside the relevant time frame is in general immaterial, unless it constitutes conclusive indirect proof that the mark must have also been put to genuine use during the relevant period. The Court held in this context that circumstances subsequent to the relevant point of time may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 31).

Where a mark has not been genuinely used for more than 5 years before the filing or priority date of the contested EUTM application, the fact that there may be remaining goodwill or knowledge of the mark in the mind of the trade or customers does not 'save' the mark.

The use need not have been made throughout the period of 5 years, but rather within the 5 years. The provisions on the use requirement do not require continuous use (16/12/2008, T-86/07, *Deitech*, EU:T:2008:577, § 52).

2.5.2 Oppositions filed before 23/03/2016

For oppositions filed before 23/03/2016, the regime for calculating the relevant period prior to the entry into force of Amending Regulation (EU) 2015/2424 applies, according to which the 5-year period has to be computed backwards from the **date of publication** of the contested EUTM application. In the case of contested IRs designating the EU, the equivalent date is the date of first publication of the IR or its subsequent designation in the EUTM Bulletin (25/04/2018, T-312/16, *CHATKA / CHATKA (fig.)*, EU:T:2018:221, § 19-42).

2.6 Extent of use

2.6.1 Criteria

In this regard, it has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that **the owner has seriously tried to acquire a commercial position in the relevant market**. The trade mark has to be used for goods or services already

marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37). This does not mean that the opponent has to reveal the total volume of sales or turnover figures.

Concerning the extent of use made of the earlier mark, account must be taken, in particular, of the **commercial volume** of all the acts of use on the one hand and the **duration** of the period in which those acts of use occurred, as well as the **frequency** of those acts, on the other (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35).

The assessment entails a **degree of interdependence between the factors** taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).

Under certain circumstances, even **circumstantial evidence** such as catalogues featuring the trade mark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (15/07/2015, T-398/13 TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57-58; 08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq.).

Use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, **use does not have to be continuous** throughout the relevant period of 5 years. It is sufficient if use was made at the very beginning or end of the period, provided the use was genuine (16/12/2008, T-86/07, Deitech, EU:T:2008:577).

The exact **decisive threshold** proving genuine use cannot be defined out of context. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity, or the degree of diversification of the undertaking using the trade mark, and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).

Low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (04/09/2007, R 35/2007-2, DINKY, § 22). It is, therefore, always necessary to take the characteristics of the market in question into account (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 51).

A *de minimis* rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 24 et seq.).

Genuine use is not excluded only because all use involves the same customer, as long as the trade mark is used publicly and outwardly and not solely within the undertaking that owns the earlier trade mark or within a distribution network owned or controlled by that undertaking (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 50; 08/10/2014, T-300/12, Fairglobe, EU:T:2014:864, § 36).

The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37).

Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 49).

Special circumstances, for example, lower sales figures during the initial marketing phase of a product, could be of relevance when assessing the genuineness of use (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 53). The initial phase of marketing a product may last more than a few months but it cannot be prolonged indefinitely (18/03/2015, T-250/13, SMART WATER, EU:T:2015:160, § 54-55; confirmed 17/03/2016, C-252/15 P, SMART WATER, EU:C:2016:178).

2.6.2 Examples of insufficient use

Case No	Comment
18/03/2015, T-250/13, SMART WATER	The test sales of 15 000 water bottles are considered symbolic in the light of the size of the European market (paras 34-35).

Case No	Comment
16/07/2014, T-196/13, NAMMU, EU:T:2014:1065	<p>The applicant provided an affidavit signed by the Head of the Import Department and Quality Manager, as well as photos, including one of a Nanu-Nana shop front, and others, undated, of various goods, such as folded paper boxes, albums, calendars, stickers, blocks, artists' materials, cards and other paper products, napkins, recipe books, furniture and home decor articles. The goods depicted all bear labels and stickers with the earlier mark on their packaging.</p> <p>No evidence was submitted to prove the turnover figures given in the affidavits, and the photos were undated (para. 33).</p>
17/01/2013, T-355/09, Walzer Traum, EU:T:2013:22; confirmed 17/07/2014, C-141/13 P, Walzer Traum	<p>The opponent, a German bakery located in a city of 18 000 inhabitants, proved constant monthly sales of approximately 3.6 kg of exclusive, handmade chocolates over a period of 22 months. Despite being advertised on a web page accessible throughout the world, the chocolates could only be ordered and bought in the opponent's bakery. In view of the territorial and quantitative limits, the General Court considered that use had not been sufficiently proven (para. 32 et seq.).</p>
30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135	<p>54 units of women's slips and 31 units of petticoats were sold over a period of 13 months, for a total sum of EUR 432. The General Court considered these modest quantities with regard to the relevant market (everyday consumption goods, sold at a very reasonable price) to be insufficient.</p>
27/02/2009, R 249/2008-4, AMAZING ELASTIC PLASTIC II	<p>500 plastic balloon kits given away as 'samples' free of charge cannot constitute genuine use.</p>
20/04/2001, R 378/2000-1, RINASCIMENTO/ RENACIMIENTO	<p>The Board of Appeal confirmed the decision of the Opposition Division that the submission of one bill of lading showing the delivery of 40 packages of sherry is insufficient to prove genuine use.</p>

Case No	Comment
09/02/2012, R 239/2011-1, GOLF WORLD (fig.9 / GOLF WORLD et al. (B 1 456 443, Golf World)	As the only evidence of use for <i>printed matter</i> , the opponent submitted evidence that proved 14 subscribers for a magazine in Sweden. The OD held that this is insufficient to prove genuine use in Sweden, particularly taking account of the fact that magazines are not high-priced articles.
20/05/2011, R 2132/2010-2, SUSURRO (fig.) / SUSURRO	Nine invoices concerning the sale of wine in 2005, 2006, 2007 and 2008, showing that over a period of 36 months, goods marketed under the earlier mark and worth EUR 4 286.36 were sold, as well as an undated sample of a product label, were not considered sufficient proof of genuine use of a Spanish trade mark registered for <i>alcoholic drinks (except beers)</i> in Class 33. The evidence showed that the sales of wine had been made in a small, very provincial, part of Spain. For a country with over 40 million inhabitants, the amount sold of a relatively cheap wine was found to be too small to create or preserve an outlet for goods (wine) that are consumed in large quantities by the average Spanish consumer.
07/07/2011, R 908/2010-2, ALFA-REN / ALPHA D3 et al.	Table of sales figures for ALFACALCIDOL products in Lithuania between 2005 and 2008, indicating products sold by Teva Corp. under the trade mark 'ALPHA D3' (source: IMS health database, Lithuania); an undated copy of packaging for a product 'ALPHA D3' (undated); and a copy of an advertisement for 'ALPHA D3' products sold in Lithuania (not translated) were found insufficient to show genuine use of the mark in Lithuania. It could not be seen from the evidence submitted whether the marked goods were actually distributed and, if so, the quantities involved.
16/03/2011, R 820/2010-1, BE YOU / BEYU	Sales of goods with profits below EUR 200 during the 9-month period of use were not considered sufficient proof of genuine use of the opposing mark in respect of the goods in Class 14.

Case No	Comment
06/04/2011, R 999/2010-1, TAUTROPFEN CHARISMA (fig.) / CHARISMA	Eleven invoices showing that 13 units of <i>perfumery</i> goods were sold in Spain between 2003 and 2005, for a total amount of EUR 84.63, were deemed as insufficient proof of genuine use of the sign. Account has been taken of the fact that the goods were intended for daily use and available at a very affordable price.
27/10/2008, B 1 118 605, Viña la Rosa	Photocopies of three independent wine guides mentioning the opponent's trade mark (without further explanation as to the volume, edition, publisher, etc.) were not considered sufficient to prove use for wines.
21/06/1999, B 70 716, Oregon	The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.
30/01/2001, B 193 716, Lynx	As evidence of use the opponent submitted two invoices, for a total amount of 122 items of clothing, and four undated labels with no indication of what goods they were to be affixed to. The Opposition Division considered them insufficient.

2.6.3 Examples of sufficient use

Case No	Comment
16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675	Nine invoices dated between April 2001 and March 2002, representing sales of around EUR 1 600 (with a turnover figure barely above EUR 1 000 000 per year) and showing that items were delivered to different customers in small quantities (12, 24, 36, 48, 60, 72 or 144 pieces), for widely used products like <i>shoe polish</i> , in the largest European market, Germany, with approximately 80 million potential consumers, were deemed as providing evidence of use that objectively is such as to create or preserve an outlet for <i>polishing cream</i> and <i>leather conditioner</i> . Furthermore, the volume of sales, in relation to the period and frequency of use, was deemed to be significant enough not to be considered merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. Confirmed by the General Court (para. 68)
10/09/2008, T-325/06, Capio, EU:T:2008:338	Evidence (invoices, lists of sales) proving that the intervener sold 4 hollow-fibre oxygenators with detachable hard-shell reservoirs in Finland in 1998, 105 in 1999 and 12 in 2001, for a total amount of EUR 19 901.76, was deemed sufficient proof of genuine use of the EUTM registered for <i>oxygenators with integrated pump; controllers for integrated pump; regulating devices of air pressure for integrated pump; suction pumps; blood flow meters</i> in Class 10 (paras 48, 60).

Case No	Comment
<p>27/09/2007, T-418/03, La Mer, EU:T:2007:299</p>	<p>Ten invoices over a period of 33 months, relating to several product ranges, the packaging of which bears the trade mark concerned, with numbers very far apart (22 214 for the invoice of 03/01/1995, 24 085 for that of 04/05/1995, 24 135 for that of 10/05/1995 and 31 348 for that of 26/03/1997), showing that the sales were made to different persons, were deemed as permitting the inference that they had been submitted merely by way of illustration of total sales but not as showing that the trade mark was used publicly and outwardly rather than solely within the undertaking that owned the earlier trade mark or within a distribution network owned or controlled by that undertaking. Nevertheless, the sales effected, while not considerable, were deemed as constituting use that objectively was such as to create or preserve an outlet for the products concerned and entailing a volume of sales that, in relation to the period and frequency of use, was not so low as to allow the conclusion that the use was merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark (paras 87-90).</p>
<p>25/03/2009, T-191/07, Budweiser, EU:T:2009:83</p>	<p>The Board of Appeal (20/03/2007, R 299/2006-2, 'BUDWEISER/BUDWEISER BUDVAR (fig.) et al., § 26) found essentially that the documents presented to it during the administrative proceedings — invoices proving the sale of beer in France amounting to more than 40 000 litres between October 1997 and April 1999, 23 invoices issued in Austria between 1993 and 2000 to a single buyer in Austria, and 14 invoices issued in Germany between 1993 and 1997 — were sufficient to demonstrate the extent of use of the earlier international word mark BUDWEISER (IR No 238 203) in those countries. The Board's findings were confirmed by the General Court.</p>

Case No	Comment
11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310	Evidence of the sale to a single customer in Spain of concentrated fruit juices during a period of 11.5 months, with a total volume of sales of EUR 4 800, corresponding to the sale of 293 cases of 12 items each, was considered sufficient use of the earlier Spanish trade mark (paras 68-77).
08/07/2010, T-30/09, Peerstorm, EU:T:2010:298	As evidence of use, the opponent (merely) provided several catalogues for end consumers, featuring the relevant trade mark on clothing articles. The Court held that ‘...it is true that those catalogues provide no information on the quantity of goods actually sold by the intervener under the trade mark PETER STORM. However, it is necessary to take into account ... the fact that a large number of items designated by the trade mark PETER STORM were offered in the catalogues and that those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment ... that the extent of its use was fairly significant’ (paras 42 to 43).
04/09/2007, R 35/2007-2, DINKY	The sale of approximately 1 000 miniature toy vehicles was considered sufficient extent of use in light of the products being sold mainly to collectors at a high price in a particular market.
11/10/2010, R 571/2009-1, VitAmour / VITALARMOR	The sale of 500 kg of milk proteins for a total value of EUR 11 000 was considered sufficient to prove genuine use for <i>milk proteins for human consumption</i> . In view of the nature of the products, which are not consumer goods but ingredients for use by the food processing industry, the amount and values shown did demonstrate a market presence above the threshold required.

Case No	Comment
27/07/2011, R 1123/2010-4, Duracryl / DURATINT et al.	Eleven invoices made out to different undertakings in various regions of Spain, showing that the proprietor of the mark sold, in the relevant period and under the mark, 311 containers of the product, in different sizes, for a net amount of EUR 2 684, were deemed sufficient to prove genuine use of a mark registered for <i>preservatives against deterioration of wood</i> in Class 2.
01/02/2011, B 1 563 066	An annual turnover of more than EUR 10 million over several years was claimed for <i>medical preparations</i> . The corresponding invoices (one per relevant year) only proved actual sales of about EUR 20 per year. In an overall assessment, and in the context of further material submitted, such as price lists, a sworn statement, packaging and advertising material, the Office found this sufficient to prove genuine use.
26/01/2001, B 150 039	The Opposition Division regarded evidence of sales of around 2 000 furry toy animals in a high-priced market sector as sufficient.
18/06/2001, B 167 488	The opponent submitted one invoice referring to the sale of one high-precision laser cutting machine for FRF 565 000, a catalogue describing its performance and some photographs depicting the product. The Opposition Division considered them as sufficient evidence taking into account the nature of the product, the specific market and its considerably high price.

2.7 Use of the mark in forms different from that registered

2.7.1 Introduction

Article 18 EUTMR states that use of the mark in a form different from that registered still constitutes use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.

The purpose of this provision is to allow its proprietor to make variations in the sign that, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

The General Court further mentioned that strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

In order to decide whether the sign as used and the sign as registered are broadly equivalent, it must first be established what elements are negligible. The General Court has developed criteria for doing so in several judgments.

Paragraph 2.7.2 will deal with these criteria. Paragraph 2.7.3 will describe Office practice in relation to the 'variation' of marks, 'additions' of elements to marks and 'omissions' of elements of marks.

2.7.2 Criteria of the Court

In brief, the test developed by the Court consists of first determining what the distinctive and dominant elements of the registered sign are and then verifying if they are also present in the sign as used.

The General Court has held that:

the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 36).

With regard to **additions**:

- several signs may be used simultaneously without altering the distinctive character of the registered sign (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 34);
- if the addition is not distinctive, is weak and/or is not dominant, it does not alter the distinctive character of the registered trade mark (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 29-33 et seq.; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 36 et seq.).

With regard to **omissions**:

- if the omitted element is in a secondary position and not distinctive, its omission does not alter the distinctive character of the trade mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 37).

2.7.3 Office practice

The principles set out in this section must be read in line with those adopted by the European Union Intellectual Property Network in its **Common Practice CP8 – Use of a trade mark in a form differing from the one registered**. This Common Practice was published on 15/10/2020 and has been applied by the Office since that date, including in ongoing proceedings.


In general, it has to be assessed whether use of the mark constitutes an acceptable or unacceptable ‘variation’ of its registered form.

Therefore, there are two questions to be answered. Firstly, it must be clarified what is to be regarded as the distinctive character of the mark as registered. ⁽⁷¹⁾ Secondly, it must be evaluated whether the mark as used alters this distinctive character. These questions have to be answered on a case-by-case basis.

There is **interdependence** between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. Adding elements to or omitting elements from the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

Where a mark is composed **of several elements**, only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that distinctive element(s) or its omission or replacement by another element will generally mean that the distinctive character is altered.

In order to determine whether the use of a variation of the mark should be accepted or whether the distinctive character is altered, account must be taken of the practices in the branch of business or trade concerned and the relevant public.

Case No	Registered mark	Actual use	Comment
12/12/2014, T-105/13, TrinkFix	Drinkfit		Relevant goods were <i>beverages</i> in Classes 29 and 32. The labels on bottles of beverages are narrow, so it is not unusual for a word mark to be written on two lines (para. 47).

The following paragraphs contain a number of practical guidelines for assessing whether additions (paragraph 2.7.3.1), omissions (paragraph 2.7.3.2) and alterations in

⁷¹ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

the form of the sign as used (paragraph 2.7.3.3) alter the distinctive character of the registered trade mark.

2.7.3.1 Additions

As indicated above, with regard to additions, (i) several signs may be used simultaneously without altering the distinctive character of the registered sign and (ii) if the addition is non-distinctive or weak and/or not dominant, it does not alter the distinctive character of the registered trade mark.

The following paragraphs provide examples of these two types of scenarios:

- use of several signs simultaneously;
- additions of other verbal elements;
- additions of figurative elements.

Use of several marks or signs simultaneously

It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

There is no legal precept in the European Union trade mark system that obliges the opponent to provide evidence of the earlier mark alone when genuine use is required within the meaning of Article 47 EUTMR. Two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trade mark (06/11/2014, T-463/12, MB, EU:T:2014:935, § 43). It is common practice in the trade to depict independent marks in different sizes and typeface, so these clear differences, which emphasise the house mark, indicate that two different marks are being used jointly but autonomously (07/08/2014, R 1880/2013-1, HEALTHPRESSO / PRESSO, § 42).

The Court has confirmed that the condition of genuine use of a registered trade mark may be satisfied both where it has been used as part of another composite mark or where it is used in conjunction with another mark, even if the combination of marks is itself registered as a trade mark (18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 36.). Similarly, the Court has clarified that use can be genuine where a figurative mark is used in conjunction with a word mark superimposed over it, even if the combination of those two marks is itself registered, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 31).

Registered form	Actual use	Case No
CRISTAL		08/12/2005 T-29/04 Cristal Castellblanch
<p>'In the present case the mark CRISTAL appears clearly four times on the neck of the bottle marketed by the intervener and twice on the main label, accompanied by the symbol ®. On the neck, that mark is separate from the other elements. In addition, the mark CRISTAL appears alone on the boxes in which bottles of the mark CRISTAL are marketed. Equally, on the invoices produced by the intervener reference is made to the term "cristal" with the mention "1990 coffret". It should be noted that the mark CRISTAL thus identifies the product marketed by the intervener' (para. 35).</p> <p>'As regards the mention "Louis Roederer" on the main label, it merely indicates the name of the manufacturer's company, which may provide a direct link between one or more product lines and a specific undertaking. The same reasoning applies to the group of letters "lr", which represents the initials of the intervener's name. As pointed out by [the Office], joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue' (para. 36).</p> <p>'Furthermore, [the Office's] finding that the use of the word mark together with the geographical indication "Champagne" cannot be considered to be an addition capable of altering the distinctive character of the trade mark when used for champagne must be endorsed. In the wine sector the consumer is often particularly interested in the precise geographical origin of the product and the identity of the wine producer, since the reputation of such products often depends on whether the wine is produced in a certain geographical region by a certain winery' (para. 37).</p> <p>'In those circumstances it must be held that the use of the word mark CRISTAL together with other indications is irrelevant and that the Board of Appeal did not infringe Article 15(2)(a) of Regulation No 40/94 [now Article 18(2)(a) EUTMR], Article 43(2) and (3) thereof [now Article 47(2) and (3) EUTMR], or Rule 22(2) of the implementing regulation [now Article 10(2) EUTMDR]' (para. 38).</p>		

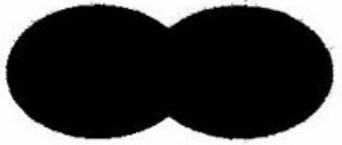

Registered form	Actual use	Case No
L.114	Lehning L114	29/02/2012, T-77/10 & T-78/10, L112, EU:T:2012:95
<p>L.114 is a French trade mark registered for <i>pharmaceutical products</i> in Class 5.</p> <p>The Court found that:</p> <p>1) the missing full-stop between the capital letter 'L' and the number 114 constituted a minor difference that did not deprive earlier mark L.114 of its distinctive character (para. 53).</p> <p>2) 'Lehning' was the house mark — the fact that earlier mark 'L.114' was used together with that house mark did not alter its distinctive character within the meaning of Article 15(1)(a) of Regulation (EC) 207/2009 [now Article 18(1)(a) EUTMR] (para. 53).</p>		







Registered form	Actual use	Case No
YGAY	YGAY together with a number of other verbal and figurative elements	24/09/2008, R 1695/2007-1, I GAI (fig.) / YGAY et al.; confirmed 21/09/2010, T-546/08, i Gai
<p>In the Board's decision (confirmed 21/09/2010, T-546/08, i Gai, EU:T:2010:404, § 19, 20) it was pointed out that the trade mark YGAY appears in many photographs on both the label and the box in which the bottle is sold. On the labels, the trade mark in question is separated from the other elements. On some labels, it appears on its own, beneath the phrase MARQUES DE MURRIETA, written in large bold letters. On others, the phrase BODEGAS MARQUES DE MURRIETA is written in small letters in the upper part, while the elements CASTILLO YGAY are written in large, stylised letters across the label. The trade mark YGAY also appears on its own or together with the phrase CASTILLO YGAY on the boxes in which the bottles are sold. Reference is also made, on the invoices submitted by the opponent, to the trade mark YGAY, along with general information such as the year of production and origin, etc. It follows, therefore, that the sign YGAY functions as the trade mark identifying the goods, <i>wine</i>, sold by the opponent (para. 15).</p> <p>The mention of MARQUES DE MURRIETA in this context might merely be an indication of the name of the manufacturer's company or the vineyard that produces and sells the wine, which might provide a direct link between one or more product lines and a specific undertaking (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 36) (para. 16).</p>		

Registered form	Actual use	Case No
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 <p>Mark No 1</p>	 <p>Mark No 2</p>	<p>18/04/2013, C-12/12, Colloseum Holding</p>
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Levi Strauss is the proprietor of the two EUTMs reproduced above. Mark No 1 is always used in conjunction with the word mark LEVI'S, i.e., as in Mark No 2. The Court found that the condition of 'genuine use' may be fulfilled where an EU figurative mark is used only **in conjunction with an EU word mark that is superimposed over it**, and the combination of those two marks is, furthermore, itself registered as a European Union trade mark, to the extent that **the differences between the form in which the trade mark is used and that in which it was registered do not change the distinctive character of the trade mark as registered.**

Registered form	Actual use	Case No
		<p>18/07/2013, C-252/12, Specsavers</p>

Registered form	Actual use	Case No
<p>Specsavers commenced proceedings for trade mark infringement and passing off on the basis of the earlier EUTM SPECSAVERS (word mark), as well as the figurative signs</p>   <p>and</p>  <p>, against ASDA, a supermarket chain, which relaunched its optical business and targeted Specsavers in its marketing campaign. Specsavers used its black and white registrations in colour and acquired reputation in the UK for the colour green, using its sign as follows:</p>  <p>. ASDA also acquired reputation in the UK for another shade of green in its supermarket business and applied it to the optical business:</p>  <p>The Court found that the use of</p>  <p>with the superimposed word sign may be considered genuine use of the wordless logo mark to the extent that the wordless logo mark as registered always refers in that form to the goods of the Specsavers group (to be determined by the referring court) (para. 24).</p>		

Registered form	Actual use	Case No
MINUTO	DUBOIS MINUTO	12/09/2001, R 206/2000-3, MINU' / MINUTO


Registered form	Actual use	Case No
<p>The Board of Appeal regarded the presentation of the two words as the use of two separate marks, since the evidence submitted by the opponent showed that one of them was an old brand of the opponent with its own identity and was present on the market with a number of accompanying signs, as is common practice in the labelling of the specific products (wine).</p> <p>“DUBOIS” and “MINUTO” are separate marks that are affixed together in the concrete product, as is common practice in the labelling of wine products (name of the winery and name of the product). As regards Spanish brands, see for example “TORRES” — “Sangre de Toro”, “TORRES” — “Acqua d’Or”. When asking for “MINUTO” wine, the relevant consumer will be aware that such wine is included within the line of products “DUBOIS”, however, “MINUTO” will be perceived as a trade mark of its own, even if it may appear next to the sign “DUBOIS” in the invoices, brochures and/or product labels’ (para. 18).</p>		

On the other hand, doubt could be cast on the genuineness of use in cases where the registered mark, when used together with another mark is perceived as a **mere decorative element**.

Addition of other verbal elements

In principle, a difference in words or even letters constitutes an alteration of the distinctive character of the mark. However, in the following three paragraphs a number of situations are described where additions are acceptable. The fourth paragraph provides examples of unacceptable additions.

Addition of non-dominant elements

Registered form	Actual use	Case No
COLORIS		30/11/2009, T-353/07, Coloris
<p>The General Court confirmed that the use of the mark <i>Coloris</i> with additional word elements such as ‘global coloring concept’ or ‘gcc’ did not alter its distinctive character because the additional elements were merely used together with the mark <i>Coloris</i> and positioned below it and were of such a size that they were not predominant in the mark.</p> <p>The same finding applies with even greater force to the additional words (global coloring concept) as ‘they are words with a general meaning. Furthermore, the word “coloring” refers to the goods concerned and, consequently, has a certain descriptive character’ (para. 31).</p>		



Additions with generic or descriptive meaning

Use of a registered word mark (or any other mark) together with a generic indication of the product or descriptive term will be considered as use of the registered mark. Additions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, do not in general constitute use of a variant but use of the mark itself.

For example:


Registered form	Actual use	Case No
HALDER	HALDER I, HALDER II, HALDER III, HALDER IV, HALDER V	13/04/2011, T-209/09, Alder Capital

The Court indicated that ‘the fact that, in that newspaper article, the names of the funds are composed of the term “halder”, to which a number in Roman numerals has been added, is not such as to call into question the conclusion on use of the mark, since, because of their brevity, their weak distinctive character and their ancillary position, those additions do not alter the distinctive character of the mark in the form in which it was registered’ (para. 58).

Registered form	Actual use	Case No
		<p>09/07/2013, R 1190/2011-4,</p> <p>VIÑA ALBERDI / VILLA ALBERTI;</p> <p>confirmed 30/06/2015, T-489/13,</p> <p>VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446</p>

Registered form	Actual use	Case No
<p>The figurative signs reproduced in the evidence of use contain the distinctive elements of the earlier mark and those elements are clearly visible on the labels. The inversion of the figurative and word elements of the sign and the additional indication of the respective appellation of origin (Soave, Soave Superiore and Chianti) do not alter the distinctive character of the earlier mark, which appears reproduced in the sign with all its distinctive elements. Consumers of wines are particularly interested in knowing the precise geographical origin of these products; however, the addition of this information about the geographical origin of the goods is not capable of altering the distinctive character of a trade mark in its essential function of identifying a particular commercial origin (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 19).</p>		

Registered form	Actual use	Case No
ARKTIS	ARKTIS LINE	16/04/2015, T-258/13, ARKTIS, EU:T:2015:207
<p>The Court stated that the term 'line', synonymous with the German word 'Linie', is commonly used in advertising and business in relation to a product line. It is likely to be perceived automatically as an additional element by the average consumer, particularly in Germany. The Court agreed with the Board of Appeal that the term 'line' did not alter the distinctive character of the disputed mark and that use of this trade mark in combination with this term was a use of that mark (paras 26-27).</p>		

Registered form	Actual use	Case No
AINHOA	<p>AINHOA in combination with 'BIO', 'LUXE', 'MINERAL PASSION', 'SPA WORLD CHOCOLATE' or</p> 	23/09/2015, T-426/13, EU:T:2015:669

Registered form	Actual use	Case No
<p>The figurative element consists of a square representing the sky, with clouds concentrated in the lower part of the square. This element has no obvious connection with the goods in question, and is not original. Therefore, and taking into account its size and accessory position, it does not alter the overall impression produced by the mark at issue. The use of the figurative element must be regarded as an acceptable variation of the contested mark. Furthermore, the elements added, such as, 'bio', 'luxe', 'mineral passion' or 'spa world chocolate', are descriptive of the characteristics of the goods. The element 'bio' may easily be perceived as an abbreviation of the term 'biological' and refers to the origin or composition of the goods concerned. The term 'mineral' describes the components of the goods in question as minerals are commonly used in cosmetics. In addition, the word 'spa' has a particular meaning with regard to health and wellness establishments. Finally, the word 'luxe' is intended to describe the range of goods in question. Consequently, such additional elements do not alter the distinctive character of the mark (paras 30-32).</p>		

Other acceptable additions

The addition of **insignificant elements** such as punctuation marks does not alter distinctive character:


Registered form	Actual use	Case No
PELASPAN-PAC	PELASPAN PAC	22/03/2013, R 1986/2011-4, PELASPAN / PELASPAN et al.
<p>The use of the earlier mark 'PELASPAN-PAC' without the hyphen connecting the elements 'PELASPAN' and 'PAC' does not alter the distinctive character of the earlier mark as registered and therefore counts for the genuine use assessment.</p>		

In the same way, the use of **plural or singular forms** in meaningful words (for instance, by adding/omitting a letter 's' in English or other languages) **normally** does not alter distinctive character:

Registered form	Actual use	Case No
Tentation	Tentations	29/07/2008, R 1939/2007-1, TEMPTATION FOR MEN YANBAL (fig.)/TENTATION

Registered form	Actual use	Case No
<p>'In the case in hand, and after an examination of the proof submitted, which focuses essentially on the Spanish market, the Board is of the opinion that use of the "TENTATION" registered trade mark through use of the "TENTATIONS" sign does not alter the distinctive character of the original registered trade mark. Specifically, the mere addition of the letter "S" to the end of the trade mark does not substantially alter the visual appearance or pronunciation of the registered trade mark and does not create a different conceptual impression on the Spanish market either. The trade mark in question will be perceived merely as being in its plural form as opposed to its singular form. Therefore, said change does not alter the distinctive character of the sign' (para. 17).</p>		

The addition of the '**type of enterprise**' is also acceptable:

Registered form	Actual use	Case No
	<p>The form used contained the logo plus the words 'SOCIEDAD LIMITADA' (in small letters) underneath the term 'SISTEMAS' and/or the 'E' device with the words 'epco SISTEMAS, S.L.' in bold</p>	<p>19/01/2009 R 1088/2008-2, EPCOS (fig.) / E epco SISTEMAS (fig.); confirmed 15/12/2010, T-132/09, Epcos</p>
<p>'... these signs are not, as the applicant seems to suggest, significant alterations of the distinctive character of the earlier mark as registered' (para. 24).</p>		

Unacceptable additions


Registered form	Actual use	Case No
VILA VITA PARC	<p>vila vita hotel & feriendorf panno[n]ja</p>	<p>14/07/2014, T-204/12, Via Vita, EU:T:2014:646</p>
<p>'... whereas the German word "Feriendorf", meaning "holiday village", could be perceived as descriptive of the relevant [hotel] services, the same was not true for the word element "panno[n]ja"' (para. 30). Consequently, the addition of the word 'panno[n]ja' alters the distinctive character of the mark.</p>		


Registered form	Actual use	Case No
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Captain	Captain Birds Eye	23/04/2001, R 89/2000-1 EL CAPITAN PESCANOVA / CAPTAIN
'It cannot be considered ... that the use of CAPTAIN BIRDS EYE constitutes use of the mark CAPTAIN in a form which does not alter the distinctive character of the mark as registered, since the two signs appear essentially different' (para. 20).		


Addition of figurative elements

In cases where the figurative element plays only a minor role, being merely decorative, the distinctive character of the sign as registered is not affected.

Registered form	Actual use	Case No
DRINKFIT		12/12/2014, T-105/13, TrinkFix
The addition of the semi-circular graphical element does not change the overall impression of the sign (para. 49).		

Registered form	Actual use	Case No
SEMBELLA		23/01/2014, T-551/12, Rebella, EU:T:2014:30
The figurative elements are only decorative or even negligible and do not alter the distinctive character of the mark (para. 43).		

Registered form	Actual use	Case No
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BIONSEN		18/04/2008, R 1236/2007-2
<p>'[T]his material shows that the respondent's products also contain other elements, in particular a Japanese character within a small circle, which is depicted either above or below the word "BIONSEN" (para. 19).</p> <p>'However, in the present case, the combination of the stylised form of the word "BIONSEN" and the Japanese character, independently of whether it is above or under the word "BIONSEN", constitutes at the most use which differs from the form in which it was registered only in negligible elements. The word "BIONSEN" as used is merely a slight and banal stylisation of the word 'BIONSEN'. As to the addition of the figurative element in the form of a circular element with a Japanese character, this will hardly be noticed by the average consumer due to its relatively small size and position, either under or on the right side above the word "BIONSEN"' (para. 23).</p>		

2.7.3.2 Omissions

When considering 'omissions' of elements of a mark in its used form, care has to be taken to check that the distinctive character of the mark has not been altered.

If the omitted element is in a **secondary position and not distinctive**, its omission does not alter the mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419).

Omissions of non-dominant elements

Registered form	Actual use	Case No
		24/11/2005, T-135/04, Online Bus

The General Court considered that both the registered form of the earlier mark and the form used included the word 'BUS' and the figurative element of 'three interlaced triangles'. The presentation of the elements is not particularly original or unusual in either form. The variation in them does not affect the distinctive character of the trade mark. As regards the omission of 'Betreuungsverbund für Unternehmer und Selbständige e.V.', the latter was 'a string of words, **written in small characters and occupying a secondary position, at the bottom of the sign**. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. 'Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive ... It follows from the foregoing that the form used of the earlier trade mark used does not contain any differences such as to alter the distinctive character of that trade mark' (para. 34 et seq.).

Omissions of generic or descriptive elements

Where a registered mark contains a **generic** indication of the product or **descriptive** term, and this term is omitted in the used form of the sign, such use will be considered as use of the registered mark.

Omissions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, in general constitute use of an acceptable variant.

Registered form	Actual use	Case No
		29/09/2011, T-415/09, Fishbone, EU:T:2011:550; confirmed 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484

The Board considered that although in **some pieces** of evidence the earlier mark did not include the word 'beachwear', this did not alter the distinctiveness of the earlier mark because it was plainly descriptive of the nature of the goods (*t-shirts, beachwear*).

The General Court held:



'In the present case, the earlier mark is a composite mark, representing a ship's wheel, that is to say, a sign with a rounded shape. In the centre of the sign there is a fish skeleton, at the top of which is written the term "fishbone", and at the bottom the term "beachwear". ... although the use of the earlier mark varies in certain items of evidence and is used in a form different from that under which it was registered, in the sense that the sign does not include the term "beachwear", such a fact does not affect its distinctive character. **The term "beachwear", which means "beach clothing" in English, is descriptive of the nature of the goods covered by the earlier mark** [emphasis added]. That descriptive character is obvious in the case of the "beach clothing" covered by the earlier mark, but also in the case of "t-shirts", for which the term "beachwear" will immediately be perceived as meaning that it refers to a t-shirt to be worn in casual situations, for example, on the beach in summer. Consumers will thus understand that term as designating the type of goods and will not perceive it as an indication of their commercial origin. The fact that the term "beachwear" is written in a more fanciful font than that of the term "fishbone", which is written in ordinary capital letters, cannot alter such an assessment. Furthermore, ... the font of the term "beachwear" cannot be regarded as uncommon, since it comprises printed lower-case characters. As for the horizontal position of the term "beachwear" in the earlier mark, which runs in a perpendicular sense across the bottom of a ship's wheel, it is no more graphically incisive than that of the term "fishbone" which, also written horizontally, follows the rounded shape of that wheel' (paras 62-63).

Other acceptable omissions

The omission of **insignificant prepositions** does not alter the distinctive character:

Registered form	Actual use	Case No
CASTILLO DE PERELADA	CASTILLO PERELADA	B 103 046
It is not considered that the absence of the word 'de' affects the distinctive character of the trade mark.		

There are instances where the earlier sign is composed of a distinctive verbal element (or several) **and** a figurative element (or several), with the latter perceived by the relevant public as banal. Such banal elements are considered non-distinctive, and their omission does not change the distinctive character of the sign. Therefore, it is important to establish which elements influence the distinctive character of the mark and how consumers will perceive them.


Registered form	Actual use	Case No
		27/02/2014, T-225/12, LIDL express, EU:T:2014:94, paras 49-53; appealed 06/09/2016, C-237/14 P, LIDL express (fig.) / LIDL MUSIC (fig.) et al., EU:C:2016:667
The Court confirmed (para. 53) the finding of the Board that the 'distinctiveness of the mark is largely dominated by the wording 'LIDL MUSIC' and only marginally influenced by the figurative elements used to represent the letters and the small monogram underneath' (21/03/2012, R 2379/2010-1, LIDL express (fig.)/LIDL MUSIC (fig.) et al., para. 19).		



The omission of the **transliteration of a term** is generally considered as an acceptable alteration.

Registered form	Actual use	Case No
ΑΡΑΛΙΑ-ΑΠΑΛΙΑ	APALIA	15/09/2011, R 2001/2010-1, APANI / ΑΡΑΛΙΑ-ΑΠΑΛΙΑ
The omission of the transliteration of the term in Greek characters does not alter the distinctive character of the mark as the form used contains the term APALIA, which is distinctive and dominant.		

Unacceptable omissions

In principle, a difference in **words or even letters** constitutes an alteration of the distinctive character of the mark.

Registered form	Actual use	Case No
TONY HAWK	HAWK 	B 1 034 208
'[T]he absence of the word element 'TONY' in the first two marks significantly alters the distinctive character of the registered earlier mark 'TONY HAWK'. Therefore, these marks will be perceived as separate marks and their use cannot be considered as the use of the word mark 'TONY HAWK'.		
Registered form	Actual use	Case No

 (in Spain)		03/02/2010, R 1625/2008-4 LT LIGHT-TECHNO / (FIGURATIVE); (appeal 10/11/2011, T-143/10, LT LighT-Thecno, EU:T:2011:652 did not refer to the Spanish trade marks)
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'In the present matter, the Board has been able to verify that none of the proof of use supplied reproduces the earlier Spanish signs in the form in which they were registered, as either a representation of the mark in its purely visual form appears, that is, without the expression "light technology", or the visual element accompanied only by the term "Light" and other word elements or the expression "LT Light-Technology" also in word form without the visual element which obviously characterises the earlier Spanish marks on which the opposition is based ... In view of these circumstances, and taking into consideration that the modifications made to the representation of earlier marks modify their distinctive character, it is considered that, in any event, the proof submitted does not demonstrate the use of the Spanish marks in the basis of the opposition' (paras 15-16).


Registered form	Actual use	Case No
SP LA SPOSA	LA SPOSA LA SPOSA COLLECTION	26/03/2010, R 1566/2008-4 ESPOSA / SP LA SPOSA
<p>'The earlier trade mark is registered as "SP LA SPOSA". The documents submitted as proof of use refer only to female wedding dresses. The element "LA SPOSA" is a common term, which will be understood by the Italian and Spanish public as "the bride" and has a weak distinctive character for the goods in issue, namely wedding dresses. The opponent itself, in its price list "tarifa de precios" which is drafted in various official languages of the EC, translated this term into the respective languages; underneath the term "LA SPOSA", the terms "novia" are mentioned in the Portuguese version of the list, "bride" in the English version, "Braut" in the German version, and so on. This shows that even the respondent itself understands the term "LA SPOSA" as a reference to the consumer targeted, namely the bride' (para. 18).</p> <p>'Therefore, the element "SP" at the beginning of the earlier mark is a distinctive element and cannot be disregarded. This element cannot be neglected, first and foremost as it is placed at the beginning of the mark. Also, it is meaningless and distinctive on its own, in all the languages of the European Union' (para. 19).</p> <p>'[T]he omission of the letter "SP" in the word "LA SPOSA" or "LA SPOSA COLLECTION" is not an acceptable variation of the earlier mark but a significant modification to the distinctive character of the mark. The documents submitted by the respondent are insufficient to prove that the mark "SP LA SPOSA" has been put to genuine use' (para. 26).</p>		

Registered form	Actual use	Case No
 <i>La Sabiduría del Sabor</i>		21/01/2015, T-46/13, KIT, EL SABOR DE NAVARRA, EU:T:2015:39

In this case the Court examined whether the omission, in the form as used, of the expression 'La Sabiduría del Sabor' alters the distinctive character of the earlier mark as registered. Firstly, the words 'Sabores de Navarra' (tastes/flavours of Navarra) refer to sensations or impressions evoking a region of northern Spain. Thus, the elements can be perceived by the Spanish-speaking public as descriptive of the geographical origin of the goods in question. Moreover, the word 'sabores' (flavours) may be perceived as an indication of product quality, i.e. flavour. It follows that the elements 'Sabores de Navarra' must be regarded as essentially descriptive.

The elements 'La Sabiduría del Sabor', given the meaning of the word 'La Sabiduría' (wisdom) and the word 'sabor' (flavour), constitutes a play of words and cannot be considered descriptive. It follows that the distinctiveness of the earlier mark comes essentially from the words 'La Sabiduría del Sabor'. The Court found that in the present case, the omission of the words 'La Sabiduría del Sabor' in the form used alters the distinctive character of the mark (paras 31-45).

In cases where the **figurative element** is the dominant or distinctive element and not merely decorative or banal, its omission can alter the distinctive character of the sign.

Registered form	Actual use	Case No
	ESCORPION	28/03/2007, R 1140/2006-2 SCORPIO / ESCORPION

Registered form	Actual use	Case No
<p>'The earlier trade marks are strongly characterised by the presence of the figurative element. However, the documents submitted during the opposition proceedings and, even if they were to be taken into account, the appeal proceedings, do not show any use of the figurative element contained in the earlier trade marks' (para. 19).</p> <p>'Therefore, the Office considers that the alteration of the opponent's trade mark appearing in the way it is currently used is not an acceptable alteration and consequently use of the registered mark is not shown. The opponent has not complied with the requirements of Article 43(2) and (3) of Regulation No 40/94 [now Article 47(2) and (3) EUTMR] and thus the opposition must be rejected, as far as it was based on the Spanish trade mark registrations' (para. 20).</p>		


2.7.3.3 Other alterations

Acceptable alterations


Word marks


Word marks are considered used as registered regardless of typeface, use of upper/lower case or colour. It would not be correct to analyse this type of use from the perspective of whether distinctive character is altered. However, a **very particular typeface** (highly stylised) may lead to a different conclusion.


Changing the **letter size** or switching between **upper/lower case** is customary when using word marks. Therefore, such use is considered use of the registered mark.

Registered form	Actual use	Case No
PALMA MULATA		12/03/2014, T-381/12, Palma Mulata EU:T:2014:119
<p>The Court confirmed that the use of a [standard] typeface does not alter the distinctive character of a word mark. It rather helps to distinguish the mark from the descriptive elements 'ron' and 'de Cuba' (para. 34).</p>		


Registered form	Actual use	Case No
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MILENARIO		18/09/2009, R 289/2008-4 Sierra Milenario / MILENARIO
The Board confirmed OD's views that use of the word mark 'MILENARIO' written in stylised bold characters did not affect the distinctive character of the mark, as the word 'MILENARIO' was considered to be the dominant element of the mark registered for <i>sparkly wines and liquors</i> in Class 33 (para. 13).		

Registered form	Actual use	Case No
AMYCOR		25/05/2009, R 1344/2008-2, CLAMYCOR / AMYCOR
Representation of the word mark, registered for <i>pharmaceutical and sanitary preparations; plasters; materials for dressings; fungicides; disinfectants</i> covered by the earlier trade mark in Class 5, in a stylised form together with figurative elements was not considered as substantially changing the distinctive character of the word trade mark 'AMYCOR' as registered.		

Registered form	Actual use	Case No
THE ECONOMIST		05/08/2011, R 56/2011-4 eIECONOMISTA (fig.) / THE ECONOMIST et al.
'The applicant's argument that the proof of use is insufficient because it refers to the device mark ... and not to the word mark 'THE ECONOMIST' fails. First, the submitted evidence refers to both earlier marks (i.e. the word mark and the device mark). Furthermore, use of the earlier device mark constitutes use of the earlier word mark. In this respect it should be noted that word marks are considered used as registered, also if the typeface is different (this may be different if the typeface is a very particular one), if there is a usual change in the letter size or a usual change between lower-case and capital letters, if used in a specific colour or if used in combination with generic additions. Use of the word "THE ECONOMIST" in a standard typeface, with the usual use of capitals at the beginning of the words "The" and "Economist", in a white colour on a contrasting background is considered use, not only of the earlier device mark but of the earlier word mark as well' (para. 14).		

Word marks are registered in black and white. It is customary to use marks in **colour**. Such use does not constitute a variant but use of the registered mark.

Registered form	Actual use	Case No
BIOTEX	<p>BIOTEX VLOEIJEN. GROEN 750ML</p> 	<p>02/10/2001, R 812/2000-1</p> <p>BIO TEK (fig.) / BIOTEX</p>

'The mark, as shown in those documents, has been variously depicted in the following styles:

- The word BIOTEX in white block capitals on a dark background in advertisements.
- Reference in newspaper articles to the word BIOTEX in plain typeface.
- The word BIOTEX in white block capitals with the top-most point of the letter 'l' in darker colouring.
- The word BIOTEX in plain block white capitals on the labels and packaging of detergent products.
- The word BIOTEX in plain typeface on shipping invoices.
- The word BIOTEX in white upper and lower cases block letters on a darker background incorporating a figurative 'wave' device' (para. 14).

'The evidence of use shows the mark has remained, in spite of various stylistic changes, essentially BIOTEX. The letters forming the mark have in general been mere block capitals, lacking anything fanciful. Sometimes the capitals are plain and two-dimensional, at other times they are shadowed to give the impression of being three-dimensional. Sometimes the letter "l" has a different colour tip. The Board considers these variations minimal and routine and that they demonstrate a practice that is commonplace not only in the particular business field of relevance here, but in other fields also. The Board does not consider that these variations invalidate use of the mark BIOTEX and therefore the contested decision must be annulled at this point' (para. 17).

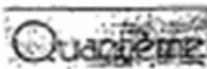

Registered form	Actual use	Case No
SILVER		B 61 368

Registered form	Actual use	Case No
<p>'The actual use of the trade mark which can be seen on the beer pack, the newspaper extract and on the calendar is not the use of the registered <i>word</i> mark SILVER, but of the <i>colour device</i> mark, namely a beer label with the word SILVER written in white capital letters in a red banner which overlaps a golden circle which contains the word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg". This does not automatically mean that the mark was not used as registered. Each case must be looked at on its own merits. In this case, the Office finds that the mark SILVER is the actual trade mark. The appearance of the other word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg" and the figurative element is only secondary to the mark SILVER. It is also clear from the marketing study, the newspaper extract and the invoices that the actual trade mark is SILVER. The Office finds that the use of the word SILVER is so dominant in the figurative mark that it fulfils the requirements of having been used as registered.'</p>		

Figurative marks

Using a **purely figurative mark** (without word elements) in a form other than registered often constitutes an unacceptable alteration.

In the case of **composite marks** (i.e. marks composed of word and figurative elements), **changes to certain figurative elements do not** normally affect the distinctive character of the marks.



Registered form	Actual use	Case No
		12/01/2006, T-147/03, Quantum, EU:T:2006:10; dismissed 15/03/2007, C-171/06 P, Quantum, EU:C:2007:171
<p>'[T]he only elements which differentiate the earlier national mark, as it was registered, from the sign used by the applicant are the stylisation of the letter "q", suggesting the face of a watch, and the use of capital letters to write the verbal element of the earlier national mark ... In the first place, although it is true that the stylisation of the letter "q" is more pronounced in the representation of the sign used than in that of the earlier national mark, the distinctive character of the earlier mark is still based on the entire verbal element of that mark. In any case, since the stylisation of the letter "q" suggests, as has just been said, the face of a watch, it is not particularly distinctive for goods in Class 14, the only goods for which the applicant has furnished proof of use of the earlier mark. In the second place, as regards the use of capital letters, it suffices to note that that is not at all original and also does not alter the distinctive character of the earlier national mark ... It follows that the proof furnished by the applicant which refers to the sign reproduced in paragraph 10 above for the Class 14 goods "watches and watch bands or straps" could legitimately be taken into account by the Board of Appeal for the purposes of assessing whether the applicant had shown genuine use of the earlier national mark' (paras 28-30).</p>		

Registered form	Actual use	Case No
		18/11/2015, T-361/13, VIGOR / VIGAR, EU:T:2015:859

The word 'vigar' is an invented word and is, therefore, inherently distinctive. Given the fact that the word 'vigar' is the only word element, and given its inherent distinctiveness, its central position and the fact that the additional elements highlight its presence, the word is the most distinctive element of the earlier mark.


The form as used differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of lower case instead of upper case letters and the replacement of the crown element by a sequence of three dots. The Court agreed that a different orientation of the same background, the use of upper case or lower case letters when they are standard letters that reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term 'vigar', are minor differences that do not alter the distinctive character of the earlier trade mark as registered.

That finding is not called into question if the second form of use is taken into account, inasmuch as, even though, in that case, the basic background disappears and the word 'spain' is present, the latter will be understood as a merely descriptive addition (paras 70-74).

Registered form	Actual use	Case No
		10/12/2015, T-690/14, Vieta, EU:T:2015:950

The distinctive character of the mark is essentially derived, not from its figurative elements, but from the word 'vieta'. The element has a high level of distinctive character and occupies an important position in the overall impression created by the mark as registered, whilst the figurative elements have only weak distinctive character and occupy merely an ancillary position in the overall impression. Those figurative elements, including the typeface used, have a relatively marginal visual impact. The rectangular border does not present any originality in relation to usual commercial use. As regards the figurative elements made up of, on the one hand, grey rectangles separating the letters of the word 'vieta' and, on the other hand, white rectangles appearing in the middle of the sides of the rectangular border, they are very small in size, are not striking and do not present any originality (paras 47 and 48).

This is particularly relevant in cases where the figurative element is **mainly descriptive** of the relevant goods and services.



Registered form	Actual use	Case No
GRECO TAVERNA		01/03/2013, R 2604/2011-1, Taverna MEDITERRANEAN WHITE CHEESE
<p>'In relation to the "FETA" product, as regards the two Greek flags next to the word "TAVERNA" it should be noted that the obligation to use a trade mark as registered does not require its proprietor to use the mark in isolation in the course of trade. Article 15(1) CTMR [now Article 18(1) EUTMR] does not preclude the possibility of the trade mark's proprietor adding further (decorative or descriptive) elements, or even other marks such as its house mark on the packaging of the product, as long as the trade mark 'as registered' remains clearly recognisable and in an individual form. The two Greek flags do not possess any distinctive character in relation to the products at hand which are commonly known to be food specialities originating from Greece. This is supported by the whole get-up of the product, coloured in blue and white in accordance with the colours of the Greek flag, the depiction of scenery which calls to mind a Mediterranean scene and the symbol for a Protected Designation of Origin below the picture' (para. 39).</p>		



This is also the case where the dominant elements remain unchanged (24/11/2005, T-135/04, Online Bus, EU:T:2005:419 above).

For **alterations in colour** specifically, the main question that needs to be addressed is whether the mark as used alters the distinctive character of the registered mark, that is to say whether use of the mark in colour, while being registered in black and white or greyscale (and vice versa) constitutes an alteration of the registered form. The Office and a number of IP offices of the European Union have agreed on a common practice under the European Trade Mark and Designs Network, whereby a change only in colour does not alter the distinctive character of the trade mark as long as:



- the word/figurative elements coincide and are the main distinctive elements;
- the contrast of shades is respected;
- the colour or combination of colours does not have distinctive character in itself;

- the colour is not one of the main contributors to the overall distinctiveness of the sign.

Registered form	Actual use	Case No
		24/05/2012, T-152/11, Mad, EU:T:2012:263
<p>The Court took the view that, if no colour is claimed in the application, the use of different colour combinations 'must be allowed, as long as the letters contrast against the background.' The Court also noted that the letters M, A, D were arranged in a particular way in the EUTM. Accordingly, representations of the sign that do not alter the arrangement of the letters, or the contrast of colour, constitute genuine use (paras 41 and 45).</p>		

Registered form	Actual use	Case No
		23/06/2011, R 1479/2010-2, VOLKS-LASUR (fig.) / LASUR et al.
<p>The word element was considered to be the dominant feature of the figurative mark, since it was in a central position and in large letters. It was considered that the distinctive character was not changed (para. 15).</p>		

Registered form	Actual use	Case No
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		29/04/2010, R 877/2009-1, Kaiku Bifi actiVium (fig.) / Bi-Fi (fig.)
<p>'The orange background is the colour of packaging of the products. The mark is used in black on a white background, outlined in silver similar to the earlier registered mark. The typeface has been slightly modernised and the small hyphen between "Bi" and "Fi" has been deleted. Nevertheless, these may be considered as minor changes which do not alter the distinctive character of the mark in the form in which it is registered ... The typeface has been modernised but the letters keep their rounded shape and the deletion of the hyphen may pass unnoticed. The distinctive character of the earlier mark is still based on the large black letters "Bi Fi", the "B" and "F" being in capital letters and the two "i" letters in lower case, on a white background and outlined in silver' (para. 45).</p>		

3D marks

The use of a 3D mark in varying sizes usually amounts to use of the mark as registered. The addition of a word/figurative element to such a mark does not generally alter the distinctive character of the sign.

Colour marks



Colour marks are marks consisting of one or more colours. Where the mark is a colour combination, the registration must indicate the proportion of each colour and specify how they will appear.

Colour marks must be used with the colours as registered. Insignificant variations in the colour shade and strength will not alter distinctive character.

Where a colour combination is registered without specifying the respective proportions, use in **varying proportions** will not affect distinctive character. The case is different when particular proportions were claimed and these are substantially altered in the variant as used.

Where a colour or colour combination is registered, use in combination with a **distinctive or descriptive word** will not affect distinctive character. See, by analogy, the Court judgment below regarding the proof of acquired distinctiveness of a mark (examination).



Registered form	Actual use	Case No
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	(with word mark John Deere)	28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417 (AG case)
<p>'The colours covered by the application for registration were designated using the Munsell system as: 9.47 GY3.57/7.45 (green) and 5.06 Y7.63/10.66 (yellow). The arrangement is described as being 'green for the vehicle body and yellow for the wheels', as is shown by a picture attached to the application and reproduced below</p>  <p>' (para. 3).</p> <p>'[A]lthough it is true that the disputed mark was used and promoted in conjunction with the word mark John Deere [underlining added] and that the intervener's advertising expenditure in the European Union was presented as a whole and not individually for each country, the applicant is wrong to claim that it was not proved to the required legal standard that the intervener had used the combination of the colours green and yellow on its goods as a trade mark and that the market penetration of its goods had been deep and long-lasting in all the Member States of the European Union as at 1 April 1996' (para. 46).</p>		

Unacceptable alterations

Where a mark is composed of several elements, only one or some of which are distinctive, that have rendered the mark as a whole registrable, an alteration of that element or its omission or replacement by another element will generally mean that the distinctive character is altered.

Registered form	Actual use	Case No
MEXAVIT	MEXA-VIT C	30/03/2007, R 159/2005-4, Metavit / MEXA-VIT C et al.
In this case the use of the mark with a different spelling and the addition of the letter 'C' alter the distinctive character of the registered sign, because the letters 'VIT' are now seen as a descriptive element, namely 'VIT C' (which refers to 'Vitamin C').		

Registered form	Actual use	Case No
		09/09/2011, R 2066/2010-4, HAPAG LLOYD EXPRESS

'[T]he 'NOVEDADES' catalogues dated 2004-2009 consistently show the mark



and only this version. This does not constitute use of the mark [as registered] (with or without colour) as admissible under Article 15(1)(a) CTMR [now Article 18(1)(a) EUTMR]. The mere fact that both marks include a word element LLOYD'S is not enough for that purpose, also the figurative elements of the earlier mark must appear in the form as used. The form as used is in a different font, lacks the single letter L at the end and surrounded by an orbital device, and lacks the circular or orbital device around the word 'LLOYD'S'. In other words, all its figurative elements are missing in the form as used. On top, the form as used contains the conspicuous device of a flying bird with a long beak. The omission of all the figurative elements of the mark as registered and the addition of another figurative element does alter, in the form as used, the distinctive character of the mark and is much more than a mere variation or modernisation' (para. 35).

Registered form	Actual use	Case No
		15/12/2015, T-83/14, ARTHUR & ASTON / Arthur, EU:T:2015:974
<p>There are significant differences between the sign used and the earlier mark in its registered form. Those differences are such as to alter, from the perspective of the average French consumer to whom the goods in Class 25 are addressed, the distinctiveness of the earlier mark in its registered form. The graphic element of that mark, consisting of a stylised signature, disappears entirely from the sign used and is replaced by a radically different graphic element which is very classical, symmetrical and static. The earlier mark in its registered form attracts attention by its asymmetry and the dynamism conferred by the movement of the letters from left to right. The differences between the abovementioned mark and sign are not negligible and the mark and sign cannot be regarded as being broadly equivalent within the meaning of the case-law. Having regard to the fact that the particular graphic design of the word 'arthur' contributes, with that word, to the distinctiveness of the earlier mark in its registered form and that it is radically altered in the sign used, the differences between the mark and the sign at issue are such that the distinctiveness of the first has been altered (paras 22-24).</p>		

2.8 Use for the goods or services for which the mark is registered

In accordance with Article 18 EUTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable. In accordance with the first

sentence of Article 47(2) EUTMR, the earlier registered mark must have been put to genuine use in connection with the goods or services in respect of which it is registered and which the opponent cites as justification for its opposition. The third sentence of Article 47(2) EUTMR stipulates that if the earlier trade mark has been used for part only of the goods or services for which it is registered it will, for the purposes of the examination of the opposition, be deemed to be registered for only that part of the goods or services.

As the General Court stated in the *Aladin* case:

The provisions of Article 43 of Regulation No 40/94 [now Article 47 EUTMR] allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a **limitation on the rights** which the proprietor of the earlier trade mark gains from his registration ..., and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to **extend his range of goods or services**, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly-defined category.

(14/07/2005, T-126/03, *Aladin*, EU:T:2005:288, § 51, emphasis added.)

The analysis of genuine use must in principle extend to all of the registered goods and/or services on which the opposition is based and for which the EUTM applicant has made an explicit request for proof of use. However, in situations where it is clear that likelihood of confusion can be established on the basis of **some** of the earlier goods and/or services, the Office's analysis of genuine use need not extend to all the earlier goods and/or services but instead may focus on only those goods and/or services sufficient for establishing identity/similarity to the contested goods and/or services.

In other words, since likelihood of confusion can be established on the basis of a finding of genuine use for some of the earlier goods and/or services, it is unnecessary to examine the evidence of use submitted by the opponent with respect to the remaining earlier goods and/or services.

The following sections include a number of guidelines to help establish whether the earlier trade mark has been effectively used for the registered goods and services. For further details, see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services and, in particular, the practice regarding the use of all the general indications in the class heading, and the Guidelines, Part B, Examination, Section 3, Classification.

2.8.1 Comparison between goods/services used and specification of goods/services

It must always be carefully assessed whether the goods and services for which the mark has been used fall within the category of the registered goods and services.

Examples

Case No	Registered G&S	Used G&S	Comment
18/01/2011, T-382/08, Vogue	<i>Footwear.</i>	<i>Retail of footwear.</i>	Not OK (paras 47, 48).
13/05/2009, T-183/08, Jello Schuhpark II	<i>Footwear.</i>	<i>Retail services regarding footwear.</i>	Not OK (para. 32)
08/11/2001, R 807/2000-3, DEMARA / DEMAR Antibioticos, S.A.	<i>Pharmaceuticals, veterinary and disinfectant products.</i>	<i>Napkins and napkin pants for incontinence.</i>	Not OK, even though the specific goods might be distributed by pharmacies (paras 14, 16).
03/10/2008, R 1533/2007-4, Geo Madrid (fig.) / GEO	<i>Telecommunication services in Class 38.</i>	<i>Providing an internet shopping platform.</i>	Not OK (para. 16).
03/05/2004, R 68/2003-2, SWEETIE / SWEETY	<i>Preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugar, biscuits, cakes, pastry and confectionery.</i>	<i>Dessert toppings that are strawberry, caramel or chocolate flavoured.</i>	Not OK (para. 20).
24/02/2010, R 1519/2008-1, DADO / DODOT et al.	<i>Baby diapers of textile in Class 25.</i>	<i>Disposable diapers of paper and cellulose (Class 16).</i>	Not OK (para. 29).
18/06/2010, R 594/2009-2, BANIF / BANIF (fig.)	<i>Administration, representation and general counsel in Class 35</i> <i>Technical, economic and administrative projects in Class 42.</i>	<i>Administration of funds and personal assets or real estate affairs (Class 36).</i>	Not OK (para. 39).
31/05/2011, B 1 589 871	<i>Electric switches and 'parts of lamps'.</i>	<i>Apparatus for lighting.</i>	Not OK.
25/11/2002, B 253 494	<i>Education services.</i>	<i>Entertainment services.</i>	Not OK.

Case No	Registered G&S	Used G&S	Comment
28/04/2011, B 1 259 136	<i>Transportation and distribution services</i> in Class 39.	<i>Home delivery of goods purchased in a retail store.</i>	Not OK as the registered services are provided by specialist transport companies whose business is not the provision of other services, while the home delivery of goods purchased in a retail store is just an additional auxiliary service integrated in retail services.
23/08/2012, R 1330/2011-4, AF (fig.)	<i>Advertising, business management, business administration, office functions</i> in Class 35.	<i>Retail services.</i>	Not OK. If a trade mark is registered for the general indications in Class 35, but use is proven only for <i>retail services</i> for particular goods, this cannot amount to valid proof of use for any of the specific indications of Class 35 or the class heading as a whole (para. 25 by analogy).

2.8.2 Relevance of the classification

It is relevant to establish whether the specific goods or services for which a mark has been used fall under any **general indication** listed in the **class heading** of a particular class of goods or services, and if so, which.

For instance, in Class 25, the class heading is *clothing, footwear, headgear*, and each of these three items constitutes a 'general indication'. Whereas, in general, classification does not serve more than administrative purposes, it is relevant, in order to assess the nature of the use, to establish whether the goods for which a mark has been used fall under the general indication of *clothing, footwear, headgear*.

This is apparent when similar categories of goods have been classified differently for certain reasons. For instance, shoes have been classified in various classes according to their intended purpose: *orthopaedic shoes* in Class 10 and ordinary *shoes* in

Class 25. It must be established, according to the evidence provided, to which kind of shoes the use relates.

2.8.3 Use and registration for general indications in 'class headings'

Where a mark is registered under **all** or **part of** the general indications listed in the class heading of a particular class and where it has been used for several goods or services that are properly classified in the same class under one of these **general indications**, the mark will be considered as having been used for that specific **general indication**.

Example: The earlier mark is registered for *clothing, footwear, headgear* in Class 25. The evidence relates to 'skirts', 'trousers' and 'T-shirts'.

Conclusion: The mark has been used for *clothing*.

On the other hand, when a mark is registered for only **part** of the **general indications** listed in the class heading of a particular class but has been used only for goods or services which fall under **another** general indication of that same class, the mark will not be considered as having been used for the registered goods or services (see also paragraph 2.8.4 below).

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

2.8.4 Use for subcategories of goods/services and similar goods/services

This part deals with the extent of protection granted where there is use for subcategories of goods and of 'similar' goods (or services).

In general, it is not appropriate to accept proof of use for 'different' but somehow 'linked' goods or services as automatically covering registered goods and services. In particular, the concept of **similarity of goods and services is not a valid consideration** within this context. The third sentence of Article 47(2) EUTMR does not provide any exception in this regard.

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

2.8.4.1 Earlier mark registered for broad category of goods/services

In the *Aladin* case, the General Court held:

if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition

proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45; see also 16/07/2020, C-714/18 P, tigha / TAIGA, EU:C:2020:573, § 43.)

Therefore, if the earlier mark has been registered for a **broad category** of goods or services but the opponent provides evidence of use only for specific goods or services **falling within this category**, this raises the question of whether the submitted evidence is to be regarded strictly as proof of use only for the particular goods or services, which are not mentioned as such in the list of goods or services, or for the broad category as specified in the registration.

The General Court further pointed out, on the one hand, that it is necessary to interpret the last sentence of Article 47(2) EUTMR as seeking to deny a trade mark extensive protection, if it has only been used in relation to part of the goods or services for which it is registered, merely because it has been registered for a wide range of goods or services. Therefore, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark is registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do so in the light of the goods or services for which genuine use has actually been established (paragraph 44).

On the other hand, it is not necessary for the opponent to file evidence of all the commercial variations of similar goods or services but merely of those goods or services that are sufficiently distinct to constitute coherent categories or subcategories (paragraph 46). The underlying reason is that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration.

Thus, protection is available **only** for the subcategory or subcategories to which the used goods or services belong if:

1. a trade mark has been registered for a **category** of goods or services:
 - a. that is sufficiently broad to cover a number of subcategories other than in an arbitrary manner;
 - b. that are capable of being perceived as being independent from each other;and
2. it can be shown that the mark has been genuinely used in relation to only **part** of the initial broad specification.

Appropriate reasoning should be given for defining the subcategories and, on the basis of the evidence submitted by the opponent, it must be explained whether use has been shown in relation to only **part** of the initial broad specification or subcategory/subcategories. See examples in paragraph 2.8.4.3 below.

This is especially important in the case of trade marks registered for *pharmaceutical preparations*, which are usually used only for one kind of medicine for treating a certain disease (see the examples of **pharmaceutical preparations** in paragraph 2.8.4.3 below).

On the other hand, the use for a whole category has to be accepted if there are examples of different kinds of products belonging to this category and there is no other subcategory that covers the different products.

Contested sign	Case No
CARRERA	09/09/2009, R 260/2009-4, (revocation)
<p>The proven use of a trade mark for:</p> <ul style="list-style-type: none"> • decorative lettering; • increased performance packages; • covers for storage compartments; • wheel sets and complete wheel sets for summer and winter; and • door sill cover plates <p>was considered sufficient proof of use for <i>motor vehicle and land vehicle parts</i> overall, for which the mark was registered. The main arguments were that it was used for numerous different motor vehicle parts and the goods for which use had been proven thus covered a wide spectrum of motor vehicle parts: elements of the chassis, the bodywork, the engine, the interior design and decorative elements.</p>	

In the case of a mark registered for a **broad category of goods and services that is not sufficiently clear and precise** to enable the competent authorities and economic operators, on that sole basis, to determine the scope of protection, it should be possible, in principle, to determine the precise scope through proof of use (29/01/2020, C-371/18, SKY, EU:C:2020:45, § 68-70; 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 136). The general principles stated above apply. For further information on unclear and imprecise terms, see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services, paragraph 1.5.2.

2.8.4.2 Earlier mark registered for precisely specified goods/services

In contrast, proof of genuine use of the mark for some of the specified goods or services necessarily covers the **entire category** if:

1. a trade mark has been registered for goods or services **specified** in a relatively precise manner; so that
2. it is not possible, without any artificiality, to make any significant subdivisions within the category concerned (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45; 16/07/2020, C-714/18 P, tigha / TAIGA, EU:C: 2020:573, § 42).

The decision should duly indicate in which cases it is considered impossible to make subdivisions and, if necessary, why.

2.8.4.3 Examples


In order to define adequate subcategories of general **indications**, the **criterion of the purpose or intended use of the product or service** in question is of fundamental importance, as consumers do employ this criterion before making a purchase (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 29-30; 23/09/2009, T-493/07, *Famoxin*, EU:T:2009:355, § 37). If the goods or services concerned have several purposes, it is not possible to create, in a non-arbitrary manner, separate subcategories by considering in isolation each of those purposes (16/07/2020, C-714/18 P, *tigha / TAIGA*, EU:C: 2020:573, § 51).

Other applicable criteria for defining adequate subcategories could be the characteristics of the product or service, for instance the nature of the product or service or the target consumer of the product or service. The geographical origin of the goods is not relevant. Even if the geographical origin of wines is an important factor when they are being chosen, such a factor is not so important that wines with different appellations of origin could constitute subcategories of goods that could be viewed autonomously (30/06/2015, T-489/13, *VIÑA ALBERDI / VILLA ALBERTI*, EU:T:2015:446, § 37).

Earlier sign	Case No
ALADIN	14/07/2005, T-126/03
<p>G&S: <i>polish for metals</i> in Class 3.</p> <p>Assessment of PoU: the earlier mark was registered for <i>polish for metals</i> in Class 3, but was actually used genuinely only for <i>magic cotton</i> (a product for polishing metals consisting of cotton impregnated with a polishing agent). The Court held that 'polish for metals', which in itself is already a subcategory of the class heading term <i>polishing preparations</i>, is sufficiently precise and narrowly defined in terms of the function and intended purpose of the claimed goods. No further subcategory can be established without being artificial, and thus, use for the entire category of <i>polish for metals</i> was assumed.</p>	

Contested sign	Case No
PELLICO	15/06/2018, R 2595/2015-G, PELLICO (fig.) Revocation
<p>G&S: <i>footwear</i> in Class 25.</p> <p>Assessment of PoU: use has been proven for <i>women's footwear</i> only, which constitutes a sufficiently distinct subcategory within the broad category of <i>footwear</i>. The targeted consumer does not wish only to satisfy the needs of covering and protecting their own feet, but is looking specifically for ladies' shoes. Market realities also support such division: many shoe shops offer exclusively women's footwear or physically separate the women's footwear section from the rest (paras 32, 39-42).</p>	

Contested sign	Case No
Turbo	19/06/2007, R 378/2006-2, TURBO Revocation
<p>G&S: <i>clothing</i> in Class 25.</p> <p>Assessment of PoU: the Board found that, in addition to swimwear, other types of clothing were referred to in the invoices and could be found in the catalogues, for example t-shirts, Bermuda shorts, cycling shorts and female underwear (para. 21). Thus, the Board found that use of the contested mark had been proved for <i>clothing</i> (para. 22). The Board, moreover, found it almost impossible and certainly unduly onerous to impose on the proprietor of a registered EUTM for <i>clothing</i> the obligation to demonstrate use in all possible subcategories that could be endlessly subdivided by the applicant (para. 25).</p>	

Earlier sign	Case No
	19/01/2009, R 1088/2008-2, EPCOS (fig.) / E epco SISTEMAS (fig.); confirmed 15/12/2010, T-132/09, Epcos, EU:T:2010:518
<p>G&S: <i>measuring apparatus and instruments</i> in Class 9.</p> <p>Assessment of PoU: the mark was used for apparatus and parts thereof for the measurement of temperature, pressure and level. The contested decision considered that the original specification of the earlier mark for <i>measuring apparatus and instruments</i> was a 'very wide' one, and determined, applying the criteria established in the <i>Aladin</i> judgment, that use had in fact only been shown for a subcategory of goods, namely: <i>measuring apparatus, all being for the measurement of temperature, pressure and level; parts for the aforesaid apparatus</i>. The Board found that approach to be a reasonable one in the circumstances of the case and endorsed the reasoning and findings of the contested decision in this regard (para. 29).</p>	

Contested sign	Case No
ICEBERG	23/07/2009, R 1166/2008-1, ICEBERG Revocation

Contested sign	Case No
<p>G&S: <i>apparatus for heating, steam generating, refrigerating, drying, ventilating and water supply purposes</i> in Class 11.</p> <p>Assessment of PoU: the Board concluded that the trade mark use was only proven for fridges, freezers and air-conditioning modules for yachts and boats (para. 26). These goods were included in the subcategories <i>apparatus for heating</i> (insofar as an air-conditioning machine can also perform as a heater), <i>apparatus for refrigerating</i> (insofar as an air-conditioning machine, a fridge and a freezer can keep air/things cold), and <i>apparatus for ventilating</i> (insofar as an air-conditioning machine, a fridge and a freezer all include ventilation circuits), for which the mark was registered. Therefore, the Board thought it should remain registered for those subcategories (para. 27). However, the Board did not consider it appropriate to limit the scope of protection of the trade mark to <i>yachts and boats</i>. This would have further split the 'subcategories' and would amount to unjustified limitation (para. 28).</p> <p>Conclusion: use was considered proven for <i>apparatus for heating, refrigerating and ventilating</i>.</p>	

Contested sign	Case No
LOTUS	02/12/2008, R 1295/2007-4, LOTUS Revocation
<p>G&S: <i>outerwear and underwear, hosiery, corsets, neckties, braces, gloves, underclothes</i> in Class 25.</p> <p>Assessment of PoU: no evidence was submitted in respect of the goods <i>corsets, neckties, braces</i>. None of the pieces of evidence submitted mentions these goods or refers to them. Use must be demonstrated for all goods or services for which the trade mark is registered. The trade mark is registered for <i>outerwear and underwear</i>, but also for specific products within this category — inter alia <i>corsets, neckties, braces</i>. Use for other goods is not sufficient to maintain protection under trade mark law for these goods, even if these other goods also fall under the category <i>outerwear and underwear</i>. The Invalidity Division, however, considered use to be sufficient because, according to the principles of the <i>Aladin</i> judgment (14/07/2005, T-126/03, <i>Aladin</i>, EU:T:2005:288) the <i>corsets, neckties, braces</i> fall under the generic term of <i>outerwear and underwear</i>. While this is indeed true, this question is subordinate to examining whether the goods used can be subsumed under the claimed term at all. This is not the case for <i>corsets, neckties, braces</i>. If, alongside the broad generic term, the trade mark also explicitly claims specific goods covered by the generic term, it must also have been used for these specific goods in order to remain registered for them (para. 25).</p>	

Earlier sign	Case No
GRAF-SYTECO	16/12/2010, R 1113/2009-4, GRAFSYSTEM / GRAF-SYTECO

G&S: *electric instruments (included in Class 9); optical, weighing, measuring, signalling and checking (supervision) instruments; data processing equipment and computers, in particular for operating, monitoring and checking machines, installations, vehicles and buildings; recorded computer programs; electronic counters* in Class 9, *repair services* in Class 37 and *computer programming* in Class 42.

Assessment of PoU: the devices that the opponent has proven to have placed on the market fall under the wording of *hardware* as specified in Class 9. This is, however, a vast category, especially considering the massive development and high specialisation taking place in this field, which can be divided into subcategories according to the actual goods produced. In the present case, the goods must be limited to the automotive industry. As the opponent is obliged to provide a legal guarantee to clients, it can be considered that it has also proven use of the service relating to repair of the hardware in question (Class 37). The Board also found that *recorded computer programs* in Class 9 were a very broad category and had to be limited to the actual field of activity of the opponent (paras 30-31). No evidence was submitted for Class 42.

Earlier sign	Case No
HEMICELL	20/09/2010, R 155/2010-2, HICELL (fig.) / HEMICELL
<p>G&S: <i>foodstuffs for animals</i> in Class 31, and <i>animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31.</i></p> <p>Assessment of PoU: the contested decision erred in considering that the earlier mark had been put to genuine use for <i>foodstuffs for animals</i> in Class 31, and <i>animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31</i>, since this finding is contrary to the findings of the Court in <i>Aladin</i>. The reason given by the contested decision is not acceptable because it should have been tested whether or not the category of goods covered by the earlier mark was susceptible of being divided into independent subcategories and whether the goods for which use of the earlier mark had been proven could be classified in one of those. Therefore, the Board considers that the earlier EUTM is, for the purposes of examination of the opposition, deemed to be registered in respect of <i>additives for animal feed</i> only in Class 31.</p>	

Contested sign	Case No
VIGOR	18/11/2015, T-361/13, VIGOR / VIGAR

Contested sign	Case No
<p>G&S: <i>all kinds of brushes and brush goods, for cleaning and hygiene purposes</i> in Class 21.</p> <p>The proven use of a trade mark for brooms, brushes and sponges, among other goods, was considered sufficient proof of use for 'all kinds of brushes and brush goods, for cleaning and hygiene purposes', for which the mark was registered. The Court stated that these household and kitchen products do not constitute a category that is broad enough for it to be necessary to identify them within subcategories in which actual use had specifically to be proven. Rather, it must be held that it is not possible to make significant subdivisions within that category of goods.</p>	

Pharmaceutical preparations

In a number of cases, the Court had to define adequate subcategories for *pharmaceutical preparations* in Class 5. It held that the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. Thus, the *therapeutic indication* is the key for defining the relevant subcategory of pharmaceutical products. Other criteria (such as dosage form, active ingredients, whether it is sold on prescription or over the counter) are irrelevant in this regard.

The following subcategories for *pharmaceutical preparations* were assumed to be adequate by the Court:

Case No	Adequate	Non-adequate
13/02/2007, T-256/04, Respicur	<i>Pharmaceutical preparations for respiratory illnesses.</i>	<i>Multi-dose dry powder inhalers containing corticoids, available only on prescription.</i>
23/09/2009, T-493/07, Famoxin	<i>Pharmaceutical preparations for cardiovascular illnesses.</i>	<i>Pharmaceutical preparations with digoxin for human use for cardiovascular illnesses.</i>
16/06/2010, T-487/08, Kremezin, EU:T:2010:237	<i>Pharmaceutical preparations for heart treatment.</i>	<i>Sterile solution of adenosine for use in the treatment of specific heart condition, for intravenous administration in hospitals.</i>
17/10/2006, T-483/04, Galzin, EU:T:2006:323	<i>Calcium-based preparations.</i>	<i>Pharmaceutical preparations.</i>

2.8.5 Use of the mark as regards integral parts and after-sales services of the registered goods

In the *Minimax* judgment, the Court held that, in certain circumstances, use of the mark may be considered genuine also for 'registered' goods that had been sold at one time

and were no longer available (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 40 et seq.).

- This may apply where the proprietor of the trade mark under which such goods had been put on the market **sells parts** that are integral to the make-up or structure of the goods previously sold.
- The same may apply where the trade mark proprietor makes actual use of the mark for **after-sales services**, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

Sign	Case No
Minimax	11/03/2003, C-40/01
<p><i>G&S: fire extinguishers and associated products v components and after-sales services.</i></p> <p>Assessment of PoU: the authorisation for the fire extinguishers sold by Ansul under the Minimax trade mark expired in the 1980s. Since then, Ansul has not been selling fire extinguishers under that mark. However, Ansul nonetheless sold component parts and extinguishing substances for fire extinguishers bearing the mark to undertakings with responsibility for maintaining them. During the same period, it also maintained, checked and repaired equipment bearing the Minimax mark itself, used the mark on invoices relating to those services and affixed stickers bearing the mark and strips bearing the words 'Gebruiksklaar Minimax' (Ready for use Minimax) to the equipment. Ansul also sold these stickers and strips to undertakings that maintain fire extinguishers.</p>	

However, this finding of the Court should be interpreted **strictly** and applied only in very exceptional cases. In *Minimax*, the Court accepted use for goods other than those registered, which runs counter to the general rule laid down in Article 47(2) EUTMR.

2.8.6 Use for the sale of the manufacturer's own goods

Retail services in Class 35 are defined in the explanatory note of the Nice Classification as

... the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes.

It follows from that explanatory note that the concept of 'retail services' relates to **three essential characteristics**: firstly, the purpose of these services is the sale of goods to consumers; secondly, they are addressed to consumers with a view to enabling them to conveniently view and purchase the goods; and, thirdly, they are provided for the benefit of others (04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, *BURLINGTON / BURLINGTON ARCADE et al.*, EU:C:2020:151, § 126). The '**others**' benefiting from the 'bringing together of a **variety** of goods' are the various manufacturers looking for an outlet for their goods.

The Court has held that the objective of retail trade is the sale of goods to consumers. This includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question, rather than with a competitor (07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 34). For example, the concept of 'retail services' includes a shopping arcade's services aimed at consumers with a view to enabling them to conveniently view and purchase the goods, for the benefit of the businesses occupying the arcade concerned (04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 130). The Court has confirmed that services can also be the subject of retail trade as there are situations in which a trader selects and offers an assortment of third-party services so that the consumer can choose among those services from a single point of contact (10/07/2014, C-420/13, Netto Marken-Discount, EU:C:2014:2069, § 34).

In the same way that advertising one's own goods does not constitute use for advertising services in Class 35, there is no use for retail services in Class 35 where the manufacturer is merely selling its own goods from its shop or website. The sale by the manufacturer of its own goods is not an independent service but an activity covered by the protection conferred by registration for the **goods**. It would not be appropriate to equate the protection conferred by registration for goods in any of Classes 1 to 34 with that conferred by registration for Class 35 retail services. While manufacturers may provide ancillary services (such as maintaining an outlet with shop assistants, advertising, consultancy, after-sales services, etc.) in the course of the sale of their own goods, such activities fall within the concept of a remunerated 'service' only if they do not form an integral part of the offer for sale of the goods (10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 26). Consequently, if a manufacturer uses a trade mark in relation to activities that form an integral part of the offer for the sale of its own goods, there is no use for retail services of such goods in Class 35. This interpretation is also confirmed by the examples of (infringing) use provided in Article 9(3) EUTMR.

Nor would such sales activity be in line with the definition of 'retail services' as provided in the explanatory note to the Nice Classification and interpreted by the Court, because it does not entail any benefit for third-party manufacturers. Therefore, an essential characteristic of retail services is missing.

Furthermore, genuine use must be consistent with the essential function of a trade mark. The trade mark used in relation to an outlet for the manufacturer's own goods serves to distinguish those **goods** from goods of other manufacturers but not to distinguish the **services** provided through that outlet from those provided through other outlets. Manufacturers selling their own goods from their own shops compete on the market of the **goods** they are selling but do not compete on the **retail services** market, which targets third-party manufacturers. Operating a shop **exclusively** for the purpose of selling the manufacturer's own goods excludes offering competing goods from third-party manufacturers.

However, genuine use for retail services should not be denied if the opponent, when bringing together goods offered by third parties, includes, in addition to goods offered by other traders, goods that it itself manufactures.

2.9 Use by the proprietor or on its behalf

2.9.1 Use by the proprietor

According to Articles 18(1) and 47(2) EUTMR, it is in general the owner who has to put the earlier registered mark to genuine use. These provisions also cover use of the mark by the previous owner during its ownership (10/12/1999, B 74 494).

2.9.2 Use by authorised third parties

According to Article 18(2) EUTMR, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent **prior** to the use of the mark by the third party. Acceptance later is insufficient.

A typical case of use by third parties is use made by **licensees**. Use by companies **economically related** to the trade mark proprietor, such as members of the same group of companies (affiliates, subsidiaries, etc.) is similarly to be considered as authorised use (30/01/2015, T-278/13, now, EU:T:2015:57, § 38). Where goods are produced by the trade mark proprietor (or with its consent), but subsequently placed on the market by **distributors** at wholesale or retail level, this is to be considered as use of the mark (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32; 16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 73).

At the **evidence** stage it is prima facie sufficient that the opponent only submits evidence that a third party has used the mark. The Office infers from such use, combined with the opponent's ability to present evidence of it, that the opponent has given prior consent.

This position of the Office was confirmed by judgment of 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 25 (further confirmed 11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310). The Court pointed out that it was unlikely that the proprietor of a trade mark would be in a position to submit evidence if the mark had been used against its wishes. There was all the more reason to **rely on that presumption**, given that the applicant did not dispute the opponent's consent.

However, if the Office has **doubts** or, in general, in cases where the applicant explicitly contests the opponent's consent, the burden is on the opponent to submit further evidence that it gave its consent prior to use of the mark. In such cases, the Office gives the opponent a further period of 2 months for the submission of such evidence.

2.9.3 Use of collective and certification marks by authorised users

Collective marks are generally used not by the proprietor association but rather by its members. As far as EU collective marks are concerned, this is reflected in Article 78 EUTMR, which provides that use by any authorised person satisfies the user requirement.

Certification marks are not used by their proprietors but by authorised users, for the purpose of guaranteeing to consumers that the goods or services possess a particular characteristic. As far as EU certification marks are concerned, this is reflected in Article 87 EUTMR, which provides that use by the authorised person in accordance with the regulations governing the use of the certification mark satisfies the user requirement.

2.10 Legal use

Whether a mark has been used in a way that satisfies the use requirements of Articles 18 and 47 EUTMR requires a factual finding of genuine use. Use will be 'genuine' in this context even if the user violates legal provisions.

Use that is **deceptive** within the meaning of Article 7(1)(g) or Article 58(1)(c) EUTMR or under provisions of national law remains 'genuine' for the purpose of asserting earlier marks in opposition proceedings. The sanctions for deceptive use are invalidation or revocation, as the case may be, or a prohibition of use (provided for pursuant to Article 137(2) EUTMR).

The same principle applies where use is made under an illegal licensing arrangement (for example arrangements violating the competition rules of the Treaty on the Functioning of the European Union or national rules). Similarly, the fact that use may infringe third-party rights is also irrelevant.

2.11 Justification of non-use

According to Article 47(2) EUTMR, the opponent may alternatively prove that there are justifiable reasons for non-use of its earlier registered mark. These reasons cover, as mentioned in the second sentence of Article 19(1) of the TRIPS agreement, circumstances arising independently of the will of the owner of the trade mark that constitute an obstacle to the use of the trade mark.

As an exception to the obligation of use, the concept of proper reasons for non-use is to be interpreted rather narrowly.

'Bureaucratic obstacles' as such, that arise **independently of the will** of the trade mark proprietor, are not sufficient, unless they have a **direct relationship** with the mark, so much so that use of the trade mark depends on successful completion of the administrative action concerned. However, the criterion of a direct relationship does not necessarily imply that use of the trade mark is impossible; it might suffice that use is

unreasonable. It must be assessed on a case-by-case basis whether a change in the undertaking's strategy to circumvent the obstacle under consideration would make use of the mark unreasonable. Thus, for example, the proprietor of a mark cannot reasonably be required to change its corporate strategy and sell its goods in its competitors' sales outlets (14/06/2007, C-246/05, *Le Chef de Cuisine*, EU:C:2007:340, § 52).

2.11.1 Business risks

The concept of proper reasons must be considered to refer to circumstances arising independently of the will of the owner that make use of the mark impossible or unreasonable, rather than to circumstances associated with commercial difficulties it is experiencing (14/05/0008, R 855/2007-4, *PAN AM*, § 27; 09/07/2003, T-156/01, *Giorgio Aire*, EU:T:2003:198, § 41; 18/03/2015, T-250/13, *SMART WATER*, EU:T:2015:160, § 67-69).

Thus, financial difficulties encountered by a company as a result of an economic recession or due to its own financial problems are not considered to constitute proper reasons for non-use within the meaning of Article 47(2) EUTMR, as these kinds of difficulties constitute a natural part of running a business.

2.11.2 Government or court intervention

Import restrictions or other government requirements are two examples of proper reasons for non-use that are explicitly mentioned in the second sentence of Article 19(1) of the TRIPS agreement.

Import restrictions include a trade embargo affecting the goods protected by the mark.

Other **government requirements** can be a state monopoly, which impedes any kind of use, or a state prohibition of the sale of goods for reasons of health or national defence. Typical cases in this respect are regulatory procedures such as:

- clinical trials and authorisation for new medicines (18/04/2007, R 155/2006-1, *LEVENIA / LEVELINA*); or
- the authorisation of a food safety authority, which the owner has to obtain before offering the relevant goods and services on the market.

Earlier sign	Case No
HEMICELL	20/09/2010, R 155/2010-2, <i>HICELL (fig.) / HEMICELL</i>

Earlier sign	Case No
The evidence submitted by the opponent duly shows that use of the earlier marks for a food additive, namely, <i>zootechnical digestibility enhancer (feed enzyme)</i> was conditional upon prior authorisation, to be issued by the European Food Safety Authority following an application filed before that body. Such a requirement is to be deemed a government requirement in the sense of Article 19(1) TRIPS.	

With regard to Court proceedings or interim injunctions, the following must be differentiated:

On the one hand, the mere threat of litigation or a pending cancellation action against the earlier mark should not exempt the opponent from the obligation to use its trade mark in the course of trade. It is up to the opponent, being the attacking party in opposition proceedings, to conduct an adequate risk assessment of its chances to prevail in the litigation proceedings and to draw the appropriate conclusions from this evaluation as to whether or not to continue with use of its mark (18/02/2013, R 1101/2011-2, SMART WATER, § 40; 18/03/2015, T-250/13, SMART WATER, EU:T:2015:160).

Earlier sign	Case No
HUGO BOSS	09/03/2010, R 764/2009-4, HUGO BOSS / BOSS
<p>The national [French cancellation] proceedings brought against the opposing trade mark cannot be acknowledged as a proper reason for non-use (para. 19).</p> <p>The fact remains that proper reasons for non-use are only those outside the sphere and influence of the trade mark proprietor, for instance national authorisation requirements or import restrictions. These are neutral with regard to the trade mark to be used; they concern not the trade mark but the goods and services that the proprietor wishes to use. Such national authorisation requirements or import restrictions apply to the type or properties of the product to which the trade mark is affixed, and cannot be circumvented by choosing a different trade mark. In the present case, conversely, the trade mark proprietor could have readily manufactured cigarettes in France or imported them into France if it had chosen a different trade mark (para. 25).</p>	

Earlier sign	Case No
MANPOWER	18/06/2010, R 997/2009-4, MOON-POWER / MANPOWER

According to Article 9 EUTMR and Article 5 of Directive 2008/95/EC, the trade marks of third parties must not be infringed. The requirement not to infringe trade marks applies to any person using a name in the course of trade, regardless of whether it has itself applied for or been granted trade mark protection for that name. A person refraining from such infringements is acting not for 'proper reasons' but as ordered by law. Hence, even refraining from use that would otherwise infringe a right is not a proper reason (09/03/2010, R 764/2009-4, HUGO BOSS / BOSS, § 22) (para. 27).

Nor is use in such instances 'unreasonable'. Persons who, as trade mark proprietors, are threatened with proceedings or an interim injunction if they start using the trade mark concerned, must consider the prospects of the action against them succeeding and can either capitulate (not start using the trade mark) or defend themselves against the complaint. In any event, they have to accept the decision of the independent courts, which may be in expedited proceedings. Nor, pending a decision at final instance, can they object that they must be protected by the fact that, until that decision becomes final, uncertainty is to be recognised as a proper reason for non-use. In fact, the issue of what should happen in the period between the filing of an action or the application for an interim injunction and the conclusive final decision is again to be left to the courts, in that they take decisions that are not yet final on provisional enforceability. The defendant is not entitled to ignore those decisions and be put in a position as if there were no courts (para. 28).

On the other hand, for example, an interim injunction or a restraining court order in insolvency proceedings, imposing a general prohibition of transfers or disposals on the trade mark owner, can be a proper reason for non-use because it obliges the opponent to refrain from using its mark in the course of trade. Use of the mark contrary to such a court order would make the trade mark owner liable to damage claims (11/12/2007, R 77/2006-1, MISS INTERCONTINENTAL (fig.), § 51).

2.11.3 Defensive registrations

The General Court has clarified that the existence of a national provision recognising what are known as 'defensive' registrations (i.e. of signs not intended to be used in trade on account of their purely defensive function in relation to another sign that is being commercially exploited) cannot constitute a proper reason for non-use of an earlier trade mark invoked as a basis of an opposition (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 46).

2.11.4 *Force majeure*

Further justifiable reasons for non-use are cases of *force majeure* that hinder the normal functioning of the owner's enterprise.

2.11.5 Consequences of justification of non-use

The existence of justified reasons does not mean that non-use during the period concerned is treated as equivalent to actual use, which would result in a new grace period beginning after the end of the period of justified non-use.

Rather, non-use during such period merely stops the 5-year period from running. This means that the period of justified non-use is not taken into account in calculating the grace period of 5 years.

In addition, the length of time during which justified reasons existed may be significant. Reasons for non-use existing during only part of the relevant 5-year-period may not always be considered justification for setting the proof-of-use requirement aside. In this context, the period of time during which these reasons were pertinent and the elapse of time since they no longer applied are of particular importance (01/07/1999, B 2 255).

2.12 Decision

2.12.1 Competence of the Office

The Office makes its own evaluation of the evidence of use submitted. This means that the probative value of the evidence submitted is evaluated independently of the observations submitted by the applicant in this respect. Assessment of the relevance, pertinence, conclusiveness and efficacy of evidence lies within the discretion and power of judgment of the Office, not the parties, and falls outside the adversarial principle that governs *inter partes* proceedings (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.), § 19; 14/11/2000, R 823/1999-3, SIDOL / SIDOLIN).

A declaration by the applicant concluding that use has been proved does not, therefore, have any effect on the Office's findings. The request for proof of use is a defence plea by the applicant. However, once the defence plea has been raised by the applicant, it is solely up to the Office to carry out the subsequent procedure and evaluate whether the evidence submitted by the opponent is to be regarded as of sufficient probative value. However, the applicant does have the possibility of formally withdrawing the request for proof of use (see paragraph 3.4.4 above).

This is not contrary to Article 95(1) EUTMR, which stipulates that in *inter partes* proceedings the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. However, although the Office is bound by the facts, evidence and arguments provided by the parties, it is not bound by the legal value that the parties may give thereto. Hence, the parties may agree as to which facts have been proved or not, but may not determine whether or not these facts are sufficient to establish genuine use (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.), § 19; 14/11/2000, R 823/1999-3, SIDOL / SIDOLIN, § 20; 13/03/2001, R 68/2000-2, MOBEC / NOVEX PHARMA).

2.12.2 Need for assessing proof of use

A decision on whether the obligation of having genuinely used the registered mark has been fulfilled is not always necessary.

When **proof of use** of the earlier rights has been requested by the applicant, the Office will also examine whether, and to what extent, use has been proved for the earlier marks, provided this is relevant for the outcome of the decision in question. The examination of proof of use is always necessary and obligatory in cases where the opposition is fully or partially successful on the basis of the earlier mark that was subject to the proof of use obligation.

The Office may decide not to assess the proof of use if it is irrelevant to the outcome of the opposition, for example:

- under the ground of Article 8(1)(b) EUTMR, if there is no likelihood of confusion between the contested mark and the earlier mark that is subject to the proof of use obligation (15/02/2005, T-296/02, Lindenhof, EU:T:2005:49, § 43);
- if the opposition is fully successful on the basis of another earlier mark, which is not subject to the proof of use obligation;
- if the opposition is fully successful on the grounds of Article 8(3) and/or Article 8(4) EUTMR;
- under the ground of Article 8(5) EUTMR, if one of the necessary conditions for application of this ground is not fulfilled.

However, in the event that the earlier trade mark that was subject to the proof of use obligation was examined in the decision but the assessment of the proof of use has been omitted, this will be expressly stated in the decision with a brief justification.

2.12.3 Overall assessment of the evidence presented

As stated in more detail above (see paragraph 2.2 above), the Office has to evaluate the evidence submitted with regard to place, time, extent and nature of use in an **overall assessment**. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31).

The **principle of interdependence** applies, meaning that weak evidence with regard to one relevant factor (e.g. low sales volume) might be compensated by solid evidence with regard to another factor (e.g. continuous use over a long period of time).

All the circumstances of the specific case have to be taken into account **in conjunction with each other** in order to determine whether the mark in question has been genuinely used. The particular circumstances can include, for example, the specific features of the goods/services in question (e.g. low- or high-priced; mass products versus special products) or the particular market or business area.

Indirect/circumstantial evidence, under certain conditions even on its own, can also be suitable for proving genuine use.

As the Office does not assess commercial success, even minimal use (but not mere token or internal use) can be sufficient to be deemed 'genuine', as long as it is viewed as warranted in the economic sector concerned to maintain or acquire a share in the market.

The decision indicates what **evidence** was submitted. However, in general, only the evidence relevant for the conclusion is mentioned. If the evidence is found convincing, it suffices for the Office to indicate those documents that were used to come to this conclusion and why. If an opposition is rejected because the proof of use was not sufficient, neither likelihood of confusion nor Article 8(5) EUTMR, if claimed, is to be addressed.

2.12.4 Treatment of confidential information

Pursuant to Article 113(1) EUTMR, the Office must publish its decisions. On the other hand, pursuant to Article 114(4) EUTMR, upon the prior request of a party with a special interest in keeping parts of the file confidential, the data concerned must be kept confidential vis-à-vis the public ⁽⁷²⁾. However, the need to keep certain data confidential does not exempt the Office from the obligation to state the reasons for its decisions.

Given the public nature of decisions, the justified interest of a party in keeping certain information confidential vis-à-vis the public has to be reconciled with the Office's duty to state reasons. It may be problematic to reason without divulging confidential business data, but this can be done by referring to those data in a general manner and without disclosing concrete data. For example, the decision may refer to the invoices submitted, indicate the time span, frequency and territory of sales, the significance of the sales volumes they represent and whether they are sufficient to support the finding of genuine use. What is important is that the decision reflects that the relevant business data were considered and assessed in relation to the kind of goods and services at issue and the characteristics of the relevant market. Simply stating whether the relevant factors (time, place, nature and extent of use) have been fulfilled or not is not sufficient to support the final conclusion on the issue of genuine use.

Finally, it must be clarified that, notwithstanding the confidentiality of an entire submission or annex, data contained therein that are clearly within the public domain (e.g. in the form of press extracts) can be referred to in the decision.

2.12.5 Examples

The following cases present some of the decisions of the Office and the Court (with different outcomes) where the overall assessment of the submitted evidence was important.

⁷² Note, however, that no parts of the file can be kept confidential vis-à-vis the other party to the proceedings due to the right of defence (see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.4.4).

2.12.5.1 Genuine use accepted

Case No	Comment
17/02/2011, T-324/09, Friboi, EU:T:2011:47	<p>The opponent (Fribo Foods Ltd.) submitted several invoices relating to large quantities of goods, addressed to its distribution company (Plusfood Ltd.), which belongs to the same group (Plusfood Group). It is not disputed that the distribution company put the products on the market later. Furthermore, the opponent presented undated brochures, a press clip and three price lists. With regard to the 'internal' invoices, the Court held that the producer-distributor-market chain was a common method of business organisation, which could not be regarded as purely internal use. The undated brochures had to be seen in conjunction with other dated evidence such as invoices and price lists and, therefore, might still be taken into consideration. The Court accepted genuine use and stressed that an overall assessment implied that all the relevant factors be viewed as a whole and not in isolation.</p>
02/05/2011, R 872/2010-4, CERASIL / CERATOSIL	<p>The opponent submitted inter alia about 50 invoices, not in the language of proceedings. The names of the addressees as well as the quantities sold were blacked out. The Boards held that standard invoices containing the usual information (date, indication of seller's and buyer's name/ address, product concerned, price paid) did not require a translation. Even though the names of the addressees and the quantities sold were blacked out, the invoices nevertheless confirmed the sale of 'CERATOSIL' products, measured in kilograms, to companies throughout the relevant territory during the relevant period. Together with the remaining evidence (brochures, affidavit, articles, photographs), this was considered sufficient to prove genuine use.</p>

Case No	Comment
29/11/2010, B 1 477 670	<p>The opponent, which was active in the field of vehicle maintenance and the management of businesses associated with buying and selling vehicles, provided several Annual Reports giving a general overview of its overall commercial and financial activities. The OD found that these reports, by themselves, did not provide sufficient information on actual use for the majority of services claimed. However, in conjunction with advertisements and publicity displaying the mark in question for particular services, the OD concluded that the evidence as a whole provided sufficient indications as to the scope, nature, period and place of use for these services.</p>
29/11/2010, R 919/2009-4, GELITE / GEHOLIT	<p>The documents submitted by the appellant showed use of the trade mark for 'coating materials based on artificial resin (base, intermediate and top coatings) and industrial lacquers'. The attached labels showed use of the trade mark for various base, primer and top coatings. This information coincided with the attached price lists. The associated technical information sheets described the goods as corrosion coatings based on artificial resin, which are offered for sale in various colours. The attached invoices showed that these goods were supplied to various customers in Germany. Although the turnover figures stated in the written declaration in relation to the period from 2002 to 2007 did not expressly refer to Germany, it had to be concluded that they were obtained at least in part also in Germany. Consequently, the earlier mark was deemed to be used for the goods <i>lacquer, lacquer paints, varnishes, paints; dispersions and emulsions to coat and repair surfaces</i> because it was not possible to create any further subcategories for these goods.</p>

Case No	Comment
20/04/2010, R 878/2009-2, SOLEA / Balea	<p>The solemn declaration refers to high sales figures (over EUR 100 million) for marked products from 2004 to 2006 and attaches internet extracts of pictures of the products sold during the relevant period (<i>soap, shampoo, deodorant (for feet and body), lotions, and cleaning items</i>). Although the internet extracts bear a copyright date of 2008, the credibility of what the declaration affirms is reinforced by the judgment of the State Court of Mannheim, a copy of which had been adduced previously by the opponent in order to demonstrate the enhanced distinctiveness of the earlier mark and which referred to the market share enjoyed by products bearing the opponent's mark for ladies' face care products (6.2 %), caring lotions (6.3 %), shower soaps and shampoos (6.1 %) and men's face care and shaving products (7.9 %). Moreover, the judgment states that, according to a GfK study, one fifth of German citizens purchase at least one BALEA product per annum. Reference is also made to two further studies that demonstrate that the brand is well known in Germany. Thus, proof of use for the mark has been demonstrated sufficiently for the products on which the opposition is based.</p>
25/03/2010, R 1752/2008-1, ULUDAG / BURSA uludağ (fig.)	<p>The evidence provided to substantiate use of the earlier Danish trade mark appears to be sufficient. The Board is satisfied that the invoice provided shows place and time of use, as it proves the sale to a Danish company of 2 200 cartons of products within the relevant date. The labels submitted show use on soft drinks bearing the mark as represented on the registration certificate. As to the question whether proof consisting of one single invoice is sufficient in terms of extent of use, the content of that invoice, in the context of the remaining pieces of evidence, serves, in the Board's view, to conclude that the use made of the mark in Denmark is sufficient and genuine in connection with <i>aerated water, aerated water with fruit taste and soda water</i>.</p>

2.12.5.2 Genuine use not accepted

Case No	Comment
18/01/2011, T-382/08, Vogue, EU:T:2011:9	<p>The opponent submitted a declaration from the opponent's managing partner and 15 footwear manufacturers that footwear had been produced for the opponent under the trade mark VOGUE over a number of years, 35 photographs of VOGUE footwear models, photographs of stores and 670 invoices issued to the opponent by footwear manufacturers. The Court held that the declarations did not provide sufficient evidence concerning the extent, place and time of use. The invoices concerned the sale of footwear to the opponent, not the sale of footwear to end consumers and, therefore, were not suitable for proving external use. Mere presumptions and suppositions ('highly unlikely', 'unreasonable to think', '... which probably explains the absence of invoices ...', 'reasonable to assume', etc.) cannot replace solid evidence. Therefore, genuine use was denied.</p>
19/09/2007, 1359 C; confirmed 09/09/2008, R 1764/2007-4, PAN AM II	<p>The owner of the mark owned a US-based airline, operating solely in the US. The fact that flights could also be booked via internet from the European Union could not alter the fact that the actual services of transportation (Class 39) were rendered exclusively outside the relevant territory. Furthermore, the lists submitted of passengers with addresses in the European Union could not prove that the flights had actually been booked from Europe. Finally, the website was exclusively written in English, the prices were in US dollars and the relevant telephone and fax numbers were from within the US. Therefore, genuine use in the relevant territory was denied.</p>

Case No	Comment
04/05/2010, R 966/2009-2, COAST / GREEN COAST (fig.) et al.	There are no special circumstances that might justify a finding that the catalogues submitted by the opponent, on their own or in combination with the website and magazine extracts , prove the extent of use of any of the earlier signs for any of the G&S involved. Although the evidence submitted shows use of the earlier sign in connection with <i>clothing for men and women</i> , the opponent did not produce any evidence whatsoever indicating the commercial volume of the exploitation of this sign to show that such use was genuine.
08/06/2010, R 1076/2009-2, EURO CERT (fig.)/ EUROCERT	It is well established in the case-law that a declaration , even if sworn or affirmed in accordance with the law under which it is rendered, must be corroborated by independent evidence. The declaration in this case, drawn up by an employee of the opponent's company, contains an outline of the nature of the relevant services, but only general statements concerning trade activities. It contains no detailed sales or advertising figures or other data that might show the extent and use of the mark. Furthermore, a mere three invoices with important financial data blanked out and a list of clients can hardly be considered corroborative evidence. Therefore, no genuine use of the earlier mark has been demonstrated.

Case No	Comment
01/09/2010, R 1525/2009-4, OFFICEMATE / OFFICEMATE (fig.)	The spreadsheets with turnover figures and the Analysis and Review reports concerning sales figures are documents drawn up by or commissioned by the appellant itself and, therefore, have less probative value. None of the evidence submitted contains any clear indication concerning the place of use of the earlier mark. The spreadsheets and the Analysis and Review Reports, which contain data compiled on the total value of estimated sales (in SEK) between the years 2003 to 2007, contain no information on where the sales took place. There is no reference to the territory of the European Union, where the earlier trade mark is registered. The invoices do not cover any sales of goods made by the appellant. Therefore, the evidence submitted is clearly insufficient to prove genuine use of the earlier mark.
12/12/2002, T-39/01, HIWATT, EU:T:2002:316	A catalogue showing the mark on three different models of amplifiers (but not indicating place, time or extent), a catalogue of the Frankfurt International trade fair showing that a company called HIWATT Amplification International exhibited at that fair (but not indicating any use of the trade mark) and a copy of the 1997 HIWATT Amplification Catalogue showing the mark on different models of amplifiers (but not indicating place or extent of use) were not considered sufficient to prove genuine use, principally because of lack of extent of use.