



5th IP Case Law Conference

29 - 30 April 2024

Delimiting Reputed
Trade Marks

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Chairperson of the Fourth Board of Appeal

Article 8(5) EUTMR

... irrespective of whether the goods or services ... are identical..., similar ... or not similar ... , where the earlier trade mark has a reputation..., and where the use without due cause ... would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Original wording: *goods or services which are not similar*

- 22/03/2007, **T-215/03, VIPS / VIPS**, EU:T:2007:93, § 32-33 (referring to 09/01/2003, C-292/00, Davidoff, EU:C:2003:9, § 24-26; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 19-22):
 - where the sign is used for identical or similar goods or services, a mark with a reputation must enjoy protection which is at least as extensive as where a sign is used for non-similar goods or services
 - Article 8(5) may be relied on against both dissimilar and similar goods and services

Four cumulative conditions

- 1) The earlier mark which is claimed to have a reputation **must be registered**.
- 2) That **mark** and the **mark applied for must be identical or similar**.
- 3) The earlier mark **must have a reputation** in the European Union, in the case of an earlier EU trade mark, or in the Member State concerned, in the case of an earlier national trade mark.
- 4) The **use without due cause** of the mark applied for must lead to the **risk that unfair advantage might be taken of the distinctive character or the repute of the earlier mark or that it might be detrimental to the distinctive character or the repute of the earlier mark**.

(25/05/2005, T-67/04, SPA-FINDERS / SPA, EU:T:2005:179, § 30)

Additional essential condition: link

- The **existence of a link** between the mark applied for and the earlier mark is an **essential condition** for the application of Article 8(5). The infringements referred to in that provision, where they occur, are the consequence of a **certain degree of similarity between the mark applied for and the earlier mark**, by virtue of which the public concerned **makes a connection** between them, that is, **establishes a link** between them. The existence of such a link must be appreciated **globally**, taking into account all factors relevant to the circumstances of the case (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 30).
- 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).

(25/05/2005, T-67/04, SPA-FINDERS / SPA, EU:T:2005:179, § 41;

22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 47)

- It is possible, particularly in the case of an opposition based on a mark with an **exceptionally high reputation**, that the probability of a future, non-hypothetical **risk** of detriment to or unfair advantage being taken of the earlier mark by the mark applied for is **so obvious** that the opponent does **not need to put forward and prove any other fact to that end**.

(22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 48)

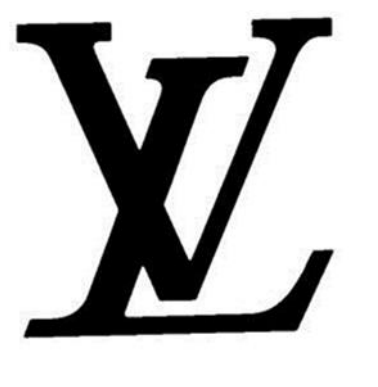

Global assessment of a link

- the degree of similarity between the conflicting marks;
- the **nature of the goods or services** for which the conflicting marks were registered, including the **degree of closeness or dissimilarity** between those goods or services, and the **relevant section of the public**;
- the **strength of the earlier mark's reputation**;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public
(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42)

- The **relevant sections of the public** can be **completely distinct** so that the earlier mark, although it has a reputation, is **not known to the public targeted by the later mark**. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks (§ 48).
- **Even if** the relevant section of the public 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 (§ 49).
- Accordingly, the **nature of the goods or services** for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks (§ 50).


However:

- Certain marks may have acquired **such a reputation** that it **goes beyond the relevant public as regards the goods or services** for which those marks were registered (§ 51).
- **In such a case**, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered **will make a connection** between the conflicting marks, **even though that public is wholly distinct** from the relevant section of the public as regards goods or services for which the earlier mark was registered (§ 52).
- For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account **the strength of the earlier mark's reputation** in order to determine **whether that reputation extends beyond the public targeted by that mark** (§ 53).



Earlier mark	Contested EUTM
	
<p><i>Class 18: Goods made of leather, especially travelling trunks and bags, handbags and fine leather goods, such as pocket wallets and purses</i></p> <p><i>Class 25: Clothing items for at least women</i></p>	<p><i>Class 32: Energy drinks; non-alcoholic beverages...</i></p> <p><i>Class 35: Advertising; sales promotion for others</i></p> <p><i>Class 43: Bar services; services for providing food and drink; catering services for the provision of food; catering; fast food restaurant services; snack-bars; restaurant services; self-service restaurants; cafeterias; canteens</i></p>

Earlier mark	Contested sign
GOOGLE	GOOGLE CAR
Classes 9, 35, 42	Class 12: <i>Vehicles and conveyances; parts and fittings for vehicles; air and space vehicles; land vehicles and conveyances; water vehicles; cable transport apparatus and installations; air cushion vehicles; cars for cable transport installations; drones; cable transport installations; conveying installations [ski lifts]; conveying installations (aerial -) for the transportation of people; cargo carriers for vehicles; ski lifts; aerial conveyors; chairlifts; vehicles</i>

- Opposition upheld in all instances



Earlier mark	Contested sign
<p style="text-align: center;">BIMBO</p>	
<p>Class 30: <i>Bread</i></p>	<p>Class 3: <i>Cleaning preparations for bicycles; detergents; soap; grease-removing preparations</i></p> <p>Class 8: <i>Spanners [hand tools]</i></p> <p>Class 9: <i>Spectacles; head guards; spectacle cases; computers for use with bicycles; work gloves; gloves for protection against accidents</i></p> <p>Class 11: <i>Taillights for vehicles; Bicycle reflectors</i></p> <p>Class 12: <i>Bicycles; electric bicycles; sports bicycles...</i></p> <p>Class 21: <i>Drinking bottles; drinking bottles for sports</i></p> <p>Class 28: <i>Scooters [toys]; tricycles for infants [toys]; scooters for kids; athletic protective knee pads for cycling; athletic protective elbow pads for cycling; gloves for games; gloves for sporting purposes; protective gloves for bicycles</i></p> <p>Class 35: <i>Online retailing or wholesaling relating to bicycles and bicycle accessories; consumer services and information; presentation of goods on communications media; presentation of bicycles and accessories on the internet; advertising</i></p>



Puma cases

Earlier mark	Contested sign
	
<p><i>Class 25: Clothing, including boots, shoes, slippers and booties, especially clothing and sports, leisure and exercise shoes</i></p>	<p><i>Class 7: Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine</i></p>

- 26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604
- 21/12/2022, T-4/22, PUMA (fig.) / PUMA (fig.) et al., EU:T:2022:850 (17/07/2023, C-145/23 P, EU:C:2023:597: refusal to allow the appeal to proceed)

28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133

Earlier mark	Contested sign
	
<p>Class 25: <i>Apparel, footwear, headgear</i></p>	<p>Class 7: ... <i>machines for the breadmaking industry</i> Class 9: <i>Scientific apparatus and instruments... for the baking industry; photographic, cinematographic, optical, signalling, life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or image; magnetic data carriers, recording discs; optical readers; cash registers, calculating machines, data processing equipment, computers; fire-extinguishing apparatus; hydraulic balances for dough</i> Class 11: <i>Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, including for industrial bakeries, sanitary installations, cooling installations for water</i></p>

Earlier mark	Contested sign
	
<p>Class 25: <i>Sport apparel, footwear and headgear</i></p>	<p>Class 10: <i>Diagnostic, examination, and monitoring equipment, namely equipment comprising soundproof cabins for audiometric tests performed by medical personnel; Sound excluding instruments for medical use, particularly soundproof booths</i></p> <p>Class 17: <i>Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets; all the aforesaid goods intended for professional construction of silent cabins and soundproofing booths for medical use</i></p>

THANK YOU!



PRO 28 F
AUDIOMETRIC BOOTH
puma
SOUNDPROOFING



1.280 x 720



PRO 28 F
AUDIOMETRIC BOOTH
NIKE
SOUNDPROOFING



1.280 x 720



PRO 28 F
AUDIOMETRIC BOOTH
adidas
SOUNDPROOFING



1.280 x 720