

## OPPOSITION No B 3 106 028

**Nike Innovate C.V.**, One Bowerman Drive, 97005-6453 Beaverton, United States of America (opponent), represented by **Stobbs Ireland Limited**, Suite 308, The Merrion Buildings, 18-20 Merrion Street Upper, D02 XH98 Dublin 2, Ireland (professional representative)

a g a i n s t

**Marc Pohren**, Charlottenstraße 47, 56077 Koblenz, Germany; **Cyc Chen**, 3fl., No. 107, Lane 26, Dong-shi St., Nuan-Nuan District, 20546 Keelung City, Taiwan (applicants).

On 03/03/2023, the Opposition Division takes the following

### DECISION:

1. Opposition No B 3 106 028 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

### REASONS

On 12/12/2019, the opponent filed an opposition against all the goods of European Union trade mark application No 18 097 556 'FoFoCup - Just fold it!' (word mark). The opposition is based on European Union Trade mark registrations No 514 984 and No 16 026 379 'JUST DO IT' (word marks), and United Kingdom trade mark registrations No UK 00 003 035 855 and No UK 00 002 000 711 'JUST DO IT' (word marks). The opponent invoked Article 8(1)(b) and 8(5) EUTMR.

#### On the effect of Brexit

The opponent based the opposition on, inter alia, United Kingdom trade mark registrations.

In this regard, it must be recalled that on 01/02/2020, the United Kingdom (UK) withdrew from the EU subject to a transition period until 31/12/2020. During this transition period EU law remained applicable in the UK. As from 01/01/2021, UK rights ceased *ex-lege* to be earlier rights protected 'in a Member State' for the purposes of proceedings based on relative grounds. The conditions for applying Article 8(1), (4) and (5) EUTMR, worded in the present tense, must also be fulfilled at the time of taking the decision.

Consequently, the abovementioned UK earlier rights, as also recognised by the opponent in its communication dated 27/06/2022, must be disregarded, since they no longer represent a valid basis for the opposition.

**LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR**

A likelihood of confusion 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. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

**a) The goods and services**

The goods and services on which the opposition is based are the following:

EUTM registration No 514 984

*Class 25: Singlets, underpants, combinations, sweaters, pullovers, jerseys, bathing suits, pyjamas, stockings, socks, waterproofs, ties, neckerchiefs, shirts, shawls, corsets, girdles, brassiers, belts, dresses, sports jackets, jumpsuits, headgear, trousers, waistcoats, open slippers, shoes and closed slippers; sportswear and sport footwear.*

*Class 28: Games and toys; gymnastics and sport items not included in other classes; Christmas tree decorations; bladders of balls for games; cricket bags; golf bags, with or without wheels; gut for rackets; novelties for parties, dances [party favors, favours]; protective paddings [parts of sports suits]; rollers for stationary exercise bicycles; scrapers for skis; seal skins [coverings for skis]; ski bindings; sole coverings for skis; strings for rackets.*

*Class 42: Services rendered by hotels, boardinghouses, providing accommodation, lodging and meals; services rendered by establishments mainly engaged in the obtainment of ready-made food or drinks; such services may be rendered by restaurants, self-service restaurants, canteens; personal services rendered by establishments engaged in covering individual needs; such services may include chaperone services at social events, beauty parlours, hairdressing salons; services rendered by people individually or collectively, as members of an organization requiring a high level of mental activity and referred to theoretical or practical aspects of complex matters of human resources. the services rendered by these people require an intense university education or equivalent professional experience. services rendered by travel agencies or intermediaries providing hotel bookings for tourists; services rendered by associations to their own members and not included in any other class. computer programming services.*

EUTM registration No 16 026 379

*Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; bags; all purpose sports bags; tote bags; duffle bags; messenger bags; backpacks; pouches for carrying school materials; drawstring pouches; waist packs; purses; umbrellas; luggage; wallets; portfolios; cosmetic cases sold empty; toiletry cases sold empty.*

The contested goods are the following:

*Class 18: Luggage; bags; wallets; pouches; luggage, bags, wallets and other carriers.*

Class 20: *Furniture and furnishings; combined closures for containers [non-metallic and not for household or kitchen use]; covers for clothing [wardrobe]; containers, and closures and holders therefor, non-metallic.*

Class 21: *Cups; compostable bowls; salad bowls; fruit bowls; plastic bowls [basins]; biodegradable bowls; plastic bowls [household containers]; bowls; heat-insulated containers for household use; insulated containers for beverage cans, for domestic use; flasks; double heat insulated containers for food; thermal insulated containers for food or beverage; pitchers; baskets for household purposes; kitchen containers; bottle coolers [receptacles]; bottle coolers; cool bags; shakers; coffee filters, non-electric; portable cool boxes, non-electric; portable refrigerating boxes [non-electric]; cups of paper or plastic; paper plates; bowls; soup bowls; flasks; tea caddies; teapots; tea pots; plates; drinking bottles for sports; drinking bottles; drinking vessels; drinking straws; coffee mugs; tea cups; beer mugs; disposable table plates; table plates (disposable -); chopsticks; bottles; containers for household or kitchen use; household or kitchen containers; heat-insulated containers; thermally insulated containers for food; heat-insulated containers for beverages; beverages (heat insulated containers for -); heat insulated containers for drinks.*

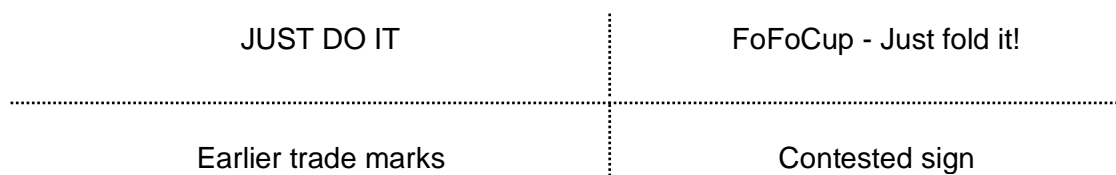
For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed as if all the contested goods were identical to the goods and services of the earlier marks which, for the opponent, is the best light in which the opposition can be examined.

#### **b) Relevant public – degree of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

In the present case, the goods assumed to be identical target the public at large. The degree of attention is considered to be average.

#### **c) The signs**



The relevant territory is the European Union.

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

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for

registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

The earlier marks, 'JUST DO IT', and the contested sign, 'FoFoCup - Just fold it!', are slogans.

The English-speaking part of the public, and other parts of the public with a basic knowledge of the English language, will perceive the earlier marks as an expression meaning 'DO IT'. The component 'JUST' lends this slogan the idea of 'stop talking about', or 'trying to do it', or 'dreaming about it', but get on with it. Another part of the public might, however, not understand the slogan. Understood or not, since it does not convey any specific meaning for the public under assessment in relation to the relevant goods and services, it is distinctive to a normal degree.

The contested mark's first component 'FoFoCup' is meaningless for the relevant public. However, in relation to part of the goods, part of the public might recognise the English term 'Cup' as meaning 'a small, open container used as a drinking vessel for hot beverages', due to the upper-case letter 'C', which creates a separation. This part of the public might understand the word 'Cup' as descriptive of some of the contested sign's goods, namely part of the goods in Class 21. Therefore, 'FoFo' is distinctive and 'Cup' is non-distinctive. For the part of the public for which 'FoFoCup' is fanciful, as a whole, its distinctiveness is normal.

The English-speaking part of the public will perceive the components 'Just fold it!' as an expression meaning 'make it compact'. For this part of the public, bearing in mind that the relevant goods can be foldable, it is non-distinctive, since it describes the characteristics of the goods. For the rest of the public that does not understand this component, these elements are distinctive to a normal degree.

For the purposes of this comparison and bearing in mind that similarities between signs are higher where the coincidences reside in distinctive elements, the Opposition Division will assess the signs from the perspective of the public for whom the expression 'Just fold it' is distinctive, namely the non-English speaking part of the public, such as the Spanish-speaking part. This is, therefore, the public that will not understand the contested sign's component 'Cup' nor the earlier marks as a whole. This is the most advantageous scenario for the opponent.

Finally, it is recalled that consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left (top) to right (bottom), which makes the part placed at the left (top) of the sign (the initial part) the one that first catches the attention of the reader.

**Visually** and **aurally**, the signs coincide in the components 'JUST' and 'IT', although in different positions in each sign. The signs differ significantly in their beginnings, 'JUST' versus 'FoFoCup', respectively (and their sounds). They also differ in 'DO' and 'fold', respectively (and their sounds), as well as in the contested sign's dash and exclamation mark.

Considered as a whole, the signs are structured and arranged differently. Aurally, they have a different number of syllables and different rhythms and intonations.

Therefore, overall, the signs are considered visually and aurally similar to a low degree.

**Conceptually**, from the perspective of the part of the public in the relevant territory that will not perceive a meaning in 'JUST DO IT', neither of the signs has a meaning. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs. From the perspective of the other part of the public, since the contested sign will not be associated with a concept, the conflicting signs are conceptually not similar.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

#### **d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier trade marks have a reputation in connection with the goods and services for which they are registered, namely the following:

##### EUTM registration No 514 984

*Class 25: Singlets, underpants, combinations, sweaters, pullovers, jerseys, bathing suits, pyjamas, stockings, socks, waterproofs, ties, neckerchiefs, shirts, shawls, corsets, girdles, brassiers, belts, dresses, sports jackets, jumpsuits, headgear, trousers, waistcoats, open slippers, shoes and closed slippers; sportswear and sport footwear.*

*Class 28: Games and toys; gymnastics and sport items not included in other classes; Christmas tree decorations; bladders of balls for games; cricket bags; golf bags, with or without wheels; gut for rackets; novelties for parties, dances [party favors, favours]; protective paddings [parts of sports suits]; rollers for stationary exercise bicycles; scrapers for skis; seal skins [coverings for skis]; ski bindings; sole coverings for skis; strings for rackets.*

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##### EUTM registration No 16 026 379

*Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; bags; all purpose sports bags; tote bags; duffle bags; messenger bags; backpacks; pouches for carrying school materials; drawstring pouches; waist packs; purses; umbrellas; luggage; wallets; portfolios; cosmetic cases sold empty; toiletry cases sold empty.*

The opposition is directed against the following goods:

Class 18: *Luggage; bags; wallets; pouches; luggage, bags, wallets and other carriers.*

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This claim must be properly considered given that the distinctiveness of the earlier trade marks must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier marks, the greater will be the likelihood of confusion and, therefore, marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

The opponent submitted the following evidence.

- Witness statement, dated 23/06/2022, of Kristen K. Downer, the Manager of Nike Innovate C.V., in which she provides information on Nike as a business, and of the marks 'NIKE' and 'JUST DO IT', globally and in Europe. The witness statement refers, with detailed explanations, to the following exhibits, also submitted as evidence.
  - Exhibits A-G: documentary evidence attesting to the fact that the opponent's 'NIKE' trade mark and the company is consistently ranked amongst the highest valued, most powerful, most admired and most innovative brands in the world.
  - Exhibit H: online website extracts attesting the awards and publicised recognitions the opponent has received for its over 30 years of 'JUST DO IT' advertising campaigns.
  - Exhibit I: copies of relevant pages from the opponent's annual reports for the years 2011, 2014, 2017, 2019 and 2020, as a representative sample of the annual revenues for Western, Central and Eastern Europe or Europe, the Middle East and Africa. The documents refer to the opponent and to the 'NIKE BRAND'.

- Exhibit J: examples of the opponent's advertisements in printed publications as have appeared in the EU, mostly in relation to the 'NIKE' mark.
- Exhibit K: word documents with photos reflecting, as the opponent claimed, television advertisements that ran in the EU for the period 2004-2009. The opponent claimed that the advertisements refer to the Swoosh and 'JUST DO IT' trade marks. However, it is the Swoosh trade mark that can mostly be seen.
- Exhibit L: examples of advertising billboards and murals with the 'NIKE' mark and Swoosh.
- Exhibit M: 10 photos of 'NIKE' store signage featuring 'NIKE' brands in the EU, including four with the 'JUST DO IT' mark.
- Exhibit N: screenshots of the opponent's 'NIKE' Facebook profile, showing a community of 36 649 152 followers, Instagram profile with 202 million followers and twitter profile.
- Exhibit O: photos of a number of globally well-known, elite athletes wearing 'NIKE' and the Swoosh branded products. Furthermore, there are a few advertisements in which the mark 'JUST DO IT' can be seen on the footer. Undated.
- Exhibit P: a list of the opponent's 'JUST DO IT' trade mark registrations in EU countries.
- Exhibit Q: a USB stick containing representative examples of advertisements featuring the 'JUST DO IT' mark that have circulated throughout the world, including internet video promotions. The opponent claimed that the advertisements correspond to the period 1993-2013. However, no information regarding the countries of diffusion of the TV advertisements has been provided.
- Exhibit R: a collection of articles published mainly in American newspapers between 1989-2013, discussing the long history, promotion and worldwide renown of the 'JUST DO IT' mark.
- Exhibit S: a list of successful trade mark cases around the world involving the 'JUST DO IT' mark, including full copies of the EUTMs and references to Spanish opposition decisions.
- Exhibit T: screenshots from the opponent's EU country specific websites showing 'JUST DO IT' branded goods for sale.
- Exhibit U: screenshots of the opponent's 'JUST DO IT' campaign in Germany.
- Exhibit V: further examples of advertising material featuring the 'JUST DO IT' brand in Germany, undated, but seemingly from the nineties.
- Exhibit W: examples of promotional events featuring the 'JUST DO IT' brand in Antwerp in 2008 and the 'NIKE' brand at the World Basketball Festival in 2012.

- Exhibit X: screenshots of the opponent's offerings in the digital sphere, where it promotes the 'JUST DO IT' brand.
- Exhibit Y: five articles in German attesting to how well-known and highly regarded the 'JUST DO IT' brand is in EU countries.

Having examined the material above, the Opposition Division concludes that the evidence submitted by the opponent does not demonstrate that the earlier trade marks acquired a high degree of distinctiveness through its use.

Both enhanced distinctiveness and reputation require recognition of the mark by a significant part of the relevant public. 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, § 22).

Furthermore, it must be recalled that, as follows from Article 76(1) EUTMR, in *inter partes* proceedings, the Office is restricted in its examination to the acts, evidence and arguments submitted by the parties. Therefore, in assessing whether the earlier marks enjoy 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 base its findings exclusively on the information and evidence submitted by the opponent. The evidence must be clear, convincing and ultimately reveal facts necessary to safely conclude that the mark is known by a significant part of the public (06/11/2014, R 437/2014-1, SALSA / SALSA (fig.) et al.).

In the present case, the evidence refers mainly to the opponent's 'NIKE' and Swoosh trade marks and, when referring to the earlier marks, it consists primarily of documentation emanating from the opponent (the witness statement, website excerpts and overview of advertising examples), five magazine articles, the opponent's online stores, photos and TV and magazine advertisements, of which most are dated 1989-2013. Therefore, there is insufficient information from independent third parties that could serve to corroborate the opponent's statements and reflect, in a clear and objective manner, the degree of recognition of the earlier marks among the relevant public, as well as evidence dated within the closer previous years of the filing of the application.

The submitted witness statement and table provide certain indications of the extent of use of the earlier marks, and the figures specified therein are noteworthy. Nevertheless, account must be taken of the fact that the witness statement emanates from the opponent and that the table in which these numbers and data are provided is an internal document, drawn up by the opponent itself. In that regard, it should be noted that statements drawn up by the interested parties themselves, or their employees, are admissible means of evidence. However, they are generally given less weight than independent evidence because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter. However, this does not mean that such statements do not have any probative value at all. The final outcome depends on the overall assessment of the evidence in the particular case. This is



because, in general, further evidence is necessary, since these statements have to be considered as having less probative value than evidence originating from independent sources or physical evidence. Bearing in mind the foregoing, it is necessary to assess the remaining evidence to see whether or not the contents of the witness statement are supported by the other items of evidence.

The magazines or online shops, as well as the photos, where the earlier trade marks are shown, do not refer to the public's recognition of the earlier trade marks, but merely show advertisements of the goods, the sale of the goods or the goods themselves. The fact that the opponent advertises its marks in magazines and newspapers cannot be seen as evidence of reputation, since it does not imply that the earlier marks are known by a significant part of the public in relation to the relevant goods. In this regard, the evidence contains no information at all about the amounts invested in promoting the marks or the degree of recognition of the marks.

**Exhibit Y** contains five press articles in German that the opponent claimed reference the earlier marks' fame. Whilst it is true that the articles originate from independent sources, which endows them with a sufficient level of objectivity so as to be considered reliable references, there are insufficient indications demonstrating the actual level of awareness on the part of the target consumers, which would allow a positive finding of reputation. It cannot be inferred from the evidence in exhibit Y that the press coverage of the opponent's trade marks is so substantial that it can lead to a positive finding of reputation of the earlier marks when considered in conjunction with the rest of the evidence. These articles are the only relevant documents, considering that they are dated 2019 (except one, dated 2008), to show the earlier marks' enhanced distinctiveness. However, this is not further corroborated by other valid evidence. Furthermore, there is no information as to the number of actual consumers that were reached by those articles, in order to determine, with the required level of certainty, the public's actual knowledge of the earlier trade marks.

Under these circumstances, it is considered that despite showing use of the earlier marks, the evidence is not sufficient to show the actual degree of recognition of the earlier marks in the relevant market. In other words, the materials submitted do not support, without resorting to probabilities and assumptions, a conclusion that the earlier marks (and not the opponent's 'NIKE' and Swoosh marks) were known by a significant part of the relevant consumers for the goods and services concerned.

Under these circumstances and in the absence of any independent and objective evidence that would enable the Opposition Division to draw solid conclusions about the degree of recognition of the earlier marks by the relevant public during the relevant period, the market share held by the marks, the position they occupy in the market in relation to competitors' goods and services, the duration, extent and geographical area of its use or the extent to which it has been promoted, it is concluded that the evidence does not show the relevant public's degree of recognition of the trade marks. As a consequence, the Opposition Division concludes that the opponent failed to prove that its trade marks have reputation.

Consequently, the assessment of the distinctiveness of the earlier marks will rest on their distinctiveness per se. In the present case, the earlier trade marks as a whole have no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier marks must be seen as normal.

### **e) Global assessment, other arguments and conclusion**

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).

In the present case, the contested goods have been assumed to be identical to the goods and services of the earlier marks. The relevant public's degree of attention is average and the earlier marks enjoys a normal degree of distinctiveness.

The signs are visually and aurally similar to a low degree and conceptually not similar, or the conceptual aspect has no influence. Although the signs coincide in the components 'JUST' and 'IT', this is not sufficient to find the signs to be similar overall. These are two of the earlier marks' three components, whereas they are at the end of the contested mark. The signs also differ in the contested sign's additional long first element 'FoFoCup' and in the earlier marks' verb 'DO', whose counterpart in the contested sign is 'fold'. All these are effective distinguishing features that the relevant public will remember. Therefore, these additional components and the signs' different structures are clearly perceivable and sufficient to exclude any likelihood of confusion between the signs.

In view of all the above, based on an overall assessment of the visual, aural and conceptual similarities (or lack thereof) between the marks, there is no relevant similarity between them. Even assuming the goods and services covered by the conflicting marks are identical, the Opposition Division finds it implausible that the relevant public will be able to distinguish the marks from each other.

Considering all the above, even assuming that the goods and services are identical, there is no likelihood of confusion on the part of the selected public. Therefore, the opposition must be rejected.

This absence of a likelihood of confusion equally applies to the non-Spanish-speaking part of the public, which understands the contested sign's component 'Cup' and the earlier marks. This is because this part of the public will understand these elements and will perceive the signs as even less similar.

The examination will continue on the basis of the other ground claimed by the opponent.

### **REPUTATION – ARTICLE 8(5) EUTMR**

In relation to Article 8(5) EUTMR, the opponent invoked earlier European Union Trade mark registrations No 514 984 and No 16 026 379 'JUST DO IT' (word marks).

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would

take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicants did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

#### **a) Reputation of the earlier trade marks**

Reputation implies a knowledge threshold that is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case, the contested trade mark was filed on 20/07/2019. Therefore, the opponent was required to prove that the trade marks on which the opposition is based had acquired a reputation prior to that date. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation, namely:

##### EUTM registration No 514 984

*Class 25: Singlets, underpants, combinations, sweaters, pullovers, jerseys, bathing suits, pyjamas, stockings, socks, waterproofs, ties, neckerchiefs, shirts, shawls, corsets, girdles, brassiers, belts, dresses, sports jackets, jumpsuits, headgear, trousers, waistcoats, open slippers, shoes and closed slippers; sportswear and sport footwear.*

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Class 42: *Services rendered by hotels, boardinghouses, providing accommodation, lodging and meals; services rendered by establishments mainly engaged in the obtainment of ready-made food or drinks; such services may be rendered by restaurants, self-service restaurants, canteens; personal services rendered by establishments engaged in covering individual needs; such services may include chaperone services at social events, beauty parlours, hairdressing salons; services rendered by people individually or collectively, as members of an organization requiring a high level of mental activity and referred to theoretical or practical aspects of complex matters of human resources. the services rendered by these people require an intense university education or equivalent professional experience. services rendered by travel agencies or intermediaries providing hotel bookings for tourists; services rendered by associations to their own members and not included in any other class. computer programming services.*

EUTM registration No 16 026 379

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The opposition is directed against the following goods:

Class 18: *Luggage; bags; wallets; pouches; luggage, bags, wallets and other carriers.*

Class 20: *Furniture and furnishings; combined closures for containers [non-metallic and not for household or kitchen use]; covers for clothing [wardrobe]; containers, and closures and holders therefor, non-metallic.*

Class 21: *Cups; compostable bowls; salad bowls; fruit bowls; plastic bowls [basins]; biodegradable bowls; plastic bowls [household containers]; bowls; heat-insulated containers for household use; insulated containers for beverage cans, for domestic use; flasks; double heat insulated containers for food; thermal insulated containers for food or beverage; pitchers; baskets for household purposes; kitchen containers; bottle coolers [receptacles]; bottle coolers; cool bags; shakers; coffee filters, non-electric; portable cool boxes, non-electric; portable refrigerating boxes [non-electric]; cups of paper or plastic; paper plates; bowls; soup bowls; flasks; tea caddies; teapots; tea pots; plates; drinking bottles for sports; drinking bottles; drinking vessels; drinking straws; coffee mugs; tea cups; beer mugs; disposable table plates; table plates (disposable -); chopsticks; bottles; containers for household or kitchen use; household or kitchen containers; heat-insulated containers; thermally insulated containers for food; heat-insulated containers for beverages; beverages (heat insulated containers for -); heat insulated containers for drinks.*

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

The evidence submitted by the opponent to prove the reputation of the earlier trade marks has already been examined above under the grounds of Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR.

It is a requirement for the opposition to be successful under Article 8(5) EUTMR that the earlier trade marks have a reputation. Since it has not been established that the earlier trade marks have a reputation, as set out above under section d) of the assessment under Article 8(1)(b) EUTMR, one of the necessary conditions contained in Article 8(5) EUTMR is not fulfilled, and the opposition must be rejected.

## **COSTS**

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicants in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



### **The Opposition Division**

**Cindy BAREL**

Cristina CRESPO MOLTO

**Richard BIANCHI**

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.