

**DECISION
of the Fifth Board of Appeal
of 25 August 2026**

In case R 2526/2025-5

Servicios Productivos Malagueños, S.L.

Calle Alonso de Bazán 8, 6º
29602 Marbella
Spain

Applicant / Appellant

represented by Falcon Abogados, C/ Goya, 23 - 3º izda., 28001 Madrid, Spain

v

Hilton Worldwide Manage Limited

Maple Court Central Park, Reeds Crescent
WD24 4QQ Watford
United Kingdom

Opponent / Defendant

represented by Boekx Trademarks B.V., Leidsegracht 9, 1017 NA Amsterdam, Netherlands

APPEAL relating to Opposition Proceedings No B 3 219 702 (European Union trade mark application No 19 005 062)

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), R. Ocquet (Member) and A. Pohlmann (Member)

Registrar: K. Zajfert

gives the following

Decision

Summary of the facts

- 1 By an application filed on 27 March 2024, Servicios Productivos Malagueños, S.L. ('the applicant') sought to register the figurative mark



as a European Union trade mark (the 'EUTM') for the following services:

Class 35: Dissemination of advertisements via the internet; commercial information services, via the internet; advertising via electronic media and specifically the internet; providing consumer product information via the internet; distribution of promotional matter; promotion [advertising] of business; advertising, marketing and promotional services; promotion of goods and services through sponsorship; advertising services for the promotion of beverages.

Class 43: Services for providing food and drink; bistro services; providing food and drink in bistros; serving of alcoholic beverages.

- 2 The application was published on 5 April 2024.
- 3 On 3 July 2024, Hilton Worldwide Manage Limited ('the opponent') filed an opposition against the registration of the published trade mark application for all the above services.
- 4 The opposition was based on the following three earlier rights:
 - a) EUTM No 1 852 946 (**earlier mark 1**)

Waldorf Astoria

filed on 13 September 2000, registered on 7 October 2004 and duly renewed for the following services:

Class 42: Hotel and motel services; restaurants and catering services, provision of facilities for meetings, conferences and exhibitions; reservation services for hotel accommodation.

- b) International trade mark registration designating the European Union No 926 493 (**earlier mark 2**)

THE WALDORF=ASTORIA COLLECTION

filed and registered on 21 May 2007 and duly renewed for services in Classes 36 and 43. The opposition is based on the following services:

Class 43: Rental of temporary accommodation; reservations (temporary accommodation); hotel, motel, bar, cafe, restaurant, banqueting and catering services; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings; provision of serviced apartments.

- c) Benelux trade mark registration No 493 934 (**earlier mark 3**)

WALDORF=ASTORIA

filed on 13 March 1991, registered on 1 November 1991 and duly renewed for the following services:

Class 43: Hotel, restaurant and bar services.

- 5 The opponent invoked Article 8(1)(b) EUTMR in relation to all of the earlier rights and Article 8(5) EUTMR in relation to earlier rights 1 and 3.
- 6 Within its submissions of 17 October 2024 (during the substantiation period), the opponent submitted the following evidence in support of its claim of a high degree of distinctiveness and reputation of the earlier mark:
 - Annexes 1-3.2: general information on the opponent's activities and the restaurants in the Waldorf Astoria hotels in Rome (La Pergola), Amsterdam (Spectrum) and France (Gordon Ramsay au Trianon).
 - Annexes 4.1-4.29: printed and online media regarding the Waldorf Astoria Amsterdam.
 - Annexes 5.1-5.19: printed and online media regarding the Waldorf Astoria Berlin.
 - Annexes 6.1-6.10: printed and online media regarding the Waldorf Astoria Rome Cavalieri.
 - Annexes 7.1-7.9: printed and online media regarding the Waldorf Astoria Trianon Palace Versailles.
 - Annexes 8.1-8.6: printed and online media concerning Waldorf Astoria driving and luxury experiences at EU and worldwide hotels, President Obama's decision not to stay at the Waldorf Astoria New York and the hotel's popularity among US presidents, the Waldorf salad, and a Wikipedia extract on Waldorf Astoria Hotels & Resorts.

- Annexes 9.1-9.6: awards and rankings for Waldorf Astoria hotels, including World Travel Awards for Rome Cavalieri and Trianon Palace Versailles, a World Travel Awards nomination for Amsterdam, the 2016 Connie Award, and Tripadvisor, U.S. News & World Report and CNBC rankings placing Waldorf Astoria Amsterdam among the top hotels in Europe and the Netherlands.
- Annexes 10.1-10.9: screenshots of blogs and articles with reviews of Waldorf Astoria hotels in Amsterdam, Versailles, Paris, Berlin and Rome (dated between 2018 and 2023).
- Annex 11: affidavit of 13 December 2023 by Hilton's Senior Vice President, Assistant General Counsel, with exhibits on the history and fame of the WALDORF ASTORIA brand, including mainly US/worldwide material but also EU references to awards, hotels, restaurants, reservations, revenues, advertising and EU website visits. It refers to brand-level awards, including Travel + Leisure recognition and HSMAI Adrian Awards, and property-level awards for Waldorf Astoria hotels in Amsterdam, Versailles, Rome, Edinburgh and Berlin.
- Annexes 12.1-12.9: official partnerships, advertising and media references involving Waldorf Astoria Hotels, including collaborations with Goodwood Festival of Speed, Lamborghini, Aston Martin, Le Mans, Trudon, McLaren/Lando Norris, the 'Live Unforgettable' campaign, and the Rome Film Festival gala dinner at La Pergola.
- Annexes 13.1-13.3: media references to 'WALDORF ASTORIA', including IMDb filming-location results, books available on Amazon in Germany, France and the Netherlands, and a 2018 podcast.
- Annexes 14.1-14.4: screenshots of WALDORF ASTORIA social media accounts, including YouTube and Instagram pages for the worldwide brand and European hotels in Amsterdam, Versailles, Rome Cavalieri and Berlin, with examples of posts and videos.
- Annex 15: invoices from Waldorf Astoria Berlin (2017, 2019, 2021), Trianon Palace Versailles (2023) and Edinburgh (2017, 2019, 2022), with only a few invoices and relatively modest amounts in euro and pounds sterling.
- Annexes 16.1-16.20: online articles, reviews, guides and awards concerning Waldorf Astoria restaurants in Amsterdam, Rome, Versailles and Berlin, including Goldfinch Brasserie, Spectrum, La Pergola, Roca and Gordon Ramsay au Trianon, with Michelin/Gault&Millau references, culinary awards and press coverage between 2015 and 2024.
- Annexes 17.1-17.3: *EL MUNDO* and *SUR* articles of September 2024 on the opening of the applicant's ASTORIA TABERNA/New Taberna Astoria in Málaga, together with examples of the applicant's use of the contested and similar signs, including references to old New York City.

- 7 On 24 March 2025, within the time limit to submit the proof of use, the opponent submitted the following evidence:
- Annex 18: EUIPO Opposition Division decision (14/11/2024, B 319 996), BRASSERIE ASTORIA versus Waldorf Astoria;
 - Annex 19: images published on Google between 2019 and 2024, showing use of the earlier mark for hotel services in Class 43 at the Waldorf Astoria Amsterdam, Waldorf Astoria Berlin, Waldorf Astoria Rome Cavalieri and Waldorf Astoria Versailles;
 - Annexes 20.1-20.3: Wayback Machine screenshots between 2019 and 2024 showing use of ‘WALDORF ASTORIA’ on the opponent’s websites and booking platforms for hotel and restaurant reservations, including EU-language versions aimed at EU residents;
 - Annexes 21-23.5: samples of Waldorf Astoria Amsterdam, Berlin and Versailles invoices/receipts for hotel and restaurant services between 2019 and 2024; Instagram overviews for the worldwide brand and European hotels as of 5 February 2025; and Ryder Cup 2023 materials concerning Rome Cavalieri, including partner, press, *GQ Magazine* and YouTube references.
- 8 By decision of 5 November 2025 (‘the contested decision’), the Opposition Division upheld the opposition in its entirety on the grounds that it was well founded under Article 8(5) EUTMR. It gave, in particular, the following grounds for its decision.

Proof of use

- For reasons of procedural economy, the Opposition Division finds it appropriate to focus the examination of proof of use on EUTM No 1 852 946 ‘Waldorf Astoria’ (**earlier mark 1**), which is the most relevant earlier mark for the examination of the opposition vis-à-vis the contested sign.
- The request for proof of use was submitted in due time and is admissible.
- The date of filing of the contested application is 27 March 2024. The opponent was therefore required to prove that the mark on which the opposition is based was put to genuine use in the European Union from 27 March 2019 to 26 March 2024 inclusive.
- Furthermore, the evidence must show use of the mark for the services on which the opposition is based, namely the following:

Class 42: Hotel and motel services; restaurants and catering services, provision of facilities for meetings, conferences and exhibitions; reservation services for hotel accommodation.

- Within its submissions of 17 October 2024 (during the substantiation period), the opponent submitted evidence in support of its claim of a high degree of distinctiveness and reputation of the earlier mark, as listed in paragraph 6 above.
- On 24 March 2025, within the time limit to submit proof of use, the opponent submitted evidence of use. As the evidence in support of the opponent’s claim of a

high degree of distinctiveness and reputation of the earlier mark was submitted before the expiry of the time limit for providing proof of use, it will be taken into account for the examination of proof of use together with the evidence submitted on 24 March 2025 listed in paragraph 7 above.

- Regarding Annex 11.1, affidavits are admissible evidence, although those from interested parties, as in the present case, carry limited weight and normally require corroboration by the remaining evidence.
- The applicant objects to the absence of translations for some of the evidence. However, no translation is required unless requested by the Office. Given the self-explanatory nature of the relevant documents, including invoices, and the translations already provided for some annexes, no such request is necessary.
- The applicant further argues that not all of the evidence proves genuine use in terms of time, place, extent, nature and the relevant services. However, genuine use must be assessed globally. Even if some items lack certain factors, the evidence as a whole may still establish genuine use.

Assessment of the evidence

- The invoices show that the **place of use** covers various countries in the European Union, including Germany, France, Italy and the Netherlands. This can be inferred from the language of the documents and invoices submitted by the opponent as Annexes 15 and 21.1-21.3. Therefore, the evidence relates to the relevant territory.
- The applicant argues that ‘A substantial portion of the evidence provided, notably in Annex 20.3 and related annexes, refers to establishments located outside the territory of the European Union (including Washington D.C., Bangkok, Dubai and Cancun)’. However, as clearly shown in the description of the Annexes in paragraphs 6 and 7 above, there is a significant volume of evidence that refers at least to the Netherlands.
- As regards the **time of use**, most of the evidence is dated within the relevant period.
- As regards the applicant’s objection that some of the evidence is undated, such material may still be considered in the overall assessment when read together with dated evidence. In the present case, the undated evidence, read with the dated evidence, including invoices, allows the Opposition Division to assess the relevant factors of use, in particular its nature.
- As regards the **extent of use**, the evidence shows relevant use of the earlier mark in various countries in the European Union, such as Germany, France, Italy and the Netherlands. The invoices in Annexes 15 and 21.1-21.3 read in conjunction with the remaining pieces of evidence, provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use.
- It is clearly shown that several sales transactions took place between 2019 and 2024 in various countries in the EU in relation to hotel and restaurant services. The invoices seen in conjunction with the remaining pieces of evidence such as numerous online

articles in leading online magazines, and numerous awards, show use of the sign during various years. It follows from the evidence that the opponent has seriously tried to acquire a commercial position in relation to hotel and restaurant services.

- Therefore, there are sufficient indications concerning the extent of use.
- Regarding **nature of use**, the evidence shows the use of the earlier mark in, inter alia, the following forms:



- Its use in the form of a logo or as a word mark as shown above does not alter the distinctive character of the earlier mark in the form in which it was registered, as the difference in colour combination or the addition of city names such as Amsterdam, which merely indicated where hotels are located or where restaurant services are provided, have a lesser impact on the consumers' perception of the sign as a whole. Furthermore, the addition of the letters 'WA' above the verbal elements 'Waldorf Astoria' further reinforces these elements since they are considered abbreviations of the first letters of the earlier mark's verbal elements.
- The evidence shows that the mark has been used in accordance with its function and as registered or in an acceptable variation of its registered form for at least *hotel and motel services* in Class 42.
- Therefore, the Opposition Division will only consider the abovementioned services in its further examination of the opposition.

Reputation – Article 8(5) EUTMR

- For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to EUTM No 1 852 946 (**earlier mark 1**).
- In the present case, the applicant did not claim to have due cause for using the contested sign. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

Reputation of the earlier mark

- In the present case, the contested sign was filed on 27 March 2024. Therefore, the opponent was required to prove that the mark on which the opposition is based had

acquired a reputation prior to that date. In principle, it is sufficient that the opponent show that its mark already had a reputation on that date. While it follows from the wording of Article 8(5) EUTMR that the conditions for its application also need to be present at the time of taking the decision, and therefore the reputation of the earlier mark must subsist until the decision on the opposition is taken, any subsequent loss of reputation is for the applicant to claim and prove.

- The evidence must also show that the reputation was acquired for the services for which the opponent has claimed reputation and for which the genuine use has been proven, namely:

Class 42: Hotel and motel services.

- The opposition is directed against the services in Classes 35 and 43 as listed in paragraph 1 above.
- In its arguments submitted on 17 October 2024 (during the substantiation period of the opposition), the opponent submitted initial evidence to support its claim for reputation of the earlier mark and, after a request of proof of use, on 24 March 2025, within the time limit to submit the proof of use, it submitted some additional evidence to show genuine use, all of which have been listed above in paragraphs 6 and 7.
- The opponent submitted relevant evidence within the time limit initially set by the Office and, therefore, the later evidence can be considered additional to support its claim for reputation of the earlier mark.
- Having examined the evidence, the abovementioned press information, being in the form of articles issued from independent sources and not referring to simple advertising announcements, illustrate some degree of the opponent's reputation in relation to, at least, hotel services in the Netherlands. These documents prove that the opponent's commercial activities related to the abovementioned services are often recorded by press and in the public interest. These publications refer directly to the opponent's commercial success and mention the earlier mark in relation to 'major luxury hotel' with the 'Waldorf Astoria Amsterdam' being located within the Grachtengordel, or Canal Ring, which, according to the evidence, is an UNESCO world heritage site. Some of the publications in local online magazines, such as the one included in Annex 4.11, rate the 'Waldorf Astoria Amsterdam' as the number one luxury hotel in Amsterdam and one of the best hotels in the world.
- Furthermore, the evidence contains information on rankings and awards where, for example, the 'Waldorf Astoria' was ranked by Tripadvisor as the 13th best hotel of Europe and the best hotel of The Netherlands (Annex 9.5) and it won the Connie Award for best performing luxury Waldorf Astoria and Conrad Hotels in 2016 (Annex 9.4). It is also important to mention the 'Waldorf Astoria' brand involvement in partnerships with other brands such as the collaboration between Waldorf Astoria Amsterdam and luxury candlemaker Trudon (Annex 12.7) or its partnership with Guerlain where a Guerlain Spa is located in the hotel premises. It is also worth mentioning that 'Waldorf Astoria' was mentioned on a Belgian F1's website since the McLaren F1 driver Lando Norris became a chef at the Waldorf Astoria Amsterdam (Annex 12.8). Furthermore, the article enclosed in Annex 4.28, describes the Waldorf

Astoria Amsterdam as one of the city's most opulent and exclusive hotels, frequently chosen by celebrities like Ariana Grande for their stays.

- Taking into account all the relevant criteria, namely, the frequent and regular exposure of the public to the mark through publications and taking due account of the awards and rankings showing the recognition of the earlier mark for hotel services, the Opposition Division concludes that the earlier mark has been proved to enjoy some degree of recognition among the relevant public in relation to at least *hotel services*. Whether the degree of recognition is sufficient for Article 8(5) EUTMR to be applicable depends on other factors relevant under Article 8(5) EUTMR.

The signs

- The Opposition Division finds it appropriate to focus the comparison of the signs on the Dutch-speaking part of the relevant public because, as shown above, the reputation has been demonstrated in the Netherlands.
- Before analysing the meaning of both signs, it should be pointed out that English is widely understood in the Netherlands.
- The earlier mark's verbal element 'WALDORF' will be perceived either as a meaningless word or part of the public might understand it as referring to 'Waldorf education', an educational style, which is holistic, intended to develop pupils' intellectual, artistic, and practical skills, with a focus on imagination and creativity. Whether or not understood, it has no relation to the relevant services.
- The signs' coinciding verbal element 'ASTORIA' is meaningless for the public under analysis and is, therefore, distinctive for the relevant services.
- The contested sign's verbal element 'TABERNA' is a Spanish word, which will be understood by the public under analysis due to its similarity with the English equivalent word 'tavern' referring to a place where people gather to drink and be served food. While this verbal element is of limited (if any) distinctiveness for the services in Class 43 since it describes their nature, it has no direct connection to the relevant services in Class 35 resulting in it being distinctive for these services.
- The contested sign's numerical element '1872' is descriptive of the year in which the establishment of the brand or company behind the services in question took place.
- The contested sign's oval frame and the stylisation of its verbal elements are purely decorative and are, therefore, non-distinctive.
- None of the contested sign's elements has a visually dominant role, however, the word 'astoria' is preponderant, given its larger size and central position.
- **Visually and aurally**, the signs are similar to an average degree. They coincide in the distinctive verbal element 'ASTORIA'. They differ in the earlier mark's verbal element 'Waldorf' and the contested sign's verbal element 'TABERNA' and the non-distinctive numerical element '1872'. They further differ, visually, in the contested sign's figurative aspects, which have less impact.

- **Conceptually**, while the earlier mark is meaningless, the contested sign's verbal element 'TABERNA' and the year '1872' convey concepts, which results in the signs being conceptually not similar. However, since the numerical element '1872' and the word 'TABERNA' in relation to services in Class 43, are of limited (if any) distinctiveness, they have a limited impact on the present comparison.

The 'link' between the signs

- The earlier mark is reputed, and the signs are similar to some extent.
- The signs are visually and aurally similar to an average degree and conceptually not similar. The earlier mark enjoys some degree of reputation for, at least, *hotel services* in Class 42 in the Netherlands.
- The contested services in Class 43 are *services for providing food and drink; bistro services; providing food and drink in bistros; serving of alcoholic beverages*. It is common for hotels, especially luxury hotels, such as the opponent's, which provide all types of additional services to please the guests in all possible ways (as also evidenced by the opponent), to also provide food and drink services and bar services. Therefore, there is a sufficiently close connection between hotel services and the contested services in Class 43 for a link to be established.
- The remaining contested *dissemination of advertisements via the internet; commercial information services, via the internet; advertising via electronic media and specifically the internet; providing consumer product information via the internet; distribution of promotional matter; promotion [advertising] of business; advertising, marketing and promotional services; promotion of goods and services through sponsorship; advertising services for the promotion of beverages* in Class 35 are services rendered for others to help them run or improve their commercial or industrial undertaking. Although these contested services, unlike the earlier mark's services, target business customers, the latter are also familiar not only with the earlier mark itself but also with its advertising efforts and its corporate success, as demonstrated above. It clearly follows that an association with the earlier mark remains possible.
- Therefore, considering and weighing up all the relevant factors of the present case, it must be concluded that, when encountering the contested sign, the relevant consumers in the Netherlands will be likely to associate it with the earlier sign and establish a mental 'link' between the signs.

Risk of injury

- The opponent claims that use of the contested sign would take unfair advantage of the distinctive character or the repute of the earlier mark and be detrimental to the distinctive character or the repute of the earlier mark.

Unfair advantage (free-riding)

- The opponent claims that the applicant's use of the contested sign would take unfair advantage of the reputation of the earlier marks by leading the relevant public to associate its services with the exclusivity, quality and prestige of the opponent's

marks. This would confer an unfair commercial benefit without the applicant's own investment, amounting to free-riding on the opponent's goodwill, marketing efforts and reputation. Given the distinctiveness and reputation of 'WALDORF ASTORIA', use of the contested sign is likely to call the opponent's services to mind and create an impression of origin, endorsement or licensing.

- As already established, the earlier mark enjoys some degree of reputation for, at least, *hotel services* in Class 42 in the Netherlands. As seen from the evidence submitted, the opponent's mark is associated with the positive qualities, image and characteristics of its hotel services.
- The specific reputation of the earlier mark (including qualitative aspects, such as a particular image the earlier mark has created in the minds of the public in the Netherlands due to its extensive use and popularity in the Netherlands) and the degree of similarity between the marks, make it possible for the image of the reputed mark to be transferred to the contested sign. This image transfer would facilitate the marketing of the contested services.
- Bearing in mind the link between the services in question, as established above, some degree of reputation of the earlier mark and the similarities of the signs, the Opposition Division concludes that the contested sign is likely to take unfair advantage of the distinctive character or the repute of the earlier mark. Indeed, the accumulation of all the above factors makes it quite likely that the contested sign recalls the earlier mark, thus misappropriating its attractive powers and advertising value.
- The connection that the contested sign might trigger with the earlier reputed mark and the positive image it possesses, would inevitably compel consumers to further explore the contested brand and the services offered under it. In this way, the contested sign will already unfairly benefit from the continuous investments of the opponent in creating and preserving the positive image of its mark.

Other types of injury

- The opponent also alleges detriment to the earlier mark's distinctive character and repute. However, since unfair advantage has already been established and only one type of injury is required under Article 8(5) EUTMR, there is no need to examine the remaining types of injury.

Conclusion

- The opposition is well founded under Article 8(5) EUTMR. Therefore, the contested sign must be rejected for all the contested services.
- Given that the opposition is entirely successful under Article 8(5) EUTMR, it is not necessary to examine the remaining ground and earlier rights.

9 On 31 December 2025, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside.

10 On 5 March 2026, the statement of grounds of the appeal was received.

- 11 In its response received on 6 May 2026, the opponent requested that the appeal be dismissed.
- 12 On 18 May 2026, the appeal was reallocated from the First to the Fifth Board of Appeal and the parties were informed thereof.

Submissions and arguments of the parties

- 13 The arguments raised in the statement of grounds may be summarised as follows.

On the applicability of Article 8(1)(b) EUTMR

- The Opposition Division’s conclusion that a likelihood of confusion exists rests on an overly reductive assessment of the signs, combined with an abstract approach to the services at issue, and an insufficiently realistic appreciation of how the relevant public perceives and selects the services concerned. When the marks are compared as a whole, in their proper commercial context, it becomes clear that the similarities relied upon in the contested decision cannot generate any likelihood of confusion or association within the meaning of Article 8(1)(b) EUTMR.

Incorrect assessment of the overall impression of the signs

- The contested decision gives decisive weight to the coinciding element ‘ASTORIA’, treating it as the dominant indicator of origin in the contested mark. This disregards the principle that signs must be assessed as a whole, according to the overall impression perceived by the average consumer, who does not analyse their components in isolation. The contested figurative sign with device elements and the earlier word mark are structurally distinct and convey different overall visual and aural impressions.
- Visually, the differences between the signs are apparent. The earlier mark is composed of two verbal elements forming a single expression presented exclusively in a word format. By contrast, the contested figurative sign combines several verbal elements together with graphic components that contribute to shaping the visual appearance of the sign. The structure of the contested sign is therefore significantly more complex and visually distinctive than that of the earlier mark.
- A key visual distinction lies in the signs’ initial elements: the earlier mark begins with ‘WALDORF’, whereas the contested sign begins with ‘TABERNA’. This is significant because consumers generally pay greater attention to the beginning of a mark, which often shapes the overall visual impression.
- Therefore, the signs differ visually from the outset: ‘WALDORF ASTORIA’ contrasts with a sign beginning with ‘TABERNA’, an element absent from the earlier mark and altering the contested sign’s overall composition. The additional element ‘1872’, absent from the earlier mark, further changes the contested sign’s structure, length and visual balance. Moreover, the contested sign’s figurative depiction and graphic elements give it a more elaborate visual identity than the earlier word mark, which contains no figurative features.

- Taken together, the different initial elements, the addition of ‘1872’ and the figurative depiction make the signs visually distinguishable overall, despite the coinciding element ‘ASTORIA’.

Clear conceptual differences between the signs

- Conceptually, the signs convey clearly different meanings, reducing the likelihood that the relevant public will perceive them as indicating the same commercial origin. Such conceptual divergence may significantly reduce, or even exclude, a likelihood of confusion.
- The earlier mark ‘WALDORF ASTORIA’ will be perceived as a well-known luxury hospitality mark, linked to exclusive accommodation, international hospitality and a prestigious hotel group serving an international clientele.
- By contrast, ‘TABERNA ASTORIA 1872’ evokes a traditional gastronomic establishment. The Spanish word ‘TABERNA’ points to a local, informal venue associated with cuisine, culture and culinary heritage, rather than luxury accommodation.
- The element ‘1872’ further suggests historical origin and tradition, reinforcing the impression of a longstanding establishment with historical roots.
- This is particularly relevant because the applicant’s use of ‘ASTORIA’ is linked to Málaga’s former Cines Astoria, a well-known cinema complex and cultural landmark in the city centre. For decades, Cines Astoria formed part of Málaga’s cultural and social life and remains a strong local historical and cultural reference.
- Accordingly, in the contested sign, ‘ASTORIA’ does not evoke an international hotel chain but a local historical reference. Together with ‘TABERNA’ and ‘1872’, it conveys a traditional gastronomic venue rooted in Málaga’s heritage.
- The contested sign therefore reflects local identity and cultural continuity, rather than the image of a global luxury hotel brand.
- The marks thus create distinct conceptual impressions: the earlier mark refers to a global luxury hospitality group, while the contested sign evokes a traditional establishment rooted in Málaga’s local history and culture.
- These clear conceptual differences support the conclusion that the relevant public is unlikely to assume any commercial connection between the signs.

Lack of sufficient similarity between the services in their commercial context

- In addition to the clear differences between the signs, the services at issue also differ significantly when assessed in their proper commercial context. This factor must also be considered when assessing the existence of a likelihood of confusion under Article 8(1)(b) EUTMR.

- The earlier mark covers accommodation services provided by hospitality establishments to travellers and guests. By contrast, the contested Class 35 services concern advertising, marketing and commercial promotion, targeting businesses seeking to promote their goods or services. The contested Class 43 services concern food and drink, bistro and alcoholic beverage services, typically provided by restaurants, bars, bistros or similar gastronomic establishments.
- In commercial reality, those services differ substantially from hotel and motel services: accommodation services provide lodging, whereas the contested services concern either promotion or food and drink.
- They are also provided through different commercial structures and in different circumstances: hotels offer overnight accommodation, while restaurants, bistros and advertisers operate in distinct market contexts.
- Consumers' expectations also differ: hotel guests seek accommodation, restaurant or bistro customers seek a dining experience, and business clients seek commercial communication services.
- Their classification in different Nice classes also reflects, although not decisively, that the services generally belong to distinct commercial sectors.
- Overall, the services differ in nature, purpose, method of provision and commercial context, making it unlikely that the public would attribute them to the same or economically linked undertakings.

Non-existence of likelihood of confusion or association

- Considering the differences between the signs, the services and the relevant public's perception, there is no likelihood of confusion or association under Article 8(1)(b) EUTMR. Likelihood of confusion must be assessed globally, taking account of all relevant factors, and depends on whether the public may believe that the services come from the same or economically linked undertakings. In the present case, that is highly unlikely.
- The acknowledged reputation of 'WALDORF ASTORIA' as a luxury hospitality mark reinforces, rather than weakens, the distinction between the signs.
- Consumers associate the earlier mark with luxury hotel services provided by an international hospitality undertaking, characterised by exclusivity, prestige and elevated pricing. By contrast, 'TABERNA ASTORIA 1872' refers to a different commercial context: a gastronomic venue offering food and beverages, as well as Class 35 advertising and promotional services.
- Consumers generally distinguish between luxury hotel services and traditional gastronomic establishments, which meet different needs and are encountered in different circumstances.

- The contested services concern a traditional taberna offering food and beverages in an informal, culturally rooted setting, targeting consumers seeking dining rather than accommodation.
- Luxury hotel services target consumers seeking premium accommodation and usually exercising a relatively high level of attention due to the cost and planning involved. The contested food-and-drink services target a broader and different public seeking dining services in a context distinct from luxury hotel accommodation.
- The signs themselves also differ: ‘TABERNA’, ‘1872’ and the figurative elements alter the contested sign’s overall impression and create a distinct identity from ‘WALDORF ASTORIA’.
- Taken together, the visual and conceptual differences, the different services, commercial positioning and public perception make it unlikely that consumers would assume a common commercial origin.
- The marks therefore evoke different commercial realities and operate in distinct hospitality and gastronomy contexts.
- Consequently, the public is unlikely to believe that the contested services are connected with, authorised by or economically linked to the opponent. The conditions for the application of Article 8(1)(b) EUTMR are not fulfilled.
- Accordingly, the signs can coexist without leading consumers to believe that they share the same commercial origin.

14 The arguments raised in response to the appeal may be summarised as follows.

The sole complaint of the applicant: alleging that there is no likelihood of confusion

- In its statement of appeal, the applicant has put forward, in essence, one sole ground of appeal, namely that the conditions required for the application of Article 8(1)(b) EUTMR would not have been fulfilled and that there would thus be no likelihood of confusion between the signs at issue. Accordingly, the applicant requests that the contested sign should proceed for registration in its entirety.
- The applicant has not put forward any complaint or argument regarding Article 8(5) EUTMR, which was the basis on which the Opposition Division concluded that the opposition was well founded. The applicant has thus, in fact, not contested the arguments and considerations of the Opposition Division at all.
- Moreover, the applicant has explicitly acknowledged the reputation of Hilton’s earlier mark by stating that: ‘The earlier mark “WALDORF ASTORIA” will generally be understood by the relevant public as referring to a well-known luxury hospitality mark associated with luxury hotel services. The expression is widely recognised as the name of an international hotel chain operating extravagant establishments in various cities around the world’.
- Since the opposition succeeded entirely under Article 8(5) EUTMR, the Opposition Division rightly found it unnecessary to examine the remaining ground or earlier

rights. Although likelihood of confusion may be relevant to the assessment of a link, the Opposition Division did not examine Article 8(1)(b) EUTMR because there was no procedural need to do so.

- In assessing the link, the Opposition Division correctly noted that the relevant criteria are not exhaustive and established a link on the basis of the signs’ similarity, the earlier mark’s reputation and the close connection between the services.
- For these reasons alone, the appeal must be rejected in its entirety as inadmissible for lack of any relevant grounds of appeal. Alternatively, if deemed admissible, the appeal should be dismissed as unfounded, and/or rejected as ineffective in its entirety, since none of the arguments put forward by the applicant in its grounds of appeal statement cast any doubt on the *ratio decidendi* of the Opposition Division.
- If the Board considers an Article 8(1)(b) EUTMR assessment necessary, the opponent requests that it (i) take into account Hilton’s first-instance submissions on Article 8(1)(b) EUTMR (paragraphs 5.1-5.32 of its observations and 3.5-3.29 of its reply to observations); and (ii) allow the opponent to file further observations in response to the applicant’s grounds of appeal.

Reasons

- 15 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 16 The applicant appealed the contested decision in its entirety since the opposition was upheld for all the contested services and the contested sign was rejected in its entirety.
- 17 Therefore, the Board will examine the contested decision in full.
- 18 The opposition was based on both Article 8(1)(b) EUTMR (likelihood of confusion) and Article 8(5) EUTMR (reputation). The contested decision based its assessment on Article 8(5) EUTMR. However, in its statement of grounds, the applicant restricted its argumentation to the criteria applicable under Article 8(1)(b) EUTMR.
- 19 Therefore, the Board will take into account the applicant’s arguments to first revise the Opposition Division’s assessment under Article 8(5) EUTMR, where applicable.
- 20 The Board finally notes that the applicant has not raised any specific plea against the Opposition Division’s findings on proof of use of **earlier mark 1**. The statement of grounds is directed exclusively to the comparison of the signs, the comparison of the services, and the alleged absence of confusion or association. Accordingly, the findings on proof of use are not disputed on appeal. In any event, the Board sees no reason to depart from the Opposition Division’s assessment in that regard and confirms its findings.

Confidentiality request

- 21 The opponent requested that part of the evidence on reputation of the earlier mark (submitted at first instance) be treated as confidential vis-à-vis third parties because of its

special interest in keeping them confidential. Therefore, the Opposition Division described the evidence in general terms without disclosing sensitive commercial information.

- 22 In accordance with Article 114(4) EUTMR, files may contain certain documents that are excluded from public inspection (e.g. parts of the file that the party concerned shows a special interest in keeping confidential).
- 23 In the event that a special interest in keeping a document confidential, in accordance with this provision, is invoked, the Office must check whether that special interest is sufficiently shown. Such a special interest exists because of the confidential nature of the document or its status as a trade or business secret.
- 24 In the present case, the Board confirms that there is no need to refer to any evidence that would divulge data that is not otherwise available from publicly accessible sources, and therefore this evidence is properly deemed confidential.

Article 8(5) EUTMR (reputation)

- 25 According to Article 8(5) EUTMR, an opposition to an application for an EUTM may be based on an earlier mark that has a reputation in the European Union or on an earlier national mark with a reputation in the Member State concerned, even though the earlier mark is registered for goods or services that are not similar to the goods or services covered by the application, provided that 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.
- 26 Although the primary function of a mark is that of an indication of origin, the fact remains that a mark also acts as a means of conveying other messages concerning, inter alia, the qualities or particular characteristics of the goods or services which it covers or the images and feelings which it conveys. To that effect, each mark has an inherent economic value independent of and separate from that of the goods or services for which it is registered. The messages conveyed, inter alia, by a mark with a reputation, or that are associated with it, confer on that mark a significant value that deserves protection, particularly because, in most cases, the reputation of a mark is the result of considerable effort and investment on the part of its proprietor (22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 35; 07/12/2022, T-623/21, Puma / Puma (fig.), EU:T:2022:776, § 19; 24/05/2023, T-509/22, BimboBIKE (fig.) / BIMBO et al., EU:T:2023:281, § 19; 21/12/2022, T-4/22, PUMA (fig.) / PUMA (fig.) et al., EU:T:2022:850, § 18).
- 27 The application of Article 8(5) EUTMR is therefore subject to the following conditions:
 - The earlier mark has a reputation in the territory in which it is registered. That reputation must predate the contested mark's filing date, must exist in the relevant territory and must relate to the goods and/or services on which the opposition is based.
 - The signs are identical or similar.
 - Risk of injury, namely the use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
 - There is no due cause justifying the use of the mark applied for.

- 28 These conditions are cumulative, and failure to satisfy one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 30; 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 20-21; 28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133, § 18).

Reputation of earlier EUTM registration No 1 852 946 ‘Waldorf Astoria’ (earlier mark 1)

- 29 In order to satisfy the requirement of reputation, the earlier mark must be known to a significant part of the public concerned by the goods and services covered by the mark (26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU:T:2019:444, § 15 and the case-law cited). The Court has held in this regard that a mark does not need to be known by a specific percentage of the relevant public in order to be regarded as having a reputation (06/02/2007, T-477/04, TDK / TDK, EU:T:2007:35, § 49), or for it to have a reputation throughout the relevant territory as long as it has a reputation in a substantial part of it (06/10/2009, C-301/07, PAGO, EU:C:2009:611, § 27; 16/10/2018, T-548/17, ANOKHI / Kipling, EU:T:2018:686, § 94 and the case-law cited).
- 30 In the context of the assessment of reputation, account must be taken of all the facts relevant to the case, in particular 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 (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 34; 02/10/2015, T-624/13, Darjeeling, EU:T:2015:743, § 75). However, the above list being merely illustrative, it cannot be required that proof of the reputation of a mark pertains to all these elements (08/11/2017, T-754/16, CC / O, EU:T:2017:786, § 101; 26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU:T:2019:444, § 24).
- 31 Taking into account all the relevant criteria, namely, the frequent and regular exposure of the public to the mark through publications, as well as the awards and rankings showing the recognition of the earlier mark for hotel services, the Opposition Division concluded that the earlier mark has been proved to enjoy some degree of recognition among the relevant public in relation to at least *hotel services* in the Netherlands.
- 32 This conclusion was not disputed by the parties.
- 33 In the absence of arguments to dispute the contested decision’s findings, the Board may lawfully adopt the reasoning of the contested decision, which then becomes an integral part of the Board’s own decision (13/09/2010, T-292/08, OFTEN / OLTEN et al., EU:T:2010:399, § 48; 11/09/2014, T-450/11, GALILEO (fig.) / GALILEO, EU:T:2014:771, § 36; 06/02/2020, T-135/19, LaTV3D / TV3, EU:T:2020:36, § 19). Following the examination of the evidence submitted by the opponent, the Board sees no obvious reason to reverse the contested decision’s correct findings and hereby endorses the contested decision’s reasoning and conclusion regarding the reputation of the earlier mark.
- 34 The applicant expressly stated that the earlier mark will generally be understood by the relevant public as referring to a well-known luxury hospitality mark associated with luxury hotel services, and that it is widely recognised as the name of an international hotel chain operating extravagant establishments in various cities around the world.

- 35 The Board therefore confirms that the earlier mark has been subject to long-standing and intensive use and enjoys reputation to an average degree on the relevant market of *hotel and motel services* in Class 42.

Relevant public and territory

- 36 The public amongst whom the earlier trade mark must have acquired a reputation is that public concerned by that trade mark, that is to say, depending on the goods or services 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).
- 37 The opponent's *hotel and motel services* in Class 43 target both the public at large and the professional public (e.g. people travelling for private or business reasons and/or specialists in temporary accommodation services).
- 38 The applicant's various advertising and promotional services in Class 35 target the professional public (i.e. people interested in promoting their business activities), and the *services for providing food and drink; bistro services; providing food and drink in bistros; serving of alcoholic beverages* in Class 43 target both the public at large and the professional public (e.g. specialists in the restauration sector).
- 39 It is therefore necessary to take into account the section of the overlapping relevant public (business travellers and hospitality-sector professionals).
- 40 The earlier mark is an EUTM. Therefore, the relevant territory is the European Union.
- 41 It follows from the unitary effect of the European Union trade mark under Article 1(2) EUTMR that a trade mark application (including an IR designating the EU) may be refused registration if a relative ground for refusal exists only in part of the European Union (18/09/2008, C-514/06 P, ARMAFOAM / NOMAFOAM, EU:C:2008:511, § 57; 13/12/2011, T-61/09, Schinken King / Curry King et al., EU:T:2011:733, § 32; 03/06/2015, T-544/12, PENSA PHARMA, EU:T:2015:355, § 42; 05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 84).
- 42 In line with the Opposition Division's approach, which was, moreover, not disputed by the parties, the Board will focus the comparison of the signs on the Dutch-speaking part of the relevant public because, as shown above, the reputation has been demonstrated in the Netherlands.

Similarity between the signs

- 43 The types of injury referred to in Article 8(5) EUTMR, where they occur, are the consequence of a certain degree of similarity between the earlier mark and the later mark, 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 they do not confuse them (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 30; 28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133, § 19).

- 44 According to case-law, in order to satisfy the condition that the signs at issue must be identical or similar, laid down by Article 8(5) EUTMR, it is not necessary to prove that there is, on the part of the relevant section of the public, a likelihood of confusion between the earlier mark with an alleged reputation and the mark applied for. It is sufficient for the degree of similarity between those marks to have the effect that the relevant section of the public establishes a link between them (28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133, § 27; 21/04/2021, T-44/20, DEVICE OF TWO INTERLOCKING ELEMENTS (fig.) / DEVICE OF TWO BOLD BLACK CIRCLES OVERLAPPING (fig.), EU:T:2021:207, § 23).
- 45 The comparison of the signs at issue must, insofar as the visual, phonetic and conceptual similarities are concerned, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements (28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133, § 28).
- 46 The signs to be compared are:

Waldorf Astoria	
<i>Earlier mark</i>	<i>Contested sign</i>

- 47 The earlier mark is a word mark consisting of the two verbal elements ‘WALDORF’ and ‘ASTORIA’ (14 letters overall). The protection that results from registration of a word mark concerns the word mentioned and not the specific graphic or stylistic elements accompanying that mark (13/02/2007, T-353/04, CURON / EURON, EU:T:2007:47, § 74; 18/11/2020, T-21/20, K7 / K7, EU:T:2020:550, § 40). It follows that a word mark may be used in any form, in any colour or font type (23/03/2022, T-146/21, Deltatic / Delta, EU:T:2022:159, § 56).
- 48 The contested sign is a figurative mark comprising the verbal elements ‘TABERNA’, ‘astoria’ and ‘1872’ (14 letters and 4 numerals overall), displayed within an oval border. The element ‘astoria’ appears in a large, stylised typeface and occupies the central position in the sign. The word ‘TABERNA’ is placed above it in significantly smaller letters, whilst the number ‘1872’ appears below it.

Distinctive and dominant elements

- 49 As correctly stated by the Opposition Division and not disputed by the parties, English is widely understood in the Netherlands (09/12/2010, T-307/09, NATURALLY ACTIVE, EU:T:2010:509, § 26-27; 20/01/2021, T-253/20, It’s like milk but made for humans, EU:T:2021:21, § 35).

- 50 From the perspective of the Dutch-speaking relevant public, the coinciding term ‘ASTORIA’ has no generally recognised meaning and will be perceived as a fanciful term. The term ‘WALDORF’ is likewise devoid of an immediately apparent meaning for the relevant public.
- 51 In the contested sign, ‘TABERNA’ is likely to be perceived as a word referring to a tavern or eating establishment by at least part of the relevant public familiar with the English equivalent word ‘tavern’ (referring to a place where people gather to drink and be served food) or with international hospitality terminology. In relation to the contested services in Class 43, that element possesses, at most, a weak distinctive character, whereas it is less directly descriptive for the Class 35 services. The number ‘1872’ will be perceived as the year designating the creation of an industrial or commercial establishment or of a specific product or service. It is, therefore, descriptive of the year in which the establishment of the brand or company behind the services in question took place.
- 52 The earlier word mark does not have a dominant element since, by its nature, none of the constituent elements has a particular graphic or stylistic aspect capable of giving it this dominant character (02/03/2022, T-149/21, Vitadha / Vitanadh et al., EU:T:2022:103, § 79).
- 53 In the contested sign, the element ‘astoria’ is visually dominant owing to its central position, substantially larger size and stylised depiction. By contrast, the elements ‘TABERNA’ and ‘1872’ occupy secondary positions and are likely to play a subordinate role in the overall impression conveyed by the sign.
- 54 Therefore, the coinciding seven-letter verbal element ‘ASTORIA’/‘astoria’ will play an independent and distinctive role in the comparison of the signs.

Visual, phonetical and conceptual similarities

- 55 **Visually**, the signs are similar to an **average degree**. The signs coincide in the identical element ‘ASTORIA’/‘astoria’, which is reproduced in its entirety in the contested sign in the same (second) position. That element constitutes one of the two verbal components of the earlier mark, namely half of the earlier mark (7 out of 14 letters of the compared verbal elements).
- 56 The signs differ in: (i) their additional verbal elements placed in the first position of each sign respectively, namely the earlier mark’s distinctive element ‘WALDORF’ and the contested sign’s non-distinctive element ‘TABERNA’; (ii) the non-distinctive number ‘1872’ in the contested sign; and (iii) the contested sign’s non-distinctive figurative components consisting of the verbal elements arranged within an oval border and the slightly stylised typography of ‘astoria’. Nevertheless, the coincidence in the distinctive element ‘ASTORIA’, which is the dominant distinctive component of the contested sign and the independent distinctive component of the earlier mark, cannot be overlooked.
- 57 **Aurally**, the signs are similar to an **average degree**. The earlier mark will be pronounced as ‘WAL-DORF A-STO-RI-A’, comprising six syllables in total. The contested sign is likely to be verbalised as ‘TA-BER-NA A-STO-RI-A’, comprising seven syllables in total, whilst the number ‘1872’ is unlikely to be consistently pronounced and may be omitted by consumers.

- 58 The signs coincide completely in the pronunciation of the word ‘ASTORIA’, which constitutes a substantial part of both signs and will be clearly audible when the marks are pronounced. The signs differ, however, in their first verbal elements, namely ‘WALDORF’ and ‘TABERNA’, which are phonetically distinct in terms of sound, rhythm and articulation. Given that consumers generally pay particular attention to the beginning of signs, those differences can influence the overall aural impression.
- 59 **Conceptually**, neither ‘WALDORF’ nor ‘ASTORIA’ is likely to convey a clear and immediate meaning to the relevant Dutch-speaking public. The earlier mark as a whole will therefore generally be perceived as a combination of fanciful terms. In the contested sign, the element ‘TABERNA’ may evoke the concept of a tavern or eating establishment for part of the relevant public, whilst the number ‘1872’ may be perceived as a reference to a year. However, the dominant element ‘ASTORIA’ does not convey a clear concept.
- 60 Accordingly, the contested sign may give rise to a limited conceptual association with a hospitality establishment, whereas the earlier mark is largely conceptually neutral. Since the coinciding element ‘ASTORIA’ does not have a recognised meaning for the relevant public, it does not contribute to conceptual similarity. The signs are therefore **conceptually different** or, for a substantial part of the relevant public, **conceptually neutral**, rendering the conceptual comparison of limited significance.
- 61 The applicant argues that the marks convey fundamentally different concepts. According to the applicant, ‘WALDORF ASTORIA’ is perceived as the name of a renowned luxury hotel brand associated with international hospitality, exclusivity and premium accommodation services. By contrast, ‘TABERNA ASTORIA 1872’ allegedly evokes a traditional gastronomic establishment rooted in local culture and culinary heritage. The term ‘TABERNA’ directs consumers towards a restaurant or tavern setting, while ‘1872’ reinforces an impression of history and tradition. The applicant further submits that ‘ASTORIA’ in the contested sign refers to the former Cines Astoria in Málaga, a local cultural landmark, and therefore carries a distinct local historical significance rather than any reference to the opponent’s hotel brand. On that basis, the applicant concludes that the marks evoke different commercial realities, namely an international luxury hotel group on the one hand and a traditional local gastronomic venue on the other, thereby excluding any commercial association between them.
- 62 Firstly, the alleged reference to the former Cines Astoria in Málaga is not apparent from the contested sign itself. The average consumer in the Netherlands, who is the relevant public in the present case, is unlikely to perceive or recognise that specific local historical reference. The conceptual meaning attributed by the applicant therefore depends on external circumstances rather than on the sign as filed.
- 63 Secondly, while the element ‘TABERNA’ may evoke a traditional dining establishment and ‘1872’ may suggest a historical origin, those additional concepts do not eliminate the presence of the word ‘ASTORIA’, which remains the dominant element of the contested sign. The relevant public is unlikely to perceive ‘ASTORIA’ as referring to a specific cinema in Málaga and may instead regard it as a fanciful term without an immediately obvious meaning.
- 64 The Board therefore concludes that the conceptual differences relied upon by the applicant are not sufficient to neutralise the visual and aural similarities between the signs as analysed above.

- 65 Overall, the signs coincide in the distinctive element ‘ASTORIA’, which is reproduced in its entirety in the contested sign and constitutes the dominant component thereof. However, they differ in their remaining verbal elements, their overall structure and, in particular, the figurative depiction of the contested sign. The signs are visually and aurally similar to an average degree, while the conceptual comparison is neutral or points to insignificant differences.

Existence of a link between the signs

- 66 The existence of a link between the marks in conflict, as well as the existence of a serious risk that any of the infringements provided for in Article 8(5) EUTMR will be committed in the future, must be assessed globally, taking into account all factors relevant to each case, including, inter alia, the following criteria: the degree of similarity between the marks in conflict; the degree of proximity or differentiation between the goods or services, as well as the relevant public; the strength of the earlier mark’s reputation; the strength of the distinctive character of the earlier mark, whether intrinsic or acquired through use; and the existence of a likelihood of confusion on the part of the public (03/09/2025, T-302/24, OMV! / OMV (fig.) et al., EU:T:2025:822, § 39).
- 67 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.

a) The degree of similarity between the signs

- 68 The signs are overall similar to an average degree, as analysed above.

b) The strength of the earlier mark’s reputation

- 69 As already demonstrated above, the earlier mark enjoys an average reputation on the relevant market of *hotel and motel services* in Class 43 in the Netherlands and is recognised worldwide.

c) The degree of the earlier mark’s distinctive character, whether inherent or acquired through use

- 70 The earlier mark is reputed in the Netherlands for the designated *hotel and motel services* in Class 42, which demonstrates the distinctive character acquired through use of the earlier mark.

d) The degree of closeness or similarity between the services and the relevant public

- 71 When assessing the link between the signs for the application of Article 8(5) EUTMR, the goods and services at issue need not necessarily be similar within the meaning of Article 8(1)(b) EUTMR. The wording of Article 8(5) EUTMR is clear: it may be invoked whether or not the goods and services under comparison are identical or similar (22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 33; 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 76).

- 72 It is apparent from case-law that the fact that the goods or services in question are different does not preclude a certain proximity between them (04/10/2017, T-411/15, GAPPOL (fig.) / GAP et al., EU:T:2017:689, § 193). The concepts of ‘similarity’ and ‘proximity’ between the goods and services in question should not be confused. The similarity between the goods and services covered by the marks at issue does not constitute a condition for the application of Article 8(5) EUTMR, whereas it does constitute one of the cumulative conditions for the application of Article 8(1) EUTMR. The concept of the ‘proximity’ between the goods and services, for the purposes of the application of Article 8(5) EUTMR, must be understood as the existence of a simple connection between those goods and services (04/10/2018, T-150/17, FLÜGEL / VERLEIHT FLÜGEL et al., EU:T:2018:641, § 79; 30/03/2022, T-445/21, Copalli / Compal et al., EU:T:2022:198, § 48).
- 73 In the present case, the earlier mark enjoys an average reputation in the Netherlands for *hotel and motel services* in Class 42, and the contested sign seeks protection for various advertising and promotional services in Class 35, as well as for restauration/bar-related services in Class 43.
- 74 The contested *services for providing food and drink; bistro services; providing food and drink in bistros; serving of alcoholic beverages* in Class 43 are **similar to a low degree** to the earlier *hotel and motel services* in the same class. Although they differ in nature and immediate purpose, the former consisting of catering services / beverage provision and the latter of accommodation services, they all have the same hospitality-oriented character and are frequently offered by the same undertakings operating within the hospitality industry. Consumers commonly encounter food and beverage services within hotels and motels, and both services aim to satisfy hospitality-related needs of the same public.
- 75 Although the contested services in Class 35, namely *dissemination of advertisements via the internet; commercial information services, via the internet; advertising via electronic media and specifically the internet; providing consumer product information via the internet; distribution of promotional matter; promotion [advertising] of business; advertising, marketing and promotional services; promotion of goods and services through sponsorship; advertising services for the promotion of beverages*, primarily target business customers and differ in nature and purpose from the earlier *hotel services* in Class 42, this does not preclude the establishment of a link within the meaning of Article 8(5) EUTMR.
- 76 The earlier mark enjoys a reputation in the Netherlands in relation to hotel services and is therefore known to a significant part of the relevant public. The relevant public for the contested services consists of business professionals and undertakings, a category of consumers that is also likely to be exposed to and be aware of reputed hotel chains and hospitality brands. Moreover, in the modern marketplace, advertising, promotional and sponsorship activities constitute an essential aspect of the operation and development of reputed hotel businesses. As a result, the relevant public may reasonably associate the contested advertising and promotional services offered under the contested mark with the proprietor of the reputed earlier mark, perceiving them as an extension or diversification of the latter’s commercial activities. Consequently, notwithstanding the dissimilarity of the respective services, the reputation of the earlier mark, combined with the similarity of the signs, is capable of giving rise to a mental link in the minds of the relevant public. Therefore, the Opposition Division was correct in finding that an association between the contested services in Class 35 and the reputed earlier mark remains possible.

- 77 The case-law recognises that an overlap may exist even where the contested services target professionals and the earlier mark is known to the general public, since the same persons may encounter both marks in different contexts. In particular, professionals may form part of the general public and may therefore be familiar with reputed marks known beyond their immediate commercial sphere (10/05/2012, C-100/11 P, BOTOLIST + BOTOCYL, EU:C:2012:285, § 66; 25/01/2024, T-266/23, puma soundproofing (fig.) / PUMA (fig.) et al., EU:T:2024:138, § 22-23; 28/02/2024, T-184/23, BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al., EU:T:2024:133, § 21-22).
- 78 Furthermore, market realities such as brand extension, sponsorship, merchandising and expansion into adjacent commercial activities are relevant factors when assessing whether a reputed mark may be brought to mind by a later sign (01/02/2023, T-569/21, Google car / Google et al., EU:T:2023:38, § 23, 32; 01/02/2023, T-568/21, GC GOOGLE CAR (fig.) / Google et al., EU:T:2023:37, § 51-52, 55, where the Court accepted that consumers could establish a connection between highly reputed services and commercially distinct goods on account of the reputation and commercial elasticity of the earlier mark). In the present case, advertising, marketing and sponsorship activities constitute a normal and significant aspect of the operation and promotion of hotel businesses. Consequently, the relevant public, when confronted with the contested advertising and promotional services under the contested sign, may perceive them as an extension or diversification of the commercial activities carried out under the reputed earlier mark. Therefore, notwithstanding the dissimilarity of the respective services, it cannot be excluded that the contested sign will bring the earlier mark to mind and that the relevant public will establish the requisite mental link between the signs.
- 79 Consequently, although the services at issue in Class 43 are similar to a low degree and the contested services in Class 35 are dissimilar to the earlier *hotel and motel services* in Class 42, since the relevant overlapping public (business travellers and hospitality-sector professionals) may encounter both marks in different contexts, any proximity between those services cannot be ruled out.

e) Conclusion on the existence of a link

- 80 Consideration is given to all the relevant factors, in particular that the marks at issue are similar to at least an average degree, the earlier mark is reputed in the Netherlands and internationally recognised by the relevant public, and, while partly similar to a low degree and partly dissimilar, the services at issue have a certain proximity. Therefore, the Board considers that the overlapping public (business travellers and hospitality-sector professionals) will naturally establish a mental link between the signs.
- 81 In the present case, such a link is not only possible but likely, as the earlier mark is reputed

for *hotel and motel services* in Class 42. Indeed, it is likely that the sign , when encountered in relation to the contested services, would bring to the mind of the travelling consumer the reputed hospitality mark ‘WALDORF ASTORIA’ associated with luxury hotel services and known as an international hotel chain operating extravagant establishments in various cities around the world. The relevant public may consequently perceive the applicant’s restaurant/bar-related services in Class 43 and



advertising/promotional services in Class 35 as associated with, or at least endorsed by, the opponent's reputed mark.

- 82 The condition related to the existence of a link is therefore fulfilled.
- 83 The applicant submits that the reputation of the earlier mark 'WALDORF ASTORIA' reinforces, rather than diminishes, the distinction between the signs. According to the applicant, the earlier mark is associated by consumers with luxury hotel services provided by a prestigious international hotel operator; by contrast, the contested sign would be perceived as designating a traditional gastronomic establishment offering food and beverages, as well as certain advertising and promotional services. The respective services allegedly belong to different commercial contexts, satisfy different consumer needs and target different consumer groups. Consumers seeking luxury accommodation are said to display a higher level of attention and to perceive the earlier mark as referring specifically to premium hotel services, whereas consumers encountering the contested sign would perceive it as referring to a dining establishment. The applicant further argues that the additional verbal elements 'TABERNA' and '1872', together with the figurative elements of the contested sign, clearly differentiate the signs and create a distinct overall commercial impression.
- 84 The applicant's arguments largely rely on the differences between the respective establishments and services and on the absence of a likelihood of confusion. However, the relevant question under Article 8(5) EUTMR is not whether consumers would believe that the services originate from the same undertaking, but whether the contested sign would bring the reputed earlier mark to mind. Given the coincidence in the distinctive element 'ASTORIA', the reputation established for the earlier mark, and the fact that hospitality, restaurant, advertising and promotional activities may be encountered by overlapping consumers (business travellers and hospitality-sector professionals), it cannot be excluded that the relevant public would establish a mental link between the signs, notwithstanding the differences in their respective commercial positioning and services. Accordingly, the applicant's arguments do not appear sufficient, in themselves, to rule out the existence of a link under Article 8(5) EUTMR.
- 85 Finally, the applicant argues that hotel consumers exercise a high degree of attention because hotel bookings are important and expensive.
- 86 However, although consumers of luxury hotel services are likely to display a relatively high level of attention, this does not exclude the existence of a link. As already mentioned above, Article 8(5) EUTMR does not require a likelihood of confusion, but only that the relevant public establish a mental connection between the signs. Consequently, even a particularly attentive public may, when confronted with the contested sign, call the reputed earlier mark to mind.

Use which would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark

- 87 The Opposition Division concluded that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.
- 88 This finding has not been disputed by the parties.

- 89 In the absence of arguments to dispute the contested decision's findings, the Board may lawfully adopt the reasoning of the contested decision, which then becomes an integral part of the Board's own decision (13/09/2010, T-292/08, *OFTEN / OLTEN et al.*, EU:T:2010:399, § 48; 11/09/2014, T-450/11, *GALILEO (fig.) / GALILEO*, EU:T:2014:771, § 36; 06/02/2020, T-135/19, *LaTV3D / TV3*, EU:T:2020:36, § 19). Following the examination of the relevant arguments presented before the Opposition Division, the Board sees no obvious reason to reverse the contested decision's correct findings and hereby endorses the contested decision's reasoning and conclusion regarding the risk of injury of the earlier mark.

Due cause

- 90 The Opposition Division noted that the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it was assumed that no due cause exists.
- 91 This finding, which is, moreover, correct, was not disputed by the parties.

Conclusion

- 92 Given that the opposition is entirely successful under Article 8(5) EUTMR on the basis of the opponent's EUTM No 1 852 946 '*Waldorf Astoria*' (***earlier mark 1***), it is not necessary to examine the remaining ground and the other earlier rights invoked.
- 93 In light of the above, the appeal must be dismissed, the contested decision fully confirmed, the opposition fully upheld, and the contested mark refused registration in its entirety.

Costs

- 94 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.
- 95 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 96 As to the opposition proceedings, the applicant must reimburse the opposition fee of EUR 320 and the opponent's costs of professional representation of EUR 300. This decision remains unaffected.
- 97 The total amount for both proceedings is therefore EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal.**
- 2. Orders the applicant to bear the opponent's costs incurred in the appeal and opposition proceedings in the amount of EUR 1 170.**

Signed

V. Melgar

Signed

R. Ocquet

Signed

A. Pohlmann

Registrar:

Signed

K. Zajfert

